ESTTA Tracking number: **ESTTA89058**

Filing date: **07/10/2006**

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

Proceeding	91161603
Party	Plaintiff Allergan, Inc. Allergan, Inc. 2525 Dupont Drive Irvine, CA 92612
Correspondence Address	SUSAN J. HINCHEY CORPORATE TRADEMARK DEPT. 2525 DUPONT DR IRVINE, CA 92612-1599
Submission	Other Motions/Papers
Filer's Name	Kenneth L. Wilton
Filer's e-mail	kwilton@seyfarth.com, kelko@seyfarth.com
Signature	/Kenneth L. Wilton/
Date	07/10/2006
Attachments	Opposer's Brief.pdf (26 pages)(240540 bytes)

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

In the Matter of Application Serial No. 78/320,975
Published in the Official Gazette on August 3, 2004

ALLERGAN, INC., Opposer, v. BIOCENTRIC LABORATORIES, INC. Applicant.	Opposition No. 91161603 **CERTIFICATE OF ON-LINE FILING** I hereby certify that this paper was filed on-line with the Trademark Trial and Appeal Board on July 10, 2006 Eleanor Elko Eleanor Elko

OPPOSER'S BRIEF

Pursuant to Rule 2.128(a)(i), Opposer Allergan, Inc. hereby submits the following brief in support of its opposition to registration of the mark at issue in the opposed application.

TABLE OF CONTENTS

Page

INTRODUCTION 1

DESCRIPTION OF THE RECORD 1

STATEMENT OF THE ISSUE 2

RECITATION OF FACTS 2

ARGUMENT 5

I. APPLICANT'S "SEATOX" MARK SO RESEMBLES OPPOSER'S "BOTOX" MARK AS TO BE LIKELY, WHEN USED ON OR IN CONNECTION WITH APPLICANT'S CLOSELY RELATED GOODS, TO CAUSE CONFUSION, TO CAUSE MISTAKE, OR TO DECEIVE. 5

A. A Lower Degree of Similarity Between the Marks is Required to Show Likelihood of Confusion in View of the Famous Nature of the BOTOX® Mark, the Relatedness of the Parties' Goods, Similar Channels of Trade, and Identity of Consumers. 6

1. The BOTOX® Mark is Famous and is Entitled to Broad Protection. 6

2. The Goods, Channels of Trade, and Consumers Are Related 9

B. The "SEATOX" Mark is Confusingly Similar to the BOTOX® Mark 11

1. The "TOX" Portion of Applicant's Mark Serves No Descriptive or Suggestive Function 13

a. Applicant's Explanation Regarding the Selection of Its Mark Is Suspect 13

b. The Ingredients in Applicant's Product Do Not Justify the Use of "TOX" 14

2. The Timing and Number of "TOX"-suffix Applications in Class 3 Show That The Suffix Is A Reference To The BOTOX® Mark 15

II. CONCLUSION 17

TABLE OF AUTHORITIES

Page

FEDERAL CASES

Allergan, Inc. v. Mira Life Group, Inc.,
72 U.S.P.Q. 2d 1756 (C.D. Cal. 2004).....8

Block Drug Co., Inc. v. Den-Mat Inc.,
17 U.S.P.Q. 2d 1315 (TTAB 1989).....15

Bose Corp. v. QSC Audio Prods., Inc.,
293 F.3d 1367, 63 U.S.P.Q. 2d 1303 (Fed. Cir. 2002).....6, 7, 9

Burroughs Wellcome Co. v. Warner-Lambert Co.,
203 U.S.P.Q. 191 (TTAB 1979).....12

CBS, Inc. v. Morrow,
708 F.2d 1579, 218 U.S.P.Q. 198 (Fed. Cir. 1983).....10, 11

Century 21 Real Estate v. Century Life of America,
970 F.2d 874, 23 U.S.P.Q. 2d 1698 (Fed. Cir. 1992).....6, 11

Chemetron Corp. v. Morris Coupling & Clamp Co.,
203 U.S.P.Q. 537 (TTAB 1979).....12

In re Elbaum,
211 U.S.P.Q. 639 (TTAB 1981).....10

Giant Food, Inc. v. Nation's Foodservice, Inc.,
710 F.2d 1565, 218 U.S.P.Q. 390 (Fed. Cir. 1983).....7

In re International Telephone & Telegraph Corp.,
197 U.S.P.Q. 2d 910 (TTAB 1978).....9

Kangol Ltd. V. KangaROOS U.S.A. Inc.,
974 F.2d 161, 23 U.S.P.Q. 2d 1945(Fed. Cir. 1992).....10

Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.,
963 F.2d 350, 22 U.S.P.Q. 2d 1453 (Fed. Cir. 1992).....5, 6, 7, 8, 9

Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.,
774 F.2d 1144, 227 U.S.P.Q. 541 (Fed. Cir. 1985).....7, 12

King Candy Co. v. Eunice King's Kitchen, Inc.,
496 F.2d 1400, 182 U.S.P.Q. 108 (CCPA 1974).....5

