

**YESCARTA and Design – Serial No. 88351140
RESPONSE TO OFFICE ACTION**

The Examining Attorney has refused Applicant's mark, YESCARTA and Design, Serial No. 88351140, for "providing medical and healthcare information; providing medical information in the field of pharmaceuticals and cell therapy" in class 44 (the "Yescarta Mark") on the basis that "the IC 44 activities recited in the identification of services, when viewed in conjunction with the specimen, are not registrable services as contemplated by the Trademark Act" because they are "performed primarily for the benefit of applicant, as they are activities merely incidental or necessary to an applicant's larger business."

Applicant respectfully submits that Applicant provides medical and healthcare information and medical information in the field of pharmaceuticals and cell therapy for the primary benefit of third parties and that these services are not merely incidental to the Applicant's business, therefore the application should be approved for publication.

Failure to function refusals

TMEP Section 1301.04(g)(ii) states that a failure-to-function refusal should issue if a specimen shows the mark used as something other than a service mark for the identified services; for example, if the specimen shows the mark is "used solely as a trade name, only as the name of a computer software program or application, exclusively as the name of a method, process, or system, or merely as informational or ornamental matter." The Examining Attorney has issued this failure to function refusal on the basis that the services shown in the specimen are performed primarily for the benefit of the applicant, as they are activities merely incidental or necessary to the applicant's business.

As the Examining Attorney notes, the activities set forth as services in an application are reviewed using the following criteria to determine whether they constitute registrable services:

- (1) A service is a real activity, not an idea, concept, process, or system.
- (2) A service is performed primarily for the benefit of someone other than the applicant.
- (3) A service is an activity that is sufficiently separate and qualitatively different from an applicant's principal activity, i.e., it cannot be an activity that is merely incidental or necessary to an applicant's larger business.

"The fact that an activity is ancillary to a principal service or to the sale of goods does not in itself mean that it is not a separately registrable service." TMEP Section 1301.01(A)(iii). The service need only be provided for the benefit of others. *In re Heavenly Creations, Inc.*, 168 USPQ 317, 318 (TTAB1971)(finding that the conducting of parties or demonstrating for groups of women regarding and hair pieces wigs was a separate and registrable service from the sale of its own goods, wigs and hair pieces).

Section 1301.01(a)(ii) clarifies that the "controlling question is who primarily benefits from the activity for which registration is sought." The fact that the Applicant derives an incidental benefit is not fatal. See *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). Examples of where an activity primarily benefits the applicant and are *not* registrable include a contest promoting the applicant's goods, an intranet website solely for internal purposes,

performing research and development in the production of one's goods, or offering shares of one's own stock for investment. See *In re Dr. Pepper Co.*, 836 F.2d 508, 5 USPQ2d 1207 (Fed. Cir. 1987); *City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1676 (TTAB 2013); TMEP 1301.01(a)(ii).

Applicant uses the YESCARTA Mark to provide health and medical information services, separate and apart from its products, for the primary benefit of third parties

Applicant respectfully submits that the specimen that it provided in March 2019 shows use of the Yescarta Mark in connection with medical and health information primarily for the benefit of patients and their families, healthcare providers and others in the general public by providing them with critical information regarding CAR T cell therapy, therefore it is not merely incidental to the applicant's larger business or the sale of its goods.

TMEP 1301.01(b)(v) states that "providing general information or instructions as to the **purpose and uses of applicant's goods** is merely incidental to the sale of goods, not a separate informational service." For example, a paper manufacturer who rates the recycle content and recyclability of its own products is merely providing information regarding its own goods, as opposed to rendering services to others. *In re Moore Business Forms Inc.*, 24 USPQ2d 1638 (TTAB 1992). Similarly, analyzing the needs of customers is not registrable as a consulting service, because it is an ordinary activity that is normally expected of a manufacturer selling goods. *Ex parte Armco Steel Corp.*, 102 USPQ 124 (Comm'r Pats. 1954).

Here, Applicant is providing information about a **general category of treatment called CAR T cell therapy**. CAR T is short for chimeric antigen receptor T cells, and it is a form of immunotherapy that uses specially altered T cells to fight cancer. The specimen shows use of the Yescarta Mark in connection with an explanation of how CAR T works. A sample of the patient's T cells are collected from the blood, then modifying them by adding a chimeric antigen receptor (CAR) gene. Then the CAR T cells are infused back into the patient's body and those cells work to attack cancer cells. In short, CAR T is a type of immunotherapy and a treatment option for patients with certain types of cancer.

CAR T refers to a category of treatment much broader than the YESCARTA pharmaceutical product; it is akin to a website offering information about chemotherapy or other general treatment category, which is also a service separate and apart from offering information about a particular branded product. While the medical information Applicant is providing may be useful to patients who use the YESCARTA pharmaceutical product, it is equally appealing to various other audiences because the information is not merely about the purposes and uses of applicant's goods – it is about a broad category of innovative immunotherapy for certain types of cancer that is also offered by numerous entities other than Applicant.

