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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: Sorrento Therapeutics, Inc.

Filed: November 18, 2020

Serial No.: 90327954

Mark: COVIDROPS

International Class: 5

Examining Attorney

Sara Anne Helmers

Law Office: 130

Commissioner for Trademarks

P O Box 1451

Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

I. INTRODUCTION

On November 23, 2021, the Examining Attorney issued an Office Action refusing registration of applicant's mark COVIDROPS ("Applicant's Mark"), applied for use with, as amended, *Pharmaceutical preparations for the treatment of infectious, viral, inflammatory, immunological, autoimmune and cardiovascular diseases and disorders, namely, COVID-19/Coronavirus; Pharmaceutical preparations for the treatment of COVID-19/Coronavirus; Intranasal pharmaceutical solutions for use as a neutralizing antibody against COVID-19/Coronavirus* ("Applicant's Goods"), based on Section 2(e)(1) of the Trademark Act.

For the reasons set forth herein, Applicant respectfully disagrees with the Examining Attorney's characterization of the mark as descriptive. Applicant submits that Applicant's Mark is not merely descriptive, and requests that the merely descriptive refusal to register be withdrawn.

I. APPLICANT'S MARK IS SUGGESTIVE, NOT MERELY DESCRIPTIVE

Case law supports a finding that Applicant's Mark is at a minimum, suggestive, not merely descriptive.

In order for a mark to be “merely descriptive” when viewed in its entirety, the mark must do nothing but describe the particular goods or services in connection with which it is sold. *Ex parte Heatube Corp.*, 109 U.S.P.Q. (BNA) 423 (Comm. Pats. 1956) (emphasis added). In the *Heatube* decision, the Commissioner held that although the mark “HEATUBE” may have been descriptive of heating tubes, the mark was not descriptive of electrical heating units, which were the goods for which registration was sought. **“The fact that a mark consists of two or more words or terms which may individually describe a quality or characteristic of a product does not render the mark, when considered in its entirety, merely descriptive thereof”**. *In re R. J. Reynolds Tobacco Company*, 183 U.S.P.Q. (BNA) 127 (TTAB 1974)(emphasis added). Similarly, in *In re Diamond Walnut Growers, Inc.*, 183 U.S.P.Q. (BNA) 63 (TTAB 1974), the Board ruled that although the individual words “NUT,” “CRUST” and “BAKE” describe a function, ingredient, and/or resultant use of applicant’s product, namely a seasoned coating mix; the entire combination of the words “NUT CRUST BAKE” was not merely descriptive of Applicant’s Services because applicant’s product is not actually a crust. And in *In re Wells Fargo & Company*, 231 U.S.P.Q. (BNA) 116, 118 (TTAB 1986), the Board considered whether or not the combination of two ordinary descriptive terms “EXPRESS” and “SAVINGS” was merely descriptive of banking services. In its decision, the Board ruled that “the mere combination of the word ‘express’ with the apt descriptive term ‘savings’ is, in its combination” was not merely descriptive of appellant’s banking services.

Further, in *Equine Technologies, Inc. v. Equitechnology, Inc.* 36 U.S.P.Q.2d 1659 (1st Cir. 1995), the appellate court upheld the trial court’s determination that the plaintiff’s mark EQUINE TECHNOLOGIES for horse products was not merely descriptive of plaintiff’s goods. The court stated that, although the mark suggested that the product to which it applies has to do with horses, the mark clearly required the consumer to exercise imagination in order to determine exactly what types of horse related goods were offered in association with the mark. *Id.* at 1662. As such, the mark was not merely descriptive. A mark is suggestive, and not merely descriptive, where some mental analysis is required to understand the application of the mark to the goods or services. *Ex Parte Consolidated Products Co.*, 76 U.S.P.Q. 73, 74 (Commissioner of Patents 1948).

A mark is suggestive, and not merely descriptive, where some mental analysis is required to understand the application of the mark to the goods or services. *Ex Parte Consolidated Products Co.*, 76 U.S.P.Q. 127 (Commissioner of Patents 1948). Common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark. See *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989).

