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

Ex Parte Appeal - Serial No.	90536031
Appellant	Bristol-Myers Squibb Company
Applied for mark	A CHANCE TO LIVE LONGER
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Submission	Reply brief
Attachments	Reply Brief A CHANCE TO LIVE LONGER and design.pdf(441416 bytes)
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Date	04/29/2024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant:	Bristol-Myers Squibb Company	:
Serial No:	90536031	:
Mark:	A CHANCE TO LIVE LONGER	:
Filed:	February 19, 2021	:

APPLICANT'S REPLY BRIEF

Applicant Bristol-Myers Squibb respectfully submits this reply brief in support of its appeal from the Examining Attorney's requirement for a disclaimer of A CHANCE TO LIVE LONGER.

OBJECTIONS TO EXAMINING ATTORNEY'S BRIEF

Applicant objects to the following irrelevant and erroneous material included in the Examining Attorney's Brief in this matter.

1. Attachments To Examining Attorney's Brief

The Examining Attorney's brief attaches twenty-two pages of printouts from YakChat, an SMS text messaging application. This material is not properly introduced and is not relevant to this proceeding. (10 TTABVUE 11-32.) Applicant objects to any consideration of this material.

2. Corrections To "Statement of Facts" In Examining Attorney's Appeal Brief

The Examining Attorney's Appeal Brief states that Applicant filed an application on February 19, 2021 seeking registration of the mark A CHANCE TO LIVE LONGER and design, in stylized font, for "Printed matter, namely, brochures and pamphlets in the field of cancer" in Class 16, and "Medical information services" in Class 44, without a filing basis. (10 TTABVUE 2.) This is not accurate to the extent that it omits goods from the initial application that were

deleted later in the application process. In fact, Applicant's initial application sought to register A CHANCE TO LIVE LONGER and design for "Pharmaceutical preparations for human use for the treatment of cancer" in Class 5, "Printed matter, namely, magazines, books, booklets, brochures, pamphlets, newsletters and catalogs in the field of cancer" in Class 16, and "Medical information services" in Class 44. (Feb. 21, 2021 Application.) This is relevant because the requirement for a disclaimer issued while all of these goods and services were present in the application.

The Examining Attorney's Appeal Brief also states that Applicant deleted Class 5 from its application on January 27, 2023. (10 TTABVUE 2.) This date is incorrect. Applicant filed its Response to Office Action deleting Class 5 on February 27, 2023. (Feb. 27, 2023 Response to Office Action, TSDR p. 1.)

ARGUMENT

The record does not establish that A CHANCE TO LIVE LONGER "merely" conveys general information about the goods and services, or that the matter is a commonplace phrase or message. In the context of advertising of marks in the medical, pharmaceutical and health and wellness fields, it is customary for slogans to convey information about the benefits of a particular drug or treatment, but such marks are not refused registration as being "merely" informational. As the evidence does not support the Examining Attorney's determination and instead supports a conclusion that Applicant's mark is suggestive and entitled to registration, the requirement for a disclaimer of the wording must be reversed.

1. The Examining Attorney's Determination of The Registrability of A CHANCE TO LIVE LONGER Was Not Based On The Specimens Or Applicant's Evidence of Use.

As the Examining Attorney acknowledges, the specimen and any other relevant evidence of use must be reviewed to determine whether an applied-for mark is being used as a trademark.

(10 TTABVUE 9 (citing cases).) Despite reciting this principle, though, the determination in this case was made before the Allegation of Use was even filed. As admitted by the timeline of proceedings in his brief, the Examining Attorney required a disclaimer of the words A CHANCE TO LIVE LONGER in the first Office Action that issued, *before* Applicant filed its Allegation of Use and specimens. (10 TTABVUE 2 (non-final Office Action refusing registration, in part, because A CHANCE TO LIVE LONGER is a "widely-used commonplace informational message" on Sept. 15, 2021, although Amendment to Allege Use not filed until Aug. 24, 2022); *see also* Aug. 24, 2022 Specimen, TSDR pp. 1-27.) At the time the Examining Attorney made this determination, the application file consisted of the application (which did not state any basis for registration) and evidence attached to a Letter of Protest that was placed in the record. (Sept. 15, 2021 Office Action, TSDR p. 2.) In light of this fact, the Examining Attorney's subsequent efforts to justify the requirement for a disclaimer by saying that the use on the specimen would not be perceived by consumers as distinguishing the goods and/or services, or identifying their source, ring hollow.

