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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87570858

MARK: ZIKAVAX



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GENERAL TRADEMARK INFORMATION:

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APPLICANT: Bharat Biotech International Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

108139

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Bharat Biotech International Limited ("Applicant") appeals the examining attorney's final refusal to register the trademarks ZIKAVAX and ZICAVAC, both for "vaccine formulations" in International Class 5, on the grounds that the applied-for marks are merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

STATEMENT OF THE FACTS

Applicant filed two intent-to-use applications on August 16, 2017, seeking registration on the Principal Register for the trademarks ZIKAVAX in standard characters, U.S. Serial No. 87570858, and ZICAVAC in standard characters, U.S. Serial No. 87570862. Both identified the goods as “vaccine formulations” in International Class 5.

On November 21, 2017, registration was refused under Section 2(e)(1) of the Trademark Act on the grounds that ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of the goods, vaccine formulations.¹ Following Office Action responses filed on May 21, 2018, the examining attorney issued Final refusals under Section 2(e)(1) on June 14, 2018.

On December 14, 2018, Applicant filed a notice of appeal in each application regarding the Section 2(e)(1) Refusals, and filed an appeal brief in each application on December 17, 2018. The examining attorney filed Motions to Consolidate the cases in Serial Nos. 87570858 and 87570862 on December 28, 2018, which were granted on January 7, 2019. These applications are therefore briefed together, as follows.

The Office has reassigned this application to the undersigned trademark examining attorney.

ISSUE ON APPEAL

The sole issue on appeal is whether the marks ZIKAVAX and ZICAVAC are each merely descriptive of the applied-for goods, “vaccine formulations.”

ARGUMENT

¹ The Section 2(e)(1) refusals were issued after Examiner’s Amendments were entered into the record in each application on November 20, 2017, clarifying Applicant’s legal status. ZIKAVAX, November 20, 2017, TSDR p. 1; ZICAVAC, November 20, 2017, TSDR p. 1.

As the arguments set forth herein and the evidence in the record demonstrates, the applied-for marks ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of “vaccine formulations” because the marks are a combination of (1) the name of a virus and (2) common abbreviations for the word “vaccine,” which immediately informs consumers that the vaccine formulations are for the Zika virus. Further, Applicant’s arguments are unpersuasive because Applicant does not set forth any evidence that the applied-for marks are not descriptive of vaccine formulations for the Zika virus and has cited cases that are inapposite, and therefore the refusal to register the marks pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), should be affirmed.

I. ZIKAVAX and ZICAVAC Are Merely Descriptive of a Feature or Purpose of Applicant’s Identified Goods

Applicant seeks to register the marks ZIKAVAX and ZICAVAC, which combine the name of a virus, or novel misspelling thereof, with widely used abbreviations of the word “vaccine” for “vaccine formulations.” In this case, the evidence of record establishes that consumers will immediately understand the marks as a combination of descriptive terms forming composite wholes that merely describe a feature or purpose of Applicant’s goods as vaccines for preventing the Zika virus.

Registration was refused because the applied-for marks, ZIKAVAX and ZICAVAC, merely describe a feature or purpose of Applicant’s goods, “vaccine formulations.” Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.* A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)).

The evidence of record clearly establishes the descriptiveness of ZIKAVAX and ZICAVAC because the identified goods are “vaccine formulations,” and such a determination must be made in relation to

an applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). As the evidence of record demonstrates, ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of "vaccine formulations." First, the individual elements are descriptive because VAX and VAC are each common abbreviations for the word "vaccine," ZIKA is the name of a virus, for which vaccines are being developed, and ZICA is a novel misspelling of Zika. Second, it is common practice in the vaccine industry to combine the name of a virus with the abbreviations for "vaccine" to indicate that such product is a vaccine for the prevention of that named virus. Accordingly, in the context of "vaccine formulations," the marks ZIKAVAX and ZICAVAC are merely descriptive of Applicant's goods because they each immediately inform the consumer that Applicant's goods are vaccines with the feature or purpose of preventing the Zika virus. Finally, Applicant has not set forth sufficient evidence or arguments to refute the descriptive nature of the applied-for marks.

A. Each Element in the Applied-For Marks is Descriptive Individually

Here, the record evidence establishes that the component elements of the ZIKAVAX and ZICAVAC marks are merely descriptive individually, in addition to their composite form. Specifically, the record shows that ZIKA and ZICA would be understood to be the name of a virus, which is descriptive of a feature or purpose of vaccines because vaccines are used to prevent viruses, and that VAX and VAC would be recognized as abbreviations of "vaccine," which is descriptive of a key feature of vaccine formulations.

