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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lumera Corporation

Serial No. 78564687

Jana L. France of Fish & Richardson P.C., P.A. for Lumera Corporation.

S. Michael Gaafar, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Bucher and Wellington, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lumera Corporation seeks registration on the Principal Register of the mark **PROTEOMICPROCESSOR** for goods identified in the application, as amended, as follows:

> "surface plasmon resonance instruments in the nature of resonators used for scientific bioanalysis" in International Class 9; and
>
> "Surface plasmon resonance instruments in the nature of resonators used for medical analysis" in International Class 10.[1]

[1] Application Serial No. 78564687 was filed on February 10, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

This case is 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 is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "proteomicprocessor" (or "proteomic processor") immediately informs potential purchasers about the nature of applicant's goods.

Applicant and the Trademark Examining Attorney have filed briefs addressing the issues involved in this appeal.

We affirm the refusal to register.

Is term merely descriptive?

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 "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) [ASPIRINA is merely descriptive of analgesic product]. *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980).

To be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009. Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. 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 Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"; "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"]. Rather, the proper test in determining whether a term is merely descriptive is to consider the applied-for 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. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re*

Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). Hence, the ultimate question before us is whether the term PROTEOMICPROCESSOR conveys information about a significant feature or characteristic of applicant's goods 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. "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) *In re Gyulay*, 3 USPQ2d at 1009; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In arguing for registrability, applicant contends that its mark is suggestive at worst, and that it requires a great deal of thought and imagination in order for the relevant public to perceive any significance of the mark as it relates to the applicant's goods.

By contrast, the Trademark Examining Attorney contends that applicant has selected two descriptive words, and that the combination does not create a mark having a separate and distinct meaning, and that even if applicant is the first and only user of a merely descriptive designation, such a situation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods.

The term "proteomic"

Applicant is a nanotechnology company. Applicant's identified goods are surface plasmon[2] resonance (SPR) instruments used for scientific bioanalysis and for medical analysis. As shown by the evidence of record, this optical biosensor is a compact platform able rapidly to scan high density microarrays. This instrument is capable of high throughput – detecting, reading and characterizing up to 5,000 individual ligand:analyte interactions in a single run. Applicant touts this advanced Micro-Electro-Mechanical Systems [MEMS]-based imaging instrument as being able to look at high-content microarray analysis (e.g., up to 5,000

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[2] **plas·mon** n. The aggregate of cytoplasmic or extranuclear genetic material in an organism. *THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE*, Fourth Edition, Copyright © 2006. The Trademark Examining Attorney made this definition of record.

unique ligands per slide) without the need for a fluorescent label, thereby preserving the analyte as it should be analyzed.[3] For example, SPR microscopy can observe how well a drug compound binds to a target molecule of interest, thereby streamlining the drug discovery process.

In its brief, applicant acknowledges that consistent with the several definitions placed into the record by the Trademark Examining Attorney, the term "proteomic" can be defined as the adjective form of the term "proteomics," which, in turn, is defined as "the set of proteins specified

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[3] Applicant submitted a copy of several of its web pages, containing, *inter alia*, the following information:

> "The ProteomicProcessor is a new Surface Plasmon Resonance (SPR) instrument system for the detection and quantification of molecular binding interactions. Surface Plasmon Resonance is an advanced *optical* technology that measures changes in refractive index caused by the binding of molecules to a reflective surface. SPR delivers high-content data, including binding affinity, and kinetics data, in a label-free format. SPR has been applied to the analysis of protein-protein, antibody-antigen, protein-oligonucleotide, and other molecular binding interactions.
>
> The ProtenmicProcessor extends the power of SPR to the analysis of high density microarrays, by use of a novel optical design that includes a rapid-scanning Micro-Electro-Mechanical Systems (MEMS) mirror.
>
> By precisely orienting reflected light from a diode laser onto an array surface, and scanning at 60Hz, the MEMS mirror optical design enables the simultaneous interrogation and analysis of very high-density microarrays. The light beam is scalable, while maintaining uniform beam intensity. Array spot intensity is recorded by a high-definition Charge Couple Device (CCD) camera. The device utilizes the Kretschmann configuration, and gold-layered, high reflection index glass slides.

by genes within an organism."[4] In fact, the record shows that proteomics is a relatively new and rapidly evolving field of bioscience that seeks to specify the proteins produced by a cell in many different types of situations and environments, and to understand how the proteins function.

