

This Opinion is not a
Precedent of the TTAB

Mailed: November 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Boehringer Ingelheim Vetmedica, Inc.
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Serial No. 87072333
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Scott J. Major, Millen White Zelano & Branigan PC, for Boehringer Ingelheim Vetmedica, Inc.

Tejbir Singh, Law Office 106, Mary I. Sparrow, Managing Attorney.
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Before Mermelstein, Bergsman, and Coggins, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Alleging an intent to use its mark in commerce, Boehringer Ingelheim Vetmedica, Inc., applied to register¹ the mark **PREVENTION CHAIN** (in standard characters) for

Educational services, namely, providing classes, seminars, workshops, conferences and webinars on the treatment and management of infections in swine and other animals (Class 41); and

Providing veterinary information on the prevention, treatment and management of infections in swine and other animals (Class 44).

¹ Filed June 15, 2016.

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Following publication in the Official Gazette and issuance of a notice of allowance, Applicant filed a statement of use (SOU) accompanied by a specimen for each class. Stmt. of Use (Aug. 1, 2017). The Examining Attorney refused registration “because the applied-for mark d[id] not appear anywhere on the specimen for” either class. Ofc. Action (Aug. 25, 2017). In response, Applicant filed substitute specimens. Resp. to Ofc. Action (Sept. 17, 2017).

Upon examination, the Examining Attorney found the substitute specimens unacceptable:

The first page is unacceptable because the mark does not stand apart from other wording within the paragraph and header. Consumers would not perceive the term as a service mark. The second page shows the mark as the third header in a row with three columns. It is unclear what services, if any, applicant is providing in connection with the mark.

Ofc. Action (Sept. 28, 2017).

Applicant responded, arguing that the specimens provided are acceptable. Resp. to Ofc. Action (Dec. 10, 2017). Nonetheless, the Examining Attorney continued the requirement for acceptable specimens and issued a new refusal on the ground that “the applied-for mark, as used on the specimen of record, merely identifies a process or system; it does not function as a service mark to indicate the source of applicant’s services and to identify and distinguish them from others.” Ofc. Action (Dec. 29, 2017).

Once again, Applicant responded, contending that the specimens are acceptable and that the mark is not used merely to identify a process. Resp. to Ofc. Action (June

29, 2018). Not persuaded, the Examining Attorney made both refusals final. *Ofc. Action* (July 23, 2018). Applicant filed an appeal and requested reconsideration, which was denied. *Req. for Recon.* (Jan. 23, 2019), denied, *Ofc. Action* (Mar. 1, 2019).

We affirm.

I. Applicable Law

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable *merely* because they do not happen to be descriptive of the goods or services with which they are associated.

In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960).

Not surprisingly, Section 1 of the Trademark Act contemplates registration of **trademarks**. *See* Trademark Act § 1(a)(1) (“The owner of a **trademark** . . . may request registration of its **trademark**” (emphasis added)); § 1(b)(1) (“A person who has a bona fide intention . . . to use a **trademark** in commerce may request registration of its **trademark**” (emphasis added)). Likewise, Section 2, which sets out various bars to registration, contemplates that what is sought to be registered must be a trademark in the first place. Trademark Act § 2 (“No **trademark** . . . shall be refused registration . . . unless it” (emphasis added)).²

A trademark “includes any word . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate

² While Section 2 and other provisions of the Act speak of trademarks used on goods, these same provisions generally apply to the registration of service marks used in connection with services. Trademark Act Section 3, 15 U.S.C. § 1053. Unless otherwise noted, references in this decision to statutory provisions and cases discussing goods apply equally to services.

the source of the goods.” Trademark Act § 45. But as the court noted in *Standard Oil*, not every word that might be used on or in connection with a good is a trademark. To be a trademark, a word must “identify and distinguish” the relevant goods or services and “indicate the[ir] source.” Trademark Act § 45. During examination of an application under Section 1, the Examining Attorney must examine the specimens to determine whether an applicant is using the applied-for matter as a trademark. See *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992) (examining attorney should look primarily to the specimen to determine whether a designation would be perceived as a source indicator). As relevant to this case, it has long been determined that a designation that is solely used to designate a process or method is neither a trademark for services, *In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973), nor goods, *In re Griffin Pollution Control Corp.*, 517 F.2d 1356, 186 USPQ 166, 167 (CCPA 1975). While a designation may serve as a trademark notwithstanding that it *also* identifies a method or process, “[a] term that identifies only a process, style, method or system is not registrable as a [trade]mark.” *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1270 (TTAB 2012).

II. Specimens and Evidence

Applicant “concede[s] that the specimens submitted with its SOU properly were rejected by the Examiner.” App. Br. 8 TTABVUE 2. In response to the initial Office Action addressing Applicant’s SOU, Applicant submitted two substitute specimens. Applicant did not designate which substitute specimen is alleged to support which of the two classes of services involved, so we will consider the acceptability of both sub-

stitute specimens with respect to each class. We have reproduced³ Applicant's substitute specimens below:

First Specimen

PREVENTION CHAIN APPROACH FOR SYSTEMATIC DISEASE CONTROL IN LARGE FARMS

2016-08-04

by Oliver Duran and Eduardo Fano

The Infection/Prevention Chain™ concept brings together new and existing knowledge in swine diseases management, connecting epidemiological events between the different production phases.