Instead, the Examining Attorney had made up his mind that the wording was merely informational or a commonplace message well before Applicant submitted its Allegation of Use and specimens of use, based solely on the Letter of Protest evidence. (*See* Sept. 15, 2021 Office Action Outgoing, TSDR p. 2 (referring to evidence attached in June 25, 2021 Letter of Protest in determining that A CHANCE TO LIVE LONGER was widely used commonplace message)). Then, when evaluating the actual specimens of use that were submitted in support of the application, the Examining Attorney *accepted* the specimens of use for the goods and services that remain in this application on appeal.[1] (Aug. 31, 2022 Non-Final Action Office Action,

[1] The specimen for Class 5 was not accepted because it did not show the applied-for mark as actually used in commerce in connection with any of the goods specified in International Class 5.

TSDR pp. 1-2.; *see also* 10 TTABVUE 2.) There was no mention in the Office Action rejecting the Class 5 specimen, and accepting the specimens for Classes 16 and 44, that the wording was merely informational or a commonplace message. The August 31, 2022 Office Action stated:

> Specifically, the specimens of record demonstrate the mark being used in connection with Class 16 "pamphlets and brochures," and Class 44 "medical information" appearing on the applicant's website. However, the specimens of record fail to show the mark being used in connection with the applicant's goods in Class 5, specifically, "pharmaceutical preparations."

(Aug. 31, 2022 Office Action, TSDR p. 2.)

Later, the Examining Attorney issued a subsequent final Office Action maintaining the disclaimer requirement for all wording in the mark. (Mar. 1, 2023 Subsequent Final Action, p. 1.) In denying Applicant's request for reconsideration, the Examining Attorney for the first time stated that the mark, as shown on the specimens, does not function as a trademark. (*Id.* at pp. 1-2.) These *ex post facto* justifications for why the wording is merely informational or a commonplace message are not persuasive.

In his brief, the Examining Attorney argues that Applicant failed to demonstrate that the applied-for mark is perceived as a source indicator for the goods and services. (10 TTABVUE 7-9.) The chief objection as to why the specimens would not be perceived as a source indicator is because the wording "appears directly above a 'primary analysis,' which specifies that OPDIVO + YERVOY reduce the risk of dying by 21% compared to planum-based [*sic*] chemotherapy." (*Id.* at 8-9.) The Examining Attorney concludes that "[t]he use of the wording A CHANCE TO LIVE LONGER directly above this information creates a direct connection between taking the applicant's cancer medication and being given a chance to live longer vs taking a specific type of chemotherapy." (*Id*.)

The positioning of the mark "directly above other information also contained on the specimen about scientific results that show a reduction of risk of dying" does not prevent the phrase from also being perceived as a trademark by consumers. In fact, a specimen "must show the mark used in a manner that creates in the minds of potential consumers a direct association between the mark and the services." (Trademark Manual of Examining Procedure ("TMEP") § 1301.04(f)(ii); *accord* TMEP § 904.03(i)(B) (website display specimens must show the mark in direct association with the goods)). This placement and positioning of the mark on the specimen did not prevent the Examining Attorney from concluding that the specimens "demonstrate the mark being used in connection with Class 16 'pamphlets and brochures,' and Class 44 'medical information'." (Aug. 31, 2022 Office Action, TSDR p. 2.) Moreover, the mark is used prominently on the specimens in a manner calculated to project to consumers that the mark is an indicator of a single source. It is presented in the same stylization and colors, and with the same design element, as the pharmaceutical brand name to which it relates. As shown by the fact that the specimens were accepted, they evidence valid use of the mark in commerce.

