Oral Hearing: January 12, 2022 Mailed: March 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alembic Pharmaceuticals, Inc.

Serial No. 88660548

Albert H. Manwaring, IV and Kirsten Zeberkiewicz of MORRIS JAMES LLP,
for Alembic Pharmaceuticals, Inc.

Chioma (Bata) Oputa, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

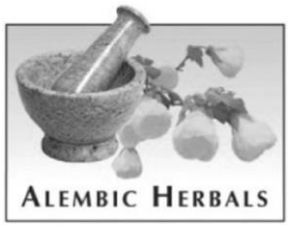
Before Shaw, Greenbaum and Dunn,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Alembic Pharmaceuticals, Inc. ("Applicant") has filed an application for registration on the Principal Register of the standard character mark ALEMBIC for:

> Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations, for the treatment of allergic conjunctivitis, Alzheimer's disease, anxiety, bacterial infections, depression, epilepsy, infection, inflammation and allergies, ulcers, bacterial conjunctivitis, bipolar disorder, bronchoconstriction,

> erectile dysfunction, fungal infection, glaucoma, herpes, hypercholesterolemia, hypertension, hyperuricemia, hypoparathyroidism, influenza A and B, Parkinson's disease/syndrome, insomnia, intraocular pressure, paralysis, amnesia, unconsciousness, high cholesterol, neuropathic pain, arthritic pain and inflammation, ocular infections, overactive bladder, postoperative inflammation, ocular pain, cough, inflammatory and pruritic manifestations, rheumatoid arthritis, seizure, panic disorder, sleep disorder, transfusional iron overload, and moderate to severe scalp psoriasis; all of the foregoing prescribed by a licensed medical doctor with the prescriptions filled by a retail pharmacy licensed to sell prescription drugs, in International Class 5.[1]

The Examining Attorney issued a final refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), claiming that Applicant's mark is likely to cause confusion with the registered mark ALEMBIC HERBALS and design, displayed as 

, on the Principal Register for a variety of goods and services, including:

> Medicines for human purposes for strengthening the immune system and restoring normal bodily functions, the treatment, mitigation and prevention of diseases and disorders, namely, digestive diseases and disorders, central nervous system diseases and disorders, namely, brain diseases, movement disorders, ocular motility, respiratory diseases and disorders, excretory diseases and disorders, cardiovascular diseases and disorders, reproductive diseases and disorders, endocrinal diseases and disorders, immunological diseases and disorders,

[1] Application Serial No. 88660548 was filed on October 18, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use in commerce and anywhere as early as January 1, 1907.

> namely, autoimmune diseases, immunologic deficiency syndrome, hepatitis, dermatological diseases and disorders, skeletal diseases and disorders, namely, bone diseases, back pain, muscular diseases and disorders, namely, muscular dystrophy, inflammatory muscle diseases, sensory diseases and disorders, namely, blindness, in International Class 5.[2]

The cited mark's description reads: "The mark consists of a rectangle containing an image of a morter [sic] and pestle, with a flowering herbal plant to the right and the words 'ALEMBIC HERBALS' in capitalized letters underneath." The term HERBALS and the pictorial representation of the mortar, pestle, and flowering herbal plant are disclaimed apart from the mark as shown. The term "alembic" is defined as "an apparatus of glass or metal, like a retort, formerly used for distilling."[3]

After the refusal was made final, Applicant appealed and requested reconsideration, which was denied. The case is fully briefed.[4] We affirm the refusal to register.

---

[2] Registration No. 5683081, issued on February 26, 2019.

[3] Https://www.collinsdictionary.com/us/dictionary/english/alembic, accessed March 7, 2022. We take judicial notice of this definition. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). We note that this definition is derived from the American, and not the British, version of the Collins Dictionary. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1592 n.4 (TTAB 2018) ("We note that Collins Dictionary offers a British and an American version. This entry by the Examining Attorney is from the British version, which does not necessarily evidence perceptions of the term by consumers in the United States.").

[4] Applicant attached exhibits to its appeal brief. The exhibits were previously submitted with its June 30, 2020 Response and should not have been submitted with Applicant's brief. *ITC Entm't Grp. Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) ("*DuPont*"); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider each *DuPont* factor that is relevant or for which there is argument and evidence of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). "Not all of the [*DuPont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

a. Similarity of the Goods, Trade Channels and Classes of Purchasers

We evaluate the relatedness of the respective goods based on their identifications in the subject application and cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *see also*

Octocom Sys. Inc. v. Hous. Comput. Servs. 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.").

