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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re BioArray Solutions, Ltd.

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Serial No. 76339812

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Eric P. Mirabel, Esq. of BioArray Solutions, Ltd. for applicant.

John E. Michos, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Hohein, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

BioArray Solutions, Ltd. (a Delaware corporation) filed on November 15, 2001 an application to register on the Principal Register the mark ARRAY CYTOMETRY for goods and services ultimately amended to read as follows:

"preparations for scientific and research use, namely, biological or biotechnical arrays and assemblies of constituents of biological cells, methods, tests, kits consisting of the aforementioned; biological preparations

for random encoded array detection to record optical signatures from cells randomly dispersed in a planar array or assembly and optically programmable reconfiguration and segmentation of assemblies cells; a highly parallel assay format that is useful for a wide variety of multiplexed bioanalytical assays, including functional and structural cellular analysis that is enabled by the optically programmable assembly and manipulation of cells (e.g., bacterial, yeast and human) providing quantitative, multi parameter cell surface analysis by direct imaging as well as fractionation and sorting of mixed cell populations" in International Class 1; and

"distribution of services in the field of biological or biotechnical arrays and assemblies of constituents of biological cells, methods, tests, kits, or apparatus therefor; random encoded array detection to record optical signatures from cells randomly dispersed in a planar array or assembly and optically programmable reconfiguration and segmentation of assemblies cells; a highly parallel assay format that is useful for a wide variety of multiplexed bioanalytical assays, including functional and structural cellular analysis that is enabled by the optically programmable assembly and manipulation of cells (e.g., bacterial, yeast and human) providing quantitative, multiparameter cell surface analysis by direct imaging as well as fractionation and sorting of mixed cell populations" in International Class 35.<sup>1</sup>

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<sup>1</sup> The acceptability of the recitation of services is an issue in this appeal and will be fully addressed later in this decision.

The application is based on applicant's assertion of a bona fide intention to use the mark in commerce on or in connection with the identified goods and services.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when used on or in connection with the goods and services identified in the application, is merely descriptive thereof. The Examining Attorney also has made final the requirement for a more definite recitation of services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Turning first to the question of the recitation of services, the Examining Attorney did not accept the original identification of services, and suggested, if appropriate: "distributorship services in the field of ...". In response, applicant offered the following amendment to the identification of services: "services in the field of ...". Applicant's proposed amendment to the identification of services was rejected by the Examining Attorney as indefinite. Applicant then requested reconsideration, which included a second proposed amendment to the identification of services to read "distribution of

services in the field of ...” This was also rejected by the Examining Attorney as indefinite because it does not set forth a particular service, and the Examining Attorney again suggested that “distributorship services in the field of ...” was an acceptable identification of services.

Both applicant and the Examining Attorney argued the issue of a proper identification of services based on the second proposed amended identification of services. Thus, our decision relates to the question of the acceptability of the second proposed amended identification.

Section 1(b)(2) of the Trademark Act, 15 U.S.C. §1051(b)(2), requires that the written application specify the goods or services on or in connection with which applicant asserts a bona fide intention to use the mark. Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth “the particular goods or services on or in connection with which the applicant uses or intends to use the mark.” Further, the identification of goods or services must be specific and definite. See TMEP §§805 and 1402.01 (3d ed. Rev. 2, 2003). The USPTO is permitted to require that the goods or services be specified with particularity. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein,

rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998).

The Examining Attorney's requirement that applicant use "distributorship services ..." rather than "distribution of services ..." is correct. The problem with applicant's second proposed identification lies with the wording "distribution of services in the field of ...". As explained by the Examining Attorney, "distribution of services" does not identify any particular service (or multiple services) with the required degree of specificity. That is, it is impossible to discern the precise type of service (or services) that applicant intends to offer. Under USPTO identification and classification requirements, the phrase "distribution of services ..." is not acceptable as an identification of services. The Examining Attorney's requirement for a more definite identification of services is proper.

We turn now to the refusal to register for both the goods and services on the ground of mere descriptiveness. A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information concerning an ingredient, quality, characteristic or feature of the goods or services, or if it directly conveys information regarding the nature, function, purpose or use

of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986). Moreover, a mark need only describe one significant quality or characteristic of the relevant goods or services in order to be held merely descriptive. See *In re Gyulay*, supra.

Of course, it need hardly be said that the descriptiveness of a mark is not judged in the abstract, but rather is judged in connection with the goods and/or services with which the mark is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). As a further elaboration on this proposition, the mere descriptiveness of a mark is not determined from the standpoint of all consumers, but rather is determined from the standpoint of the relevant purchasing public of the goods and/or services for which registration is sought. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ 1551, 1552-53 (Fed. Cir. 1991) ("The precedents of this court both before and after the 1984 Act have consistently applied the traditional *purchaser* understanding test. For example, this court has stated

that whether a term is entitled to trademark status turns on how the mark is understood by the *purchasing public*.”) (emphasis added); and *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989) (“Whether a term is entitled to trademark status turns on how the mark is understood by the *purchasing public*.”) (emphasis added).

