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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86506204
Applicant	Gulf Coast Pharmacy, Inc.
Applied for Mark	ELAN FOR HEALTHY PHYSICAL & MENTAL ENERGY
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:) Law Office 115
)
 Gulf Coast Pharmacy Inc.) Examining Attorney:
) Alison P. Schrody
)
 Serial No.: 86/506,204)
)
 Filed: January 16, 2015)
)



Mark:)

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

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Cases:

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In re W.W. Henry Co., 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007)

In re Tomberlin Prod. Group, LLC, Serial No. 78734308 (T.T.A.B. November 30, 2007)

In re The Orvis Co., Inc., Serial No. 78276739 (T.T.A.B. October 22, 2007)

Statutes & Regulations:

Trademark Act Section 2(d), 15 U.S.C. § 1052(d)

PROSECUTION HISTORY

On April 28, 2015 the Examining Attorney issued a Non-Final Office Action (the “First Office Action”), refusing registration under Trademark Act §2(d) on the ground that Applicant’s Mark is likely to be confused with five registered marks owned by Elan Corp. (see page 5, *infra*)

On June 12, 2015, Applicant submitted a response (the “OAR”), in which Applicant offered arguments against the refusal to register the mark under Trademark Act §2(d).

On July 27, 2015, the Examining Attorney issued a Final Office Action regarding the refusal under Trademark Act §2(d).

On August 3, 2015, Applicant filed a Notice of Appeal with the Board.

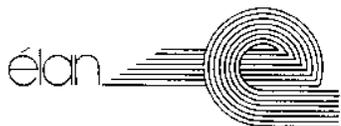
THE REFUSAL

Applicant, Gulf Coast Pharmacy, by Counsel, hereby appeals the Examining



Attorney's refusal to register Applicant's mark in

Application Serial No. 86/506,204 ("Applicant's Mark"). The Examining Attorney has refused registration pursuant to Trademark Act 2(d), 15 U.S.C. § 1052(d), on the grounds that Applicant's mark for use in connection with "dietary and nutritional supplements" in Class 5 is likely to be confused with the following marks, all owned by Elan Corp. of Dublin, Ireland:



(U.S. Reg. No. 1,645,769) for "FULL LINE OF PHARMACEUTICAL IN THE NATURE OF ANTISPASMODICS AND ANTI-ULCERANTS, ANTI-DIARRHOEALS, COLORECTAL AGENTS, CARDIAC DRUGS, DRUGS FOR THE TREATMENT OF DISORDERS OF THE CENTRAL NERVOUS SYSTEM, CNS STIMULANTS, ANALGESICS, ANTIPYRETICS AND ANTI-INFLAMMATORY AGENTS, MUSCLE RELAXANTS, STEROIDAL PREPARATIONS, DRUGS AFFECTING THE GENITO-URINARY SYSTEM, ANTI-INFECTIVES, AND IMMUNOLOGICAL AGENTS, ANTI-ALLERGIC DRUGS PHARMACEUTICAL PREPARATIONS FOR THE TREATMENT OF DERMATOLOGICAL DISORDERS"



(U.S. Reg. No. 2,982,548) for "house mark for a full line of

pharmaceutical products and substances”



(U.S. Reg. No. 3,579,986) for “Manufacturing pharmaceutical products for others” in Class 40 and “Medical research; research and development of new technology for others in the fields of medicine, pharmaceuticals, consulting services in the field of drug delivery and biotechnology; drug delivery, biotechnology and pharmaceutical drug development; engineering services in the fields of medicine, pharmaceuticals, drug delivery and biotechnology; pharmaceutical drug development services” in Class 42

ELAN DRUG TECHNOLOGIES (U.S. Reg. No. 3,739,931) for “Manufacturing pharmaceutical products for others” in Class 40 and “Pharmaceutical drug development services; pharmaceutical research and development; consultation services in the field of drug delivery technology and pharmaceutical drug development” in Class 42



(U.S. Reg. No. 3,739,934) for “Manufacturing pharmaceutical products for others” in Class 40 and “Pharmaceutical drug development services; pharmaceutical research and development; consultation services in the field of drug delivery technology and pharmaceutical drug development” in Class 42

ARGUMENT

I. The Cited Service Marks - THE GOODS AND SERVICES ARE NOT RELATED

With respect to the cited registrations that are solely in Class 40 and 42, the different consumers and associated distinct and separate channels of trade - the general consuming public for Applicant's dietary and nutritional supplements on the one hand, and pharmaceutical manufacturers and companies in need of r&d services on the other hand, guarantees that there cannot possibly be any likelihood of confusion with respect to the use of these marks. Even if, solely for the sake of argument, it could be shown that these goods and services may emanate from a single source, if no consumers would encounter both Applicant's Mark and the cited registrations, there can be no confusion. See *In re Bentley Motors Ltd.* Serial No. 85325994 (December 3, 2013) ("In a particular case, any of the du Pont factors may play a dominant role. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In fact, in some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("we know of no reason why, in a particular case, a single du Pont factor may not be dispositive"). In the present case, the lack of evidence showing an overlap in the channels of trade for Applicant's product and that of the Cited Mark is pivotal. See, e.g., *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1324 (TTAB 2010) ("There is nothing in this record to show that a normal channel of trade for dietary and nutritional supplements is that they are sold to the companies that would purchase applicant's identified goods"). Because we find that the amendment to restrict

applicant's channel of trade means there is virtually no opportunity for confusion to arise, we need not consider the other du Pont factors discussed by the examining attorney and applicant").

