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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86506204

MARK: ELAN FOR HEALTHY PHYSICAL & MENTAL

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: Gulf Coast Pharmacy, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Gulf Coast Pharmacy, Inc., has appealed the examining attorney's final refusal to register its proposed mark pursuant to Section 2(d) of the Trademark Act Section 2(d), 15 U.S.C.

§1052(d), on the basis of a likelihood of confusion with the marks in U.S. Registration Nos. 1645769, 2982548, 3579986, 3739931 and 3739934.

I. FACTS

On January 16, 2015, applicant applied to register the mark "ÉLAN FOR HEALTHY PHYSICAL & MENTAL ENERGY" for dietary and nutritional supplements in International Class 5. The examining attorney refused registration on April 28, 2015 on the basis of a likelihood of confusion with the marks in commonly-owned Registration Nos. 1645769 ("ÉLAN E"), 2982548 ("ÉLAN"), 3579986 ("ÉLAN"), 3739931 ("ELAN DRUG TECHNOLOGIES") and 3739934 ("ÉLAN ELAN DRUG TECHNOLOGIES") for goods and services including a full line of pharmaceutical preparations, manufacturing of pharmaceuticals, pharmaceutical drug development services, pharmaceutical research and development, consultation services in the field of drug delivery technology and pharmaceutical drug development, medical research, research and development of new technology for others in the field of medicine and pharmaceuticals, consulting services in in the field of biotechnology, and engineering services in the fields of medicine, pharmaceuticals, drug delivery and biotechnology. Applicant has disclaimed the wording "PHYSICAL & MENTAL ENERGY." This appeal follows the examining attorney's final refusal dated July 27, 2015.

II. ARGUMENT

A. The Dominant Portions of the Marks are Identical or Nearly Identical

Applicant's mark "ÉLAN FOR HEALTHY PHYSICAL & MENTAL ENERGY" and the registrant's marks "ÉLAN E," "ÉLAN," "ELAN DRUG TECHNOLOGIES," and "ÉLAN ELAN DRUG TECHNOLOGIES" share the identical, or nearly identical, first terms "ÉLAN" or "ELAN." The term "ELAN" differs from the term "ÉLAN" only in that it omits the accent above the letter "E," and as discussed in depth below, the

absence or presence of the accent is immaterial given that both terms share the same meaning. Thus, the marks are highly similar in overall sound, appearance and commercial impression.

As noted, the terms "ÉLAN" or "ELAN" appear first in all of the marks. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

What's more, some of the marks contain descriptive wording that has been disclaimed, particularly "DRUG TECHNOLOGIES" in the registrant's marks and "PHYSICAL & MENTAL ENERGY" in applicant's mark. Disclaimed matter that is descriptive of or generic for a party's goods or services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Lastly, the fact that some of the marks are stylized and/or include design elements would not obviate a likelihood of confusion. For composite marks containing both words and a design, the word portions may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

B. <u>The Marks Share Similar Commercial Impressions</u>

In addition to sharing a similar overall appearance and sound, the marks also share similar commercial impressions. The examining attorney notes the term "ELAN" (also élan) is defined as energy, style and enthusiasm.[1] Thus, whether the term is spelled with the accent or without, all of the marks share similar commercial impressions by using the dominant terms "ÉLAN" or "ELAN," which suggest energy, style and enthusiasm.

Particularly of note is the fact that applicant's mark includes the term "ENERGY," which reinforces this particular meaning of the term "ÉLAN." Thus, although the term élan is of French origin, applicant's voluntary translation statement indicating the term "ÉLAN" is defined as "run up" appears to be inaccurate and unnecessary, since the term in both of its spellings appears in an English language

[1] The Examining Attorney requests that the Board take judicial notice of the attached dictionary definition of the term "elan" from *Oxford Dictionaries* (Oxford University Press, 2015). The Board may take judicial notice of dictionaries and standard reference works. TBMB §1208.04.

dictionary. The examining attorney notes that it is generally unnecessary to provide a translation of a foreign term if the term appears in an English dictionary (e.g., croissant, fiesta or flambé). *See* TMEP §809.01(b)(1).