2. A CHANCE TO LIVE LONGER Is Not "Merely" Informational.

The fact that the specimen includes information that demonstrates the truth of the slogan does not mean that the mark is "merely" informational. Many marks provide truthful information about a feature or characteristic of the goods or services, but this does not prevent them from also qualifying as source-indicators. Providing information about the goods or services is common for slogan trademarks. Consider examples of well-known slogans such as "Melts in your mouth, not in your hand®" (M&M's), "All the news that's fit to print®" (New York Times), "The ultimate driving machine®" (BMW), "Have it your way®" (Burger King), "Good to the last drop®" (Maxwell House), and "You're in good hands®" (Allstate).

For this disclaimer requirement to stand, the matter must be "*merely* informational" TMEP §1202.04 (emphasis ours). As the attached entry from Merriam-Webster.com shows (printout attached as Exhibit A[2]), the word "merely" means "nothing more than" or "only." Because the phrase A CHANCE TO LIVE LONGER is suggestive of the goals or results of Applicant's goods and services, it is not "merely" informational. It is also presented prominently on the specimens in uniformity with other brand elements that draw an association between the product name and the associated slogan, giving the words a source-identifying function.

3. The Wording in The Mark Is Not A Commonplace Message.

A CHANCE TO LIVE LONGER is a slogan of the type readily deemed registrable by the USPTO. TMEP § 1213.05(b)(i) says that "[a] slogan is a type of phrase and is defined as 'a brief attention-getting phrase used in advertising or promotion' and 'a catch phrase used to advertise a product.'" This TMEP section includes a link to the dictionary definition of "slogan" at Merriam-Webster.com (http://www.merriam-webster.com/dictionary/slogan). Applicant visited this link (printout attached as Exhibit B), and it includes another definition of "slogan" that is not reflected in the TMEP and that is highly pertinent here. A slogan is also defined in Merriam-Webster.com as "a word or phrase used to express a characteristic position or stand *or a goal to be achieved*" (emphasis ours). Wholly in line with this other definition of a slogan, the phrase A CHANCE TO LIVE LONGER is suggestive of the goals or results of Applicant's goods and services. The goals or results of goods or services are one mental step removed from the actual goods sold or services performed under the mark. The Board has held such marks to be inherently registrable and suggestive.

[2] Per Trademark Trial and Appeal Board Manual of Procedure § 1208.04, the Board may take judicial notice of dictionary definitions, including definitions in online dictionaries that exist in printed format or that have regular fixed editions.

Some types of slogans are incapable of uniquely identifying a single source, and thus do not qualify for registration. These include commonplace safety admonitions, expressions of affinity for a person, place, or thing, and ubiquitous mottos and phrases used in everyday speech. The evidence in this case does not establish that A CHANCE TO LIVE LONGER is the type of slogan that is incapable of operating as a source-identifier. Instead, the evidence

shows the words "a chance to live longer" used in common parlance by health care professionals, patients, pharmaceutical companies, news agencies, and others, in reference to medical information relating to the benefit of medications and treatments that give people with illnesses a chance to live longer. (10 TTABVUE 4.) Applicant's evidence shows that the same can be said of many slogan marks made up of common English words that are the subject of registrations on the Principal Register for use in the medical, health and wellness fields such as "Managing Your Diabetes," "Helping To Cure," "Transforming Cancer Outcomes," "It's Time To Get The Facts," "Know For Sure," and "My Leukemia Journey." (8 TTABVUE 11-17.) This shows that consumers are accustomed to encountering slogans that, despite also being phrases that they might hear or see used in common parlance, nonetheless serve as source-identifying indicia. Applicant provided many other examples of federally registered slogans that similarly suggest a benefit or consequence of use of the product in the field of health and wellness that show that this practice is common. (Mar. 15, 2022 Response to Office Action, Exhibit A, TSDR pp. 13-47; Aug. 31, 2023 TEAS Request Reconsideration after FOA, Exhibit C, TSDR pp. 43-84.)