Applicant’s Mark is COVIDROPS. An ordinary consumer would not immediately think of Covid-19 when seeing the term COVI. During the pandemic, the virus has been referred to as Coronavirus, Covid and Covid-19, but not Covi, which is a more whimsical word, which has no definition, nor is it a common abbreviation or acronym. Two top level domains, <http://www.covi.org.uk/> and <https://gocovi.com/>, refer to a think tank (with Covi standing for Common Vision) and IT consulting, respectively. COVI is also a lesser known Italian surname (see <https://www.abbreviations.com/COVI> and <https://www.definitions.net/definition/COVI>). None of these meanings of COVI have anything at all to do with Covid.

Even if an ordinary consumer made the leap to determine that COVI refers to Covid, they would not be able to figure out whether COVIDROPS was a vaccine, a treatment, a preventative step, or a

therapeutic for Covid, since the field of combatting Covid is rapidly changing and evolving. For example, Applicant's goods could refer to prescriptions, and the ordinary consumer would likely have no idea as to administration of the prescription. Moreover, the phrase COVIDROPS could even be a symbolic reference to the cessation of Covid, or a reduction in infections, by reference to the primary meaning for Drops, which is "to let or make something fall vertically", i.e., use of Applicant's COVIDROPS products will reduce the incidence of Covid. As in EXPRESS SAVINGS and EQUINE TECHNOLOGIES, **in their combination**, the words are not descriptive of Applicant's Goods, and instead the coined term is, at best suggestive of a way to help reduce the occurrence of Covid.

II. APPLICANT'S MARK IS A COMPOSITE TERM WITH A UNIQUE NON-DESCRIPTIVE MEANING

The fact that a mark consists of two or more words or terms which may individually describe a quality or characteristic of a product does not render the mark, when considered in its entirety, merely descriptive thereof. *In re R. J. Reynolds Tobacco Company*, 183 U.S.P.Q. (BNA) 127 (TTAB 1974). In order for a mark to be "merely descriptive" when viewed in its entirety, the mark must do nothing but describe the particular goods or services in connection with which it is sold. *Ex parte Heatube Corp.*, 109 U.S.P.Q. (BNA) 423 (Comm. Pats. 1956). In the *Heatube* decision, the Commissioner held that although the mark "HEATUBE" may have been descriptive of heating tubes, the mark was not descriptive of electrical heating units, which were the goods for which registration was sought.

In *In re Priefert Mfg. Co., Inc.*, 222 U.S.P.Q. (BNA) 731 (TTAB 1984), the Board determined that the mark "HAY DOLLY" was not merely descriptive of self-loading trailers for hauling bales. And in *In re Wells Fargo & Company*, 231 U.S.P.Q. (BNA) 116, 118 (TTAB 1986), the Board considered whether or not the combination of two ordinary descriptive terms "EXPRESS" and "SAVINGS" was merely descriptive of banking services. In its decision, the Board ruled that "the mere combination of the word 'express' with the apt descriptive term 'savings' is, in its combination" was not merely descriptive of appellant's banking services.


To be merely descriptive, a mark must create an immediate idea in consumers' minds of the nature of the product. *Timex Grp. USA, Inc. v Focarino*, 109 U.S.P.Q.2d 1393, 1397 (ED Va 2013). Here, a consumer encountering the mark COVIDROPS would not immediately assume the mark identified the source, for example, of a pharmaceutical preparation. As mentioned above, COVIDROPS could refer to a vaccine, a treatment, a preventative step, or a therapeutic for Covid, which is not enough to convey to consumers specific characteristics describing the goods and services. Further, the mark COVIDROPS is a coined term, non-existent in English, that does not meaningfully detract from competitors' ability to describe their own goods and services. *Ibid.* Applicant's competitors could not successfully argue that they must use this same coined term in order to compete effectively in the marketplace, and that registration of Applicant's Mark prejudices them.

