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November 7, 2006

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Apotex Technologies Inc.

Serial Nos. 76449597 and 78429952

Carla C. Calcagno of Holland & Knight LLP for Apotex
Technologies Inc.

John M. Gartner, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Hohein, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Apotex Technologies Inc., a Canadian corporation,
seeks registration on the Principal Register of the mark
IPHARMACIST (*in typed or standard character formats*) for goods
and services identified in the application, as amended, as
follows:

"pre-recorded video tapes featuring training in
the use of personal digital assistants
preprogrammed with pharmaceutical information and
handheld personal digital assistant computers
preprogrammed with computer database software
containing pharmacy and pharmaceutical-related
proprietary and publicly available information,
both of which are intended for use by pharmacists

and pharmacy technicians in the practice of pharmacy" in International Class 9;

"printed matter containing pharmacy and pharmaceutical-related information, namely, books, fliers, brochures, manuals, guides, pamphlets and trade journals" in International Class 16; and

"custom design for others of personal digital assistant software programs for use by a pharmacist or pharmacy technician in the practice of pharmacy, not including Internet access software" in International Class 42;¹

and the same mark **IPHARMACIST** for substantially the same goods and services.²

These consolidated cases are now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark, **IPHARMACIST**, when considered in relation to applicant's identified goods and services, immediately describes their

¹ Application Serial No. 76449597 was filed on September 9, 2002 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

² Application Serial No. 78429952 was filed on June 4, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce (Section 1(b) of the Act) and under Section 44(e) of the Act, based upon Canadian Registration No. TMA-604,501, which issued on March 9, 2004. This later-filed application now contains exactly the same identification of goods and recitation of services as the earlier filed application except that it adds "multimedia software recorded on CD-ROM featuring pharmaceutical information for use by pharmacists and pharmacy technicians in the practice of pharmacy" to the ending of the identification of goods in International Class 9.

nature. Specifically, the Office argues that the letter "I" refers to the Internet, which in turn is a significant feature of applicant's personal digital assistants (PDAs), supporting literature and software, as well as the service of custom designing the PDAs for use by pharmacists.

Both applicant and the Trademark Examining Attorney have fully briefed this appeal, and both appeared at an oral hearing before a video-conferenced panel of the Board.

We reverse the consolidated refusals to register.

Refusal under Section 2(e)(1) of the Act

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The

Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]. Hence, the ultimate question before us is whether the term

IPHARMACIST conveys information about a significant feature or characteristic of applicant's goods and services with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when

we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. In re Abcor, supra at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of "real estate advertisement services"]; and In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Omaha



National Corp., 819 F.2d 1117,

2 USPQ2d 1859 (Fed. Cir. 1987)



[the term "first tier" describes a class of banks]; In re

Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS

is merely descriptive of "multiple viscosity motor oil"];

In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986)

[DESIGN GRAPHIX merely descriptive of computer graphics

programs]; and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB

1979) [COASTER-CARDS merely descriptive of a coaster

suitable for direct mailing].

The Trademark Examining Attorney herein argues that the letter "I" refers to the Internet, and the word "Pharmacist" refers to the users of the goods and services, and furthermore, that when these two descriptive terms are combined into **IPHARMACIST**, the components retain their descriptive meanings. He argues from an initialism dictionary and applicant's own website that **IPHARMACIST** immediately describes the nature of applicant's goods and services, i.e., that applicant's PDAs, as well as the service of custom designing the PDAs, and the supporting literature and software, are for use by pharmacists who in turn utilize the Internet as a feature of the goods.

By contrast, applicant contends that the Office has failed to prove that **IPHARMACIST** merely describes any feature or characteristic of applicant's goods or services, summarizing its arguments as follows:

1. The initial letter "I" has meanings other than "Internet," including "interactive" and "information" - connotations more applicable to applicant's goods than the suggested term "Internet";
2. "Internet pharmacist" is a common, ordinary English-language phrase meaning a person who dispenses drugs based upon orders placed over the Internet; and
3. "Internet pharmacists," as defined above, are not the targeted users for applicant's goods and services.

Evidence of Record:

We begin our analysis by looking at the evidence of record in this case. The Trademark Examining Attorney argues that it is significant that in advertising the **IPHARMACIST** goods and services on its website, applicant points out that Internet access is a feature of its goods and services, in that customers can automatically update the software and obtain technical support:



Always up-to-date

Tired of trying to keep all your information up-to-date manually? Using your Internet connection, the NetUpdate feature automatically checks for new and updated versions of your iPharmacist software each time you HotSync.

3

and

iPharmacist users have access to a wide range of Web-based and real time support options. To fully assist you, our dedicated iPharmacist support system is offered for both hardware and software.

4

The originally-assigned Trademark Examining Attorney had placed into the record entries from the online "Acronym Finder" for the letter "I" that included an entry for "Internet,"⁵ as well as an entry containing a dictionary definition of "pharmacist" as meaning "a person trained in pharmacy; a druggist."⁶

Analysis:

We turn then to look at this evidence in light of the mark that applicant seeks to register, **IPHARMACIST**.

Is the letter "I" in applicant's mark synonymous with "Internet"?