The Federal Circuit has observed that evidence of third-party use of similar marks can provide powerful evidence of consumer perceptions of such marks. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 U.S.P.Q.2d 1671, 1675 (Fed. Cir. 2015); s*ee*

also, *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015). One such use of evidence is to demonstrate that "customers have been educated to distinguish between different marks on the basis of minute distinctions." *Jack Wolfskin*, 797 F.3d at 1374, 116 U.S.P.Q.2d at 1136. Likewise, evidence of an abundance of third-party use of aspirational slogans in the health and wellness sector demonstrates that consumers have been educated to look to such slogans not as merely informational messages, but as source-identifying indicia. This is the case despite the fact that such slogans may also be encountered by consumers in regular speech. The fact that A CHANCE TO LIVE LONGER is currently the subject of Registration No. 6790349 also supports this proposition. (8 TTABVUE 5; Aug. 31, 2023 TEAS Request Reconsideration after FOA, Exhibit A, TSDR pp. 28-32.) This registration is prima facie evidence of the registrability of this slogan; likewise, the evidence in this record supports a determination that Applicant's slogan is registrable on the Principal Register without a disclaimer.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board reverse the refusal to register and approve Applicant's mark for publication.

BRISTOL-MYERS SQUIBB COMPANY

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EXHIBIT A

www.merriam-webster.com/dictionary/merely April 25, 2024

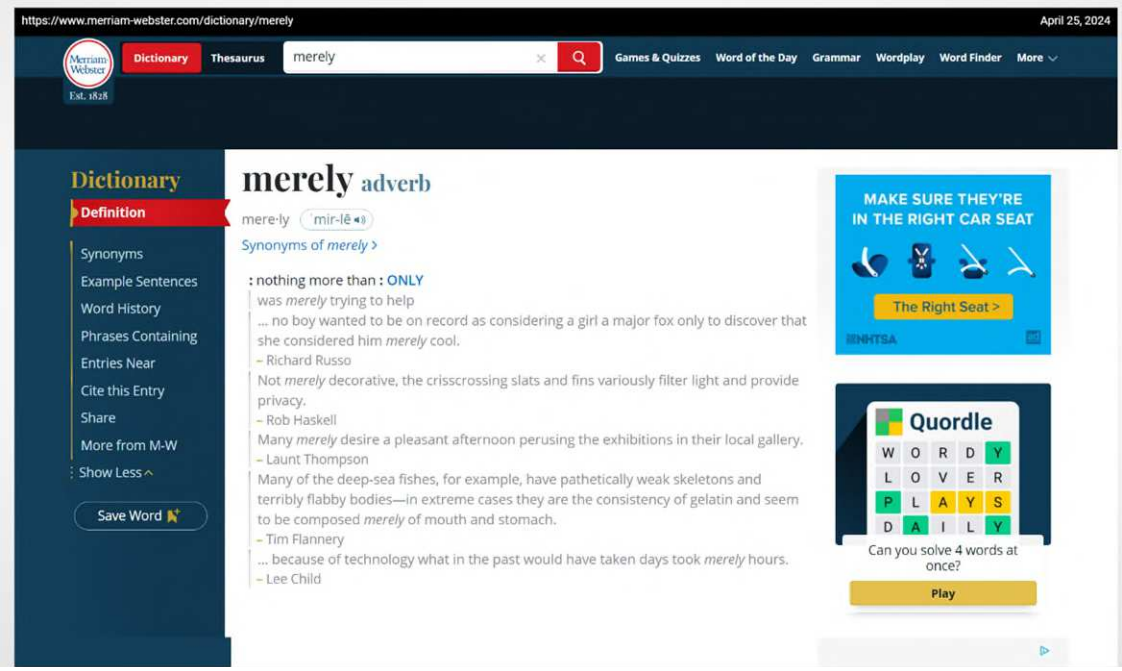

EXHIBIT B

www.merriam-webster.com/dictionary/slogan April 25, 2024