TABLE OF AUTHORITIES

Page

In re Martin's Famous Pastry Shoppe, Inc.,
748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984) 9

In re Melville Corp.,
18 U.S.P.Q. 2d 1386 (TTAB 1991) 9

Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.,
1 U.S.P.Q. 2d 1445 (TTAB 1986) 6

In re Mucky Duck Mustard Co. Inc.,
6 U.S.P.Q. 2d 1467 (TTAB 1988) 12

In re National Data Corp.,
753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985) 12

Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.,
889 F.2d 1070, 12 U.S.P.Q. 2d 1901 (Fed. Cir. 1989) 5, 7, 8

On-Line Careline, Inc. v. America Online, Inc.,
229 F.3d 1080, 56 U.S.P.Q. 2d 1471 (Fed. Cir. 2000) 12, 14

Opryland USA, Inc. v. Great American Music Show Inc.,
970 F.2d 847, 23 U.S.P.Q. 2d 1471 (Fed. Cir. 1992) 8

Planters Nut & Chocolate Co. v. Crown Nut Co.,
305 F.2d 916, 134 U.S.P.Q. 504 (CCPA 1962) 7

Recot Inc. v. M.C. Becton,
214 F.3d 1322, 54 U.S.P.Q. 2d 1894 (Fed. Cir. 2000) 9, 12

Roger & Gallet S.A. v. Venice Trading Co., Inc.,
1 U.S.P.Q. 2d 1829 (TTAB 1987) 15

Rosso and Mastacco, Inc. v. Giant Food, Inc.,
720 F.2d 1263, 219 U.S.P.Q. 1050 (Fed. Cir. 1983) 5

Sealed Air Corp. v. Scott Paper Co.,
190 U.S.P.Q. 106 (TTAB 1975) 12

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.,
748 F.2d 669, 223 U.S.P.Q. 1281 (Fed. Cir. 1984) 6, 7

TBC Corp. v. Holsa Inc.,
126 F.3d 1470, 44 U.S.P.Q. 2d 1315 (Fed. Cir. 1997) 9

TABLE OF AUTHORITIES

Page

Tektronix, Inc. v. Daktronics, Inc.,
534 F.2d 915, 189 U.S.P.Q. 693 (CCPA 1976) 15, 16

University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,
213 U.S.P.Q. 594 (TTAB 1982),
aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) 16

FEDERAL STATUTES

15 U.S.C. § 1052(d) 2, 5

15 U.S.C. § 1063 5

15 U.S.C. § 1065 2

OTHER AUTHORITIES

3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition,
§ 23:99 (4th Ed. 2006) 12

INTRODUCTION

Applicant Biocentric Laboratories, Inc. ("Applicant") seeks registration of the mark "SEATOX" for "cosmetics and cleaning preparations." Opposer Allergan, Inc. ("Opposer") owns the mark "BOTOX" for related goods, and alleges likelihood of confusion under Section 2(d) of the Lanham Act.

At trial, Opposer introduced evidence of its registrations of "BOTOX", all of which are prior to the filing date of the opposed application. Opposer also introduced evidence that the BOTOX® mark is famous, and was famous at the time the opposed application was filed; Applicant even admitted that the BOTOX® mark was well known, that it had knowledge of the BOTOX® mark when it adopted the mark at issue, and that it intends for the goods sold under the "SEATOX" mark to compete with those sold under the BOTOX® mark.

Finally, Opposer introduced evidence that the common element of the marks at issue – the "TOX" suffix – has no suggestive or descriptive meaning in the context of Applicant's goods. As a result, the narrow issue presented by this proceeding is whether consumers of related and competitive goods are likely to be confused by the simultaneous registration of similar marks. Opposer submits that, by virtue of the fame of the BOTOX® mark, they will, and this opposition therefore must be sustained.

DESCRIPTION OF THE RECORD

The record, which was filed through Notices of Reliance under Rule 2.120(j)(3)(i) of the Trademark Rules of Practice timely filed by Opposer, and transcripts of trial testimony depositions taken and filed under Rule 2.123 of the Trademark Rules of Practice, consists of:

- The trial deposition transcript and accompanying exhibits of Rebecca Spaar, Applicant's Chief Executive Officer ("Spaar Depo.");

- The trial deposition transcript of Tom Albright, Opposer's Vice President of Global Strategic Marketing for products sold under the BOTOX® mark ("Albright Depo.");
- True and correct status and title copies of each of the following registrations:
    1. United States Trademark Registration No. 1,692,384 for BOTOX;
    2. United States Trademark Registration No. 1,709,160 for BOTOX;
    3. United States Trademark Registration No. 2,510,675 for BOTOX;
- Copies from the TARR website of Class 3 "TOX"-suffix registrations filed prior to April 2002 ("Notice of Reliance Exhs. 1-6"); and
- Copies from the TARR website of Class 3 "TOX"-suffix applications filed after April 2002 ("Notice of Reliance Exhs. 7-33").

