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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87570858
Applicant	Bharat Biotech International Limited
Applied for Mark	ZIKAVAX
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/570,858

Mark: ZIKAVAX

Applicant: Bharat Biotech International Limited

Filing Date: December 17, 2018

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**APPLICANT'S BRIEF ON APPEAL  
FROM FINAL OFFICE ACTION**

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## **STATEMENT OF ISSUES**

Applicant's mark ZIKAVAX is not "merely descriptive" of Applicant's identified vaccine formulations and therefore is entitled to registration on the Principal Register.

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## **I. INTRODUCTION**

Applicant seeks to register the mark “ZIKAVAX” for use in connection with “vaccine formulations” in International Class 5. The Examining Attorney, however, has refused registration under Section 2(e)(1) of the Trademark Act on the basis that Applicant’s mark is merely descriptive of the goods. It is the Examiner’s position that the mark is merely descriptive because the mark allegedly describes a feature and the purpose of the relevant goods.

Applicant disagrees and states that the made-up term “ZIKAVAX” is not **merely** descriptive of Applicant’s identified vaccine formulations. Rather, the mark is suggestive, and therefore, entitled to registration on the Principal Register.

## **II. STATEMENT OF FACTS**

Applicant filed the present application for its mark ZIKAVAX on August 16, 2017, seeking registration in Class 005 for “vaccine formulations.” The application was initially allowed following an Examiner’s Amendment clarifying the Applicant’s legal entity status on November 20, 2017. However, a day later, on November, 21, 2017, the Examining Attorney withdrew the allowance and issued an Office action stating that the registration was refused due to the fact that the ZIKAVAX mark was “merely descriptive” of the goods under Section 2(e)(1).

The Examining Attorney argued that the ZIKA portion represented the zika virus and that “VAX” is colloquially used as an abbreviation for “vaccine.”

On May 21, 2018, Applicant filed a response to the rejection, arguing that, at best, ZIKAVAX, was suggestive, not descriptive, of the identified goods and that the ZIKAVAX mark should therefore be published for registration on the Principal Register.

On June 14, 2018, the Examining Attorney simply reiterated her previously presented “merely descriptive” arguments in issuing the final office action which Applicant is appealing herein.

### III. ARGUMENT

#### Applicant’s Mark is Suggestive as to Applicant’s Goods

To be refused registration under Section 2(e)(1), a mark must be merely descriptive of the goods. The statutory language imposes a stringent burden since the term “merely” is to be taken in its ordinary meaning of “only” or “solely,” that is, when considered with the particular goods, the mark, because of its meaning, does nothing but describe them. In re Intelligent Medical Sys., Inc., 5 U.S.P.Q.2d 1674, 1675-76 (T.T.A.B. 1987) (emphasis added) (reversing Section 2(e)(1) refusal of “INTELLIGENT MEDICAL SYSTEMS” for electronic thermometers for measuring body temperature because the mark did not tell the potential customer only what the goods are, their function, characteristics, use or ingredients).

A merely descriptive mark is one that immediately conveys information as to the nature of the goods. A La Carte, Inc. v. Culinary Enters., Inc., 1997 WL 534493, \*5 (N.D. Ill. Aug. 23, 1997) (emphasis added) (holding “A LA CARTE” suggestive, rather than merely descriptive, of the applicant’s gourmet take-out and prepared foods delivery goods). In other words, to be merely descriptive, a mark must immediately convey the nature of the ingredients, qualities, characteristics, functions, or features of the product or services with a “degree of particularity.” Plus Prods. v. Medical Modalities Assoc., 211 U.S.P.Q. 1199, 1204-05 (T.T.A.B. 1981); Holiday Inns, Inc. v. Monolith Enters., 212 U.S.P.Q. 949, 952 (T.T.A.B. 1981).

A suggestive mark, on the other hand, is one which “requires imagination, thought and

perception to reach a conclusion as to the nature of the [goods].” Stix Prods., Inc. v. United Merchants & Mfrs., Inc., 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968); see also In re Shutts, 217 U.S.P.Q. 363, 364 (T.T.A.B. 1983) (reversing refusal to register “SNO-RAKE” because it is an incongruous word combination that would require “some measure of imagination,” and therefore suggestive of snow removal hand tools); In re George Weston Ltd., 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (finding “SPEEDI BAKE” suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it may quickly and easily be baked into bread). Suggestive marks, like fanciful and arbitrary marks, fall within the classification of inherently distinctive marks. Neither category requires proof of secondary meaning for registration on the Principal Register. ChiChi’s, Inc. v. Chi-Mex, Inc., 221 U.S.P.Q. 906, 910 (W.D. Pa. 1983); Estate of Presley, 211 U.S.P.Q. 415, 440 (D.N.J. 1981).

In AMF Inc. v. Sleekcraft Boats, 204 U.S.P.Q. 808, 815 (9th Cir. 1979), the court offered the following distinction between unregistrable descriptive marks and registrable suggestive marks:

The primary criterion [in the descriptive/suggestiveness analysis] is “imaginativeness involved in the suggestion,” ... how immediate and direct is the thought process from the mark to the particular product. ... [O]ne might readily conjure up the image of appellant’s [products], yet a number of other images might also follow.