The Examining Attorney contends that the term “array” is used in the medical and research fields to refer to a collection or grouping of reagents or diagnostic preparations (as indicated in, among other places, applicant’s identification of goods), and the term “cytometry” means “the characterization and measurement of cells and cellular constituents”;<sup>2</sup> that “the mark consists of the common commercial name for the goods, array, with the name of the particular field of research, cytometry, in which they are to be used” (brief, p. 9); that the mark is merely descriptive of the goods in that it describes one of the product’s most important features--the fact that the goods include reagent arrays for use in cytometry; and that the mark is merely descriptive of the services involving

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<sup>2</sup> The Examining Attorney’s request that the Board take judicial notice of this definition of “cytometry” from Stedman’s Online Medical Dictionary is granted. See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12(a) (2d ed. Rev. 1, March 2004).

the distribution of the goods (e.g., arrays) for use in cytometry. Stated another way, the Examining Attorney contends that the mark merely describes biological and biotechnical arrays for use in research applications, including cytometry, making it merely descriptive of the goods and the services herein.

In support of his position, the Examining Attorney relies on, inter alia, (i) applicant's identifications of goods and services, (ii) printouts of several excerpted stories retrieved from the Nexis database, and (iii) printouts of pages from a few websites (including applicant's). The pages submitted by the Examining Attorney from applicant's website<sup>3</sup> include statements such as the following:

BioArray Solutions  
Welcome to BioArray Solutions!  
Pioneering the use of custom bead arrays  
as a platform for DNA, protein and  
cellular assays, enabling presymptomatic  
diagnostics as well as guiding the  
selection and monitoring of treatment for  
disease. This universal platform enables  
rapid and inexpensive analysis of

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<sup>3</sup> In the first Office action, the Examining Attorney, citing Trademark Rule 2.61(b), requested informational materials regarding the goods. Applicant made no response at all thereto, but the Examining Attorney did not make the requirement for information final even though he properly could have done so. See *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004); *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003); and *In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002). Instead, the Examining Attorney submitted printouts of several pages from applicant's website.



critical genetic and biochemical tests in medical diagnostics, drug development and biomedical research.

...

The Technology

...BioArray Solutions' optically programmable bead array technology enables a universal assay platform for next generation solutions in biomedical research, molecular diagnostics and drug development. ...

#### APPLICATIONS

Clinical Diagnostics...

Genetic Typing...

#### FUTURE FUNCTIONALITY

Drug Development...

Array Cytometry

A principal application for the company will be cell-based functional assays where automation is required, particularly for the selection and analysis of single designated cells from a larger group and subsequent analysis. This will be especially useful in applications such as immunology and oncology, where identification and separation of different cell markers is important in research, as well as clinical assessment of disease development and implementation of optimized treatment. ...

...Hosted on the Company's Palmtop Microlab, array cytometry will bring superior performance at lower cost to quantitative cellular analysis. This system will supercede the functionality of conventional flow cytometers whose operation and support requires central facilities and trained specialists. ...  
[www.bioarrays.com](http://www.bioarrays.com).

Examples of the Nexis and other website evidence submitted by the Examining Attorney are reproduced below:

Headline: Cell-Centric Solutions; High-content screening shows effects of drugs on individual cells  
...fully automated laser scanning cytometer, uses an inverted measurement platform and database software that is well suited for arrays of high-content cell specimens such as multiwell microplates and tissue arrays. "Laser scanning cytometry, which combines flow cytometry and image processing techniques to rapidly extract large amounts of data from specimens with many different cell types,..." "Drug Discovery and Development," May 1, 2002

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Headline: Beading an Array; Bead-based arrays provide a higher-throughput, more flexible alternative to conventional microarrays for genomic and proteomic analysis  
...San Diego-based BD Biosciences Pharmigen also employs particles with discrete fluorescence intensities and flow cytometry to design a multiplexed immunoassay system. The cytometric bead array (CBA) offers a broad dynamic range of fluorescence detection and efficient analyte capture on antibody-coated beads. "Genomics and Proteomics," May 1, 2002

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TITL: Recent developments in quantitative fluorescence calibration for analyzing cells and microarrays.

...

CITE: Cytometry 2000 Oct 15 ...

MJTR: Flow Cytometry trends. Fluorescent dyes, standards. Image Cytometry, trends. Oligonucleotide Array Sequence Analysis, trends. "National Library of Medicine MEDLINE Database"

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TITL: The development of a cell array and its combination with laser-scanning cytometry allows a high-throughput analysis of nuclear DNA content.

...

CITE: Am J Pathol 2000 Sep ...

ABST: ...cell array, we measured nuclear DNA content using laser-scanning cytometry for DNA ploidy analysis in nine human tumor cell lines and normal lymphocytes. Combining the cell array with laser-scanning cytometry allows not only measurement of nuclear DNA content for 50 samples but also easy comparison of DNA ploidy among the samples in a single experiment. ... "National Library of Medicine MEDLINE Database"

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TITL: Functional and phenotypic analysis of thymocytes in SCID mice. Evidence for functional response transitions before and after SCID arrest point.