Applicant presented no evidence at trial.[1]

STATEMENT OF THE ISSUE

Whether Applicant's mark "SEATOX" for "cosmetics and cleaning preparations" so resembles Opposer's previously registered BOTOX® mark as to be likely to cause confusion, to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

RECITATION OF FACTS

Opposer's trial evidence established, without rebuttal, the facts set forth below:

Opposer is the owner of three registrations of the "BOTOX" mark, two of which are now incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. (Reg. Nos. 1,692,384;

[1] On May 10, 2006, Applicant filed a document entitled "Submission No. 9." In the face of Opposer's June 6, 2006 Motion to Strike, Applicant withdrew that submission. *See* Applicant's June 8, 2006 Submission No. 10. Accordingly, the "evidence" presented in Submission No. 9, which was improper in any event, is not before the Board in this proceeding and is not discussed herein. In the unlikely event the Board considers Submission No. 9, Opposer respectfully requests consideration of its Motion to Strike and the remedies requested therein.

1,709,160; 2,510,675; Albright Depo. 8:7-10:14, 10:25-11:12; Exhs. 2-6[2].) All of Opposer's applications were filed and registered, and assert use, prior to the filing date of the opposed application. (Id.)

Opposer has been marketing a pharmaceutical preparation under the BOTOX® mark since in or about 1991, and has used the mark in connection with that product continuously since that time (the "BOTOX® Product"). (Albright Depo. 11:13-18.) In April, 2002, the United States Food and Drug Administration approved the BOTOX® Product for a cosmetic indication, namely, for the temporary improvement in the appearance of moderate to severe glabellar lines, the frown lines or wrinkles that appear in the middle of the forehead. (Albright Depo. 11:19-24, 21:22-23:16; Exhs. 13, 14.)[3]

Between 1999 and year end 2004, Opposer received revenues of over $2.4 *billion* for goods sold under the BOTOX® mark, 70% of which were received in the United States. (Albright Depo. 13:3-16:13; Exh. 7, 8).[4]

---

[2] The trial testimony deposition exhibits were numbered consecutively, with Exhibit Nos. 1-15 attached to the Albright Deposition, and Exhibit Nos. 16-37 attached to the Spaar Deposition.

[3] At the time the FDA approved the cosmetic indication for the BOTOX® Product, it required Opposer to adopt, for purposes of promoting its BOTOX® Product for that indication, the descriptor "Cosmetic" to appear next to the BOTOX® mark. (Albright Depo. 12:10-13:2.) Thus, while the product sold under the BOTOX® mark has not changed, when marketed for purposes of the cosmetic indication (as opposed to therapeutic indications) the mark appears as "BOTOX® Cosmetic." (Albright Depo. 22:5-16.) In addition, beginning in 2004, two different marks were adopted for sales of the BOTOX® Product in France, Italy and a few other European countries. (Id. at 13:17-14:12.) Nonetheless, the vast majority of sales of the product in 2004, and *all* sales before 2004, were made under the BOTOX® mark. (Id. at 16:5-13.)

[4] Opposer's 2004 Annual Report, and its Notice of Opposition as confirmed by Mr. Albright, set forth that Opposer received the following revenues for products sold under its BOTOX® mark:

Year	2004	2003	2002	2001	2000	1999
Revenue (millions)	$705.1	$563.9	$439.7	$309.5	$239.5	$175.8

(Albright Depo. 13:3-16:3; Exhs. 7, 8.)

Immediately following FDA approval for the cosmetic indication for the BOTOX® Product, Opposer launched Web, print, and television advertising promoting that cosmetic indication. (Albright Depo. 16:15-17:3.) In 2002, Opposer's spent approximately $6.2 million in the United States for print advertising for the cosmetic indication for the BOTOX® Product, with advertising appearing in over 20 magazines and periodicals, and an additional $6-7 million for television advertising. (Id. at 17:4-18:15; Exh. 9.) In 2003, Opposer spent in the United States approximately $12-14 million for print advertising in over 20 magazines and periodicals, in addition to inserts into major newspapers, all promoting the cosmetic indication for the BOTOX® Product. (Id. at 18:16-19:24; Exh. 10.) In 2004 and going forward, Opposer has spent approximately $25-35 million per year for advertising of the cosmetic indication for the BOTOX® Product in the United States. (Id. at 20:2-13.) Thus, from April 2002 through 2003 (the opposed application was filed October 30, 2003), Opposer had spent approximately $24-27 million in television and print advertising promoting the cosmetic indication for the product sold under the BOTOX® mark.

Applicant admitted that it was aware of the BOTOX® mark when it selected the mark at issue, going so far as to admit that "[e]verybody has heard of Botox." (Spaar Depo. 83:14-19; Applicant's Supplemental Responses to Request for Admission Nos. 1, 2[5].)

[5] Applicant's Supplemental Responses to Opposer's Requests for Admission are attached as Exhibit 19 to the Spaar Deposition, and Applicant's witness confirmed that the responses are Applicant's and are true and correct. (Spaar Depo. 19:12-21.)