II. The Cited Trademarks – THE GOODS ARE NOT RELATED AND THE MARKS ARE NOT SIMILAR

With respect to U.S. Reg. No. 1,645,769 and U.S. Reg. No. 2,982,548 for, respectively, “a full line” of pharmaceutical products and “a house mark” for a “full line of pharmaceutical products”, the evidence presented by the Examining Attorney fails to prove that these products are related to “dietary and nutritional supplements”. The evidence offered by the examining attorney comprises nineteen third-party trademark registrations, each purportedly containing both pharmaceuticals and dietary supplements. Such registrations always have limited probative value. *In re Mucky Duck Mustard Co. Inc.*, 6 U.S.P.Q.2d 1467, 1470 n.6 (T.T.A.B. 1988) (“Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have *some probative value* to the extent that they *may serve to suggest* that such goods or services are of a type which may emanate from a single source.”) (emphasis added).

The TTAB has held that certain registrations are inadmissible for the purpose of showing the relatedness of goods contained therein. They are as follows:

- i) Registrations that do not actually include the goods at issue. If the third-party registrations do not include both the applicant's specific goods and the specific goods in the cited registration, the third-party registrations may have little or no probative value. *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007).

- ii) Registrations for house marks or that cover a wide range of goods. *In re Gebhard*, Serial No. 78950320 (T.T.A.B. March 26, 2009) (“We have given no weight to those third-party registrations for marks which are in the nature of house marks, designer marks and merchandising marks, as it is well-recognized that such marks may be used for a wide variety of items, and therefore they are of little value in showing that the goods for which they are registered are all related.”); *In re Tomberlin Prod. Group, LLC*, Serial No. 78734308 (T.T.A.B. November 30, 2007) (“we do not give further consideration to those registrations submitted by the examining attorney that . . . include a ‘laundry list’ of goods and services”); *In re The Orvis Co., Inc.*, Serial No. 78276739 (T.T.A.B. October 22, 2007) (“we find that the vast majority of [the examining attorney’s third party] registrations are analogous to house marks because the identifications of goods encompass a broad range of clothing, accessory and sporting goods products. Therefore, the inclusion of fishing vests, swimwear and/or leotards in the identifications of goods is not particularly significant.”)

Upon close examination of all of these nineteen registrations, it can be seen that seventeen fall into one of these two categories as follows:

Those that do not show *both* dietary supplements and pharmaceuticals:

- DELAVAU
- TCT
- S (ingredients and additives only)
- M MARTEK (no pharmaceuticals)
- KERAFAST (no nutritional supplements)
- REGENEXX (no pharmaceuticals)
- HENRY THAYER M.D (no pharmaceuticals)
- LIFEVANTAGE (no pharmaceuticals, only anti-oxidants and nutraceuticals)

- LITE BURN (no pharmaceuticals)

House marks (based on the trademark being the same as the name of the company):

- The Compounding Shop (compounding pharmacies create “custom” medications so this cannot be evidence that pharmaceuticals and dietary supplements sold in their normal channels of trade are related)
- ATHERONOVA
- VIVAKEM
- MARCO PHARMA
- BAYER
- MACPHERSEN
- EUROVITAL
- MTN OPS

The only remaining third party registrations are thus CLINICAL STRENGTH HYDRATION and NOVIRIN. The Board has made it very clear that third party registration evidence that includes only a few trademarks is not probative. Two registrations are insufficient evidence. See *In re RAM Oil, Ltd., LLP*, Serial Nos. 77280977 and 77280981 (TTAB September 3, 2009). Finally both of these two marks are quite different from Applicant's mark in terms of appearance, sound and meaning. The '769 mark contains a prominent stylized lower case "e" along with the lower case word "elan", where the letters in the word "elan" are so close together that it appears as close to "elon" as it does to "elan". Applicant's Mark has a very different stylized font and a capital "E" with an arrow incorporated into it. Furthermore, it includes the words "for Healthy Physical & Mental Energy" which are words one would expect to see used for supplements as opposed to pharmaceuticals. The '548 mark is simply the word "elan" in lower case italicized letters with a very thick and prominent accent mark above the "e". According to Merriam-Webster (of which the Board can take judicial notice) the definition of "elan" is "*energy and enthusiasm*". Thus it has a highly suggestive meaning in relation to Applicant's supplements that, as the mark itself states, are used to increase physical and mental *energy*. For this reason it is not at all likely that consumers would confuse Applicant's Mark with the mark "elan" used as a house mark for pharmaceuticals but instead merely understand that it is used to suggest a feature of Applicant's supplements.

III. The “Rule” Concerning Pharmaceutical Marks is Inapplicable

The examining attorney has argued that the bar for likelihood of confusion is lower with respect to pharmaceutical marks, for public safety reasons. However, that rule is inapplicable where Applicant’s products are merely dietary and nutritional supplements. The rule to which the Examining Attorney refers pertains only to the use of similar marks on different pharmaceutical products. It is simply not possible for a pharmacist to dispense a supplement sold over the counter when filling a prescription for a pharmaceutical product that happens to come from a company¹ with an arguably similar name as the supplement.

Dated this 3rd day of August, 2015.

Respectfully submitted,

/gb/

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¹ The cited trademarks are both house marks, not the name of the pharmaceutical itself