The relevant consumer, who purchases this state-of-the-art optical resonator – whether conducting basic scientific research in the field of proteomics or diagnosing certain medical conditions – would understand that the word "Proteomic" used in connection with such instruments describes the purpose of the instrument, i.e., that it provides data relating to proteins and protein sequences and conditions that are associated with such proteins and protein sequences.[5]

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[4] **Proteomics** *noun:* a branch of biotechnology concerned with applying the techniques of molecular biology, biochemistry, and genetics to analyzing the structure, function, and interactions of the proteins produced by the genes of a particular cell, tissue, or organism, with organizing the information in databases, and with applications of the data (as in medicine or biology) – **pro·te·o·mic** *adjective* *MERRIAM-WEBSTER'S MEDICAL DICTIONARY* © 2002, also available at www.dictionary.com.

[5] The Trademark Examining Attorney has made of record several third-party registrations in which "proteomics" *(noun)* has been disclaimed (or the composite marks containing this word are registered on the Supplemental Register), thus corroborating the descriptive nature of the word "proteomic" *(adjective)*. See PRECISION PROTEOMICS (with the word "Proteomics" disclaimed) for "research and development services for others in the field of protein analysis" in International Class 42 [Registration No. 2536277 issued on February 5, 2002]; THE PROTEOMICS ALLIANCE "indicating membership in an organization of companies dedicated

Accordingly, we find that the word "proteomic" immediately conveys knowledge of a feature, function or characteristics of the involved goods.

The term "processor"

In defining the term "processor," the Trademark Examining Attorney relies on the general dictionary meaning of this word as "something that processes":

proc·es·sor n.
1. One that processes, especially an apparatus for preparing, treating, or converting material: *a wood pulp processor.*
2. *Computer Science*
a. A computer.
b. A central processing unit.
c. A program that translates another program into a form acceptable by the computer being used.[6]

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to the ongoing development, advancement, and promotion of proteomics research" in U.S. Class 200 [Registration No. 2687595 issued on the Supplemental Register on February 11, 2003]; GENOMICS & PROTEOMICS, for "printed publications, namely magazines, magazine supplements and journals relating to science, bioscience, medicine, medical research" in International Class 16 [Registration No. 2777029 issued on the Supplemental Register on October 21, 2003]; MULTIPLEXED PROTEOMICS (with the word "Proteomics" disclaimed) for "protein detection chemicals to measure multiple parameters on a single sample for research use" in International Class 1 [Registration No. 2800194 issued on December 30, 2003]; and PROTEOMICS DISCOVERY PLATFORM for "product research and development, laboratory research and consultation in the field of biotechnology and gene therapy" in International Class 42 [Registration No. 2839280 issued on the Supplemental Register on May 4, 2004].

[6] *THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE,* Fourth Edition, Copyright © 2006.

While it is clear from the record that applicant's instrument does not process *proteins*, it does process *data about proteins*. In this context, applicant concedes that "something that processes" (e.g., entry No. 1 above) is a definition of "processor." Yet, applicant goes on to argue that the term, as used in applicant's mark, also evokes a "processor" of a computer (e.g., entry No. 2(b) above), and furthermore, that it suggests the involved instrument will serve as "the engine" or "driving force" for the purchaser's research or diagnostic services. This, applicant argues, presents a new and unique combination. We are not persuaded by this explanation. Prospective purchasers will understand immediately that these goods "process" data relating to proteins and protein sequences and conditions that are associated with such proteins and protein sequences. Hence, the word "processor," in the ordinary dictionary sense of that word, is merely descriptive of the named goods.

The combined term "ProteomicProcessor"

We have found that these terms separately have a descriptive significance in relation to applicant's goods. The question remains whether combined they present a unique or incongruous combination, or whether the combined term is also descriptive. For example, if a combination of

descriptive components has a readily understood, alternative meaning, the mark would be considered to have a "double entendre" and will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. *See The Institut National des Appellations D'Origine v. Vintners International Co. Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) [CHABLIS WITH A TWIST may well project a double meaning, e.g., the unusual approach of adding a citrus flavoring to wine]; *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) [the term SUGAR & SPICE held not to be merely descriptive of bakery products][7] and *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) [NO BONES ABOUT IT for fresh pre-cooked ham]. In each of these cases, the secondary interpretations that make each expression a double entendre consist of an association that members of the public would make quite readily, and the new combination creates another meaning that renders the combination registrable as a mark.