ARGUMENT

I. APPLICANT'S "SEATOX" MARK SO RESEMBLES OPPOSER'S "BOTOX" MARK AS TO BE LIKELY, WHEN USED ON OR IN CONNECTION WITH APPLICANT'S CLOSELY RELATED GOODS, TO CAUSE CONFUSION, TO CAUSE MISTAKE, OR TO DECEIVE.

As discussed below, the unrefuted evidence shows that Applicant's "SEATOX" mark is so similar to Opposer's registered BOTOX® mark so as to be likely "to cause confusion, to cause mistake, or to deceive" when used on or in connection with Applicant's goods, namely, "cosmetics and cleaning preparations." *See* 15 U.S.C. § 1052(d).[6]

The test for likelihood of confusion requires the Board to "take into account, when of record, those of the thirteen evidentiary factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), that are pertinent to the case." *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989). "As dictated by the evidence, different factors may play dominant roles in determining the likelihood of confusion." *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). The dominant factors in this case are: (1) the fame of Opposer's mark, established by its long, exclusive and continuous use, substantial sales and advertising of goods sold under the mark, a prior judicial opinion, and Applicant's admission, (2) the relatedness of Applicant's and Opposer's goods, and similar channels of trade and

[6] There is no issue of priority because Opposer relies upon prior registrations of its mark. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Further, the record establishes use of Opposer's mark from a time long prior to the filing date of the opposed application. The prior use and registration of its mark, and the allegations of likelihood of confusion, also establish Opposer's standing to oppose as a "person who believes that [it] would be damaged by registration" of Applicant's mark. 15 U.S.C. § 1063; *see, e.g., Rosso and Mastacco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1052 (Fed. Cir. 1983).

consumers, and (3) the similarity of the marks, considered against the backdrop of factors (1) and (2). All of these factors strongly favor Opposer, and all point to a clear likelihood of confusion.

A. A Lower Degree of Similarity Between the Marks is Required to Show Likelihood of Confusion in View of the Famous Nature of the BOTOX® Mark, the Relatedness of the Parties' Goods, Similar Channels of Trade, and Identity of Consumers.

The degree of similarity between the marks sufficient to establish confusing similarity must be viewed "through the lens of the other *DuPont* factors ..." *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Several of the *DuPont* factors, including the famous nature of Opposer's mark and the identity and relatedness of the goods, channels of trade, and consumers, "tend[ ] to magnify the likelihood of consumer confusion." *Id.*

1. The BOTOX® Mark is Famous and is Entitled to Broad Protection.

"The fifth *DuPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." *Kenner Parker Toys*, 22 USPQ2d at 1456; *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). This is because there is a "propensity of consumers to associate a relatively unknown mark with one which is well known to them" that "increases the likelihood of confusion, mistake, or deception." *Miles Labs. Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1453 (TTAB 1986) (*citing Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984)).

"Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of

lasting value." *Kenner Parker Toys*, 22 USPQ2d at 1456. "[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose*, 63 USPQ2d at 1305-06 (finding ACOUSTIC WAVE mark famous based on 17 years of use, $50 million in annual sales, and $5 million in annual revenue). Here, Opposer has been selling products under the BOTOX® mark for over 15 years, enjoyed revenue during the 1999-2003 period *alone* of over $1.7 *billion* (70%, or approximately $1.2 *billion*, in the United States), and spent $24-27 million for television and print advertising in nationwide magazines and periodicals during the relatively short period from April 2002 through 2003. (Albright Depo. 13:3-16:3; Exhs. 7, 8.)[7] This evidence, and in particular the revenue and nationwide advertising figures, are sufficient to demonstrate that the BOTOX® mark is famous.[8]

---

[7] As illustrated by the advertisement and website for the BOTOX® Product, the mark is used by itself without reference to Opposer's house mark, ALLERGAN®. (*See* Albright Depo. Exhs. 11-15); *cf. Bose*, 63 USPQ2d at 1309 (finding that "ACOUSTIC WAVE" and "WAVE" were famous notwithstanding their use in conjunction with the famous "BOSE" house mark).

[8] Opposer's period of use of the BOTOX® mark, and the revenue and advertising figures related to the product sold under that mark, compare favorably to, and in most cases far exceed, the similar indicia that previously have been found to establish fame. *See Bose*, *supra*, 63 USPQ2d at 1305-06 (*citing Nina Ricci*, 12 USPQ2d at 1902 (NINA RICCI for perfume, clothing and accessories: $200 million in sales, over $37 million in advertising over 27 years); *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146-47, 227 USPQ 541, 542 (Fed. Cir. 1985) (HUGGIES for diapers: over $300 million in sales over 9 years, $15 million in advertising in one year); *Specialty Brands Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 674-75, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (SPICE ISLANDS for teas, spices and seasonings: $25 million annually in sales for spices, $12 million between 1959 and 1981 for tea, "several million" in advertising, in use for 40 years); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1567-68, 218 USPQ 390, 392-93 (Fed. Cir. 1983) (GIANT FOOD for supermarket services and food products: sales over $1 billion in one year, "considerable amounts of money" in advertising, 45 years use); *Planters Nut & Chocolate Co. v. Crown Nut Co.*, 305 F.2d 916, 917-18, 134 USPQ 504, 506 (CCPA 1962) (MR. PEANUT DESIGN for nuts and nut products: $350 million in sales, $10 million in advertising over 10 years)).