Pig production has responded to the challenge of increased global demand for pork by a process of consolidation and increased size to capture benefits of economies of scale. Over the last 25 years the swine industry has evolved in order to increase production performance, health and animal wellbeing towards age segregated or multiple site production models. In general, it can be stated that the changes in production systems have produced a positive effect in the health status of pigs by improving the way we raise pigs today. However, bigger and more complex farms and production systems require that we approach disease control in a different way by recognizing the impact throughout the production cycle or production chain.

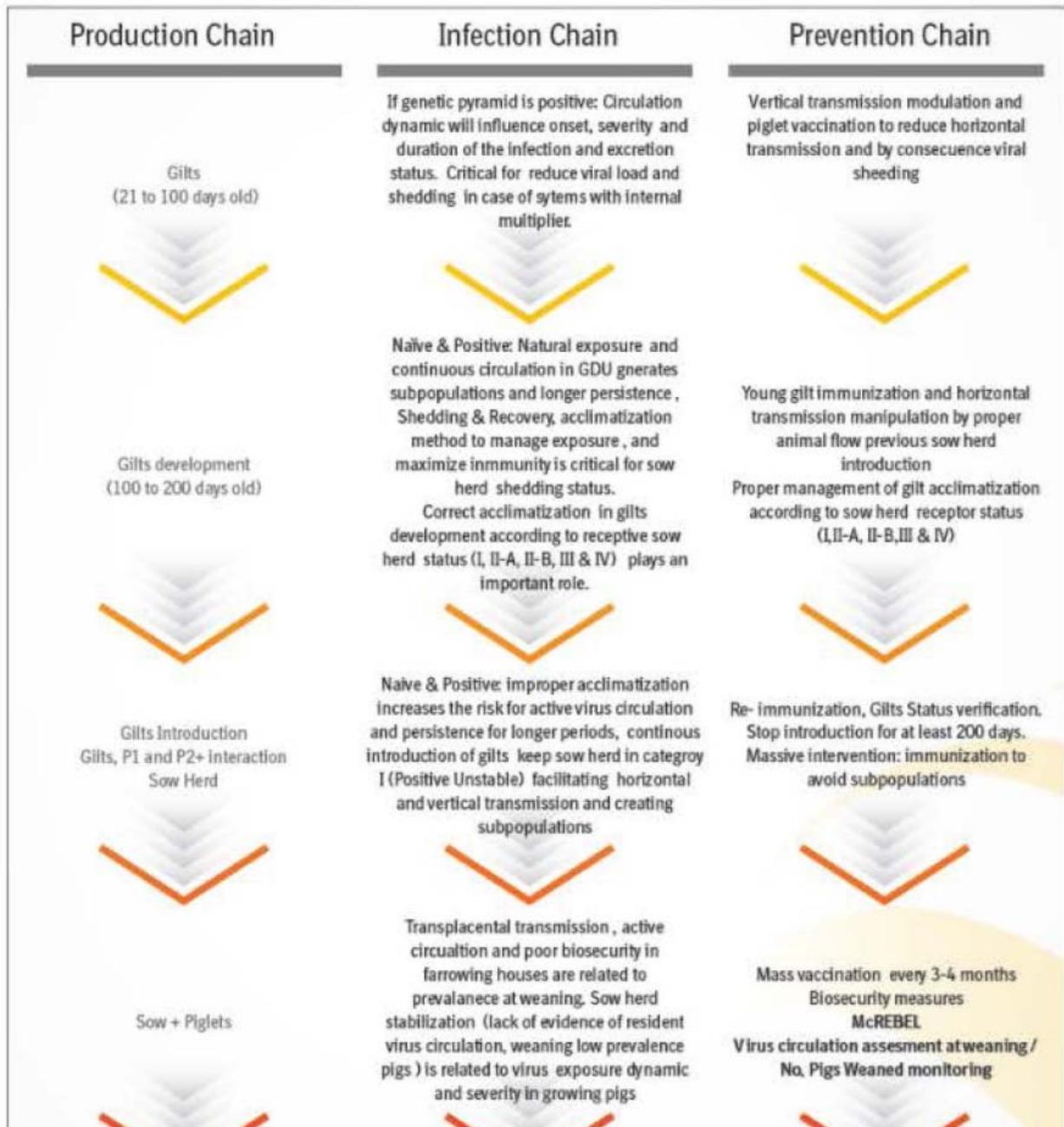
Infection and Prevention Chain™ thinking

The Infection/Prevention Chain™ concept brings together new and existing knowledge in swine diseases management, connecting epidemiological events (infection chain, see figure 1) between the different production phases (production chain), using logical chain-thinking to create multi-phase intervention strategies (prevention chain) as illustrated in figure 2. This systematic approach to disease control was first proposed by Dr Eduardo Fano, Dr Brian Payne and Dr Edgar Diaz in the Unites States to address both *M. hyopneumoniae* and PRRS control, but can be applied to practically all infectious diseases.

