

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed: October 24, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Aventis Pharmaceuticals Inc.

v.

Heal The World Inc.

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Opposition No. 91192046  
to application Serial No. 77671718  
and application Serial No. 77671728  
both filed on February 17, 2009

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G. Mathew Lombard of Lombard & Geliebter LLP for Aventis  
Pharmaceuticals Inc.

Anthony M. Verna III of Kravitz & Verna LLC for Heal The  
World Inc.

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Before Cataldo, Bergsman and Kuczma,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Heal The World Inc. ("applicant") filed intent-to-use applications for the marks LAZACOR (Serial No. 77671718) and LAZACOR + (Serial No. 77671728), in standard character form, for "homeopathic supplements," in Class 5. "Homeopathy" is a "therapy based on the premise that the most effective way to treat disease is to use drugs or other agents that produce the symptoms of the disease in healthy persons. In homeopathic therapy, for example, hot compresses are

prescribed for treating burns.”<sup>1</sup> A “homeopathic supplement,” therefore, is a “small dose of a pharmacologic [or chemical] agent that ordinarily mimics the symptoms produced by the condition being treated.”<sup>2</sup>

Aventis Pharmaceuticals Inc. (“opposer”) opposed the registration of applicant’s marks on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), and dilution under Section 43(c) of the Trademark Act of 1946, 15 U.S.C. § 1125(c). Specifically, opposer alleged ownership and prior use of the registered trademark NASACORT for a “steroid preparation for the treatment of allergic rhinitis,” in Class 5,<sup>3</sup> and that applicant’s mark LAZACOR, if used in connection with homeopathic supplements, so resembles opposer’s mark NASACORT for “steroid preparation for the treatment of allergic rhinitis” as to be likely to cause confusion.

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<sup>1</sup> Encyclopedia Americana (2011). The Board may take judicial notice of evidence in dictionaries, encyclopedias and other standard reference texts. *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). See also *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (encyclopedias may be consulted); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (online reference works which exist in printed format or have regular fixed editions); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980) (standard reference works).

<sup>2</sup> Stedman’s Medical Dictionary (28<sup>th</sup> ed. 2011).

<sup>3</sup> Registration No. 1538836, issued May 16, 1989; renewed. “Rhinitis” is an “inflammation of the nasal mucous membrane” “manifest by sneezing, rhinorrhea [nasal discharge], nasal congestion, pruritus [itching] of the nose, ears, palate.” Stedman’s Medical Dictionary.

Opposer further alleged that NASACORT has become famous and that applicant's use of LAZACOR will dilute the distinctiveness of opposer's NASACORT mark.<sup>4</sup>

Applicant, in its answer, denied the salient allegations in the notice of opposition.

#### Preliminary Matter

When the parties listed the record in their brief, opposer and applicant identified applicant's expert report and applicant identified the affidavit of Scott Scadron, founder of applicant.<sup>5</sup> However, applicant did not file either its expert report or the affidavit of Scott Scadron and, accordingly, we have been unable to consider them.

#### The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR

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<sup>4</sup> While opposer did not properly plead the fame of its mark *prior to the earliest date on which applicant can rely for purposes of priority*, because applicant did not move to strike the dilution claim for failure to state a claim and, in its brief, treated the dilution claim as if it were properly pleaded, we deem the dilution claim to have been amended by implied consent of the parties. See Fed. R. Civ. P. 15(b). In other words, we deem the dilution claim to allege that opposer's mark NASACORT became famous prior to the filing date of the applications at issue. See *UMG Recordings Inc. v. Mattel Inc.*, \_\_\_ USPQ2d \_\_\_ n.3 (2011). See also *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010), *aff'd* 637 F.3d 1344, 98 USPQ2d 1253.

<sup>5</sup> We note with approval the parties' stipulation to the introduction of testimony through declarations or affidavits.

§2.122(b). In addition, opposer introduced the evidence identified below.

