

This Opinion is Not a
Precedent of the TTAB

Mailed: June 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Essenlix Corporation

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Serial No. 87467392

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Julian D. Gonzalez,
for Essenlix Corporation.

Natalie L. Kenealy, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Taylor, Kuczma and Larkin,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Essenlix Corporation (“Applicant”) seeks registration on the Principal Register of the term ISELF-TEST (in standard characters¹) as a mark for the following goods and services, as amended:

Assays for research purposes; Biochemical reagents
commonly known as probes, for detecting and analyzing

¹ We recognize that Applicant has applied for a standard character mark. As such, the mark may be presented in any style, regardless of font, size, or color. *See In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012). We note, however, that the drawing page displays the applied-for mark as iSELF-TEST, but we will display the mark in this opinion as ISELF-TEST. *See In re Calphalon Corp.*, 122 USPQ2d 1153, 1154 n.1 (TTAB 2017).

molecules in protein or nucleotide arrays; Biochemical reagents used for non-medical purposes; Biochemicals for in vitro and in vivo scientific use in International Class 1;

Medical apparatus and instrument for diagnostic use, namely, apparatus for medical diagnostic testing in the fields of cancer or other tissue-based diagnostic testing, cytology and cell-based testing; Medical devices for obtaining body fluid samples; Medical diagnostic instruments for the analysis of body fluids; Medical diagnostic apparatus for testing cells and biomolecules in International Class 10; and

Medical assistance; Medical consultations; Medical counseling; Medical information; Medical services in International Class 44.²

The Trademark Examining Attorney refused registration of Applicant's applied-for mark for the identified goods and services in Classes 1, 10 and 44 on the ground that it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1051(e)(1).³

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. For the reasons discussed, we affirm the refusal to register.

² Application Serial No. 87467392 was filed on May 29, 2017, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ The Examining Attorney also required Applicant to provide information and documentation regarding the nature of Applicant's goods and services and the wording appearing in the mark. Although the information requirement was made final, Applicant satisfied this requirement in its request for reconsideration, and it was so noted by the Examining Attorney in her September 19, 2018 denial of Applicant's request for reconsideration.

I. Applicable Law

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used.⁴ *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (internal citations omitted); *see also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r*, 252 U.S. 538, 543 (1920) (“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark.”)). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Id.*; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). It is also not necessary to find each and every good and service listed in each class of the recited goods and services descriptive. If a proposed mark is held descriptive for any of the goods or services identified in a class of an involved application, registration is properly refused as to the entire class. *See*

⁴ We thus find unavailing Applicant’s contention at page 4 of its brief (9 TTABVue 5) that “merely descriptive marks identify the goods themselves or call to the consumer’s mind the most recognizable quality or characteristic of the product.”

In re Sterotaxis Inc., 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) (quoting *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975) (“Our predecessor court ... has stated that ‘registration should be refused if the mark is descriptive of any of the goods [or services] for which registration is sought”)); *In re Quick-Print Copy Shop, Inc.*, 205 USPQ 505, 507.

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a non-descriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). A mark comprising a combination of merely descriptive components is registrable only if the combination of terms creates a unique, suggestive, or otherwise non-descriptive meaning, *see, e.g., In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515-16 (TTAB 2016), or if the composite has a bizarre or incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983). If, however, when the mark is considered as a whole, the merely descriptive components retain their merely descriptive significance in relation to the goods and services, then the resulting combination is also merely descriptive. *See, e.g., In re Oppedahl & Larson*, 71 USPQ2d at 1371.

Lastly, a mark comprising more than one element must be considered as a whole and should not be dissected; however, we may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1756-

57 (Fed. Cir. 2012) (reversing the Board’s denial of cancellation for **Snap!** for medical devices as not merely descriptive, but noting that “[t]he Board to be sure, can ascertain the meaning and weight of each of the components that makes up the mark”).