First, ZIKA is merely descriptive because it is the name of a virus that the vaccine would be used to prevent. The record contains the following definition of "Zika:" "Discovered in the Zika forest,

Uganda, in 1947, Zika virus is a member of the flavivirus family.” (ZIKAVAX, November 21, 2017, TSDR p. 2; ZICAVAC, November 21, 2017, TSDR p. 2).

In addition, the examining attorney requests that the Board take judicial notice of the following dictionary definition for “Zika virus:” “A flavivirus that is transmitted primarily by aedes mosquitoes and that causes a mild disease with symptoms that include fever, rash, joint pain, and conjunctivitis. Infection by the Zika virus in a pregnant woman can cause microcephaly or other brain defects in her infant. The virus can also be transmitted via sexual contact and from mother to child. Also called Zika virus.” Available at <https://www.ahdictionary.com/word/search.html?q=zika> (The American Heritage® Dictionary of the English Language, Fifth Edition copyright ©2019 by Houghton Mifflin Harcourt Publishing Company). The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. *See In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (taking judicial notice of definitions from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1747 n.15 (TTAB 2018); (taking judicial notice of definition from Dictionary.com because it was from *The Random House Unabridged Dictionary*); *see also* Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

With regard to the term ZICA, this wording is merely a phonetically identical, novel or intentional misspelling of the word “Zika.” A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 526 & n.9, 205 USPQ 505, 507 & n.9 (C.C.P.A. 1980) (holding “QUIK-PRINT,” phonetic spelling of “quick-print,” merely descriptive of printing and photocopying services); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017) (holding SHARPIN, phonetic spelling of “sharpen,” merely descriptive of cutlery knife blocks with built-in sharpeners); TMEP §1209.03(j). Here,

ZICA is phonetically equivalent to “Zika,” the name of a virus, because the words are identical except for the “C,” instead of the letter “k,” but it is common for a “c” to be pronounced like a “k,” and therefore ZICA is phonetically equivalent to “Zika.” Accordingly, for the same reasons that ZIKA is descriptive, ZICA is descriptive too.

Furthermore, the elements VAX and VAC in the applied-for marks are merely descriptive of Applicant’s goods, “vaccine formulations,” because each of those terms is a merely descriptive abbreviation of the word “vaccine,” that is, each is “substantially synonymous” with the descriptive word they represent, “vaccine.” See *In re Living Well Lab Inc.*, 122 USPQ2d (BNA) 1777, 1779 (TTAB 2017) (holding LAB substantially synonymous with merely descriptive term “laboratory” and thus merely descriptive of scientific research services); *In re Caliburger*, 2015 TTAB LEXIS 471, at *3-8 (TTAB Nov. 12, 2015) (holding that CALI is an abbreviation for “California” and therefore is geographically descriptive); TMEP §1209.03(h).

A mark consisting of an abbreviation will be considered substantially synonymous with descriptive wording if:

- (1) the applied-for mark is an abbreviation for specific wording;
- (2) the specific wording is merely descriptive of applicant’s goods; and
- (3) a relevant consumer viewing the abbreviation in connection with applicant’s goods will recognize it as the equivalent of the merely descriptive wording it represents.

TMEP §1209.03(h); See *In re Living Well Lab Inc.*, 122 USPQ2d (BNA) 1777, 1779 (TTAB 2017).

Here, the record evidence clearly demonstrates that (1) “vax” and “vac” are common abbreviations for the word “vaccine;” (2) the word “vaccine” is descriptive for Applicant’s goods, “vaccine formulations,” because that describes a key feature of the goods, namely, that they are vaccines; and (3) relevant consumers are accustomed to seeing the abbreviations “vax” and “vac” used

as the equivalent of the word “vaccine” when used in connection with vaccine formulations. Therefore, the elements VAX and VAC are substantially synonymous with the word “vaccine,” which is descriptive of a key feature of Applicant’s goods, “vaccine formulations.”