1. Opposer's first notice of reliance on a certified copy of opposer's pleaded registration prepared by the U.S. Patent and Trademark Office showing the current status of and title to the registration;

2. Opposer's second notice of reliance on the expert report of Brad R. Newberg in rebuttal to applicant's expert report;<sup>6</sup> and

3. Opposer's third notice of reliance on the following items:

- a. Testimonial deposition of Timothy Tholen, opposer's Vice President of General Therapeutics and Lifecycle Management, with attached exhibits;
- b. An excerpt from applicant's website;
- c. Applicant's responses to opposer's interrogatories; and
- d. Documents produced in response to opposer's request for production of documents.

As indicated above, applicant did not take any testimony or introduce any evidence.

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<sup>6</sup> The Newberg expert report, prepared in rebuttal to applicant's expert report, was filed on February 14, 2011, during opposer's testimony period-in-chief, prior to the time that applicant's expert report could have been filed (had it been filed).

Standing

Because opposer has properly made its pleaded registration 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

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the products covered by the registration. *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).

A. The fame of opposer's marks.

This *du Pont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks

enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown.

*Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal

protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer sales of NASACORT nasal spray have been substantial. Opposer's sales from 2003 through 2008 are set forth below with the available corresponding market share in the field of inhaled nasal steroids.<sup>7</sup> The market share information is from "IMS Health, Inc., an independent company that researches, compiles and sells information about the pharmaceutical industry."<sup>8</sup>

Year	Sales	Market share
2003	\$229,000,000	No information
2004	\$275,000,000	No information
2005	\$266,000,000	13.4%
2006	\$266,000,000	12.1%
2007	\$301,000,000	11.3%
2008	\$259,000,000	9.5%

Opposer also asserts that "[i]n a survey conducted by SDI, **NASACORT/NASACORT AQ** was identified by 10.4% of

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<sup>7</sup> Tholen Dec., ¶¶28-30.

<sup>8</sup> Tholen Dec., ¶¶29-30.

respondents when asked what allergy medication first comes to mind.”<sup>9</sup>

Opposer provided its advertising expenditures for 2009 and 2010 under seal so we may only refer to them in general terms. Suffice it to say, opposer’s advertising expenditures were substantial. “Opposer currently places advertising and marketing materials for its

**NASACORT/NASACORT AQ** products/mark in the United States on the internet, printed hand-outs, other printed materials and the like.”<sup>10</sup>

While opposer has achieved commercial success and a high degree of renown, the evidence of record is not sufficient to establish that opposer’s NASACORT mark is famous for purposes of likelihood of confusion. For example, the evidence regarding consumer recognition of the mark NASACORT is not persuasive. Opposer referenced a survey by SDI, but opposer did not introduce the survey let alone identify SDI. Nor did opposer introduce any unsolicited media referencing the renown of its NASACORT products. Accordingly, we can only speculate about the actual impact of opposer’s mark on the minds of consumers. The evidence is indicative of the success of opposer’s

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<sup>9</sup> Tholen Dec., ¶32.

<sup>10</sup> Tholen Dec., ¶33.



product rather than the recognition of the fame of the mark. Nevertheless, in view of opposer's extensive sales, advertising expenditures and appreciable market share, we find that opposer's mark has a high degree of public recognition and renown.

B. The similarity or dissimilarity and nature of the products described in the applications and the registration.

Opposer's NASACORT mark is used to identify a "steroid preparation for the treatment of allergic rhinitis," a prescription product.<sup>11</sup> As indicated in footnote 3, "rhinitis" is an "inflammation of the nasal mucous membrane" "manifest by sneezing, rhinorrhea [nasal discharge], nasal congestion, pruritus [itching] of the nose, ears, palate." Mr. Tholen testified that NASACORT is used for "'the relief of seasonal and year-round nasal allergy symptoms.' It specifically alleviates stuffiness, sneezing, runny nose and itchy eyes."<sup>12</sup> Applicant's mark is intended to be used in connection with "homeopathic supplements." As indicated above, a homeopathic supplement is a small dose of a pharmacologic agent used to treat the symptoms of a condition, which, without any limitations in the description of goods, may include rhinitis. Because the scope of the registration applicant seeks is defined by its application

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<sup>11</sup> Tholen Dec., Exhibit B (Exhibit 007-9); opposer's Brief, p. 11.