...

CITE: J Immunol 1993 Oct 1 ...

ABST: ...They therefore represent a natural test case to assess those aspects of T cell development that are TCR independent. Multiparameter flow cytometry was used to analyze the array of immature phenotypes present in the SCID thymus at a steady state, as defined by the markers ... "National Library of Medicine MEDLINE Database"

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TITL: Alopecia areata - animal models.

...

CITE: Clin Exp Dermatol 2002 July ...

ABST: ...a nonscarring inflammatory hair loss disease with suspected autoimmune elements, have been identified. ... Flow cytometry and micro array characterization, manipulation of inflammatory cells by in vivo cell depletion or cell receptor blockade, lymph node cell transfer between affected and unaffected rodents, and the recent use of ... "National Library of Medicine MEDLINE Database"

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Lane Lab  
Cytometry and Array Resources

...  
[www.arc.ucla.edu](http://www.arc.ucla.edu)

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Clinical Cytometry Society  
What is Clinical Cytometry?  
...Cytometry is the measurement (-metry) of cells (cyto-) by an analytical device (cytometer) using lasers and light detectors to determine characteristics of the cells...  
Clinical Cytometry Society (CCS) website

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Cytometry  
Cytometry Part A embraces all aspects of analytical cytology and cytomics including flow cytometry, image cytometry, bead-based array analyses, slide-based array analyses, as well as other cell-based spectroscopic analyses...  
Cytometry is the official journal of the International Society for Analytical Cytology.  
Cytometry Part A website.

Applicant urges reversal of the refusal on the basis that the mark ARRAY CYTOMETRY, when viewed in its entirety,

is suggestive, not merely descriptive, of applicant's goods and services; that the Examining Attorney submitted no evidence showing the words "array" and "cytometry" together as "array cytometry"; that applicant uses the terms with initial capital letters on its website indicating it is in trademark/service mark format; that competitors have no need to use this phrase; that purchasers would have to use imagination and thought to make the connection between the mark and the identified goods and services; and that the mark is a composite mark consisting of two words which when combined create a distinctive overall impression different from the individual words.

We agree with the Examining Attorney that the phrase "array cytometry" is merely descriptive of applicant's preparations for scientific and research use, e.g., biological or biotechnical arrays and assemblies as well as its indefinitely identified services related thereto. The evidence shows that the relevant consumers of these scientific and technical goods and services are well aware of arrays and cytometry; and specifically, that biological or biotechnical arrays are used in the measurement of cells (cytometry).

When we consider the mark ARRAY CYTOMETRY as a whole, and in the context of applicant's goods and services, we

find that the mark immediately informs the relevant consumers that applicant's goods and services involve array reagents used in measuring various aspects of cells (cytometry). That is, the relevant purchasers would immediately understand a significant characteristic, purpose and/or function of applicant's identified goods and services. By applicant's own words from its website, its "array cytometry" (not capitalized or indicating a claim of trademark rights in any way) involves "quantitative cellular analysis."

We note that applicant submitted pages from Webster's Third New International Dictionary (undated) to show that the term "array" has several commonplace meanings (e.g., "to set or place in order," "to clothe or dress esp. in splendid or impressive attire") and that the word "cytometry" is not listed therein (although "cytometer" is listed). We find this evidence is unpersuasive in view of the nature of the complex scientific and research goods and services involved herein.

The combination of the two words "array" and "cytometry" does not create an incongruous or unique mark. Rather, applicant's mark, ARRAY CYTOMETRY, when used on or in connection with applicant's goods and services, immediately describes, without need of conjecture or

speculation, the essential characteristic, purpose or function of applicant's goods and services. No exercise of imagination or mental processing or gathering of further information is required in order for relevant purchasers of these goods and services to readily perceive the merely descriptive significance of the mark ARRAY CYTOMETRY as it pertains to the identified goods and services on which applicant intends to use such mark. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive for potpourri); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [FIRSTIER (stylized) merely descriptive for banking services]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays).

While evidence of descriptive use of the multiple words together is generally persuasive that such a multiple word mark is merely descriptive, there is no requirement that an Examining Attorney must obtain evidence of all the words used together in order to make a prima facie showing that a multiple word mark is merely descriptive. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (Court affirmed Board holding THE ULTIMATE BIKE RACK merely descriptive and subject to disclaimer for carrying

racks for mounting on bicycles and accessories for bicycle racks, namely attachments for expanding the carrying capacity of a carrying rack.) See also, *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998). Here the Examining Attorney has met the burden of establishing a prima facie case of mere descriptiveness, and applicant has not rebutted that showing.

**Decision:** The requirement for a more definite identification of services is affirmed, and the refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed as to both classes of goods and services.