³ <http://www.ipharmacist.ca/public/technology.xml>

⁴ <http://www.ipharmacist.ca/public/support.xml>

⁵ <http://www.acronymfinder.com/>. Applicant has not questioned the reliability of this website.

⁶ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (3rd Ed. 1992).

As noted above, the Office argues from the "Acronym Finder" that the leading letter "I" in applicant's mark will be viewed as a shorthand for "Internet." In response, applicant notes that the most commonly-used meanings of the letter "I," sorted by decreasing rank, are ① One (the Roman Numeral), ② interest, ③ incomplete (school) and ④ italic. Further down the list are meanings arguably more closely related to the current goods and services, such as "information," "international," "Internet," "interactive," "informative," and "instructional."⁷ For example, given that applicant's goods are *interactive* devices (e.g., PDAs) designed to provide *information* to the pharmacist so that she can check into possible drug *interactions* for her patient, applicant argues that entries such as "interactive," "information" or "interactions" would arguably be better fits here - grammatically and content wise - than the word "Internet."

Nonetheless, the Trademark Examining Attorney maintains that the meaning of the letter "I" as used in

⁷ Of course, as applicant also points out, the forty-two meanings other than "Internet" suggested by the "Acronym Finder" for the letter "I" included terms having absolutely no readily-seen connections to applicant's goods or services, such as "indoor."

applicant's mark is made clear from the context of the goods and services. As indicated by the entire record herein, including applicant's website, the Trademark Examining Attorney argues that access to the Internet is a significant feature of applicant's goods and services. He contends that when **IPHARMACIST** is used in connection with software and PDAs for pharmacists, software design and related literature, it is clear that users of the goods and services would readily understand that the letter "I" in this case refers to the Internet.

We agree with the general point proffered by the Trademark Examining Attorney at oral argument that in making our determination, we are not required to turn a blind eye to the reality of what is being offered on applicant's website, thereby artificially restricting our purview solely to the description of goods and services in the application itself. See In re DNI Holdings Ltd., 77 USPQ2d 1435, 1438 (TTAB 2005) [SPORTSBETTING.COM is generic for sports wagering services and provision of information regarding sports and betting], citing to Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); and In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005).

On the other hand, we agree with applicant that under the rule enunciated in Modern Optics, Incorporated v. The Univis Lens Company, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) [initial letters CV not merely descriptive for trifocal lenses known as "Continuous Vision lenses": " ... as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith ... "], there is insufficient probative evidence that the relevant purchasers of applicant's goods and services would understand that the Trademark Examining Attorney's suggested meaning (i.e., that the initial letter "I" means "Internet") is the one that will immediately come to mind when these consumers encounter the involved mark.

If "I" is synonymous with "Internet," is the word INTERNET alone merely descriptive of these goods and services?

It is a fact that access to the Internet by way of a personal computer does permit pharmacists who are applicant's customers to update the software on their PDAs and to obtain technical support from applicant. Nonetheless, the issue remains whether these features are so significant that the word "Internet" alone would have to

be considered to be merely descriptive of the named goods and services. The Office argues that these are significant features. By contrast, applicant contends they are nothing more than incidental features of its products and services:

Indeed, when taken to its logic and extreme, would the undersigned be considered an "Internet lawyer" because she researches cases on LEXIS? Given that using the Internet to obtain information is ubiquitous, virtually any professional in the country could be termed an "Internet doctor" or "Internet farmer," under the Examiners' argument, were that professional to rely on the Internet in any significant way for the practice of the profession.

Applicant's appeal brief, pp. 3 - 4.

As the Trademark Examining Attorney points out, the term Internet is certainly capable of being analyzed in the context of these goods and services. However, that fact alone is not sufficient to determine that the word Internet is descriptive of these goods and services. See In re The Rank Organization Limited, 222 USPQ 324, 326 (TTAB 1984)

[The "fact that the term 'LASER' is capable of being analyzed does not render the term merely descriptive"]. Even taking into consideration the marketplace realities gleaned from applicant's website - the involved PDAs "hot sync" with data files contained on the disk drive of ones PC, and participating pharmacists can ask for technical

support over the web - we find that the evidence in the record before us does not support the conclusion that the term "Internet" alone, when used in connection with applicant's products, merely describes a significant feature of applicant's goods or services.

The word "Pharmacist" alone for these goods and services:

Applicant's identification of goods and recital of services are replete with words like "pharmacy," "pharmaceutical," and even "pharmacist." Arguably, then, as the targeted uses of these products, the term "Pharmacist" alone must be considered to be merely descriptive for its PDA-related goods and services. See In re Hunter Publishing, 204 USPQ 957 (TTAB 1979) [JOBBER AND WAREHOUSE EXECUTIVE merely descriptive for trade magazine directed to jobber and warehouse managers or executives in the automotive aftermarket]; and In re Camel Manufacturing Co., 222 USPQ 1031 (TTAB 1984) [MOUNTAIN CAMPER merely descriptive of retail and mail order services in field of outdoor equipment and apparel].