<sup>12</sup> Tholen Dec. ¶23.

(and not by its actual use), it is the application (and not actual use) that we must look to in determining applicant's right to register:

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 sales of the goods are directed.

*Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Opposer introduced advertisements for ZICAM cold remedy products which are homeopathic products for, *inter alia*, the relief of nasal congestion and pressure, to show that homeopathic products may be used to treat nasal congestion and pressure.<sup>13</sup>

Applicant contends that it intends to sell "supplements," not drugs, that "[a] dietary supplement is a product taken by mouth that contains a 'dietary ingredient' intended to supplement the diet. The 'dietary ingredients' in these products may include: vitamins, minerals, herbs or

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<sup>13</sup> Tholen Dec., Exhibit D. Opposer also introduced evidence regarding applicant's use of LAZACOR mark in connection with libido enhancement, thus, distinguishing the products. However, as indicated above, because applicant did not restrict its description of goods to homeopathic supplements for the purpose of libido enhancement, we cannot consider opposer's evidence of applicant's actual use to distinguish the products.

other botanicals, amino acids, and substances such as enzymes, organ tissues, glandulars, and metabolites," and that dietary supplements are food, not drugs and every supplement must be labeled a dietary supplement.<sup>14</sup> The problem with applicant's argument is that even though homeopathic supplements and prescription drugs are not identical, applicant's use of the term "homeopathic supplements" in the description of goods means that the products are intended to treat symptoms of a condition which, in this case, may include rhinitis and nasal congestion and pressure.

We find that a prescription drug to treat rhinitis and a homeopathic supplement that may be used to treat rhinitis or nasal congestion and pressure are sufficiently related that if sold under the same or similar marks, they would be likely to cause confusion. While we have found that the goods of the parties are related, we do not agree with opposer's conclusion that the goods are identical.<sup>15</sup> There is simply not enough evidence and testimony to accurately compare and contrast opposer's "steroid preparation for the treatment of allergic rhinitis" and applicant's "homeopathic supplements" except for the conclusion that we reached that both products may be used to treat sinus problems.

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<sup>14</sup> Applicant's Brief, pp. 9-10, *citing* 21 U.S.C. §321.

<sup>15</sup> Opposer's Brief, pp. 22-23.

C. The similarity of or dissimilarity of the likely-to-continue trade channels and classes of consumers.

Opposer's "steroid preparation for the treatment of allergic rhinitis" is a prescription pharmaceutical sold through doctors and pharmacies. Because there are no restrictions as to channels of trade or classes of consumers in the description of goods in the applications, we may assume that applicant's "homeopathic supplements" will be sold in all of the normal channels of trade to all of the normal purchasers for such goods. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Toys R Us v. Lamps R Us*, 219 USPQ 340, 343 (TTAB 1983). In this case, however, there is no evidence regarding the channels of trade for homeopathic supplements. While opposer introduced evidence regarding ZICAM as a homeopathic remedy for, *inter alia*, nasal congestion and pressure, opposer did not introduce any evidence regarding the channels of trade for such homeopathic products. The only evidence regarding the channels of trade is applicant's responses to opposer's interrogatories. According to the record, applicant sells its products through the Internet. It does not sell through retail outlets or through wholesalers.<sup>16</sup>

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<sup>16</sup> Applicant's responses to opposer's Interrogatory No. 5.

Opposer asserts that although NASACORT is a prescription drug, someday it may be sold over the counter.