Applicant submits that “ZIKAVAX” does not immediately convey to the general public that the goods are vaccine formulations. Rather, Applicant’s mark is suggestive because it would require “thought” and “imagination” to reach a conclusion as to the nature of those goods.

In In re Hamilton Watch Co., 158 U.S.P.Q. 300, 301 (T.T.A.B. 1968), the Board reversed a refusal to register the mark “PRECISION METALS,” stating,

[A]s applied to “special metal alloys,” “PRECISION METALS” suggests the high quality and care involved in the production of the goods; but it does not immediately or with any degree of particularity describe their function, characteristics or use.

Similarly, Applicant's mark, when considered as a whole, does not "immediately or with any degree of particularity" describe fraud prevention and detection-related goods. Rather, "ZIKAVAX" requires the use of "thought" and "some measure of imagination" to reach a conclusion as to the nature of the identified goods.

The Board has held on numerous occasions that a mark is not merely descriptive simply because a consumer encountering the mark might recognize a suggestion regarding the nature of the applicant's goods. See, e.g., Worthington Foods, Inc. v. Kellogg Co., 14 U.S.P.Q.2d 1577, 1587-90 (S.D. Ohio 1990) (holding "HEARTWISE" suggestive for foods healthy for the heart); The Comic Strip v. Fox Television, 10 U.S.P.Q.2d 1608, 1611 (S.D.N.Y. 1989) (holding "COMIC STRIP" for comedy clubs suggestive and thus inherently distinctive); In re Nalco Chem. Co., 228 U.S.P.Q. 972, 973 (T.T.A.B. 1986) ("VERI-CLEAN" suggestive, not merely descriptive, of cleaning additives); In re Pennwalt Corp., 173 U.S.P.Q. 317 (T.T.A.B. 1972) ("DRI-FOOT" suggestive of foot antiperspirant); In re Polytop Corp., 167 U.S.P.Q. 383 (T.T.A.B. 1970) ("LOC-TOP" suggestive for container closures in the nature of bottle caps having a cap portion adapted to be secured to a container); In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (T.T.A.B. 1966) ("HANDI WIPES" suggestive for household cleaning cloths).

The court's analysis of the mark "PHYSICIANS FORMULA" in Physicians Formula v. West Cabot Cosmetics Inc., 8 U.S.P.Q.2d 1136 (2d Cir. 1988) is applicable here. There, the court determined that "PHYSICIANS FORMULA" is suggestive for hypoallergenic skin care and cosmetic products:

The mark is certainly not generic. Nor is it descriptive, because the mark does little to identify the product other than to locate it in the realm of medicine. We therefore regard it as suggestive because the impression it conveys falls somewhere between 'descriptive' and 'fanciful,' in that there is some relation between the product's

properties and the term, but a consumer is able to identify the genre of product only by using ‘imagination, thought and perception.’

Id. at 1137-38 (emphasis added). Here, ZIKAVAX does little more than locate the goods as possibly in the realm of vaccination formulations. In this regard, it is reminded that a suggestive mark need not leave consumers ignorant as to the general nature of the goods offered in connection with the mark: “[T]erms may convey information without being merely descriptive.” In re Wakefern Food Corp., 222 U.S.P.Q. 76, 79 (T.T.A.B. 1984). Thus, the fact that “ZIKAVAX” may convey some (in this case minimal) information regarding the nature of Applicant’s goods does not necessarily render the mark descriptive.

Finally, a term is not merely descriptive if does not have a primary significance that is descriptive in relation to any of the goods/services, or if it creates a double entendre or incongruity. See TMEP § 1209.03(e) (emphasis added). In this regard, the Examining Attorney’s analysis, however, disregards the fact that consumers would not see the primary significance of Applicant’s ZIKAVAX mark as being descriptive. Applicant’s mark is suggestive and inherently distinctive, and as such should be permitted to proceed to publication. Even if doubt exists as to whether a term is merely descriptive as applied to the goods or services for which registration is sought, it is the practice of the Board to resolve those doubts in favor of the Applicant, and allow the mark to register. In re Grand Metropolitan Foodservice, Inc., 30 USPQ2d 1974.

### **III. CONCLUSION**

In conclusion, Applicant submits that its mark is not descriptive in relation to vaccine formulations. To refuse registration on the grounds that a mark is descriptive, the Examining Attorney must make a substantial showing based on clear evidence of descriptive use. In re Kopy Kat, Inc., 182 U.S.P.Q. 372, 373 (C.C.P.A. 1974). No such evidence has been produced here.

Finally, it is well settled that any doubt as to whether Applicant's mark is merely descriptive must be resolved in favor of Applicant. In re Intelligent Medical Sys., 5 U.S.P.Q.2d at 1676; In re The Rank Organisation, 222 U.S.P.Q. 324, 326 (T.T.A.B. 1984); In re Geo. A. Hormel & Co., 218 U.S.P.Q. 286, 287 (T.T.A.B. 1983); In re Pennwalt, 173 U.S.P.Q. at 319.

Therefore, based on the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal under Section 2(e)(1) of the Trademark Act and that this application be passed to publication and, in due course, registration.

Respectfully submitted,

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