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October 18, 2006
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Global Determinants Inc.

Serial No. 76395696

Jim Zegeer, Esq. for Global Determinants Inc.

Eugenia K. Martin, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hohein, Zervas and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Global Determinants has filed an application to register on the Principal Register in standard character form the mark "CONNECTROME" for "providing genomic information, namely, information concerning the whole cell's worth of connectrons" in International Class 44.[1]

Registration has been finally refused on the ground that the term "CONNECTROME," as used on the specimens of record, does not function as a service mark to indicate the source of

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[1] Ser. No. 76395696, filed on April 16, 2002, based on an allegation of a bona fide intention to use such mark in commerce. By a statement of use, filed on October 30, 2003, a date of first use anywhere and in commerce of October 27, 2003 is alleged.

applicant's services of "providing genomic information, namely, information concerning the whole cell's worth of connectrons" and, thus, the specimens are unacceptable because they fail to show service mark use. Sections 1, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1053 and 1127; and Trademark Rule 2.56.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

The specimens submitted by applicant are identical in substance and consist, in each instance, of a copy of a solicitation letter to a prospective customer, an accompanying list and an attached advertising flyer. The solicitation letter, which on the letterhead bears in italics the name and address of "Global Determinants, Inc." and is dated "October 27, 2003," states in relevant part as follows:

> Global Determinants, Inc. is beginning to offer a new service to scientists and bioinformatics companies. We have calculated the Connectron™ structure of all the genomes on the NCBI server. We identify all of the Connectrons™ in each genome and identify each collection as a Connectrome™. The availability of this information will make it possible to study the gene regulation of each Connectrome™ in a new science that we call Connectromics™. Our Connectron™ data will eventually take its place among the "one" and "ics" (i.e. genome/genomics, ... etc.)
>
> Our data will shortly be available via the Internet. .... The attached advertisement serves as a convenient reminder of our capabilities.

An accompanying "List of Connectromes™ available from Global Determinants, Inc." sets forth in tabular format various genome collections by, respectively, "Code," "Name" and "Kingdom" (e.g.,

"Lin | Listeria innocus | Bacteria ") and an attached advertising flyer indicates in pertinent part that "Global Determinants, Inc.":

> Offers all scientists a complete Connectromics(tm) service consisting of all the Connectron(tm) data for all the Connectromes(tm) available on the National Center for Biotechnology (NCBI) server.
>
> Questions about access to this service should be directed to
>
> Richard Feldmann
> President and Gengineer
> Global Determinants, Inc.

Applicant, asserting in its brief that it "is the owner of Registration No. 2,884,762 for the mark CONNECTROMICS for 'providing genomic information, namely, information concerning the whole cell's worth of connectrons,'" takes issue with the contention by the Examining Attorney in the final refusal that the specimens "clearly show that the word 'CONNECTROME' refers to the products sold in the performance of the service." Applicant argues, in this regard, that "[i]t is settled that a particular designation in certain circumstances can function both as a trademark and as a service mark," noting that as stated in In re Heavenly Creations, Inc., 168 USPQ 317, 318 (TTAB 1971):[2]

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[2] We observe that such case, which is the sole authority cited by applicant in its brief, is essentially inapposite inasmuch as it deals with the issue of whether the activity of the applicant therein constituted a service rather than whether the specimens submitted with the application demonstrated service mark use of the term sought to be registered, which is likewise the issue herein. As the Board remarked in such case:

> It is interesting to note that the examiner did not hold that the record did not show use of the mark ... in the sale or advertising of a service. The refusal of registration

> The only restriction on the registrability of the same term both as a trademark and as a service mark is that specimens filed in a service mark application must show the mark "used or displayed in the sale or advertising of services" as distinguished from use on goods or in the sale or advertising of goods of the applicant.

Applicant, maintaining in view thereof that "[t]he fact that a service may be incidental to a principal service or to the sale of goods does not make it any less of a service," insists that in this case it "offers all genomic scientists a service consisting of the Connectron™ data for all the Connectromes™ available on the National Center for Biotechnology server" and that "the three items referred to above: (1) letter, (2) list, and (3) advertising flyer are sufficient to constitute service mark use under the statute."