It is entirely possible that Opposer's **NASACORT** product will be available without a prescription, i.e., over-the-counter, at some future time. Many once-prescription-only products are ultimately made available over-the-counter. This is particularly true in the field of allergy treatments. Other such examples include: **CLARITIN**, **BENADRYL**, **TAVIST** and **ZYRTEC**. Indeed, Opposer's **ALLEGRA** preparation, also an allergy product, was recently launched as an OTC product in the United States. ... Thus, it is entirely possible, if not likely, that Opposer's **NASACORT** product will at some future time be available over-the-counter.<sup>17</sup>

With the exception of opposer's ALLEGRA preparation, there is no evidence regarding the sale of third-party products referenced by opposer. With respect to the ALLEGRA preparation, the evidence corroborating the sale of ALLEGRA over-the-counter was a press release (February 9, 2011) reporting that the FDA approved ALLEGRA "for over-the-counter use" to be launched in March. There was no follow-up evidence reporting on the actual sale of ALLEGRA as an over-the-counter product or the channels of trade in which ALLEGRA was sold. Furthermore, with respect to all of the products identified above in opposer's brief, there is no indication as to whether those products are homeopathic supplements. Finally, the possibility that one day in the

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<sup>17</sup> Opposer's Brief, p. 23.

future, NASACORT may be sold over-the-counter is not persuasive because we have to determine likelihood of confusion at the time of registration, not some day in the future.

In view of the foregoing, the *du Pont* likelihood of confusion factor regarding the channels of trade is neutral.

On the other hand, with respect to the class of purchasers, opposer's "steroid preparation for the treatment of allergic rhinitis" and applicant's homeopathic supplements that may be used to treat rhinitis or sinus congestion and pressure would be marketed to the same ultimate consumers, notwithstanding the fact that opposer's products are sold through doctors and pharmacies.

D. The conditions under which and buyers to whom sales are made (i.e., "impulse" vs. careful, sophisticated purchasing.

Considering the particular nature of the goods involved in this proceeding, purchasing decisions will not be made impulsively or carelessly, as would be the case when purchasing a snack which is inexpensive and subject to routine purchases, in contrast to the more deliberate purchase of a product to treat a physical ailment. In this regard, opposer's products are prescription drugs. The sale of prescription drugs is regulated and sold to consumers only under the supervision of a doctor who has identified a specific purpose in prescribing the product. While

applicant's homeopathic supplements are sold over-the-counter, the consumer is going to have a reasonably focused need for the product leading to an intellectual rather than emotional purchasing decision. Because of the importance of these products in treating physical ailments, the purchasers will undoubtedly exercise great care and correspondingly pay careful attention to the trademark for the products.

E. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683,

196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer will be an ordinary person with a sinus problem.

The marks NASACORT and LAZACOR are not similar in appearance. Considering the visual appearance of the marks NASACORT and LAZACOR in their entirety, as well as the significance of the first part of the marks (NASA vs. LAZA) in making an impression with consumers, the marks look different. *See Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) ("considering the marks NATROL and NATROSOL in their entirety, the clearly dominant aspect of both marks is that the first four letters and the final two are the same"). *See also Presto Products Inc. v. Nice-Pak Products, 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"); *see also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369,



73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Accordingly, we disagree with opposer's contention that "consumers are unlikely to focus on the minor differences between the parties' marks, namely the first letters ('N' vs. 'L') and the final letter of Opposer's Mark ('T'), and instead wrongly associate Applicant's goods with Opposer's famous **NASACORT** mark."<sup>18</sup>

Although noting that a side-by-side comparison is not the proper test for comparing marks,<sup>19</sup> opposer, in fact, engaged in side-by-side comparison to highlight the arguable visual similarities in the marks (e.g., almost the same number of letters, five of the letters are identical, and the same number of syllables).<sup>20</sup> However, the purchasing public does not indulge in such recognitional contortions but sees things as they are. *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988).

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<sup>18</sup> Opposer's Brief, pp. 20-21.

<sup>19</sup> Opposer's Brief, p. 17.

