

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Hearing: October 20, 2009 Mailed: March 5, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Johnson & Johnson
v.
Klearsen Corp.

Opposition Nos. 91173864 and 91173865
to application Serial Nos. 78526275 and 78526328¹

Norm D. St. Landau and Jaye S. Campbell of Drinker Biddle &
Reath LLP for Johnson & Johnson.

David A. Weinstein of David A. Weinstein for Klearsen Corp.

Before Grendel, Cataldo and Mermelstein,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Klearsen Corp., seeks to register on the
Principal Register the following marks, in standard
characters: E-BANDAGE and ELECTRONIC BANDAGE, both for a

topical bandage with an iontophoretic [Serial No.
78526275] [or] iontophoresis [Serial No. 78526328]
generator built in which uses a current derived
from a battery or other power source to drive a
coating or material from the contact pad of the
bandage into the skin, lesion or wound area to
facilitate in the treatment of severe burns,
diabetic foot ulcers, large area infections, warts
and other skin conditions

¹ These proceedings were consolidated in a Board order issued on
July 25, 2008.

in International Class 10.²

Opposer, Johnson & Johnson, has opposed registration of applicant's applied-for marks. As grounds therefor, opposer alleges as follows:

opposer is a competitor in the field of bandages and first aid products;

opposer is the owner of four registrations for BAND-AID and BAND-AID-formative marks for, *inter alia*, bandages and adhesive bandages;

opposer has a real commercial interest in using the terms comprising applicant's marks to identify similar goods;

the terms comprising the involved alleged marks are generic for the goods identified thereby; and

the terms comprising the involved alleged marks are merely descriptive of the goods identified thereby.

In its answers, defendant denied the salient allegations of the notices of opposition.³

² Application Serial Nos. 78526275 and 78526328 both were filed on December 2, 2004, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

³ In addition, applicant asserted certain affirmative defenses, but did not pursue them by motion or at trial. Accordingly, they are deemed waived. The remainder of applicant's asserted "affirmative defenses" are more in the nature of amplifications of its denial of the salient allegations of the notices of oppositions and have been so construed.

The Record

The record consists of the pleadings and the files of the involved applications. In addition, opposer submitted the trial testimony, with related exhibits, of Susan Tang, Product Director of the Band-Aid brand for one of opposer's wholly-owned subsidiaries. Opposer further submitted a notice of reliance upon copies of its pleaded registrations showing current status and title thereof; official records of the United States Patent and Trademark Office (USPTO), namely, Patent Nos. 6,500,165 and 6,738,662, issued to Steven R. Frank, identified by applicant as an individual primarily involved in selection of applicant's involved marks; applicant's answers to opposer's first set of interrogatories; and printed publications from the Lexis/Nexis computer database, showing use of the terms comprising applicant's involved marks.

Applicant, for its part, did not submit any testimony or evidence in these cases.

Both parties filed main briefs on the case, and opposer filed a reply brief. In addition, counsel for opposer presented arguments at an oral hearing held before the Board on October 20, 2009.

Opposer's Standing

Opposer must prove its standing as a threshold matter in order to be heard on its substantive claims. *See, for*

example, Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings. Thus, the Federal Circuit has enunciated a liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d, 1023 (Fed. Cir. 1999). *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

In this case, opposer has established that it is a competitor of applicant in the field of bandages and wound care; that the goods encompassed in the involved applications are within opposer's normal expansion of its business; and that opposer has a commercial interest in using E-BANDAGE and ELECTRONIC BANDAGE as descriptive terms applied to similar goods to those recited in the involved applications.⁴

We find that because opposer is a competitor who may seek to make descriptive or generic use of the terms E-BANDAGE and ELECTRONIC BANDAGE for goods that are similar to those recited in applicant's involved applications, opposer has established its standing to oppose applicant's marks.

⁴ Tang Testimony at 9-13, and 40-1.

See, e.g., Lipton Industries, supra, (One basis for standing includes "descriptive use of term in registered mark"); and *Ferro Corp. v. SCM Corp.*, 219 USPQ 346, 352 (TTAB 1983) (Opposer "has a real interest sufficient to give it standing. The rationale is that a competitor should be free from harassment based on the presumed exclusive right which registration of a generic term would erroneously accord") (citation omitted). Based upon the foregoing, we find that opposer has demonstrated such an interest. We note in addition that applicant does not dispute opposer's standing to bring the above-referenced opposition proceedings.

Claim of Genericness Not Ripe for Determination

As noted above, opposer has pleaded and argued in its brief that the asserted marks in the involved applications are generic or merely descriptive as applied to the goods recited therein. We note, however that applicant seeks registration for both of the involved applications on the Principal Register based upon its assertion of a bona fide intent to use the marks in commerce under Trademark Act § 1(b). Inasmuch as applicant has not filed an allegation of use for either application, applicant is precluded from amending its applications to assert a claim of acquired distinctiveness under Trademark Act § 2(f) or to seek registration on the Supplemental Register. *See* TMEP § 1102.03. *See also* TBMP § 514 and the authorities cited

therein.

Inasmuch as the involved applications presently are not eligible for registration on the Supplemental Register, or under the provisions of Trademark Act § 2(f), we find that the issue of whether the marks asserted therein are generic is not ripe for determination at this time. Therefore, the question of whether such marks are generic will be given no further consideration, and we shall confine our determination herein to the issue of mere descriptiveness.

