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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 Dr. Willmar Schwabe GmbH & Co. KG

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Serial No. 76690276

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Nathaniel D. Kramer of Kirschstein, Israel, Schiffmiller & Pieroni for Dr. Willmar Schwabe GmbH & Co. KG.

Suzanne Blane, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Quinn, Kuhlke and Lykos, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Dr. Willmar Schwabe GmbH & Co. KG filed, on June 5, 2008, an intent-to-use application to register the mark EPs 7630 (in standard character form) for "plant-based pharmaceuticals for the treatment of respiratory diseases, namely, those based on an ethanolic extract of the roots of pelargonium sidoides" in International Class 5.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied

to applicant's goods, so resembles the previously registered marks EP and EP 12.5 ("12.5" disclaimed) (both in typed form), both for "pharmaceutical bronchodilators" in International Class 5,[1] as to be likely to cause confusion. The registrations are owned by the same entity.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

A procedural matter requires our attention before turning to the merits of the appeal. Applicant's brief, including the table of contents, table of cases, description of the record, statement of the issue, statement of facts and argument, comprises forty-five pages. Trademark Rule 2.142(b) provides that without prior leave of the Board, a brief in an ex parte appeal shall not exceed twenty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. Thus, applicant's brief exceeds the page limit by twenty pages.

If an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief

[1] Registration No. 1791247, issued September 7, 1993, renewed, and No. 2217874, issued January 12, 1999, Sections 8 and 15 affidavit accepted and acknowledged, respectively.

will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal of the appeal. *In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (Board refused to consider applicant's 29-page brief). *See generally* TBMP §1203.01 (3d ed. 2011).

Accordingly, applicant's forty-five page appeal brief, that exceeds the page limit by twenty pages, has not been considered in reaching our decision. We have, however, considered applicant's responses to Office actions and applicant's reply brief.[2]

We now turn to the merits of the appeal. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and

[2] It should be noted that virtually all of applicant's arguments were previously made during prosecution, most particularly in applicant's thirty-eight page request for reconsideration. Thus, although immaterial to this procedural issue, we see no undue prejudice to applicant by our decision to not consider the appeal brief. More importantly, all of applicant's evidence was timely introduced during the prosecution of the application.

the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Insofar as the goods are concerned, it is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The question of likelihood of confusion is determined based on the identification of goods in the application vis-à-vis the goods as set forth in the cited registration(s). *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); and *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of

confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Thus, our likelihood of confusion analysis focuses on a comparison between applicant's "plant-based pharmaceuticals for the treatment of respiratory diseases, namely, those based on an ethanolic extract of the roots of pelargonium sidoides" and registrant's "pharmaceutical bronchodilators." The dictionary evidence of record reveals that a "bronchodilator," as listed in the cited registrations, is "a drug that widens the air passages of the lungs and eases breathing by relaxing bronchial smooth muscle." The American Heritage Dictionary of the English Language (4th ed. 2009). The record also shows, as established by the various materials introduced by the examining attorney, that the bronchial muscles are part of the respiratory system, and that respiratory disease includes conditions that affect the lungs and bronchial muscles. Registrant's product is sold over-the-counter for the treatment of common respiratory ailments such as colds and congestion. Applicant's product information on its website indicates that these homeopathic goods are sold over the counter and are used to shorten the duration and reduce the severity of upper respiratory tract infections. The herb featured in applicant's product "has long been

used to treat cough, sore throat, congestion, and other respiratory ailments." The product also loosens phlegm or mucus to make coughs more productive. In sum, although the goods are specifically different, they are related in that both are pharmaceutical products used to treat respiratory conditions.

The examining attorney introduced several use-based third-party registrations, which each cover a number of differing goods, all relating to the treatment of respiratory conditions. More specifically, the registrations cover bronchodilators as well as other products, such as expectorants, used to treat respiratory aliments. Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that various different types of pharmaceutical treatments for respiratory treatments are the kinds of products that may emanate from a single source under a single mark. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd*, 864 F.2d 149 (Fed. Cir. 1988). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The record also includes additional registrations owned by registrant that cover various products other than

pharmaceutical bronchodilators, such as expectorants, used to treat respiratory conditions (albeit these other goods are covered by marks different than the ones cited herein).