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[7] In this oft-cited decision of the predecessor to our principal reviewing court, the Court found this matter clearly functioned as a trademark because "sugar and spice" is a well-known phrase taken from a nursery rhyme. The composite mark is inherently distinctive as applied to bakery products – even ones containing these two ingredients – precisely because this combination from the nursery rhyme is familiar to anyone seeing or hearing this mark.

Throughout the prosecution of this application applicant has argued that its mark is a double entendre, and refers in its brief to trademark decisions involving marks such as SNO-RAKE,[8] SUGAR & SPICE, and THE HARD LINE.[9] Relying on the computer science definition of the word "processor" as a reference to components often characterized as microprocessors, applicant contends that prospective purchasers, upon seeing its mark, will draw an analogy to the CPU in a computer and believe that the mark suggests that the instrument bearing the mark will serve as "the engine" or "driving force" for the purchaser's research or diagnostic services. We find that such reasoning is much too attenuated to stand as the readily understood interpretation of consumers, as contrasted with the very clear alternative meanings that were present in the double entendre cases referred to above.

Hence, we find the instant mark is not analogous to marks such as CHABLIS WITH A TWIST, SUGAR & SPICE or NO BONES ABOUT IT. Rather, we find that when the two descriptive

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[8] The board found that the mark SNO-RAKE is not merely descriptive of a snow removal hand tool, the head of which is solid uninterrupted construction without prongs. *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983).

[9] The board found that the mark, THE HARD LINE, used in connection with a line of mattresses and box springs is not merely descriptive under Section 2(e)(1) of the Trademark Act. *In re Simmons Company*, 189 USPQ 352 (TTAB 1976).

terms "Proteomic" and "Processor" are combined into the mark "ProteomicProcessor," the individual components do not lose their descriptive significance, and the new combination fails to create another non-descriptive meaning.

Specifically, when these terms are viewed together, the applied-for mark immediately conveys the meaning of an instrument that provides or processes data relating to proteins and protein sequences. Thus, we are persuaded by the evidence of record that the words "proteomic" and "processor" are merely descriptive of applicant's identified goods, and that when combined, the term PROTEOMICPROCESSOR is also descriptive.

We note that applicant has depicted its mark as a standard character drawing having all upper-case letters, PROTEOMICPROCESSOR, without a space between the word "Proteomic" and the word "Processor." The fact that applicant chose to eliminate the space between these two words, thereby compressing two words into a single word, is immaterial to the result under Section 2(e)(1) of the Lanham Act.[10] We find that the individual elements "Proteomic" and "Processor" would still be readily recognized by one viewing

[10] As actually used on applicant's website, the mark uses two upper case letters "P" ("ProteomicProcessor"), which presentation also creates a visual separation not seen in the application drawing (PROTEOMICPROCESSOR).

the combined mark. *See In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [SCREENWIPE generic for premoistened antistatic cloths for cleaning computer and television screens]. *See also In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) [CUSTOMBLENDED generic for custom blended gasoline]; *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [TURBODIESEL generic for internal combustion engines]; *In re Abcor Development Corporation*, 200 USPQ at 215 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]; *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"]; *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998) [MASSFLO is generic for flowmeters for measuring flow of mass of fluid]; and *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534 (TTAB 1987) [WASHWAX generic for product which simultaneously washes and waxes a vehicle].

Finally, applicant argues that inasmuch as the Trademark Examining Attorney failed to supply any evidence that other entities are using the term "proteomic processor" (or "proteomicprocessor") in connection with surface plasmon resonance instruments, we should find that the applied-for mark is not descriptive when used in connection with the

identified goods. Contrariwise, we find that the failure of the Trademark Examining Attorney to uncover examples of this specific combination of words does not detract from the fact that PROTEOMICPROCESSOR would be perceived as merely descriptive for surface plasmon resonance instruments by the relevant consumers. Additionally, the fact that applicant may be the first and sole user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive of the identified goods or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) [COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments]; and *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field].

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