

ESTTA Tracking number: **ESTTA271918**

Filing date: **03/13/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Amedica Biotech, Inc.
Granted to Date of previous extension	03/14/2009
Address	28301 Industrial Blvd.Suite K Hayward, CA 94545 UNITED STATES
Attorney information	Joseph L. Strabala Law Offices of Joseph L. Strabala One Embarcadero Center Suite 1020 San Francisco, CA 94111 UNITED STATES legal@quantumsi.com

Applicant Information

Application No	77491496	Publication date	01/13/2009
Opposition Filing Date	03/13/2009	Opposition Period Ends	03/14/2009
Applicant	Express Diagnostics Int'l, Inc. P.O. Box 308 Marion, IA 52302 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 1997/11/20 First Use In Commerce: 1997/11/20 All goods and services in the class are opposed, namely: reagent kit comprising of reagents for scientific or medical research for the detection of drugs in urine and test cup
Class 005. First Use: 1997/11/20 First Use In Commerce: 1997/11/20 All goods and services in the class are opposed, namely: test cup containing medical reagents for the use in detection of drugs in urine

Applicant Information

Application No	77489983	Publication date	01/13/2009
Opposition Filing Date	03/13/2009	Opposition Period Ends	
Applicant	Express Diagnostics Int'l, Inc. P.O. Box 308 Marion, IA 52302 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 1997/11/20 First Use In Commerce: 1997/11/20 All goods and services in the class are opposed, namely: reagent kit comprising of reagents for scientific or medical research for the detection of drugs in urine and test cup

Class 005. First Use: 1997/11/20 First Use In Commerce: 1997/11/20 All goods and services in the class are opposed, namely: test cup containing medical reagents for the use in the detection of drugs in urine
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Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23

Attachments	opposition_attachment.pdf (8 pages)(90176 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joseph L. Strabala/
Name	Joseph L. Strabala
Date	03/13/2009

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2 BACKGROUND

3 Applicant asserts it now owns DRUGCHECK, US Reg. No. 2,258,205
4 registered on the Supplemental Register and applications Serial Nos. 77491496
5 and 77489983 all used for the DRUGCHECK for drug checking products.
6 Opposer alleges that Applicant acquired US Reg. No. 2,258,205 by fraud and that
7 DRUGCHECK, as a mark for drug checking products defined in Registratoin
8 2,258,205 as “*test cup containing reagents for the use in the detection of drugs in*
9 *urine*” is generic and/or merely descriptive without any secondary meaning.

10 POINTS AND AUTHORITIES

11 A. SPECTRUM OF TERMS USED AS POTENTIAL TRADEMARKS

12 Case law recognizes "four different categories of terms with respect to
13 trademarks: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or
14 fanciful.” Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d
15 Cir. 1976) (Friendly, J.)). Only the first two of these four categories are at issue
16 here as DRUGCHECK is a generic term or, at the very best, a highly descriptive
17 term devoid of ‘secondary meaning’.

18 i. DRUGCHECK is generic, and as a matter of law, can never function as
19 a trademark.

20 "Generic marks are not capable of receiving protection because they identify
21 the product, rather than the product's source." KP Permanent Make-Up, Inc. v.
22 Lasting Impression I, Inc., 408 F.3d 596, 602 (9th Cir. 2005). "To determine
23 whether a term is generic, courts look to whether consumers understand the
24 potential mark refers only to a particular producer's goods or “whether consumers
25 understand the [potential] mark to refer to the goods themselves." [Id. at 604].

26 ii. Since DRUGCHECK in Reg. 2,258,205 is registered on the
27 Supplemental Register it is *per se* descriptive.

1 As to the claimed ownership of Registration 2,258,205 *is not entitled* to a
2 statutory presumption of validity see 15 U.S.C. § 1094 ("applications for and
3 registrations on the supplemental register shall **not** be subject to or receive the
4 advantages of sections of 1051(b), 1052(e), 1052(f), 1057(b), 1062(a), 1063 to
5 1068 inclusive 1072, 1115 and 1124 of [Title 15]." Thus, unlike registrations on
6 the Principal Register, "Supplemental Registration creates **no** substantive rights."
7 [Id.] McCarthy § 19:37 at 19-75 (4th ed. 1998) emphasis added. *A fortiori*,
8 Applicant currently has *no substantive rights* in DRUGCHECK by virtue of the
9 registration on the Supplement Register and has the burden of proof of the
10 existence of 'secondary meaning'