II. Arguments and Evidence

Applicant maintains that its applied-for ISELF-TEST mark is at most suggestive and therefore registrable. Applicant particularly argues that its mark is not merely descriptive because it has multiple connotations, and because “Applicant’s prospective customers must utilize imagination, thought and perception to tie the term ISELF-TEST to its [Applicant’s] products.”⁵ In support of its position, Applicant attached to its brief multiple definitions of the letter “I” from the MERRIAM-WEBSTER on-line dictionary and Acronym Finder, of which we presume Applicant requests, and we take, judicial notice.⁶ For example, the letter “I” is defined by MERRIAM-WEBSTER in part as “the one who is speaking or writing,”⁷ and the Acronym Finder defines “I,” in part, as “immediate.”⁸

⁵ 9 TTABVUE 6. The TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents. Complete Urls can be found at the TSDR cite.

⁶ *Id.* at 15-37. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (*Fed. Cir. 2016*); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁷ *Id.* at 18.

⁸ *Id.* at 35.

The Examining Attorney conversely maintains that the term ISELF-TEST immediately describes features or characteristics of Applicant's identified goods and services, namely that they will be "in the nature of a test that one can use themselves that utilizes the Internet."⁹ In support of her position, the Examining Attorney introduced the following to show that the letter "i" or "I" used as a prefix means "Internet":¹⁰

1. Definitions of "i" or "I":

Acronym Finder.com indicates "I" stands for "Internet";¹¹

Wikipedia.org indicates consumer recognition of "I" as an "Internet-related prefix," that has been widely used by companies to stand for "Internet";¹²

Wikipedia defines "I" as "[a]lluding to the Internet."¹³

2. Third-party registrations for marks with the letter "I" (combined with descriptive matter) that are used on or in connection with Internet-based goods and/or services, where the mark was registered on the Supplemental Register.¹⁴ Third-party registrations featuring goods and/or services the same or similar to the applicant's goods and/or services may be probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under

⁹ We note that during prosecution, the word Internet was capitalized in some instances and not in others. For consistency, we will capitalize the word throughout the decision, except when used in a quote.

¹⁰ 10 TTABVUE 4.

¹¹ August 4, 2017 Office Action at TSDR 6.

¹² September 19, 2018 Denial of Request for Reconsideration at TSDR 14-15.

¹³ *Id.* at TSDR 19.

¹⁴ *Id.* at TSDR 26-47.

Trademark Act Section 2(f), or registered on the Supplemental Register. *See In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) (citing *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-28, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992)). The registrations include, by way of example:

Registration No. 4303012 for the mark IHEALTH for, in part, “Providing an interactive website featuring information and links relating to healthy living and weight loss; ... Providing wellness services, namely, personal assessments, personalized routines, maintenance schedules, and counseling; Providing wellness services, namely, weight loss programs offered at a wellness center; Provision of health care and medical services by health care professionals via the Internet or telecommunication networks; Provision of medical services by health care professionals via the Internet or telecommunication networks; ... Web-based cardiovascular analysis services for medical diagnostic and treatment purposes; ... Web-based health assessment services, namely, a series of health-related questions for response from the user that result in a report that provides health-related information in the form of recommended educational resources and treatment information; ... Wellness and health-related consulting services”;¹⁵

Registration No. 4303013 for the mark IHEALTH for “In-vitro ovulation prediction test kit for home use; Ovulation test kits; Pregnancy test kits for home use; Test strips for measuring blood glucose levels”;¹⁶

Registration No. 4476313 for the mark IVET for “Providing temporary use of on-line non-downloadable computer application software for mobile phones, namely, software for transmitting and sharing information about veterinary services, veterinary office locations, animal health and pet nutrition; providing temporary use of on-line non-downloadable computer software for creating searchable databases of information and data; providing temporary

¹⁵ Id. at TSDR 31-33.

