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Mailed:  
April 25, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Schering-Plough HealthCare Products, Inc.

v.

Western Holdings, LLC

Opposition No. 91187375  
to Application Serial No. 77420097  
filed on March 12, 2008

Jonathan Hudis and Beth A. Chapman of Oblon, Spivak,  
McClelland, Maier & Neustadt, L.L.P. for Schering-Plough  
HealthCare Products, Inc.

David R. Parkinson, Esq. for Western Holdings, LLC.

Before Grendel, Bergsman and Ritchie,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Western Holdings, LLC ("applicant") filed an intent-to-use application to register the mark SOLARIN, in standard character form, for "self-tanning preparations," in Class 3.

Schering-Plough HealthCare Products, Inc. ("opposer") opposed the registration of applicant's mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Opposer alleged that it has used the mark SOLARCAINE for a medicinal antiseptic preparation for the relief of sunburn; for

medicated preparations for the relief of sunburn, minor cuts, burns, skin irritations, insect bites, detergent hands, cold sores and fever blisters; and for moisturizing skin lotions long prior to any date that could be asserted by applicant for its mark SOLARIN and that applicant's use of the mark SOLARIN for "self-tanning preparations" so resembles opposer's SOLARCAINE mark as to be likely to cause confusion. Opposer claimed ownership of the following three SOLARCAINE registrations all in typed drawing form:

1. Registration No. 0534375 for "medicinal antiseptic preparation for the relief of sunburn," in Class 5;<sup>1</sup>

2. Registration No. 0795897 for "medicated preparations for the relief of sunburn, minor cuts, burns, skin irritations, insect bites, detergent hands, cold sores and fever blisters," in Class 5;<sup>2</sup> and

3. Registration No. 1413916 for "moisturizing skin lotion," in Class 3.<sup>3</sup>

Applicant, in its answer, admitted that opposer has priority with respect to its SOLARCAINE mark but denied the remaining allegations in the notice of opposition.

In a telephone conference with the Board on February 4, 2010, the parties agreed that this proceeding could be resolved by Accelerated Case Resolution ("ACR") in lieu of a

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<sup>1</sup> Issued December 5, 1950; third renewal.

<sup>2</sup> Issued September 23, 1964; second renewal.

<sup>3</sup> Issued October 21, 1986; renewed.

trial. Subsequently, on April 15, 2010, the parties filed a stipulation setting forth their agreement on ACR discovery, procedural and evidentiary submissions, and the briefing schedule.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Stipulation of facts.

The parties filed a stipulation of facts regarding the following:

1. The parties, their affiliated companies and relevant personnel;
2. Priority;
3. The parties' marks;
4. Applicant's selection of SOLARIN;
5. The parties' goods;
6. The parties' packaging;
7. The parties' advertising and promotion of their respective marks and products;
8. Channels of trade; and
9. The purchasers and their degree of care.

Also, the parties introduced a stipulation with documents designated as confidential and a stipulation regarding documentary exhibits.

B. Opposer's Evidence.

Opposer introduced the following evidence:

1. A notice of reliance on 15 third-party registrations that are purportedly registered for sunburn relief and/or skin moisturizing as sold by opposer and tanning preparations as identified in the application at issue;

2. A notice of reliance on 66 news articles that reference opposer's mark SOLARCAINE purportedly "to show the long notoriety and considerable recognition of the SOLARCAINE mark";

3. Declaration of Shemal Ahmed, a legal assistant for opposer's counsel, testifying about the placement of the sunburn relief products and tanning products at a Walgreens store and a Rite-Aid store in Northern Virginia;

4. Declaration of Kimberly L. Bunn, an IP Specialist for opposer's counsel, authenticating Internet printouts purportedly showing the same marks used in connection with sunburn relief products and tanning products; and

5. Declaration of Amy Levine, the person responsible for the marketing of SOLARCAINE products, testifying about the marketing of SOLARCAINE products.

C. Applicant's Evidence.

1. A notice of reliance on 19 third-party registrations "that incorporate the term 'SOLAR' for products that have some connection to sun exposure"; and

2. Declaration of Gina Daines, the person responsible for marketing SOLARIN products.

Standing

Opposer attached copies of its pleaded registrations from the electronic records of the USPTO showing the current status and title of the registrations. The registrations are admissible pursuant to Trademark Rule 2.122(d)(1). In addition, applicant admitted that the copies of the registrations were accurate and stipulated to opposer's ownership of the registrations and to the status of the registrations. Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

As indicated above, applicant, in its answer, admitted that opposer's SOLARCAINE mark was in use prior to any date on which applicant may rely. The parties subsequently stipulated to opposer's priority. In any event, because

opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We find, having given due consideration to the fame of opposer's mark, and notwithstanding all the other factors in opposer's favor including the similarity of the goods, channels of trade and classes of consumers, that the marks in this case are simply too dissimilar to support a finding of likelihood of confusion. *See, e.g., Kellogg Co. v. Pack-Em Enterprises Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1989), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (dissimilarity of the marks outweighed all other du Pont factors, "even if opposer offered evidence [that its mark has become famous]").

In analyzing the marks, we note that they are similar to the extent that both marks begin with the word "Solar." However, "[a] principal definition of the word 'Solar' is 'of, relating to, or proceeding from the sun.'"<sup>4</sup> In this regard, applicant submitted 19 third-party registrations incorporating the word "Solar" in connection with products having a connection with sun exposure. Although third-party registrations are not evidence that the marks are in use, the registrations may be considered in the same manner as a dictionary to show a possible meaning or significance of the word. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1075-76 (TTAB 2011); *Tektronix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975). Thus, when used in connection with sun related products, as in this case, we find that the word "Solar" is highly suggestive and, therefore, the inclusion of "Solar" as a shared term in each mark is an insufficient basis in which to predicate a holding that the marks are similar, especially considering the different suffixes of each mark.

Furthermore, the parties stipulated that neither SOLARCAINE nor SOLARIN have any inherent meaning.<sup>5</sup>

Considering the marks in their entireties, we find that the marks differ so substantially in appearance, sound,

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<sup>4</sup> Stipulation of Facts, ¶38.

<sup>5</sup> Stipulation of Facts, ¶¶33 and 34.

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connotation and commercial impression that they are not similar and that their contemporaneous use by different parties will not result in confusion.

Decision: The opposition is dismissed.