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

Ex Parte Appeal - Serial No.	88960633
Appellant	Uman Diagnostics AB
Applied for mark	NF-LIGHT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Uman Diagnostics AB	Examining Attorney:
Serial No.: 88/960633	Lyal Fox
Filed: June 11, 2020	Law Office: 113
Mark: NF-LIGHT	

REPLY BRIEF

I. INTRODUCTION

Applicant submits this reply to the Examining Attorney's Appeal Brief dated June 13, 2022, and respectfully requests that the Board reverse the genericness and mere descriptiveness refusals in the present case. In the alternative, Applicant requests that the Board allow the application to proceed to registration on the Principal Register under § 2(f) of the Trademark Act or, in the alternative, proceed to registration on the Supplemental Register.

II. ARGUMENT

Generic terms do not qualify for registration on the Principal Register under § 2(f) or Supplemental Register because they are incapable of distinguishing source. *See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). The ultimate test for determining whether a mark is generic, and therefore ineligible for registration, is its primary significance to the relevant purchasing public. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). *See also In re Am. Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (finding the PTO did not satisfy its burden of proving

SOCIETY FOR REPRODUCTIVE MEDICINE for association services is generic based solely on the genericness of the phrase's constituents). The Examining Attorney has the burden of proving genericness. *Merrill Lynch*, 4 USPQ2d at 1143. Doubt on the issue of genericness is to be resolved in favor of the applicant. *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993).

The Examining Attorney argues that (1) the abbreviation "NF-light" is a "well-established" abbreviation for the wording neurofilament light; and (2) the relevant public understands Applicant's mark to refer to a genus of "specimen analysis kits containing reagents and assays for detecting neurological biomarkers in biological samples, serum, blood, plasma, saliva, and cerebrospinal fluid in human and animal samples used by medical and clinical researchers in labs and institutions." Furthermore, the Examining Attorney rejects Applicant's claim of acquired distinctiveness and maintains the mark is merely descriptive under § 2(e)(1). As demonstrated in Applicant's initial brief and by the arguments set forth below, the Examining Attorney has not satisfied his burden of proving Applicant's mark NF-LIGHT for the applied-for goods is generic. Moreover, Applicant submits that its evidence sufficiently demonstrates the mark has acquired distinctiveness. In the alternative, if the Board maintains the Examining Attorney's descriptiveness refusal, Applicant requests to amend the present application to seek registration on the Supplemental Register.

i. NF-LIGHT Is Not An Abbreviation For Neurofilament Light

First, the Examining Attorney argues that "the abbreviation NF-light is a well-established abbreviation for the wording neurofilament light" and points to eighteen purported pieces of evidence in an attempt to establish this fact. 14 TTABVUE 5-7.

However, the Examining Attorney's first citation references Applicant's own webpage which displays Applicant's listing for its goods as NF-LIGHT (Neurofilament light) ELISA kit. Office Action dated Sep. 17, 2020 at p. 13; Office Action dated Mar. 27, 2021 at pp. 9-10. Contrary to the Examining Attorney's assertions, Applicant is not implying (implicitly or explicitly) that NF-LIGHT is an abbreviation for neurofilament light. As Applicant has previously clarified, the relevant industry is highly specialized and utilizes a particular naming convention for products similar to those of Applicant's. When referencing these products, the scientific/medical industry will first state the product brand name (i.e., the trademark), followed by the name of the target analyte, and then the generic designation of the type of kit. *See* Applicant's Appeal Brief, 12 TTABVUE 8-9. Applicant's usage in this sense is therefore not a concession that NF-LIGHT is an abbreviation for the target analyte, neurofilament light. Instead, Applicant is simply following the standard naming convention for these types of products within the field (i.e., NF-LIGHT (trademark) Neurofilament light (target analyte) ELISA (generic descriptor)). *Id.* Furthermore, the Examining Attorney's argument that this use by Applicant is an "explicit implication" that NF-LIGHT is an abbreviation for neurofilament light is unfounded as in each instance NF-LIGHT is referred to on Applicant's website or related advertising materials, it is immediately followed by the ® or ™ symbols.[1] Contrary to the Examining Attorney's contentions, Applicant clearly informs purchasers and users that it is claiming exclusive rights in NF-LIGHT as a trademark and source identifier for the applied-for goods.

[1] Applicant has been advised that it should not use the registration symbol ® with the applied-for mark in the future and has agreed to the same.