¹⁶ Id. at TSDR 34-35.

use of on-line non-downloadable computer software for providing an on-line database of information in the field of veterinary services, veterinary office locations, animal health and pet nutrition”;¹⁷

Registration No. 4753586 for the mark ISYNC for “Computer software for managing chronic and acute disease in and out-of-hospital settings through the collaboration of health care providers and consumers to achieve an approach to cultivate disease solutions; downloadable cloud accessed computer software for managing chronic and acute disease in and out-of-hospital settings through the collaboration of health care providers and consumers to achieve an approach to cultivate disease solutions”; and “Cloud computing services featuring software for use in managing chronic disease”;¹⁸ and

Registration No. 5494094 for the mark IHEALTH for “Telemedicine services, namely, the delivery of healthcare services by doctors, medical specialists, nurses, and other healthcare professionals via telemedicine for urgent and non-urgent illnesses and injuries, health maintenance, home healthcare services, mobile healthcare services, preventative healthcare and follow-up services; Providing healthcare information.”¹⁹

To show that the wording SELF-TEST is descriptive when used in connection with Applicant’s identified goods and services, the Examining Attorney also made of record the following:

1. Relevant definitions of “SELF-TEST”

Dictionary.com defines “self-test” as:²⁰

noun 1. “a test that can be administered to oneself”;

¹⁷ Id. at TSDR 36-38.

¹⁸ *Id.* at TSDR 39-41.

¹⁹ Id. at TSDR 45-47.

²⁰ August 4, 2017 Office Action at TSDR 7.

verb 2. [verb] “to administer a test to (oneself).”

2. Various Internet articles and printouts to show “that other entities commonly use the term SELF TEST to describe goods and services that involve methods for users to determine the presence of a disease or ailment themselves and that it is increasingly common for ‘self tests’ to utilize the Internet via smart devices.”²¹ The evidence includes, for example:²²

An article from Genomeweb (www.genomeweb.com) entitled “NIH Commits \$2.6 to Fund Development of Self-Testing HIV Assays” states that “[t]he National Institutes of Health has earmarked \$2.6 million in fiscal 2018 to fund a series of projects aimed at developing HIV diagnostic assays for self testing.”²³

Printouts of product literature from Calpro (<https://calpro.no/wp>) discussing the CalproSmart Self Test Kit for determining Calprotectin levels in human stool samples which integrates with a smartphone application,

²¹ 9 TTABVUE 5.

²² We find references to both the singular and plural forms of “self-test”/“self-tests,” or with or without the hyphen, equally probative. “It is well established that trademarks consisting of singular and plural form of the same term are essentially the same mark.” *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (citing *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of ZOMBIE such that the marks were considered the same mark)). *See also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (“the hyphen in Applicant’s mark MINI-MELTS does not distinguish it from Opposer’s mark [MINI MELTS].”).

We have given the article entitled “Use of diagnostic self-test on body materials among Internet users in the Netherlands: prevalence and correlates of use” no probative value because it discusses the use of self-tests outside of the United States (August 4, 2017 Office Action at TSDR 8-17). We also have not relied on the article entitled “Astraeus Technologies wins MIT \$100K Accelerate with New Lung Cancer Test” (*Id.* at 41-44) because it is unclear whether the new test is self-administered. The articles/printouts from the websites of Women’s Health, Penn State News, Clear Choice, The Baton Rouge Clinic, and Seabrook have some value in that they discuss the trends towards self-diagnosis and self-testing generally, or are comprised of self-tests in question only format. (February 27, 2018 Final Office Action at TSDR 32-40, 45-48, 55-64).

²³ February 27, 2018 Final Office Action at TSDR 8.

and includes reagents and components supplied with the kit. The literature notes that “the test results are automatically sent to the CalproSmart portal, from where they could be viewed by a treating physician.”²⁴

Printouts from Sentara Laboratory Services website (<https://www.sentara.com>) explain that Sentara provides a “self test” through its laboratory services that enables patients in Hampton Roads to order a “variety of tests without a doctor’s order, allowing patients to monitor their health between visits to the doctor.”²⁵

