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Mailed:
February 8, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re BioCryst Pharmaceuticals, Inc.

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Serial No. 77131316

Nicholas J. Landau of Bradley Arant Boult Cummings, LLP for BioCryst Pharmaceuticals, Inc.

Brian P. Callaghan, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

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Before Bergsman, Kuczma and Masiello, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

BioCryst Pharmaceuticals, Inc. (“applicant”) filed an intent-to-use application for the mark FODOZAN, in standard character form, for the following goods:

Pharmaceutical products, namely, preparations and substances for the treatment of cancers and immunological diseases and disorders, namely, cancers of the immune system such as T-Cell and B-Cell leukemias and lymphomas and immunological disorders such as transplant rejection, in Class 5.

After publication, applicant filed a statement of use. For its specimen of use, applicant submitted a copy of a report which displayed use of the mark FODOSINE.

Applicant asserted that the report was a display associated with the goods. Subsequently, applicant submitted a substitute specimen consisting of a label displaying the mark FORODESINE.

The Trademark Examining Attorney refused to register applicant's mark because neither specimen displayed the mark sought to be registered as required by Sections 1 and 45 of the Trademark of 1946, 15 U.S.C. §§ 1051 and 1127. *See also* Trademark Rule 2.51(b). Applicant appealed the refusal to register, as well the Trademark Examining Attorney's refusal to accept applicant's 2006 report as an acceptable specimen, pursuant to Sections 1 and 45 of the Trademark of 1946, 15 U.S.C. §§ 1051 and 1127. *See also* Trademark Rules 2.56(a) and 2.88(b)(2).

A. Whether either of the marks displayed on the specimens, FODOSINE and FORODESINE, is a substantially exact representation of FODOZAN, the mark sought to be registered?

Section 1 of the Trademark Act requires that a trademark application include a drawing of the mark; in this case, FODOZAN. Trademark Rule 2.51(b) provides that "the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods ... specified in the application ..." and that once the statement of use is filed "the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods."

Before the mark in an intent-to-use application may register, the applicant must file an allegation of use that includes one specimen for each class of goods or services. Trademark Rules 2.56(a), 2.76(b) and 2.88(b)(2). The rules provide that the specimen must "show the mark as used on or in connection with the goods."

The regulation's term 'substantially' permits only inconsequential variation from the mark as it appears on the drawing (e.g., nonmaterial informational matter). *In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997). *See also In re Yale Sportswear Corp.*, 88 USPQ2d 1121 (TTAB 2008) (UPPER 90° is not a substantially exact representation of UPPER 90 because it changes the meaning of "90"); *In re Roberts*, 87 USPQ2d 1474 (TTAB 2008) ("restmycase" is not an exact representation of "irestmymcase"); *In re Larios S.A.* 35 USPQ2d 1214 (TTAB 1995) (GRAN VINO MALAGA LARIOS is not a substantially exact representation of VINO DE MALAGA LARIOS). *Compare In re ECCS Inc.*, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996) (EXAMODULE is a substantially exact representation of the mark EXA and MODULE appearing on different lines, one above the other); *In re Innovative Companies LLC*, 88 USPQ2d 1095 (TTAB 2008) (FREEDOMSTONE and FREEDOM STONE create the same commercial impression); *In re Finlay Fine Jewelry Corp.*, 41 USPQ2d 1152 (TTAB 1996) (NY JEWELRY OUTLET is a substantially exact representation of NEW YORK JEWELRY OUTLET); *Humble Oil & Refining Co. v. Sekisui Chemical Co. Ltd. of Japan*, 165 USPQ 597 (TTAB 1970) (S-LON and ESLON are and would be recognized as the same mark).

As shown on the specimens of record, applicant is using the marks FODOSINE and FORODESINE, although it seeks to register the mark FODOZAN. The question is whether applicant's use supports such a registration. To put it succinctly, "[i]t all boils down to a judgment as to whether that designation for

which registration is sought comprises a separate and distinct ‘trademark’ in and of itself.” *Institut des Appellations d'Origine v. Vintner's Int'l Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992). *See also Chem. Dynamics*, 839 F.2d 1569, 5 USPQ2d 1828, 1829-30 (Fed. Cir. 1988). Thus we must consider whether FODOZAN makes a “separate and distinct commercial impression” from FODOSINE and FORODESINE as they appear in the specimens. *See also* Trademark Rule 2.72(a)(2) (an applicant may amend its mark if the proposed mark does not materially alter the mark); *Visa International Service Ass’n v. Life-Code Systems, Inc.*, 240 USPQ 740, 743 (TTAB 1983) (“The *modified* mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.”) (Emphasis in the original).