In fact, recent USPTO prosecution history shows many instances where COVID formative marks have been allowed for registration with an Examiner's Amendment referencing Covid. In all of those instances, the word COVI/COVA/COVID was paired with a separate word arguably describing the goods and services, for example (see, the table below and Exhibit A containing third-party status records printed from TSDR and made of record):

- COVIDAMINS, Serial No. 90250225, in class 5 for “Vitamins used for the purpose of boosting immunity against contracting COVID-19”
- COVATEST, Serial No. 90523824, for
 - 5: Diagnostic kits comprised of medical diagnostic reagents and assays for testing of bodily fluids for use in disease detection, namely, infectious disease; Medical diagnostic reagents and assays for testing body fluids for microorganisms; Medical diagnostic reagents and assays for testing of body fluids; Drug testing kits comprised of medical diagnostic reagents and assays for testing body fluids; Drug testing kits comprised of medical diagnostic reagents and assays that test for the presence of infectious diseases; all of the foregoing relating to infectious disease, including COVID -19
 - 10: Diagnostic kits consisting primarily of probes, buffers and reagents for use in microbial testing; Medical diagnostic apparatus for testing DNA and RNA samples; Medical diagnostic apparatus for testing for viruses; Medical diagnostic apparatus for testing DNA and RNA samples; Medical diagnostic apparatus for testing of nucleic acids; all of the foregoing relating to infectious disease, including COVID -19
 - 42: Research and development and consultation related thereto in the field of infectious disease testing; Research and development in the field of infectious disease testing; Research and development of technology in the field of infectious disease testing; Research and development services in the field of antibodies; Research, development, engineering and testing services in the fields of immunopharmaceuticals and vaccines; Scientific research and development; all of the foregoing relating to infectious disease, including COVID -19
 - 44: Medical diagnostic testing, monitoring and reporting services; Medical testing for diagnostic or treatment purposes; Medical testing for diagnostic or treatment purposes in the field of infectious disease; all of the foregoing relating to infectious disease, including COVID -19;
- COVASSESS, Serial No. 90523844 for
 - 5: Medical diagnostic reagents and assays for testing body fluids for microorganisms; Medical diagnostic reagents and assays for testing of body fluids; all of the foregoing related to infectious disease, including Covid-19
 - 44: Medical services, namely, the treatment of infectious disease through the use of diagnostic testing to determine key susceptibilities to identified viruses and a course of therapeutics and pharmaceutical preparations in accordance with said susceptibilities; all of the foregoing related infectious disease, including Covid-19”

The marks below and especially above show composite or telescoped marks that were allowed simply with an Examiner’s amendment clarifying that the goods and services are used in connection with Covid-19.

In all of the applications below, the mark was allowed on the Principle Register with an Examiner’s Amendment referencing Covid-19 (see also, Exhibit A).