The Examining Attorney, on the other hand, contends in her brief that:

> Not every word, combination of words, or other designation used in the sale or advertising of services is registrable as a service mark. To function as a service mark, the asserted mark must be used in a way that identifies and distinguishes the source of the services recited in the application. Even if it is clear that the applicant is rendering a service, the record must show that the asserted mark actually identifies and distinguishes the source of the service recited in the application. *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987) (stationery specimens showed use of THE NOW GENERATION as a mark for applicant's

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> was directed to the nature and character of the service claimed by applicant.

In re Heavenly Creations, Inc., supra.

> advertising or promotional services as well as to identify a licensed advertising campaign, where recited services were specified in a byline appearing immediately beneath the mark). The mark as used in applicant's specimens does not indicate the source of any services. Instead, it indicates only the goods sold or provided in the course of [the] services.
>
> A term that is used only to identify a product, device or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. *See In re Moody's Investors Service Inc.*, 13 USPQ2d 2043 (TTAB 1989) ("Aaa," as used on the specimens, found to identify the applicant's ratings instead of its rating services); *In re Niagara Frontier Services, Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT , YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (term that identifies a seat in the first class section of an airplane does not function as a mark for air transportation services); *In re Editel Productions, Inc.*, 189 USPQ 111 (TTAB 1975) (MINI-MOBILE identifies only a vehicle used in rendering services and does not serve to identify the production of television videotapes for others); *In re Oscar Mayer & Co. Inc.*, 171 USPQ 571 (TTAB 1971) (WIENERMOBILE does not function as mark for advertising and promoting the sale of wieners, where it is used only to identify a vehicle used in rendering claimed services).

Specifically observing that in this case, applicant's solicitation letter states that "[w]e identify all of the Connectrons™ in each genome and identify each collection as a Connectrome™," while its list is identified as a "[l]ist of Connectromes™ available from Global Determinants, Inc." and its advertising flyer "[o]ffers all scientists a complete Connectromics(tm) service consisting of all the Connectron(tm)

data for all the Connectromes(tm) available on the National Center for Biotechnology (NCBI)," the Examining Attorney maintains that:[3]

> In each of these materials, the word CONNECTROME is used, not to indicate the service, but rather to indicate the product or information provided by the applicant [under the service mark CONNECTROMICS]. CONNECTROME refers to a collection of data, to the information available. When a service is identified, the word CONNECTROMICS, not CONNECTROME, is used to identify the service.
>
> Applicant argues that the advertising materials submitted as specimens show that the mark is used to identify a service. While it is true that the mark CONNECTROME appears on advertising materials which identify services, the fact that the proposed mark appears in an advertisement or brochure in which the services are advertised does not in itself show use as a mark. The record must show that there is a direct association between the mark and the service. *See In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973) (term that identifies only a process does not function as a service mark, even where services are advertised in the same specimen brochure in which the name of the process is used); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989) (term used on bumper sticker with no reference to the services does not function as a mark); *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985) (term PEOPLEWARE used within a byline on calling card specimen does not constitute service mark usage of term, even if specimen elsewhere shows that applicant provides the recited services); *In re J.F. Pritchard & Co.*

[3] While we recognize that applicant's services are identified as "providing genomic information, namely, information concerning the whole cell's worth of connectrons," we do not believe that the Examining Attorney, in stating that the term "CONNECTROME is used ... to indicate the product or information provided by the applicant," meant to concede that such term as used in the specimens functions as a mark for applicant's services. We accordingly have finished the Examining Attorney's contention as indicated by the language added in brackets.

> *and Kobe Steel, Ltd.*, 201 USPQ 951 (TTAB 1979) (proposed mark used only to identify a liquefaction process in brochure advertising the services does not function as a mark, because there is no direct association between the mark and offering of services). In the case at hand, there is no direct association of the mark and the goods provided as part of the service--lists of "connectromes." The specimens provided consistently state that the goods, the data supplied in the performance of the information services, are the "connectromes."