So as to be clear, however, not a single registration covers both bronchodilators and the specific type of product identified in the application, that is, plant-based pharmaceuticals for the treatment of respiratory diseases, namely those based on an ethanolic extract of the roots of pelargonium sidoides.

Insofar as channels of trade are concerned, neither applicant's nor registrant's identification of goods includes any limitations with respect thereto. Thus, we must assume that the goods move in the normal channels of trade therefor, including drug stores and pharmacies. *In re Jump Designs LLC*, 80 USPQ2d at 1374. This is buttressed by the examining attorney's evidence in the form of screenshots of retail pharmacy websites showing that bronchodilators and other treatments for respiratory conditions are sold through these outlets.

Further, there are no limitations on the classes of purchasers for applicant's and registrant's goods.[3] We must

[3] Thus, applicant's claims that its goods are sold to medical doctors and other physicians, as well as to pharmacies, and that its goods are not subject to FDA regulations, are of no moment; such limitations are not reflected in the identification of goods.

therefore assume that the goods would be purchased by all potential buyers thereof. Because the goods may be bought over the counter, the classes of consumers would include ordinary ones.

The *du Pont* factors relating to the goods, namely the similarity between the goods, trade channels and classes of consumers, all weigh in favor of a finding of likelihood of confusion.[4]

We next turn to consider the marks. We must compare the marks, applicant's mark EPs 7630 and registrant's marks EP and EP 12.5, in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression

[4] We are entirely unpersuaded by applicant's argument that the goods are different because registrant's product, with ephedrine as an ingredient, may be used as a recreational drug. As we indicated above, our comparison of the goods is made on the basis of the identification of goods in the application vis-à-vis the identification of goods in the cited registration. That registrant's over-the-counter pharmaceutical bronchodilators may be used for purposes other than treating respiratory ailments is immaterial to our likelihood of confusion analysis.

that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

It is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

One of the cited marks, EP 12.5, includes a disclaimer of "12.5".[5] Although we have considered this mark in its entirety, this non-distinctive disclaimed number plays a subordinate role to the "EP" component of this cited mark. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d

[5] The evidence shows that 12.5 is an industry-wide standard dosage (12.5 mg) for ephedrine.

1531, 1533-34 (Fed. Cir. 1997). Registrant's other mark is EP in its entirety. Of the two marks, registrant's EP mark is closest to applicant's mark, and we will focus the likelihood of confusion comparison between registrant's mark EP and applicant's mark.

As for applicant's mark, applicant stated, in response to the examining attorney's inquiry, that neither "EPs" nor "7630" has any significance in the trade. (Response, 3/16/09). Indeed, the record is devoid of any evidence to show that either of the components comprising applicant's mark, "EPs" or "7630" is anything less than inherently distinctive. We recognize that purchasers in general are inclined to focus on the first word or portion in a trademark, especially where the first word is followed by a non-distinct term. *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). With applicant's mark, however, the second portion of the mark, namely "7630" is just as distinctive as the first portion, and just as likely to be mentioned when a consumer calls for the goods.

In further support of the proposition that consumers are more likely to rely on the "EPs" portion of applicant's mark in calling for the goods, the examining attorney introduced evidence to show the common use of numbers in

marks for pharmaceuticals. More specifically, the examining attorney submitted excerpts of various third-party websites and articles retrieved from the NEXIS database, as well as third-party registrations with disclaimers of the numerical components. This evidence shows widespread use of numbers in connection with pharmaceuticals, often conveying information about the products (as in the case of the "12.5" component of registrant's mark), thereby relegating the numbers to a subordinate role in the marks' source-indicating function. In connection with this evidence, the examining attorney argues that consumers do not look to the number portions of trademarks as being distinctive for pharmaceutical products. While we appreciate the examining attorney's point, we reiterate that there is nothing in the record to suggest that the number "7630" in applicant's mark is anything other than arbitrary; this is to be contrasted with many of the examining attorney's examples wherein the numbers have a descriptive significance relative to the goods. Thus, contrary to the examining attorney's contention, we decline to find that applicant's mark is dominated by "EPs."