<sup>20</sup> Opposer's Brief, p. 20.

While there is no correct pronunciation for a trademark, NASACORT is likely to be pronounced nā/ zə kōrt (as in nasal and court). We note that while Mr. Tholen testified that opposer pronounces NASACORT as neiz/ ə kourt,<sup>21</sup> opposer's prescribing information pronounces it as na/ za-cort.<sup>22</sup> Applicant's mark LAZACOR is likely to be pronounced lā/ zə kōr. Mr. Tholen contends that LAZACOR will be pronounced laez/ ə/ kour.<sup>23</sup> In comparing the sound of the marks, we find that they share a similar cadence, rhythm and stress pattern.

With respect to meaning and commercial impression, both NASACORT and LAZACOR appear to be coined terms. However, the active ingredient in NASACORT is a "corticosteroid" and, therefore, the mark is suggestive as a combination of the word "Nasal" and "corticosteroid."<sup>24</sup> A "corticosteroid" is "a steroid produced by the adrenal cortex (i.e., adrenal corticoid)."<sup>25</sup> Thus, the mark NASACORT engenders the commercial impression of a steroid or corticosteroid for the nose. LAZACOR, on the other hand, appears to be an arbitrary term without any suggestive meaning or commercial impression.

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<sup>21</sup> Tholen Dec., ¶38

<sup>22</sup> Tholen Dec. Exhibit B (Exhibits 7-9).

<sup>23</sup> Tholen Dec., ¶40.

<sup>24</sup> Tholen Dec. Exhibit B (Exhibits 7-9) ("the active ingredient in NASACORT AQ Nasal Spray, is a corticosteroid").

<sup>25</sup> Stedman's Medical Dictionary.

In view of the foregoing, we find that the dissimilarity in the appearance, meaning and commercial impression of the marks NASACORT and LAZACOR outweigh the similarity in the sound of the marks and, therefore, we find that the marks are dissimilar.

D. Balancing the factors.

Despite the commercial success of opposer's NASACORT prescription nasal spray and the presumptive similarity of the goods and purchasers, because the marks NASACORT and LAZACOR and LAZACOR + are not similar and because the consumers will exercise a high degree of consumer care, we find that applicant's use of LAZACOR and LAZACOR + for "homeopathic supplements" is not likely to cause confusion with the mark NASACORT for a "steroid preparation for the treatment of allergic rhinitis."

In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Dilution

In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. Sections

13 and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063 and 1125(c).

The Lanham Act provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Opposer contends that applicant's marks will "blur" the distinctiveness of opposer's mark.<sup>26</sup> The Lanham Act defines dilution by blurring as follows:

"dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.<sup>27</sup>

With respect to fame, the dilution analysis requires consideration of the following issues:

1. Whether NASACORT is a famous mark;
2. Whether NASACORT became famous prior to the filing date of applicant's applications (February 17, 2009); and,
3. Whether LAZACOR is likely to cause dilution by blurring of the distinctiveness of NASACORT.

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<sup>26</sup> Opposer's Brief, p. 28.

<sup>27</sup> Section 43(c)(2)(B) of the Lanham Act, 15 U.S.C. §1125(c)(2)(B).

A. Whether opposer's mark is famous for purposes of dilution?

Because we have already found that opposer's mark is not famous for purposes of likelihood of confusion, it is not famous for purposes of dilution. Fame for likelihood of confusion and dilution is not the same. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot, supra*, 73 USPQ2d at 1694; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - it either exists or it does not exist. *Id.*; see also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion "[f]ame is relative . . . not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1<sup>st</sup> Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection"). If a mark is not famous for likelihood of confusion, it will not be famous for dilution.