Potential patients, healthcare providers, friends and family of patients who are seeking treatment, and any others interested in cell therapy technology are all the consumers and primary beneficiaries of Applicant's medical information services. These informational services are distinct and separate from Applicant's cell therapy services because they appeal to a range of consumers much broader than just patients using the YESCARTA product. While the mere advertising of one's own product is not a separate service, Applicant does more than that here; it educates readers about how CAR-T therapy works and this service is rendered in connection with the Yescarta Mark, which appears at the top of its web pages and other materials. Notably, a potential patient could educate themselves about the CAR T process on Applicant's website but choose a different course of treatment altogether. The excerpt provided as a specimen

states “learn how Yescarta® uses CAR T technology,” which further reinforces the point that Applicant offers information about the broad category of CAR T treatment in addition to and apart from its YESCARTA product.

Providing medical information regarding CAR T immunotherapy also does not primarily benefit the Applicant, although it may incidentally benefit the Applicant. A decision on what type of treatment to prescribe is a complex one, and merely coming across Applicant’s website offering information about cell therapy is unlikely to sway a healthcare provider into prescribing a particular regimen. However, there is some chance that a potential patient may read the information on Applicant’s website and ultimately decide, together with their healthcare provider, that the YESCARTA product is right product for them in part because the information has helped the patient understand how CAR T therapy works. This is distinguishable from the examples listed in TMEP 1301.01(b)(v), in which the services offered by the applicants were merely incidental to the sale their goods or served only to provide information regarding their own products.

The Examining Attorney contends that the specimen indicates that the specimen is “merely marketing” for Applicant’s class 5 pharmaceutical and biological preparations, as a “brochure showing safety and background information for applicant’s axicabtagene ciloluecel.” While there is information about the YESCARTA product contained in the specimen, the website is not merely a brochure for the product. The information provided via the website is rendered to all interested in CAR T immunotherapy and not only those interested in prescribing or purchasing the Applicant’s products. For example, someone who learns of Applicant’s CAR T cell therapy technology could share the webpage as a means to educate a friend or a family member as a resource for more information. The fact that some patients using the YESCARTA® product may take advantage of Applicant’s medical information services does not make the Yescarta Mark ineligible for registration. See TMEP Section 1301.01(A)(iii); *In re Heavenly Creations, Inc.*.

Applicant’s specimen is consistent with other, accepted specimen for identical or very similar services

Moreover, Applicant’s specimen for the class 44 services is consistent with the type of specimen that the PTO has accepted for such services for other registrations where an owner applied for the same trademark for pharmaceutical or medical products and the provision of medical services. For example:

- KERICIS, Reg. No. 5795735, for “Providing medical information, consultancy and advisory services; Providing medical assistance to physicians and surgeons performing procedures; Providing medical information, advisory, consultancy and assistance services in the use and applications of the tissue based skin substitutes” – excerpts from Registrant’s [website](#) providing information about wounds and burns where Registrant also provides tissue and skin grafts, wound dressings, and other medical products related to wounds and burns
- ALMIRALL and Design, Reg. No. 4667021 for “providing medical information” – excerpt from Registrant’s [website](#) providing information about disease awareness where the ALMIRALL product is a treatment for migraine and respiratory diseases.
- TRUVADA FOR PREP, Reg. No. 5358262, for “Information and advisory services relating to pharmaceuticals, diseases and medical conditions and treatments, namely, pharmaceutical advice, medical and pharmaceutical consultation, medical advisory services, and providing medical information, consultancy and advisory services; information and advisory services relating to pharmaceuticals, diseases and medical conditions and treatments, namely,

pharmaceutical advice, medical and pharmaceutical consultation, medical advisory services, and providing medical information, consultancy and advisory services provided on-line over a computer network and the Internet; providing medical information and advisory services regarding HIV infection” – [brochure](#) providing information about HIV/AIDS where Registrant also provides pharmaceuticals for the treatment of HIV/AIDS .

- PREVU, Reg. No. 4498680, for “Providing medical information; medical diagnostic testing services; providing on-line medical information; providing on-line medical risk assessment information for cardiovascular disease and coronary artery disease” - excerpt from website discussing atherosclerosis, where the PREVU product is a cholesterol testing device.
- VYVANSE, Reg. No. 3468580, for “Providing medical information in the field of pharmaceutical products and services” – excerpt from [website](#) discussing ADHD where VYVANSE product is a ADHD treatment.

The PTO has recognized that informational services are different from and not merely incidental to the sale of pharmaceutical goods, which is consistent with Applicant’s position that the Yescarta Mark is registrable for medical information services and that consumers perceive it as a source identifier for the same.

Conclusion

For the reasons stated above, Applicant respectfully submits that Applicant does provide medical and healthcare information and medical information in the field of pharmaceuticals and cell therapy for the primary benefit of third parties and that these services are not merely incidental to Applicant’s products, therefore the application should be approved for publication.