Mark	Serial No.	Class: Goods and Services
COVENDRY	90026271	5: Pharmaceutical preparations for treatment or prevention of COVID-19, coronavirus disease, and respiratory diseases and disorders; antivirals for treatment or prevention of COVID-19, coronavirus disease, and respiratory diseases and disorders
COVIFENZ	90112570	5: Human vaccines for the prevention and treatment of SARS-COV2, COVID-19, and coronavirus diseases and disorders
COVICEPT	90113133	5: Pharmaceutical preparations for use in the diagnosis, prevention and treatment of infectious diseases; pharmaceutical preparations for use in the diagnosis, prevention and treatment of Covid-19
KOVIDSUN	90116253	10: Colposcopes; Apparatus for blood analysis; Apparatus for physical training for medical use; Apparatus for taking blood samples; Blood testing apparatus; Clinical thermometers; Dental instruments, namely, root canal therapy instruments used to shave the inside of a root canal; Disposable syringes; Endoscopy cameras for medical purposes; Force and motion testing apparatus for physical rehabilitation; Infrared thermometers for medical purposes; Love dolls; Medical devices for closing wounds; Medical instruments for cutting tissue; Medical instruments for measuring and displaying blood pressure and lung capacity; Medical treatment apparel; Medical ventilators; Protective gloves for medical use; Sanitary masks for medical purposes; Sanitary masks for fungus isolation purposes; Sanitary masks for medical wellness purposes; Sanitary masks for protection against viral infection; Sanitary masks for virus isolation purposes; Sterile disposable oxygen humidifiers and nebulizers for respiratory therapy sold pre-filled with water; Surgical apparatus and instruments for use in ophthalmic surgery; Surgical caps; Surgical robots; Surgical and medical apparatus and instruments for use in general surgery; all the foregoing related to the treatment, prevention, neutralization, and/or diagnosis of COVID-19.
COVIDREX	90168759	5: Dietary supplements specially designed to boost immunity; Natural supplements specially designed to boost immunity; all the foregoing related to helping maintain healthy personal immunity which could assist with COVID-19
COV2QUANT	90174743	5: Diagnostic kits comprised of medical diagnostic reagents, specimen collection supplies and assays for testing of bodily fluids for use in detection of the COVID-19 virus; medical diagnostic reagents, specimen collection kits for use in virus testing comprised primarily of swabs for medical purposes, and also including collection tubes, lancets, swabs and collection envelopes for medical purposes; medical diagnostics assays for testing of body fluids; diagnostics testing kits comprised of medical diagnostic reagents and assays for testing body fluids; all of the foregoing related to the detection and diagnosis of COVID-19
COVISIGN	90204803	5: Medical diagnostic reagents and assays for testing of bodily fluids, all of the foregoing in the field of COVID-19 and Coronavirus
COVIDAMINS	90250225	5: Vitamins used for the purpose of boosting immunity against contracting COVID-19
	90356511	10: Medical diagnostic instruments for the analysis of body fluids for the detection of COVID-19.

	90 513658	35: Independent sales representatives in the field of products and services related to combating the COVID-19 virus, namely, personal protective equipment and medical diagnostic kits; Providing marketing services for products and services related to combating the COVID-19 virus, namely, personal protective equipment and medical diagnostic kits.
COVATEST	90523824	5: Diagnostic kits comprised of medical diagnostic reagents and assays for testing of bodily fluids for use in disease detection, namely, infectious disease; Medical diagnostic reagents and assays for testing body fluids for microorganisms; Medical diagnostic reagents and assays for testing of body fluids; Drug testing kits comprised of medical diagnostic reagents and assays for testing body fluids; Drug testing kits comprised of medical diagnostic reagents and assays that test for the presence of infectious diseases; all of the foregoing relating to infectious disease, including COVID -19 10: Diagnostic kits consisting primarily of probes, buffers and reagents for use in microbial testing; Medical diagnostic apparatus for testing DNA and RNA samples; Medical diagnostic apparatus for testing for viruses; Medical diagnostic apparatus for testing DNA and RNA samples; Medical diagnostic apparatus for testing of nucleic acids; all of the foregoing relating to infectious disease, including COVID -19 42: Research and development and consultation related thereto in the field of infectious disease testing; Research and development in the field of infectious disease testing; Research and development of technology in the field of infectious disease testing; Research and development services in the field of antibodies; Research, development, engineering and testing services in the fields of immunopharmaceuticals and vaccines; Scientific research and development; all of the foregoing relating to infectious disease, including COVID -19 44: Medical diagnostic testing, monitoring and reporting services; Medical testing for diagnostic or treatment purposes; Medical testing for diagnostic or treatment purposes in the field of infectious disease; all of the foregoing relating to infectious disease, including COVID -19
COVASSESS	90523844	5: Medical diagnostic reagents and assays for testing body fluids for microorganisms; Medical diagnostic reagents and assays for testing of body fluids; all of the foregoing related to infectious disease, including Covid-19 44: Medical services, namely, the treatment of infectious disease through the use of diagnostic testing to determine key susceptibilities to identified viruses and a course of therapeutics and pharmaceutical preparations in accordance with said susceptibilities; all of the foregoing related infectious disease, including Covid-19
COVSAFE	90565435	10: Diagnostic kits consisting primarily of probes, buffers and reagents for use in microbial testing for detecting Covid-19
COVID KILLER CLEANING	90666535	35: Promoting public awareness of the need for proper cleaning practices to reduce and prevent exposure to Covid-19
COVAB	90668228	5: Medical diagnostic test kits and cartridges all comprised primarily of diagnostic reagents and assays for testing bodily fluids for the

