

Aspirina Case Instructive For Trademark Practitioners

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In the case of *In re Bayer AG*, --F.3d--, 2007 WL 1502078 (Fed.Cir. May 24, 2007) ("Fed.Cir. Decision"), the Federal Circuit affirmed the Trademark Trial and Appeal Board's holding that "Aspirina" is merely descriptive for analgesics.

The court's opinion, as well as the TTAB's underlying Order (2005 WL 3395183 (TTAB Dec. 1, 2005)) ("TTAB Order"), prove instructive to trademark practitioners on a variety of issues, as discussed below in Section II.

* Summary of Decision and Dissent *

Bayer AG ("Bayer") applied to register Aspirina for analgesics in October 2000 on an intent-to-use basis. In the course of prosecution, Bayer's attorneys entered an English translation for Aspirina as "aspirin." Bayer later expressly abandoned its application.

Bayer filed a second intent-to-use application for Aspirina covering analgesics in February 2003. The examiner refused registration on the grounds that the mark was merely descriptive of aspirin, which is the generic name for a class of analgesics.

In support of this finding, the examiner relied on four translations/definitions of the term Aspirina to show that it is the Spanish-language equivalent of the English word "aspirin." The examiner also relied on Nexis® and Google® evidence in support of her position.

The examiner reasoned that there is nothing suggestive or incongruous about the mark Aspirina, and that the mark when used for analgesics leaves nothing for speculation or conjecture. The examiner was careful to note that the issue was not whether the mark was generic, but merely descriptive.

The TTAB affirmed the examiner's decision that "Aspirina" was merely descriptive and thus not registrable on the Principal Register. The TTAB reasoned that Aspirina "immediately conveys the impression that applicant's analgesics are aspirin-based products." TTAB Order at *3.

The TTAB also stated that "prospective consumers in this country, aware of the generic term 'aspirin,' will view Aspirina as a slight variation (or even a misspelling) of the generic term and, thus, the term is merely descriptive of analgesics." Id.

Bayer appealed to the Federal Circuit, which affirmed the decision of the TTAB. The determination of descriptiveness is a factual finding, which is reviewed by the Federal Circuit under the deferential "substantial evidence" standard.

The Federal Circuit ultimately concluded that there was substantial evidence to support the TTAB's finding that Aspirina is merely descriptive as applied to Bayer's analgesic products.

Notably, Judge Newman of the Federal Circuit dissented from the majority's opinion. Judge Newman characterized the record as containing no evidence of use of Aspirina in the United States or in any other country other than as a trademark in association with a Bayer product.

Judge Newman also pointed to the lack of evidence of generic usage of Aspirina by third parties in the marketplace. He pointed to other marks which have been allowed by the U.S. Patent and Trademark Office, even though they consisted of only slight variations of the term aspirin, such as "Un-Aspirin" and "Aspirin 911," and reasoned that if such marks were deemed protectable so too should Aspirina.

Judge Newman was of the opinion that the panel majority in effect concluded that Aspirina was generic, despite the fact that the issue of genericness was not before the TTAB or the Federal Circuit.

The Judge indicated that while the TTAB's decision would not have prevented Bayer from later claiming secondary meaning in the mark Aspirina, the panel majority's decision "goes farther than the PTO and holds that the Aspirina mark is simply the translation of a generic word, thereby slamming shut the PTO's open door."

In the author's opinion, this conclusion by Judge Newman is debatable. The Federal Circuit did express the opinion that the Nexis® evidence of record showed use of the term Aspirina as the equivalent of the generic English term "aspirin," and that the Google® search report and the translation of Bayer's Aspirina.com Web page showed that consumers are exposed to Aspirina as "a generic or descriptive term for the analgesic goods."

However, the board expressly affirmed the TTAB's holding that Aspirina is merely descriptive. Fed.Cir. Decision at *8. Additionally, the panel majority was careful to note that the issue of genericness was not before the TTAB and likewise was not before the court. Fed.Cir. Decision at *1, n.1.

Therefore, it appears to the author that Bayer could in good faith later apply to register Aspirina pursuant to Section 2(f), after some period of substantially exclusive and continuous use in U.S. commerce.

* Lessons for Trademark Practitioners from In re Bayer *

Expressly Abandoning a Trademark Application Can Be a Viable Strategy.

When Bayer first applied to register Aspirina in the U.S., its counsel entered an English translation for Aspirina as "aspirin." Bayer subsequently expressly abandoned its initial application, and refiled.

The examiner of Bayer's second application urged the TTAB to consider Bayer's earlier translation of Aspirina as tantamount to an admission against interest.

Bayer attempted to explain away the translation, by arguing that (1) in fact there is no English translation of Aspirina, and that the translation previously submitted by Bayer was a "mistake"; and (2) by abandoning and refiled, Bayer was simply acting to clean up the record and begin the process anew with a "clean slate."