The remaining evidence submitted by the Examining Attorney, the following seventeen citations, do show *some* generic usage by third parties of NF-LIGHT. However, these references are outweighed by Applicant's evidence showing third-party recognition of NF-LIGHT as a trademark. Applicant has provided at least twenty-three items of evidence that show use of NF-LIGHT as a source identifier for Applicant's goods. The Federal Circuit and Trademark Trial and Appeal Board have long recognized that, when the record evidence shows mixed usage of the term at issue, the Trademark Office has failed to meet its burden of establishing genericness. *Merrill Lynch*, 4 USPQ2d at 1143. *See also In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006) ("the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties"). Indeed, in a decision from only several weeks ago, *In re Mr. Bator*, the Board reversed a genericness refusal for MULLET for bicycles finding "[a]ny doubts raised by . . . mixed usage of a term must be resolved in Applicant's favor." Serial No. 88244852 (June 7, 2022) [not precedential] at *32. In *Mr. Bator*, the Examining Attorney and applicant submitted equal amounts of evidence regarding use of "mullet" as a particular type of bicycle and as Applicant's trade name or trademark. Here, Applicant has submitted **more** evidence of trademark use of NF-LIGHT than the Examining Attorney has submitted of purported generic usage of the mark. In sum, the Examining Attorney has simply not provided sufficient evidence to establish that NF-LIGHT is generic for the applied-for goods.

ii. Applicant's Mark Is Not Generic As Applied To Its Goods Because The Relevant Purchasing Public Does Not Understand NF-LIGHT Primarily As A Common Or Class Name

Applicant maintains that the relevant consumers in this case – highly sophisticated medical and clinical researchers in labs and institutions – do not perceive NF-LIGHT as a common or class name for specimen analysis kits. More specifically, the relevant purchasing public does not understand NF-LIGHT as an abbreviation for neurofilament light. Instead, the abbreviation for neurofilament light in the medical and scientific industry is NfL or NEFL. Response to Office Action dated Mar. 17, 2021 at pp. 12, and 19-105; Request for Reconsideration dated Sept. 27, 2021 at pp. 9, 19, and 72 ¶ 4. Applicant's field is highly specialized, and operates on the cutting edge of research on neuronal diseases such as Alzheimer's disease, multiple sclerosis, traumatic brain injury, and amyotrophic lateral sclerosis. Response to Office Action dated Mar. 17, 2021 at p. 11; Request for Reconsideration dated Sept. 27, 2021 at p. 72 ¶ 3. In this technical industry, naming and precision is of the utmost importance, and it is NfL or NEFL that is the recognized abbreviation of "neurofilament light" used by researchers. These consumers do not understand NF-LIGHT primarily as a common or class name for Applicant's goods, but instead perceive the term as a trademark to identify Applicant's products and distinguish them from related specimen analysis kits in the field. This is amply demonstrated by the carefully delineated, precise usage employed in numerous leading academic journals submitted by Applicant. Since any doubt regarding the issue of genericness should be resolved on an applicant's behalf, the Board should reverse the genericness refusal.

iii. Applicant Has Submitted Sufficient Evidence To Support Its Claim Of Acquired Distinctiveness

A mark may be registered on the Principal Register upon proof of acquired distinctiveness or secondary meaning. Trademark Act § 2(f), 15 U.S.C. § 1052(f). Evidence to show proof of acquired distinctiveness may include, among others, five or more years' continuous use of the mark, recognition of the mark as a source indicator, and unsolicited media coverage. *See Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). "[N]o single factor is determinative" and "[a] showing of secondary meaning need not consider each of the[] elements." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

The Examining Attorney has asserted that Applicant has failed to provide sufficient evidence to establish acquired distinctiveness because Applicant has "only" relied on a claim of five or more years of use and peer reviewed journal articles. With respect to the journal articles, in particular, the Examining Attorney asserts that the evidence is unpersuasive because the articles are not impartial. He points to the fact that Applicant's Vice President and Managing Director, Niklas Norgren, was an author for some of the articles, and that one (out of twenty-three) of the papers references that Applicant donated its NF-LIGHT kits for the particular study. This is the first time the Examining Attorney has raised the issue of impartiality of the articles cited by Applicant. These arguments are baseless in law and fact.