Regarding the element VAX, the following evidence shows that “vax” is used as a common abbreviation for the word “vaccine:”

- The Oxford Dictionary: “Vax” is defined as “a vaccine or vaccination.” (ZIKAVAX, June 14, 2018, TSDR p. 2);
- Voices for Vaccines: “From Anti-Vax to Pro-Vax”; “I dove deep into the anti-vax scene . . . until I convinced myself that I was making an informed choice not to vaccinate.” (ZIKAVAX, November 21, 2017, TSDR pp. 9-12);
- New York Post: ““I was an anti-vax crackpot until this happened”; “I began to doubt the anti-vaccine stance”; ““Purposely seeking out anti-vax books and websites that cited links between vaccines and rising rates of allergies, asthma, and ADHD”; “I got absorbed in the anti-vax culture”; “That’s the reason I wrote to the pro-vax advocacy group ‘Voices for Vaccines’”; ““If I can make even one anti-vaxxer think twice, speaking out will have been worth it.” (ZIKAVAX, November 21, 2017, TSDR pp. 13-28);
- Florida Health Care Plans: “don’t forget to call our flu hotline (1-866-281-5812) for any questions or concerns that you have about the flu vax.” (ZIKAVAX, June 14, 2018, TSDR p. 3);
- MedPage Today: “Two-Step Plan Boosts Flu Vax Rate for Kids with IBD” (ZIKAVAX, June 14, 2018, TSDR p. 4);
- Cosmos: “The research . . . helps to explain why the effectiveness of the flu vax tends to decrease in older people.” (ZIKAVAX, June 14, 2018, TSDR pp. 5-6);

- Vital Healthcare: “The flu: vax, facts, and counter attacks” (ZIKAVAX, June 14, 2018, TSDR p. 7);
- Western Michigan University: “Flu Vaccine Challenge . . . VOTE IN THE FLU VAX CHALLENGE” (ZIKAVAX, June 14, 2018, TSDR p. 8);
- Healthy Nut News: “Washington State requiring chicken pox vax for ALL public/private high schools” (ZIKAVAX, June 14, 2018, TSDR p. 10);
- Mamapedia: “Chicken Pox Vax” (ZIKAVAX, June 14, 2018, TSDR p. 11); and
- FierceBiotech: “GlaxoSmithKline jumps into clinic with swine flu vax” (ZIKAVAX, June 14, 2018, TSDR pp. 12-13).

Similarly, the following evidence shows use of “vac” as a common abbreviation for the word “vaccine:”

- All Acronyms: “VAC means Vaccine” (ZICAVAC, June 14, 2018, TSDR p. 2);
- Babycenter Community: “Are you anti-vac”; “After reading this, I am convinced and now will be helping spread the anti-vac word. . . . Are you anti-vac or pro-vac?”; “DD is strongly in the anti-vac camp, as she is terrified of them. Unfortunately for her I am in the pro-vac camp”; “I was anti-vac for a while . . .”; “Ew no. Pro vac all the way.” (ZICAVAC, November 21, 2017, TSDR pp. 9-18);
- The Sisterhood: “Why is Anti-Vac the New Black?”; “For this reason, I find myself increasingly baffled by the anti-vaccine movement . . .” (ZICAVAC, November 21, 2017, TSDR p. 19-25);
- WebMD: “Flu Vac Ts 2017-18(4 Yr,Up)-PF Syringe”; “Uses . . . This vaccine is used to prevent infection by the influenza (‘flu’) virus.” (ZICAVAC, June 14, 2018, TSDR p. 3);
- YouTube: “Bill Maher Flu Vac” which was a video clip of an interview about flu vaccines. (ZICAVAC, June 14, 2018, TSDR p. 4);

- Vimeo: “Child Flu Vac 2016” which was an informational video clip about flu vaccines for children. (ZICAVAC, June 14, 2018, TSDR p. 5);
- Babycenter Community: “Chicken pox vac”; “Has anyone’s LO (little one) broken out in a rash after the vaccine?” (ZICAVAC, June 14, 2018, TSDR p. 6);
- Mothering: “Mothering Forums > Health > Vaccinations > Chicken pox vac” (ZICAVAC, June 14, 2018, TSDR p. 7);
- Children with Diabetes: “Chicken Pox Vac and Type 1 Diabetes”; “I remember someone stating or a study suggesting Chicken Pox Vac was linked to type 1 diabetes . . . I’ve never heard that the vaccine may cause T1” (ZICAVAC, June 14, 2018, TSDR p. 8); and
- MedHelp: “Chicken Pox Vac”; “I took my 12yr old son into the Doctor for the Chicken Pox Shot” (ZICAVAC, June 14, 2018, TSDR p. 10).