Given the persuasive nature of the objective indicia of the fame of the BOTOX® mark, it therefore is not surprising that, in June, 2004, Judge Selna of the Central District of California, held, based on Opposer's long and exclusive use of the BOTOX® mark, and its over $1 billion in revenue from 1999 through 2002, that "the BOTOX mark has become famous in the United States." *Allergan, Inc. v. Mira Life Group, Inc.*, 72 USPQ2d 1756, 1758 (C.D. Cal. 2004).

Even Applicant was forced to admit that the mark was famous:

> Q. And you were aware of the Botox product and mark at the time you selected your mark, correct?
>
> A. I haven't lived under a rock. *Everybody has heard of Botox. Everybody knows who you are.*

(Spaar Depo. 83:14-19.) Based on this evidence, Opposer submits that its BOTOX® mark is famous, and was famous at the time Applicant filed the opposed application.

As the Federal Circuit has held, there is "no excuse for even approaching the well-known trademark of a competitor … and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially when the established mark is one which is famous." *Kenner Parker Toys*, 22 USPQ2d at 1456; *Nina Ricci*, 12 USPQ2d at 1904. This is so because "a well-known mark enjoys an appropriately wider latitude of legal protection, for similar marks tend to be more readily confused with a mark that is already known to the public." *Opryland USA, Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992). "[T]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for

similarities in competing marks falls." *Kenner Parker Toys*, 22 USPQ2d at 1456.[9] As a famous mark, the BOTOX® mark "casts a long shadow which competitors must avoid." *Id.* (*citing Nina Ricci*, 12 USPQ2d at 1904). Applicant made no attempt to avoid that shadow, and has implicitly admitted that it affirmatively attempted to fall within it.

2. The Goods, Channels of Trade, and Consumers Are Related

It is not necessary that the respective goods of Opposer and Applicant be identical in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910, 911 (TTAB 1978). Importantly, "when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark." *Bose*, 63 USPQ2d at 1310 (*citing Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)).

Here, Opposer markets a product that is intended to improve the appearance of wrinkles on the forehead. (Albright Depo. Exh. 14.) Applicant's unrestricted identification of goods includes face creams that are intended to reduce the appearance of wrinkles on the skin, and

[9] In addition to this rule favoring Opposer, given "the fact that applicant has filed an intent to use application, the well established rule that doubts are to be resolved against a newcomer and in favor of an established longtime user applies here." *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997).

Applicant itself has admitted the same. (*See*, *e.g.*, Spaar Depo. 50:10-22, 51:19-52:9.) The conclusion that the goods are related is reinforced by the fact that Applicant, when describing the ingredients in the product sold under the opposed mark, compares the effects of those ingredients to the effects achieved through use of Opposer's BOTOX® Product. For example, Applicant states that one of the purported ingredients in the product sold under the opposed mark, "Argirelene", acts "by reducing catecholamine release, gradually a significant reduction in the depth and size of wrinkles are noticed and *without the paralysis as with Botox® injections*." (Spaar Depo. 45:1-9, 53:8-54:1; Exhs. 29, 30 (emphasis added).) In fact, the label on Applicant's "SEATOX" product states that "SeaTox Triple Complex functions by relaxing the muscles, as opposed to paralyzing them with chemical injections." (Spaar Depo. 61:1-8, 63:2-8; Exhs. 31, 32.) Because Applicant itself is plainly relating its product to the BOTOX® Product, the consuming public will find the goods to be related as well.

Because Applicant's goods are admittedly related to Opposer's, it should be presumed that they are (or will be) sold through the same customary channels of trade to the same customary consumers of such goods. *See*, *e.g.*, *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because there are no restrictions in the opposed application's identification of goods, they are presumed to travel in all "normal and usual channels of trade and methods of distribution" customary to cosmetics. *Kangol Ltd. V. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) (*quoting CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581, 218 USPQ 198, 199 (Fed. Cir. 1983)). For example, notwithstanding the fact that Opposer's BOTOX® Product is administered by physicians, it is not inconceivable, and is indeed likely, that a physician would offer cosmetics for sale (including without limitation Applicant's product) as an adjunct or complement to services offered by the physician.

Further, Applicant markets its "SEATOX" product directly to the same types of consumers to whom Opposer markets its products, namely, people interested in reducing the appearance of wrinkles. (Albright Depo. 26:17-27:22; Spaar Depo. 46:14-50:22; Exhs. 29, 30.)[10]

Where, as here, the parties' goods, channels of trade and consumers are related, this increases the likelihood of confusion because "[w]hen 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*, 23 USPQ2d at 1700.