Applicant's identification of goods lists a variety of "Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations . . . filled by a retail pharmacy licensed to sell prescription drugs." Registrant's identification of goods also includes a variety of "medicines for human purposes for strengthening the immune system and restoring normal bodily functions, the treatment, mitigation and prevention of diseases and disorders." The respective identifications both include medicines for treating a similar range of illnesses. For example, Applicant's drugs treat Alzheimer's disease, inflammation, bronchoconstriction, erectile dysfunction, arthritic pain, and scalp psoriasis. These illnesses are similar to, if not the same, as those treated by Registrant's medicines, namely brain diseases, respiratory diseases and disorders, reproductive diseases and disorders, dermatological diseases and disorders, back pain, and inflammatory muscle diseases.

We find that Applicant's and Registrant's goods are in-part legally identical inasmuch as Registrant's broadly-worded "medicines for human purposes for . . . the

treatment, mitigation and prevention of diseases and disorders" could include Applicant's more specialized "generic prescription drugs, approved by the U.S. Food and Drug Administration . . . filled by a retail pharmacy licensed to sell prescription drugs," given that the goods are for treating similar illnesses.[5] *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of goods necessarily encompasses Registrant's narrowly identified goods").

Applicant nevertheless argues that the respective goods are different because:

> Registrant's so-called medicines are not generally accepted in the licensed medical community to treat diseases and conditions, for which the FDA has approved the Applicant's drug for treatment. Hence, the Applicant's prescription pharmaceutical products are not "competitive" with the Registrant's herbal products that are not generally accepted in the licensed medical community "to diagnose, treat, cure or prevent any disease."[6]

This argument is unpersuasive. The cited registration does not limit Registrant's medicines to "herbal products sold over the counter without a prescription, "not accepted in the licensed medical community" or "not FDA approved." Accordingly, we must assume that Registrant's medicines include all "medicines for human purposes for . . . the treatment, mitigation and prevention of diseases and disorders," including

[5] The terms "drug" and "medicine" are synonymous. A "drug" is defined as "a substance used as a medication or in the preparation of medication." Https://www.merriam-webster.com/dictionary/drug, accessed March 7, 2022. We take judicial notice of this definition as well.

[6] Applicant's Br., p. 14, 4 TTABVUE 15.

ones, such as Applicant's, that are generally accepted in the licensed medical community or FDA approved.

We cannot assume, as Applicant urges, that the goods "are distinct and travel in separate trade channels."[7] Rather, we must look to the registration and application, and not to extrinsic evidence about Registrant's and Applicant's actual goods, customers, or channels of trade. *See Stone Lion*, 110 USPQ2d at 1162 ("It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions . . . ."); *Octocom*, 16 USPQ2d at 1787; *In re Embiid*, 2021 USPQ2d 577, at *28 (TTAB 2021) ("[W]e may not import restrictions into the identification[s] based on alleged 'real world conditions' of the sort argued by Applicant, or consider extrinsic evidence regarding Applicant and Registrant themselves.") (internal citation omitted).

Regarding classes of consumers and channels of trade, Applicant argues further that "the relevant consumers for Applicant's products are drug wholesalers, retail chain drug stores, and pharmacists, whereas Registrant's consumers are ordinary consumers. Applicant's goods are only available behind a prescription counter where Registrant's goods are not found."[8] This argument is unpersuasive as well.

Because the goods described in the application and the cited registration are in-part legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905,

[7] *Id.* at 11, 4 TTABVUE 12.

[8] *Id.* at 12, 4 TTABVUE 14.

1912 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).[9]

The *DuPont* factors regarding the similarity of the goods, trade channels and classes of consumers weigh in favor finding a likelihood of confusion.

b. Similarities of the Marks

We now consider whether Applicant's and Registrant's marks are similar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *See Stone Lion,* 110 USPQ2d at 1160 (quoting *Palm Bay Imps.,* 73 USPQ2d at 1689). The test under this *DuPont* 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 that confusion as to the source of the goods offered under the respective marks is likely to result. *See In re i.am.symbolic, llc,* 866 F.3d 1315, 123 USPQ2d 1744, 1748 (TTAB 2017). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

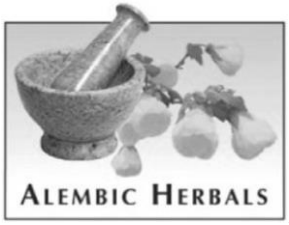
[9] To be clear, we do not dispute that there may be a difference in the trade channels and for prescription and over the counter (OTC) medicines. As explained, the issue here is that Registrant's identification of goods may include both.