One of applicant's contentions is that the letters "EP" are, at the very least, highly suggestive, thereby

rendering the cited marks weak. At other times, applicant also asserts that "EP" is the standard abbreviation for "ephedrine" and, thus, is generic or merely descriptive of bronchodilators. Both of these arguments are made in connection with applicant's position that the cited marks are entitled to only a narrow scope of protection.

Applicant submitted excerpts from the website www.all-acronyms.com showing "EP" as an abbreviation for "ephedrine." (Ex. No. 6). The record also includes four third-party websites showing use of "EP" as an abbreviation for "ephedrine." (Ex. Nos. 7-10).

Applicant also introduced third-party registrations showing marks that comprise, in part, the letters "EP" for goods that appear to be used to treat respiratory conditions. Reg. No. 2279311 (Ex. No. 11) covers dietary supplements that, according to the additional information furnished by applicant (Ex. No. 12), are beneficial to the user's lungs. Other third-party registrations also cover dietary supplements, but there is no corroborating evidence that these supplements are used for respiratory system conditions. Reg. No. 3625377 (Ex. No. 21) for the mark EPIONE covers homeopathic pharmaceuticals for treating respiratory system disorders. Reg. No. 3531161 (Ex. No.

22) for the mark EPAX covers dietary supplements that are advertised as enhancing lung function during sports.

In further support of its contentions, applicant introduced several abstracts retrieved from scientific publications. Given that the goods are sold over the counter, relevant purchasers, as indicated above, include ordinary consumers. Thus, the fact that "EP" may be used as a shorthand form of "ephedrine" in highly technical articles in scientific publications is of limited probative value. Further, rather than establishing that "EP" is a commonly used and recognized abbreviation for "ephedrine," it may well be that the use of "EP" in the scientific articles is just a shorthand way for the author to refer to "ephedrine" within the article. There is nothing in the record to indicate that ordinary consumers would be exposed to these highly technical scientific publications.

In sum, we find that the evidence supports a finding that the letters "EP" are, at the very least, highly suggestive of ephedrine-based products such as registrant's product, therby reducing the degree of distinctiveness of registrant's marks. As for applicant's allegation that the cited marks are generic or merely descriptive, we decline to consider this claim. As in the case of applicant's assertion of abandonment (discussed infra), an allegation

that the registered marks are generic or merely descriptive constitutes a collateral attack that will not be entertained in the context of this ex parte appeal.

When we consider the marks in their entireties, as we must, we find that the differences in sound, appearance, meaning and overall commercial impression between applicant's mark EPs 7630 and each of registrant's marks EP and EP 12.5 are sufficient to distinguish the marks. This factor weighs in favor of finding no likelihood of confusion.

One additional point bears mention. Applicant also has suggested that the cited marks essentially are abandoned due to nonuse. To the extent that applicant's allegation constitutes a collateral attack on registrant's registrations, it is impermissible. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in connection with the goods or services identified in the certificate. During ex parte prosecution, including an ex parte appeal, an applicant will not be heard on matters that constitute a collateral attack on the cited

registration (e.g., abandonment). *In re Dixie Restaurants, Inc.*, 41 USPQ2d at 1534; and *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). *See* TMEP §1207.01(d)(iv) (7th ed. 2010). Accordingly, no consideration has been given to applicant's arguments in this regard. The proper manner for applicant to bring the issue of abandonment before the Board is by way of a petition to cancel.

Based on the record before us, we see the likelihood of confusion refusal as amounting to only a speculative, theoretical possibility. The significant differences between the marks, when they are compared in their entireties, and the relative weakness of the common element, convince us that confusion is unlikely to occur in the marketplace. Language by our primary reviewing court is helpful in resolving the likelihood of confusion issue in this case:

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d at 1391 (Fed. Cir. 1992), *citing Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d

1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Decision: The refusal to register is reversed.