In sum, the test when comparing marks is not whether the marks can be distinguished in 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 and services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b). Here, consumers would not likely notice or recall the minor differences between the marks "ÉLAN FOR HEALTHY PHYSICAL & MENTAL ENERGY," "ÉLAN E," "ÉLAN," "ELAN DRUG TECHNOLOGIES," and "ÉLAN ELAN DRUG TECHNOLOGIES," especially when the goods and services are very closely related.

C. <u>The Goods and Services are Closely Related</u>

In such as case as this one where the marks are highly similar, the relationship between the relevant goods and services need not be as close to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); TMEP §1207.01(a).

Additionally, the Trademark Trial and Appeal Board and its primary reviewing court have used a stricter standard to determine likelihood of confusion for pharmaceuticals or medicinal products due to

the potential harm or serious consequences that could be caused if the public confused one drug or medicinal product for another. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386-87, 173 USPQ 19, 21-22 (C.C.P.A. 1972); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB 1980); *Ethicon, Inc. v. Am. Cyanamid Co.*, 192 USPQ 647, 651-52 (TTAB 1976); TMEP §1207.01(d)(xii). Although physicians and pharmacists are no doubt carefully trained to recognize differences in the characteristics of pharmaceuticals or medicinal products, they are not immune from mistaking similar trademarks used on these goods. *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1305-06 (TTAB 2004); *Blansett Pharmacal Co. v. Carmrick Labs., Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); *Schering Corp.*, 207 USPQ at 509. Thus, in this case where confusion could result in harm or other serious consequences to consumers, this potential harm is considered an additional relevant factor and a lesser degree of proof may be sufficient to establish a likelihood of confusion. *See Glenwood Labs., Inc.*, 455 F.2d at 1386-87, 173 USPQ at 21-22; *Schering Corp.*, 207 USPQ at 509; *Ethicon, Inc.*, 192 USPQ at 651-52; TMEP §1207.01(d)(xii).

Last, the examining attorney notes that the goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i). The respective goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

i. The Goods and Services Commonly Emanate from a Single Source

In this case, the evidence shows the goods and services are closely related because they commonly emanate from the same sources under the same marks. Applicant provides dietary and nutritional supplements, and registrant provides a full line of pharmaceutical preparations and services pertaining to pharmaceuticals, including manufacturing, drug development, research and development, medical research, engineering and various pharmaceutical-related consulting services.

Companies that provide pharmaceutical preparations and/or pharmaceutical-related services commonly provide dietary and nutritional supplements under the same mark. In support of this, please see the evidence consisting of third-party e-commerce websites from companies that develop, manufacture and provide both pharmaceuticals and dietary and nutritional supplements. Evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods and services are related. *See, e.g.*, *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

These examples are attached to the examining attorney's July 27, 2015, final Office action. Highlights of this evidence include the following examples:

- **Contract Pharmacal Corp.**, a company that develops and manufactures pharmaceuticals, over-the-counter drugs, and dietary supplements (http://cpc.com/products/ at pp. 15-16 of the July 27, 2015 final Office action);

- **Gemini Pharmaceuticals**, a contract manufacturer and developer of over-the-counter drugs and vitamin and nutritional products (http://geminipharm.com/contract-manufacturing/nutritionals/ at pp. 17-20 of the July 27, 2015 final Office action);

- **PureTek Corporation**, a manufacturer and developer of pharmaceuticals, over-the-counter remedies, and nutritional supplements (http://www.puretekcorp.com/ at pp. 26-27 of the July 27, 2015 final Office action); and

- **Hikma**, a manufacturer and developer of pharmaceuticals in the nature of anesthetics, anti-histamines, anti-infectives, etc., as well as vitamins and nutritional supplements (http://hikma.com/products/vitamins-and-supplements.aspx at pp. 28-29 of the July 27, 2015 final Office action).