As noted above, Applicant argues that its consumers are "drug wholesalers, retail chain drug stores, and pharmacists."[10] The Examining Attorney does not argue otherwise. Accordingly, we accept this characterization of Applicant's and Registrant's consumers, to the extent the goods are legally identical.

The similarity or dissimilarity of the marks is determined by considering the marks in their entireties, and hence our 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 Nat'l 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 233, 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."). However, while we must consider the marks in their entireties, it is appropriate to accord greater importance to the more distinctive elements in the marks in determining whether the marks are similar. *Nat'l Data*, 224 USPQ at 751 ("[T]here 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.").

Moreover, "[i]t is also well established that, when the goods at issue are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" *In re Viterra*, 101 USPQ2d at 1912 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

[10] Applicant's Br., p. 12, 4 TTABVUE 14.

Applicant's mark is simply ALEMBIC in standard characters, which, as noted above, is defined as "an apparatus of glass or metal, like a retort, formerly used for distilling." Registrant's mark, 

, comprises the words ALEMBIC HERBALS with a design of a mortar and pestle with herbal plants. We find the term ALEMBIC to be the most dominant element of both marks. ALEMBIC is the only element of Applicant's mark. In Registrant's mark, ALEMBIC is dominant for several reasons. It is the first term in Registrant mark. The first term in a mark is often the dominant portion of a mark. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). *See also, Palm Bay Imps.,* 73 USPQ2d at 1692; *Century 21 Real Estate* 23 USPQ2d at 1700.

ALEMBIC in Registrant's mark also is dominant because the other matter—the word HERBAL, the mortar and pestle, and the herbs—is less significant because the word and design elements are descriptive and have been disclaimed. Descriptive and disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001).

In addition, the design elements of Registrant's mark are subordinate to the wording ALEMBIC HERBALS. It is an often-recited principle that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser's memory and to be used in calling for the

goods or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See Viterra,* 101 USPQ2d at 1911; *CBS Inc. v. Morrow,* 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("[I]n a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.").

Because the dominant portion of Registrant's mark is identical to Applicant's entire mark in sound, meaning, and commercial impression, we find that the marks, considered as a whole, are similar in sound, meaning, and commercial impression as well. That is, both marks convey the same impression of ALEMBIC, "an apparatus of glass or metal, like a retort, formerly used for distilling."

Applicant argues that "[t]he addition of the word 'Herbals' in the Registrant's mark gives the mark a different commercial impression than the 'Alembic' trademark."[11] But Applicant does not say what that different commercial impression is. We find this argument to be unpersuasive, particularly because "alembic" has a specific meaning and is unlikely to have differing interpretations. At most, the presence of the word HERBALS in ALEMBIC HERBALS suggests the focus of the alembic distillation in Registrant's mark includes herbs, but this does not significantly change the overall commercial impression of the marks.

We also are unpersuaded by Applicant's arguments that "the Examining Attorney has neglected to consider the marks in their entirety."[12] It is well settled that,

[11] *Id.* at 8, 4 TTABVUE 9.

[12] *Id.* at 7, 4 TTABVUE 8.

although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *Id.* "Indeed, this type of analysis appears to be unavoidable." *Nat'l Data*, 224 USPQ at 751.

Here, Applicant's mark is subsumed in Registrant's mark. "Applicant's mark would appear to prospective purchasers to be a shortened form of registrant's mark." *Mighty Leaf Tea*, 94 USPQ2d at 1260 (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Alternatively, Registrant's mark could be viewed as an extension of Applicant's goods. Either way, we find that the marks are very similar overall.

The *DuPont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

c. Purchasing Conditions

The fourth *DuPont* factor involves "[t]he conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. Applicant argues that consumers are "not likely to be confused about the source of the goods. Confusion is less likely where the purchasing class comprises sophisticated purchasers."[13] The Examining Attorney does not argue with Applicant's contention that its prospective consumers exercise a higher degree of care.