In the event of an appeal and a finding by the reviewing court that NASACORT is famous for purposes of likelihood of confusion, we explain below why the mark is not famous for purposes of dilution. In *Toro*, we described the requirements for proving that a mark is famous:

While the eight statutory factors are a guide to determine whether a mark is famous,<sup>28</sup> ultimately we must consider all the evidence to determine whether opposer has met its burden in demonstrating that the relevant public recognizes the [NASACORT] mark as "signifying something unique, singular, or particular." H.R. REP. NO. 104-374, at 3 (1995). Because famous marks can be diluted by the use of similar marks on non-competitive goods and services, the owner of a famous mark must show that there is a powerful consumer association between the term and the owner.

\* \* \* \*

Fame for dilution purposes is difficult to prove.

\* \* \* \*

Therefore, an opposer . . . must provide evidence that when the public encounters opposer's mark in almost any context, it associates the term, at least initially with the mark's owner. . . . Examples of evidence that show the transformation of a term into a truly famous mark include:

1. Recognition by the other party.
2. Intense media attention.

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<sup>28</sup> The Act has subsequently been amended to list four non-exhaustive factors. 15 U.S.C. §1143(c)(2).

3. Surveys.

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But in order to prevail on the ground of dilution the owner of a mark alleged to be famous must show a change has occurred in the public's perception of the term such that it is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods or services.

*Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1180-1181. In other words, "the transformation of a term into a truly famous mark" means that "the mark must be a household name." *Thane International, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9<sup>th</sup> Cir. 2002).

Opposer's evidence regarding fame is recounted earlier in this decision. This evidence is not sufficient to show that opposer's mark is famous for purposes of dilution. In concluding that opposer has not met the stringent requirements of proving fame for purposes of dilution, we note that opposer's evidence of fame falls far short of the quantum and quality of evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003), that was found sufficient to prove that opposer's mark was famous for dilution purposes. In *NASDAQ Stock Market Inc.*, opposer introduced market studies demonstrating that the awareness of opposer's stock market among investors reached more than 80% in 1999. In this case, opposer's testimony

regarding brand awareness is of dubious probative value because opposer did not proffer the study into evidence nor did opposer proffer a witness with first-hand knowledge of the study to explain how the study was conducted and the significance of the study. In addition, the opposer in *NASDAQ Stock Market Inc.* introduced dictionary references, newspaper and magazine articles, and stock market reports that evidenced a widespread recognition of opposer's mark, beyond just investors. In this case, opposer failed to introduce any media evidence showing a widespread recognition of opposer's mark to the general population. On this record, there is no basis to find that opposer's mark has been transformed into a household name.

In view of the foregoing, we find that opposer has not established that NASACORT is famous for dilution purposes.

B. When opposer's mark became famous?

Even assuming that opposer's mark is famous for purposes of dilution, we cannot determine when opposer's mark became famous. Since applicant's applications are based on intent to use, opposer must prove that its marks became famous prior to the filing date of the applications (February 17, 2009). Mr. Tholen's testimony regarding the SDI brand awareness survey did not include the date when the survey was conducted.<sup>29</sup> Moreover, Mr. Tholen's testimony

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<sup>29</sup> Tholen Dec. ¶32.



regarding opposer's advertising expenditures covered only the years 2009 and 2010.<sup>30</sup> Accordingly, the only relevant evidence regarding the date when opposer's mark became famous is Mr. Tholen's testimony regarding the commercial success of the NASACORT product (*i.e.*, substantial revenues and significant market share) from 2003 through 2010.<sup>31</sup> As previously noted, the revenue and market share information show that NASACORT is commercially successful, but not the impact of the mark on consumers. In view thereof, we find that opposer failed to meet its burden of proving that its NASACORT mark became famous prior to the filing date of the applications at issue.

On this record, opposer cannot prevail on its dilution claim because we have found that opposer has not met its burden of proving that its mark is famous for purposes of dilution or that its mark became famous prior to the filing date of applicant's applications.

**Decision:** The opposition is dismissed and notices of allowance will be issued to applicant in due course.

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<sup>30</sup> Tholen Dec. ¶31.

<sup>31</sup> Tholen Dec. ¶¶28-30.