

THIS DISPOSITION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sheila Mikhail

Serial No. 78419550

Steven J. Hultquist of Intellectual Property/Technology Law
for Sheila Mikhail.

Ellen J. G. Perkins, Trademark Examining Attorney, Law
Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sheila Mikhail, an individual, has appealed from the
final refusal of the Trademark Examining Attorney to
register BIOLOGICAL NANOPARTICLES, in standard character
format, as a trademark for "designer viral vectors for
scientific research used to deliver genes and other
material to a biological cell" in Class 1 and "designer
viral vectors for medical use for gene therapy and drug

administration" in Class 5.¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified goods.² Both applicant and the Examining Attorney have filed appeal briefs.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973).

¹ Application Serial No. 78419550, filed May 16, 2004, based on Section 1(b) of the Trademark Act (intent-to-use).

² In her appeal brief applicant states that there are two issues on appeal--whether the mark is merely descriptive, and whether her identification of goods is acceptable. However, with her request for reconsideration applicant amended the identification, and this amended identification was accepted by the Examining Attorney. Therefore, as pointed out by the Examining Attorney in her brief, the acceptability of the identification of goods is not an issue in this appeal.

In support of her position that applicant's mark is merely descriptive of a significant characteristic or feature of applicant's goods, the Examining Attorney has submitted the following dictionary definitions:

Biological: 1. Of, relating to, caused by, or affecting life or living organisms. 2. Having to do with biology. 3. Related by blood: *the child's biological parents; his biological sister*. n. A preparation, such as a drug, a vaccine, or an antitoxin, that is synthesized from living organisms or their products and used medically as a diagnostic, preventive or therapeutic agent.³

Nanoparticle: A microscopic particle whose size is measured in nanometers <the toxic effects on cells exposed to drug-loaded nanoparticles>⁴

The Examining Attorney also made of record excerpts from a number of articles in which the term "nanoparticles" appears, including the following:

³ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁴ Merriam-Webster's Medical Dictionary, © 2002. The Examining Attorney submitted this definition with her appeal brief, and requested that we take judicial notice of it. We grant this request. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We also note that in the first Office action the Examining Attorney recited the following definition of "nanoparticle": An extremely small particle with a radius that is less than 100 nanometers. Although the Examining Attorney did not identify the dictionary from which this definition was taken, applicant has not objected to our consideration of it.

...the treatment also kills many other rapidly-dividing cells necessary to a healthy body, leading to a host of serious side effects. Where this approach is akin to carpet bombing, tiny nanoparticles studded with molecules programmed to link specifically to cancer cells could deliver that same drug with guided-missile precision.

"The News Journal" (Wilmington, DE),
December 14, 2004

...the National Aeronautics and Space Administration and medical researchers believe they've found the culprit--a nanoparticle so small it challenges the definition of life.

"The Herald-Dispatch" (Huntington, WV),
December 11, 2004

The 23-employee company is researching various uses for nanoparticles, ultra-tiny materials with unique properties because of their unusually small size.

"Reno Gazette-Journal," December 1,
2004

In addition, the Examining Attorney submitted what she described as a representative sample of web pages retrieved by the Google search system in which the term "biological nanoparticles" appears, including the following (emphasis added):⁵

Nanoparticle research seeks to exploit the strong size dependence of the physical and chemical properties of nanometer-sized particles.
Nanoparticles can be the building

⁵ The Examining Attorney also submitted the search summary page showing excerpts from the web pages, as well as printouts of the entire pages of selected websites.

blocks of materials with novel mechanical or electrical properties, or at the core of new "nanoelectronic" devices. Over the past decades, the University of Minnesota has built a leadership role in nanoparticle research around the world. A broad range of research topics is pursued in numerous thrust areas including novel nanostructured materials, nanoparticle-based devices, environmental impact of nanoparticles, **biological nanoparticles**, computational nanoparticle research, and development of instrumentation for nanoparticle science and engineering. OMNI Organization for Minnesota Nanotechnology Initiatives (University of Minnesota)
<http://www.nano.umn.edu/omni/research/sub6.html>

Synthetic **biological nanoparticles**, next generation of gene delivery systems [Title of lecture by Jude Samulski, University of North Carolina, at a September 2005 Conference on Protein Expression in Animal Cells
http://web.hospitalite.com/clients/PEACE/7thpeace_program.htm