B. The "SEATOX" Mark is Confusingly Similar to the BOTOX® Mark.

Under the first *DuPont* factor, the Board considers "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *Century 21 Real Estate*, 23 USPQ2d at 1700. As discussed above, the degree of similarity between the marks necessary for Opposer to prevail is reduced significantly because of the fame of the BOTOX® mark, the relatedness of the goods, the similarity of the channels of trade, and the identity of parties' respective consumers.

In determining whether the marks at issue are dissimilar or similar, the test 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. *See*

[10] Applicant's ingredient lists or "fliers" (Exhs. 29 and 30), which are discussed in detail below, are intended to provide information to Applicant's "customer base" as part of Applicant's marketing efforts. (Spaar Depo. 46:14-17.) In order to satisfy a perceived need by those customers, Applicant included in its product, for example, its first major ingredient, "Argirelene", because it allegedly reduced wrinkles without the use of the BOTOX® Product. (Id. at 50:10-22, 51:14-18.) Applicant plainly is directing its product to the same consumers targeted by Opposer for its BOTOX® Cosmetic Product.

Chemetron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537, 541 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Although the marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Finally, the marks must be evaluated bearing in mind that the "average purchaser is not infallible in his recollection of trademarks or the spelling thereof, and often retains but a general overall impression of the marks which he has encountered in the marketplace." *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191, 193 (TTAB 1979); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1468 (TTAB 1988).[11]

Here, the common element of the respective marks is "TOX", a substantial portion of the BOTOX® mark. It therefore is likely that consumers, when faced with two "TOX"-formative marks for related goods, would simply conclude that the latter mark – "SEATOX" – is a related product to the "BOTOX" product, perhaps with a formulation that includes some sort of "sea"-based ingredient that allows it to be sold over-the-counter as opposed through physicians.

---

[11] "When the products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." *Recot*, 54 USPQ2d at 1899; *see also Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146, 227 USPQ 541, 542 (Fed. Cir. 1985). Here, because Applicant's customers generally purchase Applicant's goods over the Internet, such purchases are inherently "impulsive" because such purchasers are prone to a lesser standard of care. (Spaar Depo, 28:22-29:2; 29:7-30:1; 78:19-24; Exhs. 26, 36); 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:99 at 23-254-255 (4th Ed. 2006); *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1087, 56 U.S.P.Q.2d 1471, 1473, 1476 (Fed. Cir. 2000) ("because of the broad proliferation of computer and Internet use, there is no basis for concluding that Internet users are any more knowledgeable or sophisticated than the general public" or that "all customers are necessarily knowledgeable enough to distinguish between … two marks and their respective services."

Apparently recognizing the similarity between the marks, and having admitted that it was aware of the BOTOX® mark when it adopted the opposed mark, Applicant asserts that the "TOX" portion of its mark is descriptive of a feature of its product – namely that its product has a "detoxifying" effect. (Spaar Depo. 72:22-73:10.) However, Applicant's own testimony controverts this claim, and third party applications for "TOX"-formative marks in the cosmetic field provide circumstantial evidence that, in fact, the "TOX"-suffix serves as a reference to the BOTOX® mark. Because Applicant's explanation is not believable, and fails to explain the dominant common element of the marks at issue, the marks should be found to be confusingly similar.

1. The "TOX" Portion of Applicant's Mark Serves No Descriptive or Suggestive Function

a. Applicant's Explanation Regarding the Selection of Its Mark Is Suspect

In an apparent attempt to avoid the consequences of having chosen a confusingly similar mark for its related goods, in response to discovery Applicant provided the following explanation for having chosen the "SEATOX" mark:

> The "Sea" is for the MSM and the Red Seaweed Extract from the sea. The "Tox" is for detoxifying.

(Response to Interrogatory No. 3[12]; Spaar Depo. 31:17-32:5.) This explanation is unsupported by the record. Not only does the "SEATOX" product contain no "MSM",[13] it also does not

[12] Applicant's Responses to Opposer's Interrogatories are attached as Exhibit 18 to the Spaar Deposition, and Applicant's witness confirmed that the responses are Applicant's and are true and correct. (Spaar Depo. 18:16-19:7.)

[13] MSM, which Applicant stated is short for "methylsulfonylmethane" (Spaar Depo. 33:21-34:1), does not appear on either Applicant's fliers listing the "major active" ingredients contained in the "SEATOX" product (Exhibits 29 and 30), or the listings of *all* the ingredients in the product that

contain any ingredients that purport to have a "detoxifying" effect. Applicant's explanation, therefore, appears to have been created for purposes of this proceeding, and certainly does not justify the adoption of a mark that includes a substantial, and the dominant, portion of the BOTOX® mark for a related and competitive product.

b. The Ingredients in Applicant's Product Do Not Justify the Use of "TOX"