As shown by the evidence of record, “vax” and “vac” are substantially synonymous with the word “vaccine” because (1) they are commonly used as a shortened form of the word “vaccine;” (2) the word “vaccine” is descriptive of a key feature of Applicant’s goods, “vaccine formulations,” namely, that they are vaccines; and (3) consumers are accustomed to the abbreviations “vax” or “vac,” when used in connection with vaccine formulations, to refer to vaccines. Therefore, VAX and VAC are descriptive because they are substantially synonymous with “vaccine,” which is descriptive of a key feature of Applicant’s goods, namely, that they are vaccines.

Accordingly, as individual elements, ZIKA, ZICA, VAX, and VAC are descriptive for “vaccine formulations” because they immediately communicate to consumers a feature or purpose of Applicant’s goods, namely, that they are vaccines, and that Zika is a virus for which they can be used to prevent.

Notably, Applicant does not contest the meanings of these terms. ZIKAVAX, May 21, 2018, TSDR pp. 1-6, ZICAVAC, May 21, 2018, TSDR pp. 1-6, ZIKAVAX, 4 TTABVUE, and ZICAVAC, 4 TTABVUE, *passim*.

B. The Applied-For Marks are Descriptive in Their Composite Form

Here, the individual components ZIKA, ZICA, VAX, and VAC, when combined into ZIKAVAX and ZICAVAC, each retain their descriptive meaning in relation to Applicant's goods, "vaccine formulations," and further, the combination results in a composite mark that is itself descriptive of a feature or purpose of Applicant's goods, namely, vaccine formulations for preventing the Zika virus, because the evidence of records shows that consumers of vaccines are accustomed to seeing the name of a virus paired with abbreviations for the word "vaccine" to describe vaccines used to prevent such virus. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB (2002)); TMEP §1209.03(d); see, e.g., *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1851 (TTAB 2017) (holding MEDICAL EXTRUSION TECHNOLOGIES merely descriptive of medical extrusion goods produced by employing medical extrusion technologies).

Here, the evidence of record shows that the composite result of each applied-for mark is descriptive of Applicant's goods because neither creates a unique, incongruous, or nondescriptive meaning in relation to "vaccine formulations." *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (holding BATTLECAM merely descriptive of computer game software with a feature that involve battles and provides the player with the option to utilize various views of the battlefield); *In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL merely descriptive of publications featuring news and information about Atlanta where THEATL was the equivalent of the nickname THE ATL for the city of Atlanta).

Specifically, the record amply demonstrates that consumers are not only accustomed to seeing "vax" as an abbreviation for "vaccine," but also that consumers are accustomed to seeing "vax" being used in connection with the name of a specific virus to indicate that the vaccine is for such virus, e.g., flu vax, chicken pox vax. See evidence from Florida Health Care Plans, MedPage Today, Cosmos, Vital

Healthcare, Western Michigan University, Healthy Nut News, Mamapedia, and FierceBiotech discussed above. Likewise, the record also amply demonstrates that consumers are not only accustomed to seeing “vac” as an abbreviation for “vaccine,” but also that consumers are accustomed to seeing “vac” being used in connection with the name of a specific virus to indicate that the vaccine is for such virus, *e.g.*, flu vac, chicken pox vac. See evidence from WebMD, YouTube, Vimeo, Babycenter Community, Mothering, Children with Diabetes, and MedHelp discussed above. Thus, the combination of ZIKA, or the phonetic equivalent ZICA, the name of a known virus, plus the abbreviation VAX or VAC immediately informs consumers that Applicant’s goods are vaccines for preventing the Zika virus. Applicant’s goods are “vaccine formulations,” which is written so broadly as to include vaccines for preventing the Zika virus. Therefore, ZIKAVAX and ZICAVAC merely describe a feature or purpose of Applicant’s goods.

Accordingly, the combination of the elements into ZIKAVAX and ZICAVAC do not create unique, incongruous, or otherwise nondescriptive unitary wholes. Rather, the evidence demonstrates that ZIKAVAX and ZICAVAC as composite marks immediately describe Applicant’s goods as vaccine formulations for preventing the Zika virus. As such, the marks are merely descriptive of a feature or purpose of Applicant’s goods, and the refusal to register the marks pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), should be affirmed, and these appeals denied.