Cardiovascular Gene Therapy
The cardiovascular sessions at this year's ASGT meeting in St. Louis provided an update on work vital to moving cardiovascular gene and cell therapy forward successfully. ... Dr. Jude Samulski from the University of North Carolina presented an exciting update on recent work with adeno-associated viral vectors, including the ability to manipulate vector tropism by swapping and/or engineering the viral coat, holding out the promise of eventually providing designer **biological nanoparticles** optimized for

particular biological or clinical applications.
ASGT News, Summer 2005 (American Society of Gene Therapy)
<http://www.asgt.org>

Applicant, in response to this website evidence, submitted declarations from both herself and from Dr. Richard Jude Samulski, the person referenced in the latter two excerpts quoted above. She and Dr. Samulski state they are co-founders of Asklepios Biopharmaceutical, Inc. (hereafter Asklepios); that applicant is the Chief Executive Officer and Dr. Samulski is the president; that the company uses technology licensed from the University of North Carolina at Chapel Hill; and that, in addition to his employment as president of Asklepios, Dr. Samulski is a Full Professor in the Pharmacology Department of the University of North Carolina at Chapel Hill and the Director of the Gene Therapy Center at the University, where he is engaged in research focused on the study of dependent parvovirus and associated virus. The declarations further state that Asklepios' business is the custom design, development and production of vectors for gene therapy applications, and the references in the Google search to usage by Dr. Samulski of BIOLOGICAL NANOPARTICLES relate to synthetic vectors prepared for gene therapy being developed for commercialization by Asklepios. Both

declarations (which are identical insofar as the pertinent information regarding the product and Google information is concerned) assert that Asklepios has used the trademark BIOLOGICAL NANOPARTICLES "for several years in an open and notorious manner within the biotechnology industry to describe custom viral vectors being developed by the company," ¶ 8, and that Asklepios' use of "BIOLOGICAL NANOPARTICLES as a trademark for designer viral vectors used for delivery of genes and other materials to a biological cell is to [their] knowledge the first and original use of BIOLOGICAL NANOPARTICLES and subsequent usages by others are derivatively traceable to such first and original use by Asklepios Biopharmaceutical, Inc." ¶ 9.⁶ Attached as an exhibit to each declaration is a

⁶ The declarations also state that "the term BIOLOGICAL NANOPARTICLES as used by me and other representatives of Asklepios Biopharmaceutical, Inc. has developed independent significance as a trademark for designer viral vectors used for the delivery of genes and other materials to a biological cell." ¶ 9. Although such language may be used when making a claim of acquired distinctiveness, applicant has not in any other manner in the application suggested that she is seeking registration under Section 2(f), and we do not regard this statement as an assertion of acquired distinctiveness. Moreover, in denying applicant's request for reconsideration, with which the declarations were submitted, the Examining Attorney stated that the mark is unregistrable absent a showing of acquired distinctiveness, and applicant never responded by asserting that she was making such a claim. (We also note that the application is based on an asserted intention to use the mark, rather than on actual use in commerce; normally, to be successful in showing acquired distinctiveness, an applicant must have used the mark in commerce.)

PowerPoint presentation which, on the page headed "Company Focus," has the statement, "Utilizing our proprietary Biological Nano Particles™ (BNPs) derived from recombinant adeno-associated viruses, AskBio develops novel protein/cellular based therapies for muscular-skeletal disorders and other diseases treatable by delivering BNPs to muscle."

Responding to these declarations, the Examining Attorney made additional Internet evidence of record showing descriptive and/or generic use of the term "biological nanoparticles" (emphasis added):

NanoVirDetect--a micro-fluidic device for dielectrophoretic manipulation, trapping and analysis of **biological nanoparticles**.

Manipulation, trapping and in-situ analysis of **biological nano-particles** such as viruses and bacteria opens up new avenues towards advanced diagnostics.

www.nmi.de/englisch/showprj.php3?typ=1&id=73

Membrane Chromatography of **Biological Nanoparticles**

Abstract: ...However, for large biological nanoparticles such as viruses, plasmid DNA, and LDL cholesterol...

...These results are pertinent to the removal of LDL from human plasma and the purification of gene therapy delivery vectors, viral vaccines, and other large **biological nanoparticles**.

www.aiche.org.conferences

Curriculum Focus Areas

...