Claim of Mere Descriptiveness

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). It further is settled that "[t]he question is not whether someone

presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In this case, opposer has introduced by notice of reliance evidence of the term ELECTRONIC BANDAGE used to describe wound care dressings. The following examples are illustrative:

Melvyn Burk does not claim to have the ultimate cure for painful, hard-to-heal wounds commonly associated with diabetes, but he's working on technology that he says substantially could speed the healing process.

Mr. Burk's one-employee company, Oxyfast Corp., plans this fall to begin selling an **electronic bandage**. The device uses a synthetic membrane that pulls oxygen from the air and directs it via a small tube to a bandage spread over a wound.⁵

ELECTRONIC BANDAGE UNDER REVIEW

The Food and Drug Administration is reviewing a proposal by Medlec Limited Partnership of Prior Lake, Minn. to manufacture an **electronic bandage**. The copper and tin, or silver and zinc device would emit a small dose of electricity to help heal wounds and is activated by moisture.⁶

Opposer further made of record as exhibits to the testimony deposition of Ms. Tang newswire stories using the term ELECTRONIC BANDAGE to describe wound care dressings. It is settled that newswire stories may be probative of the manner

⁵ Crain's Cleveland Business, July 7, 2003, retrieved from the Lexis/Nexis database.

⁶ State News Service, October 6, 1988, retrieved from the Lexis/Nexis database.

in which the public views a term in a mark. See, e.g., *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1798 (TTAB 2003) (While "we are not saying that newswire stories are of the same probative value as are stories appearing in magazines and newspapers, we think that the situation has changed such that said newswire stories have decidedly more probative value than they [previously] did"). The following samples are illustrative:

Once switched on, the bandage produces a flow of electricity which kick-starts the healing process. All living tissue in the body produces electrical signals that help wounds heal. But in severe wounds, these signals do not get through. The **electronic bandage**, which is changed every 48 hours, mimics this electric stimulation and allows the natural healing process to begin.⁷

...Gentzkow also will direct studies being conducted by the University of Tennessee School of Medicine on Staodyn's Nuwave Pain Management System, and the ongoing joint research project with the University of Miami School of Medicine on development of an "**electronic bandage**."⁸

Staodyn has developed the Dermapulse system of electrical stimulation for wound healing. The company submitted a premarketing approval (PMA) application for use of Dermapulse in healing dermal ulcers to the FDA on December 17, 1990. This application has not been approved. Staodyn is also developing **electronic bandage** technology for wound healing.⁹

According to an article in a recent issue of High Technology Business Magazine, Dr. Richard Bentall of Bioelectrics Corp. in Washington DC, USA, claims that **electronic bandages** can heal wounds 30% faster than ordinary dressings. ... The bandage

⁷ Tang Testimony, Exhibit 16.

⁸ Id., Exhibit 20.

⁹ Id., Exhibit 21.

consists of an adhesive strip that contains a small antenna attached to a wristwatch-sized energy source. Although the device is awaiting US Food and Drug Administration (FDA) approval, Bentall expects the **electronic bandage** to be used for episiotomies, incisions made during childbirth.¹⁰

The evidence of record, of which the above is a sample, supports a finding that ELECTRONIC BANDAGE merely describes, without conjecture or speculation, a significant characteristic or feature of applicant's goods, namely, that they utilize electricity to speed and facilitate the healing process. We hereby take judicial notice of the following definition of "iontophoresis:" "a painless alternative to drug injection in which a weak electrical current is used to stimulate drug-carrying ions to pass through intact skin."¹¹ The term ELECTRONIC BANDAGE merely describes dressings that utilize a weak electrical current to drive medications from the bandage into the skin to facilitate the treatment of wounds. We find, therefore, that ELECTRONIC BANDAGE merely describes the goods identified thereby.

With regard to applicant's E-BANDAGE mark, we hereby take judicial notice of the following definition of "E-:"

¹⁰ Id., Exhibit 23.

¹¹ Random House Dictionary, 2010. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

"electronic: e-mail; E-text."¹² Such definition is consistent with our previous decisions in which the Board has found that the prefix "E-" is recognized as a shorthand for "ELECTRONIC." See *Int'l Business Machines Corp.*, 81 USPQ2d 1677, 1679 (TTAB 2006) (Board takes judicial notice that "E-" stands for "ELECTRONIC"); and *In re Styleclick*, 57 USPQ2d 1445, 1447-8 (TTAB 2000) ("E-" is recognized as denoting "ELECTRONIC"). Thus, the above-referenced evidence supporting a finding that ELECTRONIC BANDAGE merely describes a function, feature or characteristic of the recited goods also applies to the mark E-BANDAGE. An E-BANDAGE is a shorthand form of ELECTRONIC BANDAGE; both terms describing a bandage utilizing electrical current to facilitate healing of wounds.

We are not persuaded by applicant's arguments that its marks are at most suggestive of the recited goods. To the contrary, the evidence of record establishes that the involved marks merely describe, without the need for conjecture or multi-stage reasoning, a central function, feature or characteristic of the goods identified thereby. As a result, we find that the marks ELECTRONIC BANDAGE and E-BANDAGE are merely descriptive of the goods within the meaning of Trademark Act § 2(e)(1); 15 U.S.C. § 1052(e)(1).

DECISION: opposer's oppositions to the registration of

¹² Id.

Opposition Nos. 91173864 and 91173865

application Serial Nos. 78526328 and 78526275 are sustained
on the ground of mere descriptiveness.