During its deposition, Applicant admitted to preparing two lists of ingredients for formulations of its "SEATOX" product. (Spaar Depo. 45:2-9 (Exh. 29); 53:8-16 (Exh. 30).) Each of these lists, or "fliers" as Applicant refers to them, was intended by Applicant to provide Applicant's customers with information regarding all of the major active ingredients in the product. (Id. at 46:18-47:3.) A review of the fliers, and Applicant's own testimony, reveals that *none* of the ingredients contained in the "SEATOX" product are described by *Applicant* itself as having a "detoxifying" effect. (Id. at 50:9-19 (Argirelene included because it allegedly "reduced wrinkles"), 51:19-52:9, 55:2-8 (Matrixyl included because it was intended to "reduce the appearance of wrinkles"), 54:2-55:1 (white tea extract included because it was intended to "boost the immune function of skin cells"), 55:9-56:9 ("Vitamin C Ester" included because it was intended to "stimulate[] collagen production, cut[] down the acidity of the skin, fight[] free radicals"), 56:10-57:1 ("Olive Leaf Extract" included because it allegedly "supports the texture and integrity of the skin"), 57:2-17 ("red algae extract" included because it is an "exfoliant"), 57:18-58:10 ("Sepilift" included because it was intended to "stimulate[] the contraction of collagen fibers, protect[] elastin, and protect[] fibroblasts against free radicals"), 58:11-59:2

---

appear on the labels for the product itself (Exhibits 31 and 32). While the "SEATOX" product *does* contain "red algae extract" – thereby supporting Applicant's position that the "SEA" portion of the opposed mark could be suggestive – the fact that the product does not contain MSM lends support to the notion that Applicant's explanation is merely a fiction created in response to Opposer's opposition.

("retinol" included because it was intended to "reduce wrinkles, pigment spots, and helps to reduce the damage from UV rays").

As shown above, *none* of the ingredients in the product sold under the "SEATOX" mark has a detoxifying effect by drawing impurities or "toxins" out of the body. As a result, there is no evidence of record to support the notion that the "TOX" portion of Applicant's mark has anything whatsoever to do with Applicant's goods, or that it is descriptive or suggestive of any feature or quality of the goods. Because there thus is no evidence to explain the commonality between the marks at issue, they should be found to be confusingly similar. *See, e.g., Block Drug Co., Inc. v. Den-Mat Inc.*, 17 USPQ2d 1315, 1317 (TTAB 1989) (finding "POWERDENT" and "POLIDENT" confusingly similar despite evidence of suggestive nature of "DENT" portion of each mark); *Roger & Gallet S.A. v. Venice Trading Co., Inc.*, 1 USPQ2d 1829, 1832 (TTAB 1987) ("TENAX" and "DINAX" confusingly similar in part because "Applicant's witness' testimony as to the circumstances of adoption of the 'DINAX' mark is not entirely believable," and in particular, '[t]he testimony as to the adoption of the 'X' ending of applicant's mark 'DINAX' is less believable").

2. The Timing and Number of "TOX"-suffix Applications in Class 3 Show That The Suffix Is A Reference To The BOTOX® Mark

Although admittedly of little weight in determining likelihood of confusion, the timing and number of third-party applications for "TOX"-suffix marks in Class 3 provide circumstantial evidence that, in fact, the "TOX"-suffix is intended by trademark owners for goods in that class to refer to Opposer's famous BOTOX® mark. *See Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (while third-party registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use, they

may be given some weight to show the meaning of a mark in the same way that dictionaries are used).

As discussed above, on April 15, 2002, Opposer received approval to market its BOTOX® Product for cosmetic purposes, namely the improvement of the appearance of wrinkles formed between the eyebrows. (Albright Depo. 11:19-13:2.) Immediately following approval, Opposer began a nationwide advertising campaign for that indication for the product. (Id. at 16:15-17:3.)

Prior to the approval and nationwide advertising of the BOTOX® Product for its cosmetic indication, excluding marks that include "detox", there are *no* active Class 3 registrations for skin care products that include a "TOX" suffix. (Notice of Reliance, Exhs. 1-6.) And for those trademark owners that *did* want to connote a detoxifying effect, they adopted a mark that included a form of "DETOX". (Id. at Exhs. 1 ("HAIR DETOX"), 2 ("D:TOX"), 3 ("CELLULAR DETOX") and 6 ("URBAN DETOX").) The reason for this is obvious; "tox" by itself is variant of "toxi", which means "poison", "poisonous" or "toxic", qualities that are anathema for any cosmetic product. *See* Appendix A: The American Heritage® Dictionary of the English Language, Fourth Edition (2000).[14]

In stark contrast to the pre-approval period, *after* the advertising campaign for the BOTOX® Product began in April 2002, a large number of third parties, including Applicant, began filing applications to register "TOX"-suffix marks in Class 3, all for cosmetics, many of which were identified as having the same or similar effects as the BOTOX® Product. (Notice of Reliance, Exhs. 7-33.)