11 B. DRUGCHECK (THE COMPOSITE) DIFFERS NOT FROM THE
12 WORDS "DRUG & CHECK" USED SEPARATELY

13 While marks are not dissected for analysis, see Official Airline Guides,
14 Inc. v. Goss, 6 F.3d 1385, 1392 (9th Cir. 1993), combining two generic words,
15 here DRUG and CHECK into a DRUGCHECK composite where the meaning of
16 the composite is the same as using these words separately, does not a valid mark
17 make, i.e., DRUGCHECK is synonymous with DRUG CHECK. See In Re
18 Gould, 834 F.2d 1017, 1018, 5 USPQ2d at 1111-12) holding SCREENWIPE for
19 wipers for screens is generic, to wit:

20 "The compound term [SCREENWIPE] immediately and
21 unequivocally describes the purpose, function and nature of the goods
22 as Gould itself tells us. Gould has simply joined the two most
23 pertinent and individually generic terms applicable to its product, and
24 then attempts to appropriate the ordinary compound thus created as its
25 trademark. See Cummins Engine Co. v. Continental Motors Corp., 53
26 C.C.P.A. 1167, 359 F.2d 892, 149 U.S.P.Q. (BNA) 559 (1966)
27 ("TURBODIESEL" generic for engines having exhaust driven turbine
28 superchargers); In re Abcor Dev. Corp., 588 F.2d 811, 815, 200
U.S.P.Q. (BNA) 215, 219 (CCPA 1978) (Judge Rich, concurring)
("GASBADGE" generic for a gas monitoring badge)."

29 During the prosecution of the application for U.S. Registration No.
30 2,258.205 the trademark attorney examining that application opined:

1 “In this case, the applicant’s mark “DRUGCHECK is descriptive of
2 the purpose of the goods. The goods are a ‘test cup for the detection
3 of drugs in urine.’ The proposed mark is descriptive based on the
4 ordinary meaning of the terms to create the proposed mark. One of
5 the ordinary meanings of the term “CHECK” is a standard for
6 inspecting or evaluating a test. The American Heritage Dictionary of
7 the English Language, Third Edition (1992). A mark which combines
8 descriptive terms may be registerable if the composite creates a
9 unitary mark, with a separate non descriptive meaning. In re Ampco
10 Foods, Inc. 227 USPQ 331 (TTAB 1985). However in this case the
11 combination of the terms does not alter their descriptive significance.
12 The proposed mark clearly indicates to relevant customers that the
13 purpose of the goods is to test or “check” for drugs.” [see Prosecution
14 paper from file of Reg. # 2,258,205]

9 C. EVIDENCE PROVING GERNERICNESS OF A TERM (CLAIMED AS
10 A MARK).

11 To show genericness of a term used as a potential mark, an opposer may use
12 "*dictionary definitions, newspapers and other publications, generic use by*
13 *competitors, generic use of the term by the mark's owners, and use of the term by*
14 *third parties in trademark registrations.* Nartron Corp. v. STMicroelectronics,
15 Inc., 305 F.3d 397, 406 (6th Cir. 2002). Opposer relies on such evidence, *infra*,
16 regarding the meaning of ‘DRUG CHECK’ based on dictionaries, use in news
17 media, use in other publications (web pages), use by competitors, and use in
18 third party registrations, all of which evidence demonstrates the term
19 DRUGCHECK is, in fact, generic.

20 D. DRUGCHECK, A HIGHLY DESCRIPTIVE TERM, IS IN FACT
21 GENERIC

22 The Ninth Circuit, in Filipino Yellow Pages, Inc. v. Asian Journal
23 Publications, Inc., 198 F.3d 1143 (9th Cir. 12/06/1999) at 1147, sets forth the test
24 for determining if a mark is generic as follows:

25 “In determining whether a term is generic, we have often relied upon
26 the "who-are-you/what-are-you" test: "A [valid] mark answers the
27 buyer's questions 'Who are you?' 'Where do you come from?' 'Who
28 vouches for you?' But the [generic] name of the product answers the
question 'What are you?' "Official Airline Guides, Inc. v. Goss, 6

1 F.3d 1385, 1391 (9th Cir. 1993) (quoting 1 J. Thomas McCarthy,
2 Trademarks and Unfair Competition § 12.01 (3d ed. 1992)). Under
3 this test, "[i]f the primary significance of the trademark is to describe
4 the type of product rather than the producer, the trademark [is] a
5 generic term and [cannot be] a valid trademark. AntiMonopoly, Inc.
6 v. General Mills Fun Group, 611 F.2d 296, 304 (9th Cir. 1979)"
7 (emphases added).