An article from the website of Accelerating Science Award Program [ASAP] (<http://asap.plos.org>) entitled “HIV Self-Test Empowers Patients” discusses an HIV SELF-TEST for patients in the nature of an “integrated approach [which] included HIV education, an online test to determine HIV risk level...” and a “tailored smartphone application.”²⁶

A printout from the U.S. Army website (www.army.mil) features a “self-test kit” that “warns soldiers of biological exposure in the field,” and “transmits the results over Nett Warrior, a field integrated dismounted situational awareness system that displays tactical data on a smartphone.”²⁷

Printouts from Nature.com Scientific Reports (www.nature.com) discuss “a new field of mass manufacturable, ultra-fast smartphone-enabled consumer diagnostics” that would support a “HIV self test for use in the home [that would give] results in under 5 minutes.”²⁸

Printouts from True Diagnostics (<http://truediag.com>) show that it provides “self-testing” test systems that are

²⁴ *Id.* at TSDR 16, 18 and 26.

²⁵ *Id.* at TSDR 41.

²⁶ *Id.* at 54.

²⁷ *Id.* at TSDR 66.

²⁸ *Id.* at TSDR 79, 75.

optionally Wi-Fi® enabled, and that the TrueDX assays are stable at room temperature.²⁹

An article from the U.S. National Library of Medicine at the National Institutes of Health (www.ncbi.nlm.nih.gov) entitled “Perceptions of Self-Testing for Chlamydia: Understanding and Predicting Self-Test Use” states that “[s]elf-test technology allows people to test themselves for illness without intervention from health care professionals” and “self-test use could increase diagnosis amongst people who would not otherwise come forward for testing.”³⁰

An article from DarkDaily (www.stoptheclot.org) entitled “Cheap, Fast, Accurate Home Colon Cancer Test Joins Growing List of Diagnostic Tests Shifting from Medical Laboratories to Homes” states, “[s]teady progress is happening in consumer self-test kits as new diagnostic technology supports at-home kits that produce results with accuracy approaching 90%” for colon cancer detection. The article also notes that “[i]n the U.S., the FDA approved the country’s first rapid at-home saliva test for HIV in July. To address the concerns about the impact of potentially devastating positive test results, the company agreed to provide a 24-hour support hotline.”³¹

Printouts from the website of Atomo Diagnostics (<http://atomodiagnostice.com>) show that Atomo is “spearheading the development of the next generation of HIV self-test products.”³²

Printouts from Metro Health of the University of Michigan Health (<https://metrohealth.net>) discuss a self-test for breath alcohol concentration.³³

A second article from the DarkDaily website (<https://www.darkdaily.com>) entitled “Consumers Increasingly Purchase Medical Laboratory Self-Test Kits

²⁹ February 27, 2018 Final Office Action at TSDR 10-12.

³⁰ August 4, 2017 Office Action at TSDR 19.

³¹ *Id.* at TSDR 36.

³² February 27, 2018 Final Office Action at TSDR 15.

³³ *Id.* at TSDR 43.

for Blood Glucose, Cholesterol, and Colon Cancer Screening, according to Consumer Reports” states that “consumers increasingly purchase medical laboratory self-test kits for blood glucose, cholesterol, and colon cancer screening” and shows that telemedicine is being used in conjunction with in-home testing and video counseling to help manage HIV-related issues.³⁴

III. Analysis/Conclusion

In view of the evidence submitted by the Examining Attorney, we find that the individual components of ISELF-TEST have descriptive significance as used in connection with the identified goods and services. With regard to the letter “I,” we find that the “I-,” a prefix for “Internet,” immediately informs consumers that Applicant’s goods and services will utilize an Internet connection. Notably, although there is no specific reference to the Internet in Applicant’s recitation of goods and services, and Applicant indicated that it is “unlikely” to provide the goods and services online, Applicant admitted that: “Applicant’s goods will utilize internet connection, but expected to utilize [sic] internet to transmit test results to the Cloud and connect nationally and internationally.”³⁵ Four of the five referenced third-party I-formative registrations made of record by the Examining Attorney, e.g., Registration Nos. 4303012, 4303013, 4753586 and 5494094, show that goods and services of the types identified in Applicant’s application are offered for sale or performed via the Internet. Moreover, our conclusion is consistent with Board precedent, in which we have recognized the prefix “i” or “I” is understood by purchasers to signify “Internet.” *See*

³⁴ September 19, 2017 Denial of Request for Reconsideration at TSDR 48.