II. Applicant’s Arguments Are Unpersuasive

In its briefs, Applicant argues that ZIKAVAX and ZICAVAC, “when considered as a whole, do[] not ‘immediately or with any degree of particularity’ describe fraud prevention and detection-related goods[sic]. Rather, ‘ZIKAVAX’ [and ZICAVAC] requires the use of ‘thought’ and ‘some measure of imagination’ to reach a conclusion as to the nature of the identified goods.” ZIKAVAX, 4 TTABVue 7-8; ZICAVAC, 4 TTABVue 7-8. Applicant relies heavily on *Physicians Formula v. West Cabot Cosmetics, Inc.*, 8

USPQ2d 1136 (2d Cir. 1988) and *In re Hamilton Watch Co.*, 158 USPQ 300, 301 (TTAB 1968). ZIKAVAX, 4 TTABVUE 7-9; ZICAVAC, 4 TTABVUE 7-9. Applicant's reliance is misplaced.

Physicians Formula has little to no bearing on this case because it is an Opinion from the U.S. Court of Appeals for the Second Circuit, granting summary judgment arising from a trademark infringement lawsuit, and not an ex parte appeal of a refusal to register pursuant to Section 2(e)(1) of the Trademark Act. 8 USPQ2d 1136 (2d Cir. 1988). Therefore, any analysis set forth by the Court is purely dicta and not binding on the Board. Further, even briefly applying the Court's reasoning to the facts in this appeal, unlike PHYSICIANS and FORMULA, which could refer to any number of goods, ZIKA and ZICA clearly refer to the Zika virus, and VAX and VAC are common abbreviations for "vaccine." Therefore, if the average consumer encountered this mark in the marketplace, the mark would immediately inform such consumer of a feature or purpose of Applicant's vaccine formulations, namely that they are vaccine formulations for the prevention of the Zika virus. Applicant argues that the mark "does little more than locate the goods as possibly in the realm of vaccination formulations." (ZIKAVAX, 4 TTABVUE 9; ZICAVAC, 4 TTABVUE 9) (emphasis in the original). That statement concedes the argument, however, because Applicant's goods are, in fact, "vaccine formulations," and when an abbreviation for the word "vaccine" is combined with the name of a virus, like the Zika virus, that immediately informs consumers that, in the "realm of vaccine formulations," Applicant's goods have the feature or purpose of preventing the Zika virus. Therefore, ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of Applicant's goods, "vaccine formulations."

Applicant also cited *Hamilton Watch*. (ZIKAVAX, 4 TTABVUE 7-8; ZICAVAC, 4 TTABVUE 7-8). Such reliance on *Hamilton Watch* is also misplaced because the posture and basis for the Board's decision is almost the exact opposite of the posture of this appeal. In *Hamilton Watch*, the Board reversed the refusal under Section 2(e)(1) because the examining attorney did not submit any evidence beyond dictionary evidence (*Hamilton Watch*, 158 USPQ at 300), but, conversely, the applicant

submitted sufficient evidence to rebut the examining attorney's arguments, and Board determined that the mark had no descriptive meaning. *Hamilton Watch*, 158 USPQ at 301.

In stark contrast, the record in this appeal contains significant evidence, going beyond dictionary evidence, of real-world usage of "vax" and "vac" as abbreviations for "vaccine" and that consumers are accustomed to seeing the name of a virus paired with abbreviations for the word "vaccine" to describe a vaccine for preventing that virus. ZIKAVAX, November 21, 2017, TSDR pp. 9-28; ZICAVAC, November 21, 2017, TSDR pp. 9-25; ZIKAVAX, June 14, 2018, TSDR pp. 2-13; ZICAVAC, June 14, 2018, TSDR pp. 2-10. Here, Applicant has not provided any evidence to rebut the examining attorney's evidence, beyond conclusory statements that ZIKAVAX and ZICAVAC are not merely descriptive of a feature or purpose of vaccine formulations. ZIKAVAX, May 21, 2018, TSDR pp. 1-6, ZICAVAC, May 21, 2018, TSDR pp. 1-6, ZIKAVAX, 4 TTABVUE, and ZICAVAC, 4 TTABVUE, *passim*.