8 See, also, 15 U.S.C. § 1064(3) (statutory test for genericness) to wit:

9 ". . . . The primary significance of the registered mark to the relevant
10 public rather than purchaser motivation shall be the test for
11 determining whether the registered mark has become the generic
12 name of goods or services on or in connection with which it has been
13 used."

14 i. Dictionary Definitions of 'drug' & 'check' Describe Plaintiff's
15 Product under the "What Are You?" Test

16 Dictionary definitions are used as one test to determine "What are you?"

17 Here Registration 2,258,205 describes the applicant's product as a **'test cup
18 containing reagents for use in the detection of drugs in urine'**.

19 As noted by the trademark attorney in the prosecution of Registration
20 2,258,205 (quoted *supra*) found: "*The proposed mark is descriptive based on the
21 ordinary meaning of the terms to create the proposed mark. [Drugcheck] is
22 descriptive based on the ordinary meaning of the terms to create the proposed
23 mark. One of the ordinary meanings of the term "CHECK" is a standard for
24 inspecting or evaluating a test. The American Heritage Dictionary of the English
25 Language, Third Edition (1992).*"

26 ii. Another U. S. Trademark Registration Employs "DRUGCHECK" for
27 identical products proving Plaintiff's Use of DRUGCHECK Is Not
28 Exclusive to the Plaintiff.

The U. S. Patent and Trademark Office issued a registration for **DRÄGER
29 DRUGCHECK** to Drager for **'Drug analyzers for detecting and identifying
30 drugs, through the use of samples taken from humans or inanimate objects'**,
31 as U. S. Registration No. 3,287,893. 'Drug analyzers' is a synonym for 'cups' or
32 'containers.' Drager's registration, has a disclaimer: 'NO CLAIM IS MADE TO

1 THE EXCLUSIVE RIGHT TO USE "DRUGCHECK" APART FROM THE
2 MARK AS SHOWN'. This disclaimer was required because the trademark
3 attorney found that DRUGCHECK in Drager's application was descriptive, see
4 Trademark Attorney's findings in an office action for Reg. No. 3,287,893, to wit:

5 "Applicant [Drager] must disclaim the descriptive wording
6 "DRUGCHECK" apart from the mark as shown because it merely
7 describes a purpose or use of the goods/services. Trademark Act
8 Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).
9 Applicant should note that the cited §2(d) registration in (sic) on the
10 Supplemental Register, an indication of its descriptive nature.

11 The mere existence of Drager's registration proves that DRUGCHECK
12 on drug checking products **does not** denote the Applicant as the single source of
13 such products marked with DRUGCHECK. *Ipsa facto*, no 'secondary meaning'
14 can exist, as rhetorically, when public sees DRUGCHECK who do they think
15 of, Drager? Or Applicant? Or do they think of Rapid-Exam, Inc. (see evidence of
16 use *infra*)? If, in the public perception of DRUGCHECK marked products come
17 from multiple sources, then DRUGCHECK cannot have a 'secondary meaning'.

18 iii. 'Drug Check' Is Commonly Used to Refer to Drug Checking in the
19 News Media.

20 Newspaper reporters are in the business of communicating with their
21 readership and use terminology well understood by such readership, especially
22 when crafting headlines. Headlines noted below demonstrate that the public's
23 *perception* of DRUG CHECK is tantamount to checking for drugs, see e.g., on
24 May 17, 2002 the Laredo Morning News, posted the headline, '**OFFICER SHOT
25 DURING DRUG CHECK**', the Denver Rocky Mountain News of August 15,
26 2003 displayed the headline, '**DRUG CHECK ON SIGNPOST UP AHEAD?
27 IT's A WHITE-LIE ZONE, BUT POLICE PLOY LEGAL, APPEALS
28 COURT RULES**', LJWORLD.COM carried the following headline on June 8,
2006 '**HIGHWAY PATROL DRUG CHECK GREETES FANS ON WAY TO
FEST**', by reporter Eric Weslander. Even the New York Times, sported the

1 headline “**2 OFFICERS WOUNDED IN NEWARK SHOOTING DURING**
2 **DRUG CHECK**” on October 27, 1968.