[13] *Id.* at 14, 4 TTABVUE 15.

Instead, the Examining Attorney simply argues that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion."[14]

As discussed above, the respective goods include medicines prescribed by physicians, sold by pharmacies, and used by end consumers seeking to cure illnesses. This suggests that consumers will engage in sophisticated purchasing. We agree that because of the nature of the goods, consumers are likely to engage in a higher than ordinary degree of care in purchasing.

This *DuPont* factor weighs against likely confusion.

d. Lack of actual confusion

Applicant argues that there has been no actual confusion regarding the marks: "Alembic is not aware of a single instance of actual confusion, or of any evidence to indicate that actual confusion has ever existed between Alembic's use of the mark 'Alembic' and the mark 'Alembic Herbals' or any other mark incorporating the term Alembic."[15]

Generally, the "lack of evidence of actual confusion carries little weight, especially in an ex parte context" and that is the case here. *Majestic Distilling,* 65 USPQ2d at 1205 (internal citation omitted). We have little evidence pertaining to the nature and extent of use by Applicant and Registrant so we cannot conclude that there has been

[14] Examining Attorney's Br., 10 TTABVUE 17.

[15] Applicant's Br., p. 17, 4 TTABVUE 18.

a meaningful opportunity for confusion to have occurred. *Double Coin Holdings Ltd. v. Tru Dev.,* 2019 USPQ2d 377409, at *9 (TTAB 2019) (explaining that "for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred"); *Barbara's Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends on there being a significant opportunity for actual confusion to have occurred). Applicant states that its parent company "has been in the pharmaceutical business for over 100 years,"[16] but the parent company is based in India and it is not clear how long or how widely Applicant has been selling its drugs in the U.S. market. Nor do we have any information regarding Registrant's sales.

We also do not know whether Registrant is aware of any instances of actual confusion. *Guild Mortgage*, 2020 USPQ2d 10279, *7 ("[I]n this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story."); *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (absence of actual confusion in ex parte cases "entitled to limited probative weight" because the Board generally has no information regarding whether registrant is aware of any actual confusion and it is difficult to determine whether there has been a significant opportunity for confusion to have occurred). In any event, the test under Section 2(d) is not actual confusion but likelihood of confusion. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1027 (TTAB 1984).

[16] *Id.* at 17, 4 TTABVUE 18.

Accordingly, the absence of any actual confusion is neutral in our likelihood of confusion analysis.

e. Stricter standard for likelihood of confusion

Citing *Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 173 USPQ 19, 21-22 (CCPA 1972), similar cases, and TMEP § 1207.01(d)(xii) (2021), the Examining Attorney argues that we should apply a stricter standard to determine likelihood of confusion because "[t]he 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."[17]

We decline to apply a stricter standard in the present case. Given the breadth of the respective identifications, we find it likely that the marks will be used as house marks and not as the name of particular pharmaceutical or medicinal products. Further, the drugs at issue are generic drugs that will be called for under their generic formulations, not by brand names or tradenames. Accordingly, there is no need for a stricter standard because, although consumers may confuse the source of the drugs, there is nothing in the record from which we could conclude they will confuse the drugs themselves.

f. Conclusion

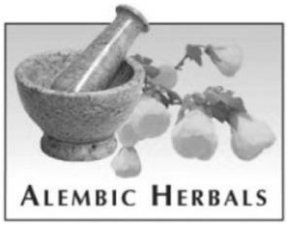
As discussed above, the goods are in-part identical and we presume the trade channels and classes of purchasers are identical as well. Further, the marks are

[17] Examining Attorney's Br., 10 TTABVUE 16.

similar in sound, meaning, and commercial impression. The first, second, and third *DuPont* factors support a finding of likelihood of confusion.

The fourth *DuPont* factor contradicts a finding that confusion is likely because purchasers of the goods would exercise a higher degree of care in purchasing. However, the fact "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar [goods]. 'Human memories even of discriminating purchasers . . . are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)). The "[s]ophistication of buyers and purchaser care are relevant considerations but are not controlling on this factual record." *Id.*

The remaining *DuPont* factors are neutral.

We find the record establishes that consumers who are familiar with the goods identified in the cited mark, 

, who encounter the goods under Applicant's mark, ALEMBIC, are likely to believe that the goods emanate from a single source.

Decision: The refusal to register under Section 2(d) is affirmed.