The examining attorney further provided evidence from the USPTO's X-Search database consisting of a representative sample of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. Some examples attached to the April 28, 2015 Office action include:

- **DELAVU**, Registration No. 2447614 for "dietary supplements" and "manufacturing of pharmaceutical products to the order and specification of others";

- **M MARTEK**, Registration No. 2910457 for "nutritional supplements" and "biotechnology research and development services";

- **ATHERONOVA**, Registration No. 4173752 for nutritional supplements, pharmaceutical preparations, and medical research services;

- **BAYER**, Registration No. 4651390 for "vitamin and mineral supplements" and "a full line of pharmaceutical preparations";

- **MACPHERSAN,** Registration No. 4652437 for dietary supplements, medicines and pharmaceutical preparations; and

- **EUROVITAL**, Registration No. 4719697 for dietary and nutritional supplements and various pharmaceutical preparations.

Last, the examining attorney provided evidence consisting of an online article titled *Pharmaceuticals & Dietary Supplements Converge* from an informational website about nutraceuticals (http://nutraceuticalsworld.com/issues/2013-09/view_columns/pharmaceuticals-dietary-supplements-converge/ at pp. 2-14 of the July 27, 2015 Office action). This article, dated September 9, 2013, explains that "'Big Pharma' and consumer packaged goods (CPG) companies are buying their way into the supplement space," largely because "the supplement consumer base has grown to reflect more mainstream behaviors and attitudes," with "physicians and other health care practitioners [being] more

willing to recommend and even dispense supplements to their patients (*Id.*, at pp. 2-3 of the July 27, 2015 Office action).

The article further discusses examples of 'Big Pharma' and supplement companies merging both in the United States and abroad, stating, "Big Pharma is once again aggressively moving into the dietary supplement space. P&G acquired New Chapter and Pfizer acquired Alacer Corp., the maker of Emergen-C. The British consumer company Reckitt Benckiser topped Bayer in a bidding war for Schiff Nutrition….Looking beyond the U.S. dietary supplement market, Pfizer bought Ferrosan Consumer Health, a Danish company that markets supplements in the emerging markets of Russia and Eastern Europe" (*Id.*, at p. 3 of the July 27, 2015 Office action). This article plainly outlines a recent trend in the pharmaceutical and nutritional supplement industries—namely, that pharmaceuticals, nutritional supplements, and pharmaceutical-related services more and more commonly share a single source.

In sum, the examining attorney has provided ample evidence from a range of sources that shows that dietary and nutritional supplements and pharmaceutical preparations, as well as dietary and nutritional supplements and services such as pharmaceutical manufacturing, pharmaceutical research and development, medical research, biotechnology research and development services, etc., commonly emanate from the same sources under the same marks. As such, applicant's unsupported assertion that it would be difficult to show "that these goods and services may emanate from a single source" (Applicant's Brief at p. 7) is unconvincing.

ii. <u>Pharmaceuticals and Supplements Share the Same Trade Channels</u>

Two of the cited registrations, Registration Numbers 1645769 and 2982548, are for a "full line of pharmaceutical[s]." Pharmaceutical preparations and dietary and nutritional supplements are closely related because they are commonly sold alongside one another in the same channels of trade, such as at pharmacies or drugstores. While at a drugstore, it is not uncommon to find an aisle filled with over-the-

counter medications such as antihistamines or analgesics right next to an aisle filled with dietary and nutritional supplements, such as vitamin C or glucosamine chondroitin.

In support of this, the examining attorney has attached pages from the websites of several nationwide pharmacy chains, including CVS Pharmacy®, Walgreens®, Rite Aid Pharmacy® and drugstore.com® (at pp. 73-102 of the April 28, 2015 Office action). This evidence shows that consumers can browse and purchase prescription pharmaceuticals, over-the-counter medications, and dietary and nutritional supplements all at the same retail locations, whether visiting online or brick-and-mortar drugstores. Thus, applicant's statement that the examining attorney's refusal lacks "evidence showing an overlap in the channels of trade for Applicant's product and that of the Cited" (Applicant's Brief at p. 7) is without merit.

