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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Novo NorDisk A/S
v.
Innoject, Inc.

Opposition No. 91125203
to application Serial No. 78059125

David M. Kelly of Finnegan, Henderson, Farabow, Garrett &
Dunner, L.L.P. for Novo NorDisk A/S.

John A. Thomas of Glast, Phillips & Murray, P.C. for
Innoject, Inc.

Before Simms, Chapman, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 18, 2001, Innoject, Inc. (applicant) applied
to register the mark INNOJECT (typed) for goods identified
as "medical syringes" in International Class 10.

The application (78059125) is based on an allegation of a
bona fide intention to use the mark in commerce.

Novo NorDisk A/S (opposer) has opposed registration on
the ground that applicant's mark for medical syringes "so
resembles Opposer's previously registered INNOLET and INNOVO

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marks as to be likely to cause confusion, or to cause mistake, or to deceive." Notice of Opposition at 2. Opposer relies on its ownership of Registration Nos. 2,349,403 for the mark INNOLET in typed form for "medical disposable hypodermic syringes" in International Class 10¹ and 2,378,343 for the mark INNOVO also in typed form for "syringes for injecting insulin" in International Class 10.²

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the pleadings, the file of the involved application, and opposer's notice of reliance on status and title copies of its registration and applicant's responses to opposer's interrogatories. Opposer has also attached dictionary definitions of "insulin" and "parenteral" to its brief and it requests that we take judicial notice of these definitions. Applicant's objection to taking judicial notice of these definitions is overruled. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹ Issued May 16, 2000, and based on the ownership of Danish Registration No. VR199801199.

² Issued August 22, 2000, and based on the ownership of Swiss Registration No. 434252.

Discussion

Opposer, as plaintiff in the opposition proceeding, bears the burden of proving, by a preponderance of the evidence, priority and likelihood of confusion. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Priority is not an issue here inasmuch as opposer relies on its ownership of two valid registrations. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).³

Therefore, we now address whether there is a likelihood of confusion between applicant's mark and opposer's INNOLET registration. In likelihood of confusion cases, we analyze the facts in light of the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

³ For purposes of our likelihood of confusion analysis, we will only consider the INNOLET registration because it is the closest registration. If applicant's mark is not confusingly similar to that registered mark, then it is less likely that there would be confusion with the INNOVO registration.

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In this case, we begin by comparing the goods of applicant and opposer. Applicant's goods are identified simply as "medical syringes." Opposer's goods are "medical disposable hypodermic syringes." Applicant argues that "the only evidence of actual use of [applicant's] goods ... show[s] the class of customers to be persons requiring self-administered automatic injection of particular drugs." Applicant's Brief at 4. Applicant's argument implies that its goods are more limited than those described in its identification of goods. However, in this opposition we must consider the goods as they are identified in the respective identifications of goods. 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"). We also do not read limitations into identification of goods. Squirtco

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v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)(“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”).

Here, applicant’s goods are broadly identified as medical syringes. Clearly, the term “medical syringes” is broad enough to include medical disposable hypodermic syringes. Therefore, we determine that the goods in this case are very similar, if not legally identical. The Court of Appeals for the Federal Circuit has held that when “marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

As indicated above, applicant implies that the channels of trade and the class of purchasers may be different. Applicant also faults opposer for not presenting any evidence of its purchasers. However, absent restrictions in the identification, we must assume that the goods travel in “the normal and usual channels of trade and methods of distribution.” CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). See also Hewlett-Packard Co. v.

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Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002); Kangol Ltd. v. KangaRoos U.S.A., 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992).

While applicant attempts to differentiate the products based on applicant's selling its products only through mail orders while opposer's sales of its goods are through ordinary retail channels of distribution, in the absence of a restriction in applicant's identification of goods and in the identification of goods in opposer's registrations, the respective goods must be presumed to travel in all channels of trade suitable for goods of that type.

Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954, 956 (TTAB 1985). See also Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"). Similarly, we have no basis to find that the class of purchasers or channels of trades of medical syringes and medical disposable hypodermic syringes would not at least overlap.

The next issue we address is the similarity or dissimilarity of the marks INNOJECT and INNOLET. Both marks begin with the same syllables "inno-" and end with the letter "T." The only differences between the marks is that applicant uses the letter "J" instead of the letter "L" in the middle of its mark and adds a letter "C." There are

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differences between the marks but there are also numerous similarities. First, the marks look similar, INNOLET and INNOJECT. There is also a strong likelihood that they would be pronounced similarly. Both start with the same sounds (In-no") and end with a "T" sound. In addition, "-ject" and "-let" are not dissimilar sounds. We hold that the marks INNOLET and INNOJECT, when considered in their entirety, are similar in sound and appearance. Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1814 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH confusingly similar for identical services).

Regarding their meaning and commercial impression, we again cannot discern noticeable differences. Applicant during discovery indicated that "inno-" is a truncation of "innovative." Applicant's Response to Interrogatories at 3. However, both marks would appear to have no specific meaning, which would tend to indicate that the meanings would not be used to distinguish the goods. In addition, there is no evidence that opposer's mark is weak or entitled to only a narrow scope of protection.

While undoubtedly if prospective purchasers studied the marks together, they would eventually notice that there are differences, a "[s]ide by side comparison is not the test." Grandpa Pigeon's of Missouri, Inc. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973). Even if purchasers

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noticed the differences between the marks, they are likely to believe that these medical syringes originate from the same source.

While not specifically raised as an issue, we have considered that medical syringes are not ordinary consumer items that may be purchased on impulse at retail stores. Even if we consider that the prospective purchasers may be sophisticated or careful purchasers, it does not mean that they are experts at noticing slight differences between trademarks and remembering those differences when purchasing products. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986). "In any event, even careful purchasers are not immune from source confusion." See also In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). When the marks INNOLET and INNOJECT could appear on similar, if not identical, medical syringes, confusion would be likely.

Interestingly, applicant also argues that although it has filed an intent-to-use application, "there is some basis for actual confusion to exist" because applicant has entered into a collaboration agreement with a pharmaceutical company, and apparently applicant is unaware of any instances of actual confusion. Applicant's Brief at 5. There is no requirement that there be actual confusion before we can find a likelihood of confusion. Giant Food,

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Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Evidence of actual confusion is often difficult to obtain and in a case like this where there is no evidence of the extent of applicant's use, we cannot give this factor much, if any, weight.

Therefore, in this case, when we consider all the relevant factors, we determine that, if the marks INNOLET and INNOJECT were used on the identified goods, confusion would be likely.

Decision: The opposition is sustained.