Applicant asserts that the marks ZIKAVAX and ZICAVAC require some degree of imagination or thought to reach a conclusion as to the nature of vaccine formulations. Other than conclusory statements, however, Applicant presents no evidence that ZIKAVAX and ZICAVAC are not descriptive. See ZIKAVAX, 4 TTABVUE and ZICAVAC, 4 TTABVUE, *passim*. Merely stating that a double entendre is registrable does not present any evidence proving that ZIKAVAX or ZICAVAC are double entendres and thus are registrable on that basis. Likewise, arguing that the marks have other meanings does not does not negate the descriptive meanings that are set forth above, especially when Applicant did not provide any other specific meanings or evidence thereof. Conversely, the record strongly supports the conclusion that ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of Applicant's "vaccine formulations" because "vax" and "vac" are common abbreviations for the word "vaccine;" "Zika" is the name of a known virus; and that consumers are accustomed to seeing the name of a virus paired with the word vaccine or abbreviations thereof used to describe vaccines whose purpose is to prevent said virus.

Applicant states that a mark may convey minimal information without rising to the level of being descriptive (ZIKAVAX, 4 TTABVUE 9; ZICAVAC, 4 TTABVUE 9), but Applicant does not explain or provide evidence why the information conveyed by ZIKAVAX and ZICAVAC is only minimal and thus only suggestive. (See ZIKAVAX, 4 TTABVUE and ZICAVAC, 4 TTABVUE, *passim*).

Applicant also asserts that this is a made-up term (ZIKAVAX, 4 TTABVUE 9; ZICAVAC, 4 TTABVUE 9), but the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that ZIKAVAX and ZICAVAC are merely descriptive of vaccine formulations for preventing the Zika virus, and even if Applicant is first to use those terms, that does not negate the descriptive nature of the marks that has been set forth in this brief and supported by an abundant record of evidence. See *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

Applicant argues that any doubt regarding the mark's descriptiveness should be resolved in Applicant's favor. (ZIKAVAX, 4 TTABVUE 10; ZICAVAC, 4 TTABVUE 10 (each citing *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)). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive. That evidence shows that, in the context of Applicant's goods, ZIKAVAX and ZICAVAC are each merely descriptive of "vaccine formulations" because each immediately conveys information about a feature or purpose of Applicant's goods, namely that these are vaccine formulations for preventing the Zika virus.

Finally, Applicant asserts that evidence has not been presented establishing a substantial showing that ZIKAVAX and ZICAVAC are merely descriptive (ZIKAVAX, 4 TTABVUE 9; ZICAVAC, 4 TTABVUE 9), but while this is the standard of review for the Federal Circuit when reviewing questions of fact, such

as a determination by the Board that a mark is merely descriptive, that is not the standard of review for the Board itself in reviewing an examining attorney's refusal. The Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board have long recognized that the USPTO has limited resources for obtaining evidence when examining applications for registration; the practicalities of these limited resources are routinely taken into account when reviewing a trademark examining attorney's action. See *In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (citing *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985)); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016) (quoting *In re Budge Mfg., Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260-61 (Fed. Cir. 1988)); TBMP §1208 nn.2 & 9. Here, sufficient evidence has been attached to the record in each application to establish that ZIKAVAX and ZICAVAC are merely descriptive of a feature or purpose of Applicant's "vaccine formulations." Accordingly, the refusal to register the marks pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), should be affirmed, and these appeals denied.

CONCLUSION

The evidence and arguments show that both the applied-for marks, ZIKAVAX and ZICAVAC, are merely descriptive for the goods identified in the applications, namely, "vaccine formulations" because they describe a feature or purpose of Applicant's goods, namely, that they are vaccine formulations for the prevention of the Zika virus. Additionally, Applicant has not stated that it might amend to the Supplemental Register if the marks are found to be merely descriptive, and therefore Applicant has not preserved this option. See TMEP § 1501.06. In light of this, Applicant's appeals should be denied and the refusals to register the marks should be affirmed on the basis of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), for the reason that the applied-for marks are merely descriptive of a feature or purpose of Applicant's goods.

Respectfully submitted,

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Zi·ka (zē'ka)

n.

1. A flavivirus that is transmitted primarily by aedes mosquitoes and that causes a mild disease with symptoms that include fever, rash, joint pain, and conjunctivitis. Infection by the Zika virus in a pregnant woman can cause microcephaly or other brain defects in her infant. The virus can also be transmitted via sexual contact and from mother to child. Also called *Zika virus*.
2. The infection caused by this virus. Also called *Zika virus disease*, *Zika virus infection*.

[So called because the virus was first isolated in 1947 from a sample taken from a Rhesus monkey at the virological research station in the Zika Forest near Entebbe, Uganda.]

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