Moreover, the examining attorney notes the wording "full line of pharmaceutical[s]" in the registrant's identifications and the wording "dietary and nutritional supplements" in applicant's identification do not specify the conditions or diseases for which these products are intended to treat. Thus, it must be assumed that both applicant and registrant could be offering medicinal goods used to treat the same or very closely related conditions. Also, registrant's identification is broad enough to cover both prescription and over-the-counter pharmaceuticals. Unrestricted and broad identifications are presumed to encompass all goods of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

For example, were a consumer to visit a drugstore and see a bottle of over-the-counter medication labeled "ÉLAN" for treating arthritis pain in one aisle, and a bottle of supplements labeled "ÉLAN FOR HEALTHY PHYSICAL & MENTAL ENERGY" used to improve joint health and treat arthritis pain in the next aisle, it is highly unrealistic to expect that such a consumer would be immune to source-confusion. This

hypothetical example highlights why a stricter standard is used to determine a likelihood of confusion for pharmaceuticals or medicinal products, namely, due to the potential harm or serious consequences that could result if the public confused one drug or medicinal product for another. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386-87, 173 USPQ 19, 21-22 (C.C.P.A. 1972); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB 1980); *Ethicon, Inc. v. Am. Cyanamid Co.*, 192 USPQ 647, 651-52 (TTAB 1976); TMEP §1207.01(d)(xii). As such, applicant's assertion that the stricter standard applied to pharmaceuticals and medicinal products is inapplicable in this case because its goods are "merely dietary and nutritional supplements" is unsound (Applicant's Brief at p. 13). Dietary and nutritional supplements fall under the plain meaning of the term "medicinal products."

D. Applicant's Additional Arguments Fall Short

Applicant's brief largely focuses on perceived flaws in the examining attorney's evidence comprising third-party registrations from the USPTO's X-Search database. This line of attack is inapposite for several reasons. First, applicant has never addressed the examining attorney's corroborating evidence consisting of websites from companies that provide both pharmaceuticals, supplements, and related services, websites showing that pharmaceuticals and supplements share the same trade channels, or the article about the convergence of the pharmaceutical and supplement markets.

Secondly, applicant's assertion that all but two of the nineteen third-party registrations are "inadmissible" because they purportedly 1) do not include the goods/services at issue and/or 2) are for house marks, is simply false (Applicant's Brief at pp. 8-12). By including these particular third-party registrations, the examining attorney has successfully shown that makers of nutritional supplements commonly also make pharmaceuticals, and that makers of nutritional supplements commonly also provide pharmaceutical-related services, such as medical research, manufacturing and development of

pharmaceuticals, biotechnology research, etc. It was not necessary for the examining attorney to include only third-party registrations showing *all* of the goods and services that both applicant and registrant provide to show the relatedness of the parties' goods and services.

Finally, registrant's mark "ÉLAN" is a house mark for pharmaceuticals. Discrediting other marks such as "BAYER," "MACPHERSAN" or "EUROVITAL" for also being house marks seems unfitting in this case, especially when these registrations include only Class 5 goods and pharmaceutical-related services in Classes 40, 42, etc., and not vast arrays of unrelated goods and services. Although third-party registrations are entitled to little weight on the question of likelihood of confusion, these registrations should not be dismissed out of hand as inadmissible. When viewed alongside the examiner's other evidence, these registrations help support the fact that the goods and services of the parties are extremely closely related.

III. CONCLUSION

The marks at issue are highly similar and the evidence supports that the goods and services are very closely related, resulting in a likelihood of confusion. The examining attorney therefore respectfully requests that the refusal to register pursuant to Section 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

/Allison P. Schrody/

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Syllabification: e-lan

Pronunciation: /ā'län/ /ā'lan/

(also **élan**)

Definition of *elan* in English:

noun

Energy, style, and enthusiasm:

'a rousing march, played with great elan'

MORE EXAMPLE SENTENCES

SYNONYMS

Origin

Mid 19th century: from French *élan*, from *élancer* 'to dart', from *é-* 'out' + *lancer* 'to throw'.

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