Chemical, Biomolecular, and
NanoBioEngineering--

Biochemical engineers develop the biological processes associated with industrial scale production of drugs, chemicals and food products. Increasingly batch processing using bacterial and eukaryotic cells is being used to process raw materials for product recovery, development of pharmaceuticals and environmental protection. ...NanoBioEngineers deal with applications of principles of nanotechnology in developing bioengineering processes, systems and products. These include **biological nanoparticles** design and manufacturing, drug design, targeting & delivery, gene delivery & therapy, cancer treatment research & development.
Bioengineering @ UIC College of Engineering
www.uic.edu

The Zeta filter is a clever device that uses an AC electric field to quickly separate out "**biological nanoparticles**," things like bacteria, viruses or cellular components...
Notre Dame Magazine
www.nd.edu

Finally, the Examining Attorney submitted web pages that show that biological vectors include viruses:

Recombinant DNA techniques use biological vectors like plasmids and viruses to carry foreign genes into cells.
Union of Concerned Scientists
www.ucsusa.org

Based on the evidence of record, we find that applicant's mark BIOLOGICAL NANOPARTICLES is merely descriptive of her goods, in that it directly informs the consumers of the designer viral vectors that these vectors consist of biological nanoparticles. The dictionary definitions of the individual elements show that, when these words are combined in the term BIOLOGICAL NANOPARTICLES, the mark clearly describes the components of applicant's identified viral vectors, namely that they are biological material (viruses) that are extremely small (nanoparticles). Moreover, the Internet evidence shows that the term BIOLOGICAL NANOPARTICLES is a recognized term in the industry.

Applicant has raised a number of arguments traversing the Examining Attorney's position that her mark is merely descriptive, and we will address them in turn. First, applicant asserts that, because the Examining Attorney found her initial identification to be indefinite, the mark cannot be merely descriptive because, if it were, the identification would be clear. This argument is not persuasive. The question of whether an identification of goods is acceptable is determined on the basis of the identification itself, not on whether the mark provides additional information about the nature of the goods.

Applicant also asserts that the Examining Attorney has impermissibly deconstructed the mark into its two separate words, rather than considering the mark in its entirety. The cases that applicant relies on in support of this position, however, refer to the consideration of marks in a likelihood of confusion analysis, in which marks must be compared in their entireties. It is not improper, in determining whether a mark is merely descriptive, to consider the meaning of the individual elements of a mark to see if they are descriptive, and then consider whether they maintain their descriptive connotation when they are combined, such that the mark as a whole is merely descriptive. See *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002), in which the Board found SMARTTOWER to be merely descriptive of commercial and industrial cooling towers, looking at the descriptive meaning of the individual words in the mark in concluding that the mark was merely descriptive.

Applicant has also asserted that there are a multiplicity of meanings for the individual words in the mark that prevent it from being merely descriptive. In this connection, applicant points out that "biological" could refer to a family relationship or genetic heritage, as in "biological mother," while the element "nano" in

"nanoparticles" could relate to a characteristic of being compact in relation to other things of a same or similar type. The fallacy of this argument is that the determination of mere descriptiveness of a mark is not made in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

Applicant's argument that her "BIOLOGICAL NANOPARTICLES" mark does not form in the viewer's or hearer's mind a simultaneous awareness and knowledge of 'designer viral vector used for the delivery of genes and other materials to a biological cell,' " brief, p. 7, also fails to take into consideration that the determination of whether a mark is merely descriptive is not made in the abstract. Thus, the question is not whether a person, seeing only the mark, is able to guess what the goods are, but whether, upon seeing the mark in connection with the goods, the consumer will immediately understand from the mark a characteristic or feature of the goods.

Applicant also argues that she has satisfied the "competitor's needs" test because there is no evidence that other entities have adopted or used BIOLOGICAL NANOPARTICLES as a trademark or service mark or in any business or advertising sense, and that she has satisfied the "competitor's use" test because there is no evidence that the term is used as a trademark by others.

As the Examining Attorney has pointed out, the fact that applicant may be the first or only user of a descriptive term does not justify registration where the evidence shows that the term is merely descriptive of the goods. Moreover, in the present case there is evidence that the term BIOLOGICAL NANOPARTICLES is used by others. Notwithstanding the declarations of applicant and of Dr. Samulski, the record clearly demonstrates a competitive need to use this terminology to describe characteristics of goods such as applicant's.

Decision: The refusal of registration is affirmed.