		presence of coronavirus and COVID-19 for use in physician's offices; medical diagnostic test kits and cartridges all comprised primarily of diagnostic reagents and assays for testing bodily fluids for the presence of coronavirus and COVID-19 for home use 44: Providing health information in the field of coronavirus and COVID-19; providing an internet website for medical professionals featuring medical information in the fields of coronavirus and COVID-19 diagnosis, monitoring and treatment
COVID CLEAR	90694433	44: Medical diagnostic testing, monitoring and reporting services, including for Covid-19; Medical testing for diagnostic or treatment purposes for Covid-19.
COVCORONA	90710919	5: Pharmaceutical preparations for the treatment of respiratory, gastrointestinal, and neurological diseases relating to RNA viruses including the covid-19 virus
COVIPOINT	90752378	1: Laboratory chemicals, namely, an antibody reagent used for the detection of Covid-19 antigens in cell and tissue analysis for in vitro diagnostic use; Diagnostic reagents for clinical or medical laboratory use for detecting Covid-19
BEYOND COVID	90831381	5: Antimicrobial preparations for treating various surfaces with copper-based solutions for inhibiting viruses, including Covid 19, bacteria and fungus
COVONALL	97000756	5: Pharmaceutical preparations for the treatment of immune system related diseases and disorders; Pharmaceutical preparations for the treatment of infectious diseases; Pharmaceutical preparations for the treatment of viral diseases; Pharmaceutical preparations for the treatment of viral infections; Pharmaceutical preparations for the treatment of h1n1, pneumonia, coronavirus, covid viruses, MRSA; Pharmaceutical preparations for treating allergic rhinitis and asthma; Pharmaceutical preparations, namely, a drug delivery system comprising polymer-based oral tablets for the continuous release of a wide variety of therapeutic agents; Pharmaceutical preparations, namely, an analgesic for human consumption taken orally; Pharmaceutical preparations, namely, antivirals; Pharmaceutical products for the treatment of infectious diseases; Pharmaceutical products for the treatment of viral and infectious diseases, for the treatment of cancer; Pharmaceutical products for the treatment of viral diseases; Pharmaceutical products for treating respiratory diseases; Pharmaceutical products for treating respiratory diseases and asthma; Plant extracts for medical, veterinary and pharmaceutical purposes
COVI-GO	97043683	10: Medical diagnostic apparatus for testing for viruses including corona (Covid) viruses

Additional examples of marks approved for registration on the Principal Register that incorporate DROPS include the following (see Exhibit B containing third-party status records printed from TSDR and made of record):

Mark	Serial/Reg No.	Class: Goods and Services
CYSTADROPS	5319533	5: Pharmaceutical preparations and medicines known as orphans for treating rare diseases and disorders including certain eye

		diseases or the consequences on sight of certain rare diseases such as cystinosis; sanitary and dietetic products, namely, chemical preparations for sanitary use, disinfectants for sanitary purposes, disinfectants for medical use in connection with the above diseases
ALLERDROPS	3269740	5: Reformulated medicated serums for treatment of allergies.
MINIDROPS	2724080	5: Lubricant Eye Solutions, rewetting eye solutions, and eye lotions
CLEARDROPS	5764946	5: Nutraceuticals for use as a dietary supplement.
SOFTDROP	5835460	5: Drug delivery agents in the form of capsules that facilitate the delivery of pharmaceutical preparations; Medicated lozenges
VITADROPS	90859677	5: Dietary and nutritional supplements
IMMUNODROPS	4987285	5: Allergy relief medication
DIETDROP	4728015	5: Dietary supplements for use in the care and treatment of laboratory research animals and domestic livestock; Nutritional supplements for use in restoring and maintaining the health of laboratory research animals, and use in maintaining and improving the health of domestic livestock
GELDROP	4478732	5: Dietary supplements for use in the care and treatment of laboratory research animals and domestic livestock; Nutritional supplements for use in restoring and maintaining the health of laboratory research animals, and maintaining and improving the health of domestic livestock.