Figure 1. Links in the Infection chain (adapted from Fano, 2015)

³ Images were cropped and enlarged to show the relevant part.

Second Specimen



Both specimens are webpages. The first is the beginning of an article, Prevention Chain Approach for Systematic Disease Control in Large Farms, by Oliver Duran and Eduardo Fano, dated August 4, 2016, discussing “[t]he Infection/Prevention Chain™ concept” and “Infection and Prevention Chain™ thinking.” The second is a chart,

showing steps in the “Production Chain” alongside those in the “Infection Chain” and the “Prevention Chain.”

With his final Office action, the Examining Attorney submitted a longer version of the article comprising the first specimen, as well as an article about the Prevention Chain, *Final Ofc. Action* (July 23, 2018) (National Hog Farmer, Integrating the Infection/Prevention Chain™ method into the swine herd). With his denial of reconsideration, the Examining Attorney submitted several other articles:

- Global PRRS Solutions, Infection chain – PRRS control, <https://www.prrs.com/en/prrs-control/infection-chain/> (Mar. 1, 2019);
- WATTAgNet, Eduardo Fano and Oliver Duran, Controlling pig disease with prevention chain approach, <https://www.wattaqnet.com/articles/27880-controlling-pig-disease-with-prevention-chain-approach> (Mar. 1, 2019).
- Eduardo Fano, Applying the Infection Chain™ and Prevention Chain™, <https://www.swineresource.com/swine-resources/prevention/applying-the-infection-chain-and-prevention-chain> (Mar. 1, 2019).

Denial of Recon. (Mar. 1, 2019).

III. Analysis

The Examining Attorney maintains that, as used on the substitute specimens, Applicant’s mark merely identifies a method or process in that it refers to an approach or concept of livestock disease prevention. Ex. Att. Br. 10 TTABVUE 6. Pointing to a more complete version of the article which comprises the first substitute specimen, the Examining Attorney notes that

“logical chain-thinking is used to create multi-phase intervention strategies,” and this is done “by matching ‘production chain’ with ‘infection chain,’ resulting in a ‘prevention chain’” that is focused on the entire production system at all stages. See March 1, 2019 Reconsideration Letter, TSDR p. 8. The article indicates that “implementation of a

systematic prevention chain approach . . . has allowed successful PRRS control, e.g., using load-close-homogenize protocols.” The article further describes that “[b]y systematically applying these methods and measuring the outcome you can establish two novel metrics.” *See* March 1, 2019 Reconsideration Letter, TSDR p. 9. This evidence demonstrates that the applied-for mark refers to a method or process.

Id. at 7.

Likewise, the Examining Attorney maintains that the second substitute specimen merely “shows how the ‘production chain,’ ‘infection chain’ and ‘prevention chain’ are connected.” *Id.* The chart shows “how the ‘Infection/Prevention concept’ connects ‘epidemiological events (infection chain) alongside the herd/production system (production chain), using a logical chain thinking to create this new concept focused in disease prevention in a comprehensive way (prevention chain).’” *Id.* The Examining Attorney maintains that because the mark is used only to denote a concept, it does not function as a trademark for the identified educational or information services.

We agree. As used on the specimens of record, the proposed mark **PREVENTION CHAIN** identifies only a concept of disease prevention among swine. The first specimen variously identifies **PREVENTION CHAIN** as an “approach,” a “concept,” and a manner of “thinking” about disease prevention. Nowhere, however, is **PREVENTION CHAIN** used to identify either educational services or providing veterinary information. Likewise, the second specimen uses **PREVENTION CHAIN** as the title of a process of swine disease prevention, but not in connection with any of the identified services. While Applicant’s specimens might themselves be characterized as educational or informational materials, they do not evidence use of

PREVENTION CHAIN to advertise or sell the educational or informational services identified in the application. It is not enough that the proposed mark merely appear on educational or informational materials. The mark must identify those services and indicate their source.

IV. Conclusion

Because a process is neither a good nor a service, it follows that a designation which serves solely to identify a process does not function as a trademark, and cannot be registered as one. *HSB Solomon Assocs.*, 102 USPQ2d at 1270. Likewise, any specimen must demonstrate use of an applicant's mark to identify and distinguish the applicant's services and to indicate their source. Trademark Act § 45. In this case, Applicant's specimens do not show use of **PREVENTION CHAIN** to identify and distinguish Applicant's identified educational services or its information services. At best, the mark identifies a process or concept of swine disease prevention. The specimens are thus inadequate to support the application for registration in connection with the identified services.

Decision: The refusal to register under Trademark Act §§ 1, 2, 3, and 45 is affirmed.