The term "Internet Pharmacist"

The Trademark Examining Attorney has submitted excerpts from the web demonstrating that the term,

"Internet Pharmacist," has a readily understood meaning to health care patients seeking pharmaceutical products online. In fact, applicant does not deny that "Internet Pharmacist" is a term of art describing someone who dispenses drugs through prescriptions or orders placed over the Internet:

Applicant readily concedes that the mark INTERNET PHARMACIST might be merely descriptive of one who dispenses drugs over the Internet, but Applicant is not applying for these services.

Applicant's brief, p. 3. In this context, we note that the three classes of goods and services in this application are training videotapes and PDAs in class 9, related printed matter in class 16, and services involving the custom design of PDAs in class 42.

The term "Internet Pharmacist" may well be merely descriptive, if not generic, for a hypothetical recitation of services such as "online retail store services featuring pharmaceuticals." Similarly, the term "Internet Pharmacist" may well be merely descriptive for goods or services specifically directed to pharmacists who dispense drugs over the Internet. However, those are not the involved goods and services herein.

As applied to products and services designed to provide up-to-date information on possible drug interactions to one's local druggist, we agree with applicant that the combined term "Internet Pharmacist" is just too nebulous in meaning and non-specific in nature for consumers to immediately associate it with a quality or characteristic of the involved products or services. See In re Sundown Technology Inc., 1 USPQ2d 1927, 1928 (TTAB 1986) ["[W]e find that 'GOVERNOR' applied to applicant's [controls used to modulate the output of a musical amplifier] is nebulous in meaning"]; In re WSI Corporation, 1 USPQ2d 1570, 1572 (TTAB 1986) [SUPERSAT is suggestive of services involving weather information services inasmuch as the SAT element might well suggest satellite involvement, but still requires imagination, perception or reflection on the part of potential customers]; and In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978) [THE MONEY SERVICE falls short of describing applicant's financial services with the requisite degree of particularity].

In his brief, the Trademark Examining Attorney takes the position that the term "Internet Pharmacist" could include the pharmacist in one's local brick-and-mortar drug

store who uses the Internet in any significant way in connection with her pharmaceutical practice. We disagree. There is nothing in the record to demonstrate that the term "Internet Pharmacist" would be interpreted in this manner. See In re Harrington, 219 USPQ 854, 856 (TTAB 1983) [COLLEGE ACADEMY "is at most suggestive of special summer learning programs for gifted and talented children in grades 4 to 8"].

The term "IPHARMACIST"

The actual mark before us is **IPHARMACIST** (*in typed or standard character formats*). We have seen in applicant's specimens actual use of "iPharmacist" (a lower case letter "i" followed by upper case letter "P"). In any case, we assume that prospective customers of applicant's goods and services will undoubtedly view this coined mark as a run-together combination of the letter "I" and the word "Pharmacist."

We have already determined that it is unlikely that the letter "I" will be seen as synonymous with the word "Internet," and if it is, the word "Internet" would be suggestive, at most, of the involved products. While arguably the term "Pharmacist" alone may be merely

descriptive for applicant's PDA-related goods and services, there is no evidence in the record before us that the phrases "iPharmacist" describes a feature of applicant's goods or services.

In support of his position, the Trademark Examining Attorney has cited to the case of In re Zanova, Inc., 59 USPQ2d 1300, 1304 (TTAB 2000) [ITOOOL merely descriptive of computer software for use in creating web pages and custom designing websites for others]. However, this Board pointed out that the record in that case was "clear that 'Internet tool[s]' is a *commonly used term* and can refer to a wide variety of computer programs or computer-based services relating to the Internet." (*emphasis supplied*) The Board found that "it is abundantly clear that the term 'Internet tools' not only describes a wide array of software and related services, but also *aptly describes applicant's goods and services.*" (*emphasis supplied*) By contrast, in this case, while acknowledging that the term "Internet Pharmacist" is a term of art, we have explicitly found that it does not describe applicant's goods and services.

When making a refusal under Section 2(e)(1) of the Act, the Examining Attorney has the burden of establishing

that the mark is merely descriptive. In the instant case, we find that burden has not been met. In re Remacle, 66 USPQ2d 1222 (TTAB 2002) [BIO-CD is not merely descriptive of, *inter alia*, modified compact discs used to test biological matter and related equipment and services]. It is not at all apparent that the Trademark Examining Attorney's interpretation of the mark will immediately come to mind when prospective purchasers encounter the term **IPHARMACIST** used in association with applicant's goods and services. In re The Rank Organization Limited, *supra* at 326. In view of the foregoing, we cannot conclude that the term **IPHARMACIST** possesses a merely descriptive significance in connection with the identified goods and services.

Finally, the Board has noted many times that any doubt we may have in reaching a conclusion about the "merely descriptive" character of a mark must be resolved in favor of the applicant - that is to say, in such cases we are required to reverse the refusal to register and allow publication of the mark for opposition so that any affected third party may file an opposition and develop a more comprehensive record. See In re Atavio, 25 USPQ2d 1361,

1363 (TTAB 1992); In re The Rank Organization Ltd., *supra* at 326, and cases cited therein; and In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981).

Decision: The refusal to register under Section 2(e)(1) of the Lanham Act is hereby reversed.