We find that applicant’s use of the mark FODOSINE is not a substantially exact representation of the mark FODOZAN, the mark sought to be registered. While the first two syllables are the same, the suffixes – SINE and ZAN – are distinctly different in appearance and pronunciation. While it is settled, at least in the likelihood of confusion context, that there is no “correct” pronunciation of a trademark, FODOSINE is likely to be pronounced as FŌ DŌ SĪN (as in “sign”) or FŌ DŌ SĒN (as in “seen”) and FODOZAN is likely to be pronounced as FŌ DŌ ZĀN (as in “san”). We accordingly conclude that FODOSINE and FODOZAN are dissimilar visually and phonetically and these dissimilarities preclude finding that the two terms are essentially the same marks.

Likewise, FORODESINE is not a substantially exact representation of the mark FODOZAN. FORODESINE is even more dissimilar to FODOZAN than FODOSINE because even if we were to assume the suffixes SINE and ZAN were substantially similar, the prefixes FODO and FORODE are different visually and phonetically. Accordingly, FORODESINE and FODOZAN are not essentially the same marks.

According to applicant, the suffixes SINE and ZAN are phonetic equivalents because the letters Z and S are often substituted for one another in English words ending in “AN” and, thus, “ZAN” and “SAN” are interchangeable.¹ However, the suffixes at issue are “ZAN” and “SINE.”

In view of the foregoing, FODOSINE and FORODESINE shown on the specimens are not substantially exact representations of the mark FODOZAN, the mark sought to be registered.

B. Whether applicant’s report is an acceptable specimen for a pharmaceutical product?

Another issue in this appeal is whether the specimen submitted by applicant with its statement of use is acceptable to show use of the mark in connection with the identified goods.

Trademark Rule 2.56 provides, in part:

§2.56 Specimens

- (a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing

¹ Applicant’s brief, p. 5.

the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

Section 45 of the Lanham Act, 15 U.S.C. §1127, states, in part, that:

For purposes of this Act, a mark shall be deemed to be in use in commerce –

(1) on goods when -

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale . . .

Applicant’s original specimen is “The 2006 Report.” An excerpt from the cover page is shown below.



Applicant identified the document as “a report from December 11, 2006 which reports the results of clinical trial programs involving the listed goods.”² However, on the page displaying the FODOSINE mark, applicant’s Chief Executive Officer greets the readers as “Dear Fellow Shareholders.” The essence of the report informs

² Applicant’s Statement of Use.

shareholders that applicant is getting close to developing therapies to treat diseases. The FODOSINE information is shown below.



Applicant contends that the report is an acceptable specimen because it “constitutes a public display, showing the mark in modified form (FODOSINE) placed prominently on the third and fifth pages of the report.”³

The report shows a picture of the packaging for the goods, and this picture is in close proximity of the mark FODOSINE shown with a “TM” designation. In addition, a description of the goods is provided, along with a statement (circa 2006) that “Fodosine™ is currently being tested in a pivotal trial, for patients with T-ALL, under a special protocol assessment negotiated with the FDA.” A purpose of the Report (which is publicly available) is to inform the shareholders of Applicant as well as the public regarding Applicant’s business, including its product. It is not merely advertising.⁴

Whether a specimen is a display associated with the goods is a question of fact. *Land’s End Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); *In re Hydron Technologies Inc.*, 51 USPQ2d 1531, 1533 (TTAB 1999); *In*

³ Applicant’s Brief, p. 2.

⁴ *Id.* at 2-3.

re Shipley Co. Inc., 230 USPQ 691, 694 (TTAB 1986). The starting point for this analysis is the specimen submitted to show use of the mark.

A crucial factor in the analysis is if the use of an alleged mark is at a point of sale location. A point of sale location provides a customer with the opportunity to look to the displayed mark as a means of identifying and distinguishing the source of the goods.

Land's End Inc. v. Manbeck, 24 USPQ2d at 1316, citing *In re Shipley Co. Inc.*, 230 USPQ at 694.

In the above-noted cases, the determinative factor was that the mark was used at the point of sale (i.e., the location where the goods could be ordered). In *Land's End*, the specimen of trademark use at issue was a mail order catalog that featured an order form and a telephone number so that a customer could order a product directly from the catalog.

The *Shipley* case involved a mark prominently displayed at a trade show booth where orders for products were taken. The Board likened the trade show booth to a sales counter and concluded that since the mark was prominently displayed, the customer would associate the mark with the products in deciding whether to buy the products.

Hydron involved an infomercial aired on QVC, a cable television channel devoted to shopping. Programming on this channel consists of advertising products and offering to send them to viewers who call and order them by telephone. In the infomercial at issue, the mark was displayed three times followed by photographic representations of the products. A telephone number was displayed during the infomercial for placing an order for the products.

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There is no offer for sale in the report, nor is there any information informing a potential customer how to order the pharmaceutical products identified by the mark. The report submitted by applicant is similar to an annual report which would be published and distributed by any corporation as generally required under securities laws. Applicant's report does not constitute a display in association with the goods because the report is not associated with an offer of sale or any means for ordering the goods.

In view of the foregoing, applicant's report is not an acceptable specimen.

Decision: The refusals to register are affirmed and registration to applicant is refused.