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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Breckenridge Pharmaceutical, Inc.

Serial No. 85034402

Dickerson M. Downing of Cromwell & Moring LLP for
Breckenridge Pharmaceutical, Inc.

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Before Bucher, Cataldo and Shaw,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Breckenridge Pharmaceutical, Inc., filed an application to register the mark FERREX in standard characters on the Principal Register for "vitamin and mineral supplements" in International Class 5.¹

¹ Application Serial No. 85034402 was filed on May 10, 2010, based upon applicant's allegation of October 15, 1998 as a date of first use of the mark anywhere and in commerce in connection with the goods.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark so resembles the mark, FERREX 18, in typed or standard characters,² previously registered on the Principal Register for "iron ingredient sold as an integral component of a vitamin supplement" in International Class 5,³ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Applicant and the examining attorney submitted main briefs on the issue under appeal.

Likelihood of Confusion

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, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis two key, though not exclusive, considerations are the similarities between the marks and

² Trademark Rule 2.52(a) was amended in 2003 to refer to "typed drawings" as "standard character" drawings. See Trademark Rule 2.52(a); 37 C.F.R. 2.52(a).

³ Registration No. 2479957 issued on August 21, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Marks

We begin our analysis by looking at the similarities and dissimilarities of the marks in the application and registration when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée 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 that confusion as to the source of the goods offered under the respective marks is likely to result.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. In

re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). See also *Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 a consideration of the marks in their entirety. *In re National Data Corp.*, 224 USPQ at 751.

In comparing the two marks, we note that applicant's mark, FERREX, is subsumed within registrant's FERREX 18 mark. There is no evidence of record to indicate that FERREX or any similar mark is used by anyone else or that the mark may somehow be considered weak in connection with the recited goods in the subject application and cited registration. While it stands to reason that term FERREX may be suggestive in connection with vitamin and mineral supplements or components thereof containing iron, we find

no specific meaning of the term in connection with the identified goods in either the subject application or cited registration. Even allowing for any suggestive nature of the term FERREX, the fact that applicant has incorporated the majority of the registered mark greatly increases the level of similarity between the marks.

With regard to the number 18 in the cited mark, we find that the mere presence of this numerical designation in registrant's FERREX 18 mark is insufficient to create a commercial impression that significantly differs from that of applicant's otherwise identical FERREX mark. First, the number 18 does not contribute as strongly to the visual impact of registrant's mark as does the term FERREX. Second, the examining attorney made of record Internet evidence suggesting that 18 indicates the amount or concentration, in milligrams, of iron contained in registrant's goods.⁴ As a result, we find that FERREX is the dominant portion of registrant's mark and, accordingly, it is entitled to more weight in our analysis. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for

⁴ Dietarysupplements.nlm.nih.gov; and labeldataplus.com.

rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re National Data Corp.*, 224 USPQ at 751.

Taken as a whole, the marks are highly similar in appearance and sound and, to the extent consumers would recognize that the goods identified thereby contain iron, are highly similar in meaning. Based upon the foregoing, we find that, when viewed in their entirety, the marks FERREX 18 and FERREX convey highly similar commercial impressions and are far more similar than they are different. Thus, they are likely to be viewed as variations on each other but nonetheless pointing to a single source.

Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

The Goods

We turn now to our consideration of the identified goods, noting that it is not necessary that the goods at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective goods 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 producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, we find that applicant's "vitamin and mineral supplements" are related to registrant's "iron ingredient sold as an integral component of a vitamin supplement" inasmuch as registrant's goods are a component of goods of a type that include those of applicant. To state the obvious, registrant's iron ingredients may be used as a component of applicant's vitamin and mineral supplements. Thus, the goods appear to be related on the face of their respective identifications thereof.

In addition, applicant's specimen of record as well as the above-noted Internet evidence made of record by the examining attorney indicates that applicant's goods in fact contain iron.⁵ Such evidence serves to demonstrate that applicant's goods are related to those of registrant.

Based upon the evidence made of record by the examining attorney, the specimen of use supplied by

⁵ Labeldataplus.com, *supra*.

applicant, and the identifications of the goods themselves, we find that registrant's goods are related to those provided by applicant.

As a result, this *du Pont* factor also favors a finding of likelihood of confusion.

Channels of Trade

It is settled that in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Because there are no restrictions in either applicant's or registrant's identification of goods as to the channels of trade in which the goods may be encountered, or type or class of customer to which the goods are marketed, both applicant's and registrant's goods must be presumed to move in all normal channels of trade and be available to all classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). While there is no evidence of record regarding the purchasers of applicant's goods, they may be presumed to include any consumers interested in using vitamin and mineral supplements. Similarly, there is no evidence of record regarding the purchasers of registrant's goods. Nonetheless, they presumably would include individuals and entities that compound or manufacture vitamin supplements. Thus, while the trade channels for these goods, as identified, may not be identical or overlapping, they nonetheless would appear to be related. In consequence thereof, this *du Pont* factor is neutral or somewhat favors a finding of likelihood of confusion.

Conditions of Sale

Another *du Pont* factor discussed by applicant is that of the conditions of sale. Applicant asserts that its goods and those of registrant would be purchased only by

careful and sophisticated users. However, even in instances of sales of the respective goods to highly sophisticated purchasers, it is still the case that both applicant's and registrant's goods are of a type which may be used for purposes that are related. Prospective purchasers, therefore, may mistakenly believe that these goods emanate from the same source. In addition, even if some degree of care may be exhibited in making the purchasing decision, the marks FERREX and FERREX 18 are sufficiently similar that even careful and discriminating purchasers are likely to assume that the marks identify goods emanating from a single source. Finally, it is settled that even sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988).

Actual Confusion

The final *du Pont* factor discussed by applicant and the examining attorney is that of the lack of instances of actual confusion. Applicant asserts that the absence of actual confusion for over thirteen years suggests no likelihood of confusion. In addition, applicant submitted declarations from its Director of Sales Administration and Pharmacy/Regulatory Consultant declaring that they have not

experienced any incidences of actual confusion between applicant's and registrant's goods under their respective marks. However, and as pointed out by the examining attorney, it is not necessary to show actual confusion in order to establish likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an *ex parte* proceeding, applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. *See In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984). This is particularly the case inasmuch as the owner of the cited registration is not a party to the proceedings.

In those situations where the Board has recognized the absence of actual confusion as probative in an *ex parte* setting, there existed a "confluence of facts" which together strongly suggested that the absence of confusion was meaningful and should be given probative weight. *See In re Opus One Inc.*, 60 USPQ2d at 1817; and *In re Jeep*

Corp., 222 USPQ at 336-37. There is no evidence that such a "confluence of facts" is present in this case.

Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See *In re Majestic Distilling Co.*, 65 USPQ2d at 1203. See also *In re Kangaroos U.S.A.*, 223 USPQ at 1026-27; and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

In summary, weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, we find that a likelihood of confusion exists. Moreover, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.