

This Opinion is Not a
Precedent of the TTAB

Mailed: June 18, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Omniome, Inc.

Serial No. 87960945

Jared M. Barrett of Seed IP Law Group LLP,
for Omniome, Inc.

Caroline E. Wood, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Shaw, Pologeorgis, and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Omniome, Inc. (“Applicant”) seeks registration on the Principal Register of the mark HIGH SPEED STEPPING, in standard characters, for “research laboratory analyzers for analysis of biological analytes for non-medical purposes” in International Class 9; “devices for analysis of biological analytes for medical purposes” in International Class 10; and “analysis of biological analytes; development

of new technology for others for analysis of biological analytes” in International Class 42.¹

The Trademark Examining Attorney refused registration on the ground that Applicant’s mark is merely descriptive of the identified goods and services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).² When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration, and the appeal resumed. We affirm the refusal to register.

I. Analysis

Section 2(e)(1) of the Trademark Act prohibits registration of a mark which, when used on or in connection with an applicant’s goods or services, is merely descriptive of them. A term is merely descriptive of goods or services if it conveys an immediate idea of a quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a term is merely descriptive is not determined in the abstract,

¹ Application Serial No. 87960945; filed June 13, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s claim of a bona fide intent to use the mark in commerce.

The Examining Attorney also initially refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), but the refusal was withdrawn. 9 TTABVUE 3.

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system.

² Applicant’s application is based on an intent to use the mark. Accordingly, Applicant has not claimed acquired distinctiveness in an attempt to overcome the refusal.

but rather in relation to the goods or services for which registration is sought, the context in which the term 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 in which the term is used or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). The question is whether someone who knows the goods or services will understand the term to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g., id.* (SNAP SIMPLY SAFER merely descriptive of “medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration, and injection syringes”); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1173 (TTAB 2013) (“[W]e find that prospective consumers of the identified goods would readily understand that applicant’s applied-for mark [SUPERJAWS] describes a superior vice system for grasping and holding work pieces.”).

The Examining Attorney maintains that HIGH SPEED STEPPING is merely descriptive because “Applicant’s goods and services feature stepping motors that

operate at high speed[.]”³ The Examining Attorney has submitted excerpts from online articles and websites that she says show “that the terms ‘high speed,’ ‘high rate,’ ‘high torque,’ or ‘velocity’ are commonly used in connection with ‘stepping motors’ to indicate a device designed specifically for high speed running and that such motors are commonly used in laboratory applications,” including DNA sequencing.⁴ Based on this evidence, the Examining Attorney concludes that “[a]stepping motor is the essence of what makes Applicant’s goods function and allows the performance of the analysis of biological analytes services because without it, the goods and services cannot accomplish their purpose or function.”⁵

Applicant does not dispute that “‘high speed stepping’ is descriptive or generic of stepper motors or perhaps goods and services for which stepper motors serve as a significant or touted feature thereof.”⁶ Applicant further acknowledges that its technology incorporates a “stepper motor.”⁷ But Applicant argues that HIGH SPEED STEPPING does not describe a “significant function or feature” of Applicant’s goods or services “with any degree of particularity” because a “stepper motor” is merely a common component of its technology that is also “commonly used by competitors,” and “in a myriad of other devices across countless industries.”⁸ Applicant asserts that

³ Examining Attorney’s Brief, 9 TTABVUE 9.

⁴ *Id.* at 10-11; *see also* October 4, 2018 Office action at TSDR 15-24; April 29, 2019 Final Office action at TSDR 7-82.

⁵ Examining Attorney’s Brief, 9 TTABVUE 11.

⁶ Applicant’s Brief, 7 TTABVUE 6 and 9.

⁷ *Id.* at 8; *see also* Applicant’s Reply Brief, 10 TTABVUE 3.

⁸ Applicant’s Brief, 7 TTABVUE 8-9.

rather than describing “a small motor component of the optical scanners,” which is “an insignificant feature of its goods,” HIGH SPEED STEPPING is suggestive of its proprietary technology.⁹ Applicant has submitted the declaration of John Murphy, Applicant’s Head of Intellectual Property, who avers that:¹⁰

HIGH SPEED STEPPING was coined ... to be suggestive of newly developed **scanning technology** intended to be employed by Omniome’s goods and services which relates to a methodology of taking **sequential images of DNA colonies** (or other biological analytes) on a surface in a flow cell, which flow cell is moved in a precise manner in a translational direction, namely, the x dimension, while maintaining its position in the y dimension and in the z dimension (focus). The y and z positions are maintained at extremely high tolerances **to facilitate detection that occurs at micron scale**. Moreover, the surface is prevented from rolling, pitching or yawing throughout the imaging process, again to facilitate micron-scale detection during the scanning operation. HIGH SPEED STEPPING was adopted by Omniome as being suggestive of the **rapid speed with which the taking of such images or scanning is carried out**, wherein **the speed of such scanning is based on the sum of the time required for at least three processes**: (1) the time required to translate the flow cell from one position to another, (2) the time required for the flow cell to cease vibrating after each translation event so that features on the surface of the flow cell that are only a few microns in diameter and only a few microns apart from each other can be resolved, and (3) the time required to obtain an image of the features on the flow cell surface **before repeating the 3 steps**.

We need not resolve whether a “stepping motor” is a significant feature of the applied-for goods and services. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (“[T]he Board need not find that the examining attorney’s rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale.”)

⁹ *Id.* at 9-10; Applicant’s Reply Brief, 10 TTABVUE 3.

¹⁰ October 28, 2019 Request for Reconsideration at TSDR 8-10, Murphy Declaration, ¶ 2 (emphasis added).

(TTAB 2010). “Stepping” is defined as “to go through or perform the steps of[.]”¹¹ Based on Mr. Murphy’s explanation, “high speed stepping” immediately and with particularity describes a characteristic and feature of Applicant’s intended goods and services, namely, that the goods and services involve imaging the surface of a flow cell by repeatedly moving through a three-step process at high speed (e.g. by “high speed stepping”). That Applicant may have coined HIGH SPEED STEPPING for its proprietary technology and services does not imbue the phrase with source-identifying significance. *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983) (the fact that the applicant may be the first to use a merely descriptive designation does not “justify registration if the term projects only merely descriptive significance.”).

II. Conclusion

Based on the record before us, we find that the proposed mark HIGH SPEED STEPPING is merely descriptive of Applicant’s “research laboratory analyzers for analysis of biological analytes for non-medical purposes” in International Class 9; “devices for analysis of biological analytes for medical purposes” in International Class 10; and “analysis of biological analytes; development of new technology for others for analysis of biological analytes” in International Class 42 because “high speed stepping” immediately conveys information about a feature or characteristic of the goods and services. We further find that the combination of the descriptive

¹¹ See <https://www.dictionary.com/browse/step>. The Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013).

wording “HIGH SPEED” with the descriptive term “STEPPING” does not create a non-descriptive or incongruous meaning. Instead, we find that each component retains its merely descriptive significance in relation to Applicant’s identified goods and services, the combination of which results in a composite mark that is itself merely descriptive.

Decision: The refusal to register Applicant’s proposed mark under Section 2(e)(1) of the Trademark Act is affirmed.