The Examining Attorney thus concludes that "applicant's mark CONNECTROME fails to function as a service mark ... because it identifies the product sold in the performance of the information service, not the service itself."

Although the distinction may perhaps be subtle, we nonetheless agree with the Examining Attorney that, as used on the specimens, the term "CONNECTROME" does not function as a service mark for the services of "providing genomic information, namely, information concerning the whole cell's worth of connectrons" and, thus, the specimens are unacceptable because they fail to show service mark use. In order for a specimen to be acceptable as showing use of a mark in the sale or advertising of the services recited in an application, there must be a direct association between the mark sought to be registered and the services so identified, and there must be sufficient reference in the specimen to the services to create such association. See In re Monograms America Inc., 51 USPQ2d 1317, 1318 (TTAB 1999). It is not enough that the term alleged to constitute the mark be used in the sale or advertising of the services; instead, there must be a direct association between the term and the services in

order for there to be service mark use. See, e.g., In re Johnson Controls Inc., 33 USPQ2d 1318, 1319 (TTAB 1994); and Peopleware Systems, Inc. v. Peopleware, Inc., supra at 323. Specifically, the asserted mark must be used in such a manner that it would be readily perceived as identifying the source of such services. In re Advertising & Marketing Development Inc., supra at 2014-15; In re Adair, 45 USPQ2d 1211, 1214 (TTAB 1997); In re Duratech Industries Inc., supra at 2054; and In re Metrotech, 33 USPQ2d 1049 1052 n.6 (Comm'r Pats. 1993).

In this case, the specimens submitted by applicant refer, in the solicitation letter, to "the Connectron™ structure of all the genomes on the NCBI server," which applicant asserts that it has "calculated" and which, as to "all of the Connectrons™ in each genome," applicant maintains that it "identify[ies] each collection as a Connectrome™." Although applicant claims in such letter that "[t]he availability of this information will make it possible to study the gene regulation of each Connectrome™ in a new science that we call Connectromics™," there is no direct association of the term "CONNECTROME" with the service of "providing genomic information, namely, information concerning the whole cell's worth of connectrons" and this is so notwithstanding the mention in such letter of the vague, if not ambiguous, reference to "[t]he availability of this information." Rather, as the accompanying "List of Connectromes™ available from Global Determinants, Inc." makes clear, the term "CONNECTROME" appears to identify a collection of genome information, but it

does not identify the service by applicant of providing such information. Moreover, as further clarified by the attached advertising flyer, applicant's service of providing genomic information is at best identified instead by the mark "CONNECTRONICS," given the statement in the advertisement that applicant "[o]ffers all scientists a complete Connectromics(tm) service consisting of all the Connectron(tm) data for all the Connectromes(tm) available on the National Center for Biotechnology (NCBI) server." Thus, to customers for its service of providing genomic information, the term "CONNECTROME" would be readily perceived solely as a collection of genome information and not as a service mark for such a service.

This case, in essence, is most analogous to those cases cited above by the Examining Attorney in which a purported mark, as shown by the specimens, is used only as the name of a process or goods rather than as a service mark for services involving such process or goods. Here, we face a similar problem, and our conclusion that the term "CONNECTROME," as used in the specimens, does not function as a service mark for applicant's service of "providing genomic information, namely, information concerning the whole cell's worth of connectrons" is based on the fact that the use shown thereby does not plainly constitute such a direct association of the term "CONNECTROME" with applicant's services that it would be readily perceived as a service mark identifying such services and not just as a collection of genome information. See, e.g., In re Vsesoyuzny Ordena Trudovogo Krasnogo Znameni Nauchnoissledovatelsky Gorno-Metallurgicheky Institut Tsvetnykh

Metallow "Vnitsvetmet," 217 USPQ 70, 72 (TTAB 1983), *recon. denied*, 219 USPQ 69 (TTAB 1983).

Decision: The refusal to register is affirmed.