3 If ‘drug check’ did not generically refer to checking for drugs, reporters
4 would not use this term in headlines, which headlines are compelling evidence of
5 the the public’s perception of this term. To name a product with a generic term
6 for checking for drugs, which product literally effects a drug check, so defines the
7 essential characteristic of Applicant’s product as to make said term generic [see
8 Title 15 USC § 1064(3) quoted, *supra*]. No amount of promotion, use or
9 advertising can make a generic term, a trademark, see Le Book Publishing, Inc. v.
10 Black Book Photography, Inc., 418 F.Supp.2d 305, 311-12 (S.D.N.Y., 2005)
11 (granting motion to dismiss because “book was generic” and holding that no
12 amount of money spent in advertising and promotion of “Le Book” can create
13 trademark rights in a generic term. Accord: Gould, quoted *supra*, holding
14 SCREENWIPES generic for wipes for screens. Also see Rudolph International,
15 Inc. v. Realys, Inc., 482 F.3d 1195, 1146, 82 U.S.P.Q.2d 1375 (9th Cir. 2007)
16 where “disinfectable” a verb, was held, on summary judgment, to be generic for
17 nail files, the court opining:

18 “No imagination or mental leap is required to understand that
19 “disinfectable” in the nail file industry means “capable of being
20 disinfecting.”

21 “Adjectives, as well as nouns, can be generic marks. See Nupla Corp.
22 v. IXL Mfg. Co., 114 F.3d 191, 196 (Fed. Cir. 1997) (holding that
23 “cush-n-grip” is generic adjective for cushion-gripped tools); Miller
24 Brewing Co. v. G. Heileman Brewing Co., 561 F.2d 75, 81 (7th Cir.
25 1977) (holding that “light” and “lite” are generic adjectives for beer
26 and opining that “[o]therwise a manufacturer could remove a common
27 descriptive word from the public domain by investing his goods with
28 an additional quality, thus gaining the exclusive right to call his wine
“rose,’ his whisky ‘blended,’ or his bread ‘white’ ”).

26 Applicant cannot remove DRUGCHECK and/or DRUG CHECK from the
27 public genre of generic terms by claiming DRUGCHECK as a mark as it

27 defines Applicant’s drug checking products, as well as those of Applicant’s

1 competitors.

2 iv. Drug Testing Products/services Are Often Identified by the term
3 “Drug Check”.

4 Internet evidence is generally admissible and may be considered for
5 purposes of evaluating a trademark, see Retail Serv., Inc. v. Freebies Publ'g, 364
6 F.3d 535, 544-45 (4th Cir.2004) (considering online dictionaries and websites as
7 evidence of consumer perception of a mark). Here there are similar or identical
8 products to applicant’s products identified as “DRUG CHECK” products; e.g.,
9 see Grensonsar’s web page, offering goods, such as “**Product: Drug Check**
10 **Single Drug Test**” and “**Product: Drug Check 6 Drug Test**”. Also see web
11 page of Drugscreen Pty. Ltd., a having a drug checking product displayed thereon
12 in a package emblazoned with the marking “**drugCHECK**” and referencing
13 “**Drug Check! Home Test Kits**”.

14 Further, Rapid Exams, Inc. at www.drugtestscreen.com offers
15 “DRUGCHECK DIPPER TEST(s)” products as individual test strips for drug
16 checking, showing a competitor of the Applicant sells competing products
17 labeled as “**Drugcheck Dip MTD Test**” and “**Drugcheck Dip AMP Test**”.

18 Moreover there are numerous businesses that offer drug checking services
19 and products using the moniker DRUGCHECK and/or DRUG CHECK see e.g.,
20 web page of **Drugcheck, Inc.**, see also the web page of **DrugCheck Consulting**.
21 Further note the address of **DRUG CHECK PLUS, Inc.**, see business
22 addresses for **DRUG CHEK** and the web site for **U.S. DRUGCHECK, Inc.**

23 E. DESCRIPTIVE MARK BECOMES GENERIC WHEN IT IS NOT POLICED

24 A term having trademark potential becomes abandoned when generic
25 usage occurs as a result of the trademark owner's failure to police the mark. J.
26 Thomas McCarthy et al., 2 McCarthy on Trademarks and Unfair Competition
27 §17:8, at 17-10 (4th ed., Rel. #21, 3/2002). Here applicant did not oppose Drager
28 from registering DRAGER DRUGCHECK nor stop Rapid-Exams, Inc. from

1 selling DRUGCHECK DIPs as drug checking product, see Freecycle Network,
2 Inc. v. Oey, 505 F.3d 898, 905 (9th Cir., 2007) noting that “genericide can occur
3 "as a result of a trademark owner's failure to police the mark, resulting in
4 widespread usage by competitors leading to a perception of genericness among
5 the public, who sees many sellers using the same term." Accord 2 J. Thomas
6 McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §
7 12:1 (2007). ‘Where the majority of the relevant public appropriates a trademark
8 term as the name of a product (or service), the mark is a victim of "genericide" and
9 trademark rights generally cease.’ MCCARTHY § 12:1.

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