---

[14] Opposer respectfully requests the Board take judicial notice of the definition of "TOX", a copy of which is attached as an appendix to this Brief. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The explanation for this contrast is two-fold. First, as discussed above, the "TOX" suffix, in and of itself, has no logical meaning in the cosmetic world and in fact would seem to convey the exact *opposite* of any quality one would want a cosmetic product to have. Second, third parties apparently believe that use of a "TOX"-suffix will help associate their products with the BOTOX® Product. While not dispositive, this evidence supports the conclusion that consumers, when faced with a similar product incorporating a "TOX"-suffix, are likely to believe that that product is a derivative of or is somehow associated with the BOTOX® Product, and emanates for the same source.

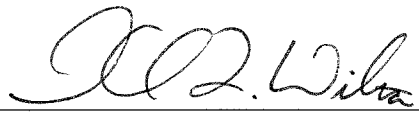
II. CONCLUSION

Based on the foregoing, and the evidence of record, Opposer respectfully requests that the Board find that the Applicant's mark is confusingly similar to Opposer's famous and previously registered and used BOTOX® mark, sustain this opposition, and refuse registration to Applicant of the mark shown in the opposed application.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: July 10, 2006

By: 

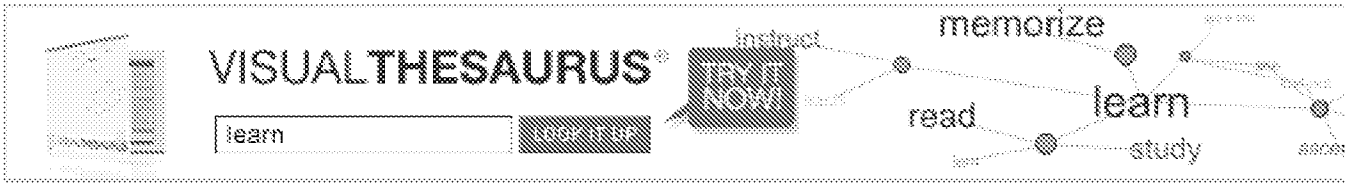
Kenneth L. Wilton
Attorneys for Opposer
ALLERGAN, INC.

2029 Century Park East, Suite 3300
Los Angeles, California 90067-3063
Telephone: (310) 277-7200
Facsimile: (310) 201-5219

Dictionary.com tox Search
Dictionary Thesaurus Encyclopedia Web

Home

Premium: Sign up | Login



ADVERTISEMENT

Dictionary - Thesaurus - Encyclopedia - Web

Top Web Results for "tox"

4 entries found for *tox*.

tox-
pref.

Variant of toxi-.

[Download Now or Buy the Book]
Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*
Copyright © 2000 by Houghton Mifflin Company.
Published by Houghton Mifflin Company. All rights reserved.

toxi- or toxo- or tox-
pref.

Poison; poisonous: *toxalbumin.*

[From Latin `toxicum`. See toxic.]

[Download Now or Buy the Book]
Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*
Copyright © 2000 by Houghton Mifflin Company.
Published by Houghton Mifflin Company. All rights reserved.

tox-
pref.

Variant of toxi-.

Source: *The American Heritage® Stedman's Medical Dictionary Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by Houghton Mifflin Company.*

tox

TOX: in Acronym Finder

Source: *Acronym Finder, © 1988-2004 Mountain Data Systems*

Ads by Google

Quick, Easy College Loans
Private Student Loans. Great Rates & Terms. No Government Process.
www.loantolearn.com

Nelnet Loan Consolidation
$170,000 loan for $561/month. Apply online today!
Refinance Low.com

Private student loan
Paying off Student Loans? Let Us Help! Less Debt Monthly. Apply now.
www.directedloans.com/

Win A $10,000 Scholarship
If You Have 15 Seconds, Enter To Win A $10,000 College Sweepstakes
www.DirectScholar.com

Advertise on this site
ADVERTISEMENT

Related ads:

- Zinc Chloride
- Hydrogen Peroxide
- Sodium Antimonate
- Ferric Chloride
- MSDS Preparation

Perform a new search, or try your search for "tox" at:

- Amazon.com - Shop for books, music and more

- HighBeam Research - 32 million documents from leading publications
- Merriam-Webster - Search for definitions
- Reference.com - Encyclopedia Search
- Reference.com - Web Search powered by Google
- Thesaurus.com - Search for synonyms and antonyms

ADVERTISEMENT

Get the FREE Dictionary.com Toolbar for your browser now!
From the makers of Dictionary.com

Copyright © 2006, Lexico Publishing Group, LLC. All rights reserved.
About Dictionary.com | Privacy Policy | Terms of Use | Link to Us | Help | Contact Us

CERTIFICATE OF SERVICE

I hereby certify that on July 10, 2006, I served the foregoing Opposer's Trial Brief on the applicant by depositing a true copy thereof in a sealed envelope with the United States Postal Service "Priority Mail Service" addressed to applicant as follows:

Ms. Rebecca Spaar
Chief Executive Officer
BioCentric Laboratories, Inc.
854 Baseline Place, Suite B
Brighton, CO 80603

AND

Ms. Rebecca Spaar
Chief Executive Officer
BioCentric Laboratories, Inc.
P.O. Box 1018
Brighton, CO 80601

Eleanor Elko

Eleanor Elko