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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oridis Biomed Forschungs-Und Entwicklungs GmbH

Serial No. 79008157

Julie B. Seyler of Abelman, Frayne & Schwab for Oridis
Biomed Forschungs-Und Entwicklungs GmbH.

Brian Pino, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Hohein, Hairston and Cataldo, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Oridis Biomed Forschungs-Und Entwicklungs GmbH has
filed an application to register on the Principal Register
the mark TISSOMICS in standard character form for the
following services:

Systemization and compilation of data into
computer databases, namely, management and
compilation of computerized databases in Class
35;

Rental of access time to databases in Class 38;

Scientific research in the fields of biochemistry and medicine; chemical analysis in Class 42; and Medical services in Class 44.¹

The trademark examining attorney has issued a final refusal to register, under 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 services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

As background, applicant submitted a printout from its Internet website describing its activities which consist of tissue-based research. According to applicant, TISSOMICS is a term it coined for a proprietary process for the analysis of normal and diseased tissue. Applicant argues that "the record is devoid of evidence establishing that TISSOMICS, when considered within the context of the services set forth in the application, describes a feature, function or quality of said services." (Reply brief at pp. 2-3). Further, it is applicant's position that the examining attorney has failed to clearly and concisely provide an analysis as to how the mark TISSOMICS describes the services in the application. In the absence of such an

¹ Serial No. 79008157, filed August 27, 2004 under Trademark Act Section 66(a).

analysis, applicant argues that the refusal should be reversed. Applicant submitted copies of the pages of four dictionaries (one general and three medical) which show the absence of any listings for the term "tissomics."

Applicant acknowledges that the examining attorney has submitted some evidence of use of the term "tissomics" by others, but applicant maintains that such uses are either references to its technology or misuses of its mark.

The examining attorney maintains that TISSOMICS describes a field of scientific research and that "[w]hen considered in relation to the applicant's services, the mark TISSOMICS is merely descriptive because it immediately tells customers that the services use tissomics or are about/related to tissomics." (Final Office, p. 2). In support of the refusal, the examining attorney submitted Internet printouts of materials, most of which are scientific papers, that contain references to the term "tissomics."

The examining attorney bears the burden of showing that a mark is merely descriptive of the relevant services. In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the services in connection with which it is used, or intended to be used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary for a term to describe all of the properties or characteristics of the services in order for it be considered merely descriptive of them; rather, it is sufficient if the term describes any significant attribute or idea about them. Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such services. In re Bright-Crest, Ltd. 204 USPQ 591 (TTAB 1979); and In re Recovery, 196 USPQ 830 (TTAB 1977).

At first blush, it would appear that a significant number of authors of scientific papers have used the term "tissomics" in a descriptive manner, that is, to describe a technology or scientific process. The following are

excerpts from three of the printouts submitted by the examining attorney (emphasis added):

This presentation reports on recent progress made to develop **tissomics, a technology to carry out a comprehensive structural profiling of normal and disease tissue specimen.**

<http://mgh.harvard.edu/wellman/calendar>

OBJECTIVES: Recent progress in **automated tissue analysis (tissomics)** provides reproducible phenotypical characterization of histological specimens.

<http://www.ncbi.nlm.gov>

Therefore, the generation of quantitative phenotypic data by high-throughput, high content **analyzing techniques including** metabolomics, as well as image based cytomics and **tissomics**, has gained interest.

<http://calendar.cs.drexel.edu>

However, closer scrutiny of the materials submitted by the examining attorney reveals that nine of the printouts (including the printouts wherein the above quoted material appears) are from papers and presentations prepared by a single individual. The examining attorney submitted two other printouts which consist simply of the titles of scientific papers, i.e., "Cytomics goes 3D: toward tissomics" (<http://bpm.micromedex.com>); and "Tissomics: detecting two and three-dimensional distribution of cells in brain tissues using laser scanning cytometry (LSC)" (<http://spiedl.aip.org/servlet>). An additional printout is from the Internet website of a company that offers software

used in scientific analysis and reads, in relevant part, "Our software is best suited for high throughput, high content analysis of microscopic images, tissue microarrays (TMAs) and tissomics" (<http://www.cvistec.com>). The remaining printout, which consists of the word "Tissomics" along side of several charts, is actually from applicant's "Tissomics" Internet website (<http://www.tissomics.com>).

After reviewing the evidentiary material introduced into the record and after considering the respective arguments of applicant and the examining attorney, we have doubt concerning the amount and character of the evidence presented in support of the examining attorney's position that "TISSOMICS" is merely descriptive of the identified services. The examining attorney's evidence is very limited. At best, the record shows four separate "uses" of the term "tissomics" to describe a technology or scientific process. Applicant has responded to this evidence and argues that such uses are either references to applicant's proprietary process or misuses of applicant's trademark. In addition, while we recognize that this is not determinative, particularly in the case of a new or recent term, applicant has submitted "negative" dictionary evidence.

We are not persuaded, on this record, that persons in the relevant scientific and medical fields understand the term "tissomics" to describe a type of technology or scientific process. Thus, we are unable to conclude that applicant's mark TISSOMICS conveys an immediate idea about any characteristic or feature of the identified services. It is well settled that if there is doubt about the "merely descriptive" character of a mark, such doubt must be resolved in applicant's favor and the mark published for opposition. In re Rank Organization Ltd., 222 USPQ 324 (TTAB 1984); In re Conductive Systems, Inc., 220 USPQ 84 (TTAB 1983); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972). On a different record, such as might be adduced in an opposition proceeding, we might well reach a different conclusion.

Decision: The refusal to register under Section 2(e)(1) is reversed as to the services in each class.