³⁵ August 27, 2019 Request for Reconsideration at TSDR 5.

In re Zanova, Inc., 59 USPQ2d 1300 (TTAB 2001) (ITool found merely descriptive of computer software for use in creating web pages, and custom design of websites for others).

The evidence of record also convinces us that the wording SELF-TEST merely describes a test that is administered by oneself. Indeed, Applicant's identification for the Class 10 goods includes "apparatus for medical ... diagnostic testing" and Applicant admits that "Applicant's goods are expected to enable users to test themselves."³⁶ That a test may also be administered by someone else does not alter our finding.

We further find that the record establishes that the designation ISELF-TEST, as a whole, is merely descriptive of the identified goods and services. When the wording ISELF-TEST is viewed in connection with the assays and reagents (Class 1), the apparatus for medical tissue-based diagnostic testing (Class 10), and the medical consultation and counseling services (Class 44), it immediately conveys, without any imagination or thought, a feature of those goods and services, namely, that the identified assays and reagents and apparatus for medical diagnostic testing are used together in a test that one can conduct on oneself, and that the test results, and consultation and counseling services concerning the results, are provided via an Internet connection. The two components of the designation ISELF-TEST retain their individual descriptive meanings and together convey a meaning that is descriptive. That is, the combination of terms is not incongruous, and no additional information

³⁶ *Id.*

is needed for the merely descriptive significance thereof to be readily apparent to prospective consumers of the goods and services. *See, e.g., In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978) (Rich, J., concurring) (GASBADGE described as a shortening of the name “gas monitoring badge”); *Cummins Engine Co., Inc. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966) (TURBODIESEL held generically descriptive of engines having exhaust driven turbine super-chargers).

Applicant’s arguments to the contrary are unavailing. While acknowledging that “T” may refer to the Internet, and admitting that its goods will utilize an Internet connection, Applicant asserts that “T” has other meanings, including as an acronym for “immediate” and as “the person who is speaking or writing.” As such, Applicant urges, a consumer viewing the mark as a whole may instead think “about the test being performed by himself or herself” **or** how the test may be performed or the results obtained. If a term has a primary significance that is descriptive in relation to at least one of the recited goods and services, and does not create any double entendre or incongruity, then the term is merely descriptive. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979) (“[S]ince the question of descriptiveness must be determined in relation to the goods or services for which registration is sought, the fact that a term may have meanings other than the one the Board is concerned with is not controlling on the question.”). Even if consumers perceive “T” as meaning performed by himself or herself or as immediate, it would still merely describe an attribute of Applicant’s goods and services.

We also are unconvinced that ISELF-TEST is too vague to be merely descriptive of Applicant's goods and services. Unlike in *In re Hutchinson Tech.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988), where the Court found the term TECHNOLOGY, in the context of an appeal of an affirmance of a refusal to register a mark that was found to be a surname, broad enough to encompass many categories of goods, as discussed, each of the component terms at issue here has a particular meaning with respect to the identified goods and services, and that meaning is retained when the two terms are combined.

Lastly, Applicant relies on the principle that when there is doubt on the issue of whether a mark is merely descriptive, that doubt should be resolved in favor of the applicant.³⁷ While we agree with the general principle, in the present case, we have no doubt.

For the reasons discussed, we conclude that the term ISELF-TEST, as a whole, is merely descriptive of the identified good and services.

Decision: The refusal to register ISELF-TEST as merely descriptive under Section 2(e)(1) is affirmed.

³⁷ See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (on issue of mere descriptiveness, reasonable doubts are resolved in favor of the applicant).