Applicant has submitted twenty-three articles published in many of the world's preeminent, peer-reviewed scientific journals in which the authors have clearly recognized NF-LIGHT as a source indicator for Applicant's goods. The journals are among the most well-known and highly respected in the industry, operating at the highest

levels of medical and scientific achievement. The authors are luminaries in their respective fields, affiliated with some of the world's most influential research institutions. Articles such as those cited by Applicant are foundational to the advancement of medical research into the world's most debilitating diseases and are relied on by researchers and clinicians world-wide to carry out their own research. In this context, accuracy and impartiality are of the utmost importance. Scholarly, peer-reviewed publications are the pinnacle of market adoption and recognition in Applicant's field – it signifies Applicant's legitimacy and usability to others in the market and serves as a true, third-party assessment of Applicant's capabilities.

Moreover, journal articles of this stature are routinely and carefully peer-reviewed by independent third-party experts for scientific and technical accuracy prior to publication. Indeed, Applicant's goods are central to the tests carried out by the researchers authoring these papers to support their findings. An accurate description of Applicant's products and their source – which is generally included in the Materials and Methods sections of these publications – is critical to the scientific validity and repeatability of the studies presented in these articles. In this context, the accurate description of the name and source of Applicant's products is not happenstance: It is essential. In addition, the papers are carefully reviewed, not only by the authors themselves, but by independent, third-party peer reviewers who are themselves experts in the field. The assertion that a small, eight employee company based in Umea, Sweden could affect the impartiality of the information presented in the articles beggars belief.

In fact, the Examining Attorney's opinion is entirely speculative as he has no evidence as to how Niklas Norgren contributed to or influenced the drafting of these

papers, which have been subjected to careful pre-publication review by independent third parties. Furthermore, in the four articles (out of twenty-three) in which Niklas Norgren is listed as an author, he appears sixth or later in the list. Authors of scientific papers are often listed in order of contribution to the work. *See How to Order Author Names and Why That Matters*, WORDVICE, https://blog.wordvice.com/journal-article-author-order/v (last visited July 5, 2022). Also, the Examining Attorney's contention that because Applicant donated its kits to one study, and that that donation somehow influenced consumer perception of NF-LIGHT as a mark, is completely unfounded. There is simply no evidence that trademark recognition is affected whatsoever based on whether the products were purchased or donated to consumers. Numerous other journal articles establish the opposite: Consumers of Applicant's goods, who are carefully versed in usage and terms commonly used in Applicant's industry, recognize NF-LIGHT as a source indicator for Applicant's products.

Instead, Applicant submits that its evidence is sufficient to establish acquired distinctiveness. Applicant has submitted sworn testimony that it has been using its mark in the industry since at least as early as November 13, 2012. Response to Office Action dated Mar. 17, 2021 at p. 107 ⁋⁋ 3-4; Request for Reconsideration dated Sept. 27, 2021 at p. 69 ⁋⁋ 8-9. Furthermore, the record includes two signed declarations by members of the industry confirming that the relevant public understands NF-LIGHT as a source indicator. Response to Office Action dated Mar. 17, 2021 at pp. 107-08 Request for Reconsideration dated Sept. 27, 2021 at pp. 68-73. One of the declarations is by Jens Kuhle, Head of the Multiple Sclerosis Centre, Senior Physician of University Hospital Basel, a renowned researcher in the field. Applicant has also submitted twenty-three

pieces of evidence of third-party recognition of the mark. This evidence includes publications from *Neurology* (the top leading source for medical and clinical researchers in neurological study), *Neurology: Neuroimmunology & Neuroinflammation*, *Nature Communications*, *The Multiple Sclerosis Journal*, *The Journal of Immunological Methods*, *Amyotrophic Lateral Sclerosis and Frontotemporal Degeneration, Alzheimer's Research and Therapy*, and *BioCompare*. Because it comes from the most prestigious and highly regarded journals within Applicant's industry, and they collectively refer to NF-LIGHT as a source indicator for Applicant's products, this evidence is highly probative that Applicant's mark has acquired distinctiveness.

III. CONCLUSION

In light of the record evidence of mixed usage of Applicant's mark, and mindful that doubt on the issue of genericness should be resolved on an applicant's behalf, the Board should reverse the final refusal to register Applicant's mark under §§ 1, 2, and 45 of the Trademark Act. Alternatively, Applicant's claim of acquired distinctiveness under § 2(f) should have been accepted and that the mark be allowed to proceed to publication. Finally, should the Board deem Applicant's mark to be merely descriptive and maintain the insufficient claim of acquired distinctiveness refusal, Applicant requests registration of its mark on the Supplemental Register.