Significantly, the TTAB stated that in reaching its decision, it did not accord any probative value to the translation submitted by Bayer in the prosecution of its first application. TTAB Order, at *4.

Likewise, the Federal Circuit only referenced the earlier application in a footnote, and pointed out that the TTAB did not assign it any probative value. Fed.Cir. Decision, at *2, n.2. Therefore, by abandoning and refiled, Bayer succeeded in effectively eradicating what otherwise could have been an error fatal

to its position that Aspirina is a suggestive mark.

Nexis® Stories of Foreign Origin and Printouts From Foreign Web sites Can Have Probative Value.

Examiners frequently rely on Nexis® stories and Internet printouts to support their positions. In this case, the Examiner relied on Nexis® news stories of foreign origin to support her position that "Aspirina" is merely descriptive for aspirin. Characterizing the Examiner's inclusion of such stories as a "common mistake", the TTAB refused to afford them any probative value. TTAB Order, at *3, n.3.

The Federal Circuit disagreed with the TTAB on this point. The court reasoned that "[i]nformation originating on foreign Web sites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer [sic] impression of a proposed mark."

Fed.Cir. Decision at *7. In finding the foreign-origin evidence probative, the court also pointed to the growing availability and use of the Internet as a resource for news, medical research results, and general medical information. Id.

Evidence of Foreign Registrations is Not Relevant to the Protectability of a Mark in the U.S. Bayer attempted to support its position that Aspirina is inherently distinctive by submitting evidence that Aspirina has long been registered in numerous foreign countries. The Federal Circuit confirmed that the TTAB's summary dismissal of this evidence was appropriate.

While acknowledging that U.S. consumers may access print and electronic materials from foreign sources and/or travel to countries where Aspirina is a registered mark, the court held that registration of a mark in other countries is not legally or factually relevant to U.S. consumers' perception of the mark, or the protectability of a mark under U.S. law.

To the Extent Possible, It Is Advisable to Carefully Monitor and Attempt to Modify Dictionary Entries That May Affect the Registrability (or Enforceability) of a Mark.

The term aspirin was adjudicated generic in the U.S. back in 1921. One of the main questions in the instant case was whether the proposed mark Aspirina was the Spanish-language equivalent to the generic term aspirin.

Both the examiner and Bayer submitted dictionary evidence to support their respective positions. While the three definitions submitted by Bayer specifically stated that Aspirina was a registered trademark, they also stated that Aspirina means aspirin and/or that Aspirina can be defined as the same crystalline product that is aspirin. Fed.Cir. Decision at *4.

Because of this, the court deemed the dictionary evidence submitted by Bayer to be "conflicting", and ultimately concluded that it provided substantial evidence in support of the TTAB's decision. Id. This decision reflects the importance of carefully monitoring and assessing dictionary entries for a mark, and using best efforts to persuade publishers to use appropriate entries that both (1) identify the word as a trademark and (2) do not go on to define the trademark in a generic-type manner for a class of goods.

Be Sure to Make Evidence Properly of Record.

The examiner attempted to rely on a Google® search report listing the first ten "hits" for Aspirina. The report included a small amount of Spanish text with each of the ten search results. Bayer challenged the Google® report as having little probative value, and the court agreed. Fed.Cir. Decision at *5.

The court reasoned that the report provided very little context of the use of Aspirina, and therefore was of little probative value. Therefore, if search "hit lists" are to be submitted as evidence, it is advisable to also include printouts from the actual Web pages referenced on the hit list in order to show the context of use.

On another note, Bayer attempted to rely on two third-party registrations of "Asper-" formative marks in support of its position that Aspirina should be deemed registrable. While the TTAB noted that the third-party registrations would not have compelled it to reach a different result, it also held that the third party registrations were not properly made of record by Bayer. TTAB Order, at *3.

In addition to raising any relevant third-party registrations in the prosecution stage of proceedings, keep in mind that the TTAB does not take judicial notice of registrations, (TMEP §710.03), and the mere citation of a mark and registration number is not sufficient. Instead, soft copies of registration certificates or the complete electronic equivalent printed from the USPTO's database must be submitted. Id.

--By Tamara A. Miller, **Leydig, Voit & Mayer Ltd.**

Tamara A. Miller is a partner in Leydig, Voit & Mayer's Chicago office, and her practice includes all aspects of trademark, copyright, trade secret, and unfair competition counseling and litigation. She represents clients in a wide variety of industries, including pharmaceuticals, perishable and non-perishable consumer goods, insurance and financial services, industrial products, and catalog and retail store services. Ms. Miller also has extensive experience in trade dress matters, from registration of color and container marks to litigation involving packaging and product configuration marks.

Leydig, Voit & Mayer has been at the forefront of intellectual property law for more than 100 years and enjoys an international reputation for excellence in all areas of intellectual property practice. The firm numbers more than 80 attorneys in four U.S. offices and provides counseling, litigation, licensing and prosecution services to clients throughout the world.

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