In all of the above instances the word DROP/DROPS was combined with an arguably descriptive word (GEL, SOFT, CLEAR) to create a distinctive mark, capable of registration on the Principal Register. In particular, CYSTADROPS is used for medicines for treating diseases including eye diseases such as cystinosis, and that mark was approved for registration on the Principal Register.

As is the case here, the above COVI-formative and DROPS-formative marks do not directly inform consumers of the goods and services, but allude to them. While Applicant recognizes that the results of prior prosecution files are not binding on the current examining attorney, Applicant respectfully submits that the foregoing provide a good idea of the Office's approach to COVID formative marks and DROPS formative marks in class 5, and why fairness, among other things, requires withdrawal of the descriptiveness refusal. Significantly, all of the foregoing references involve the same pattern of coined marks. All of them, including Applicant's Mark, are inherently distinctive when considered as a whole, as the mere descriptiveness analysis requires. *Earnhardt v Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1379, 123 U.S.P.Q.2d 1411, 1414 (Fed. Cir. 2017). Applicant's Mark is a coined term, which is not just the combination of words as used in the English language, but is instead, distinctively different.

Finally, Applicant submits that the distinctiveness of its coined term will be apparent to consumers, based on Applicant's family of marks, including (see Exhibit C): COVIAMG (Serial No 90207690) COVIMOBILE (Serial No. 90104375), COVIMSC (Serial No. 90377744), and COVIDTRAP (Serial No. 88846389). Since those marks will almost certainly advance to registration, consumers encountering COVIDROPS in the marketplace will automatically recognize the mark as

identifying the same source as the Applicant's allowed marks. For all of the foregoing reasons, Applicant respectfully requests that the merely descriptive refusal to register be withdrawn.

III. DOUBT ON THE ISSUE SHOULD BE RESOLVED IN FAVOR OF APPLICANT

In *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 189 U.S.P.Q. (BNA) 759 (CA 2 1976), the Second Circuit stated that the entire category of "suggestive" marks originated because of the need to accord protection to marks that were neither exactly descriptive nor truly fanciful. The determination of whether or not a mark that is "suggestive" of certain characteristics of goods has reached the requisite threshold of being "merely descriptive" of those characteristics is based upon a very ambiguous and subjective decision process. In *re Gourmet Bakers, Inc.*, 173 U.S.P.Q. (BNA) 565 (TTAB 1972). As such, there exists a large grey area that could easily support numerous differing opinions as to whether a mark is "suggestive" and thus entitled to registration on the Principal Register or whether a mark is "merely descriptive" and not entitled to such registration. The Board has consistently held to the general rule that "there is a thin line between a suggestive and a merely descriptive designation, and where reasonable men may differ, it is the Boards' practice to resolve the doubt in the applicant's favor and publish the mark for opposition. In *re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. (BNA) 791 (TTAB 1981).

The law is clear that any doubt on the question of descriptiveness should be resolved in favor of the Applicant. In *re Pennwalt Corp.*, 173 U.S.P.Q. 317, 318 (TTAB 1972) (DRI-FOOT not merely descriptive of foot antiperspirant).

Because Applicant's Mark crosses over the line between a suggestive and merely descriptive designation, any doubt must be resolved in applicant's favor under the guidelines set forth in *In re Morton-Norwich Products, Inc.*, *supra* 209 U.S.P.Q. (BNA) at 791 and *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and authority cited therein (There is often a thin line separating merely descriptive from suggestive terms and that judgments in these cases are frequently subjective. However, where there is doubt in the matter, the doubt should be resolved in applicant's behalf).

II. CONCLUSION

Based on the reasons set forth herein, Applicant submits that Applicant's Mark is suggestive and is entitled to registration on the Principal Register. Applicant respectfully requests that the merely descriptive refusal be withdrawn.

Respectfully submitted,

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