

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
November 29, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Chattem, Inc.

v.

Kirk Seubert and James Spencer

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Opposition No. 91200421  
to application Serial Nos. 85217060 and 85217088  
filed on January 13, 2011

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Douglas T. Johnson of Miller & Martin PLLC for Chattem,  
Inc.

Nancy Lord of Nancy Lord Ltd for Kirk Seubert and James  
Spencer.

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Before Seeherman, Taylor and Wolfson, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On January 13, 2011, Kirk Seubert and James Spencer,  
two individuals filing as joint applicants, filed intent-  
to-use applications to register the mark ACTRX in standard

characters<sup>1</sup> and in stylized form, as shown below,<sup>2</sup> for "dietary and nutritional supplements; nutritional supplement for eliminating toxins from the body; nutritional supplements."



Signal Investment & Management Co. (hereafter "Signal") filed a notice of opposition to the registration of the marks; subsequently this company advised the Board that it had merged with and into Chattem, Inc. (hereafter "Chattem"). The Board then substituted Chattem as the opposer. Hereafter, unless specifically noted, "opposer" will be used to refer to both Signal and to Chattem.

As grounds for opposition, opposer has alleged that it is the owner of registrations for the mark ACT for an anti-cavity mouth rinse<sup>3</sup> and ACT RESTORING, with RESTORING

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<sup>1</sup> Application Serial No. 85217060.

<sup>2</sup> Application Serial No. 85217088. The application includes the following description of the mark: The mark consists of the letters "A", "C", and "T" in green, block type and slightly slanted with the "A" larger than the "C" and the "T", followed by the letters "R", and "X" in blue and slightly slanted with "R", and "X" in blue and slightly slanted with "R" larger than the "X" and the "X" as a subscript.

The color(s) green, blue is/are claimed as a feature of the mark.

<sup>3</sup> Registration No. 2988776, issued August 30, 2005; Section 8 affidavit accepted; Section 15 affidavit acknowledged. The notice of opposition included, as an exhibit, the electronic record of this registration, showing status and title in Signal Investment & Management Co., the entity that filed the

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disclaimed, for anti-cavity mouthwash and dental rinse<sup>4</sup>; that it, its licensees and predecessors have been manufacturing, licensing and marketing anti-cavity mouth rinses and mouth washes under the ACT mark since as early as April 1982; that since long prior to the January 13, 2011 filing date of applicants' applications opposer has sold anti-cavity mouth rinses under the mark ACT; that opposer sells a variety of anti-cavity mouth rinses and anti-cavity mouthwashes under the mark ACT; that opposer's ACT mouthwashes and rinses are one of the top five brands in this category; that because of the similarities in the marks and the goods and trade channels, applicants' marks are likely to cause confusion or mistake or to deceive;

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opposition. Accordingly, the registration is of record pursuant to Trademark Rule 2.122(1). With its motion to substitute Chattem Inc. as a party, opposer submitted a copy of the articles of merger by which Signal Investment & Management Co. was merged into Chattem Inc., and an electronic copy of the registration, showing ownership in Chattem, Inc.

<sup>4</sup> Registration No. 3317340, issued October 23, 2007. The notice of opposition included, as an exhibit, the electronic record of this registration, showing status and title in Signal Investment & Management Co., the entity that filed the opposition. Accordingly, the registration is of record pursuant to Trademark Rule 2.122(1). With its motion to substitute Chattem Inc. as a party, opposer submitted a copy of the articles of merger by which Signal Investment & Management Co. was merged into Chattem Inc., and an electronic copy of the registration, showing ownership in Chattem, Inc. At the time the notice of opposition was filed, and at the time the updated status and title copy of the registration was submitted, the registration was not due for the filing of a Section 8 affidavit. In accordance with Board practice, we have ascertained that a Section 8 affidavit for the registration has now been accepted, and a Section 15 affidavit has been acknowledged.

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that opposer's mark ACT became famous prior to the filing of the applications for applicants' marks, and that applicants' ACTRX marks are likely to dilute by blurring the distinctiveness of opposer's ACT marks.<sup>5</sup>

Applicants have denied the salient allegations of the notice of opposition, and have asserted what they characterize as "affirmative defenses." Paragraph 24 appears to be an admission regarding opposer's use of the mark ACT in its advertising rather than being an affirmative defense: "opposer uses the mark ACT in all commercially significant advertising and promotion of its anti-cavity mouth wash, mouth wish [sic], and dental rinse." Paragraph 25 appears to be an attack on the registrations, asserting that the marks "have lost the ability to serve as source identifiers for Opposer." However, because applicants have not counterclaimed to cancel the registrations, this assertion can be given no consideration. Paragraph 26 is a denial that opposer's pleaded marks are famous for purposes of proving dilution (in effect, a repetition of the denial of this allegation

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<sup>5</sup> We note that opposer claimed that its ACT mark (singular) became famous prior to the filing of applicants' applications and prior to any use of applicants' marks, ¶ 23, but asserted dilution of opposer's ACT marks (plural). ¶ 24.

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in the notice of opposition). Thus, we do not consider these assertions to be valid affirmative defenses.

In considering what material is of record, we first address opposer's objections to applicants' notice of reliance. Opposer argues that the notice of reliance was untimely because it was filed after the close of applicants' testimony period, and therefore should not be considered. The Board's April 16, 2013 order set May 26, 2013 as the date for applicants' trial period to close. That date was a Sunday, and Monday, May 27, was Memorial Day, a Federal holiday. Therefore, in accordance with Trademark Rule 2.196, applicants had until Tuesday, May 28, to file their notice of reliance. ("When the day, or the last day fixed by statute or by regulation under this part for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday.")<sup>6</sup> Applicants filed their notice of reliance on Wednesday, May 29, 2013, one hour after the midnight deadline. In their notice, applicants requested a one hour extension of their testimony period,

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<sup>6</sup> Opposer has misstated the deadline for filing the notice of reliance as May 27, apparently not realizing that May 27, 2013 was Memorial Day.

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explaining that their attorney lives in a rural town in Nevada and had technological issues that required a 150-mile round trip into Las Vegas for equipment and delayed the filing until after 9:00 pm Pacific Time, resulting in the filing of the document after midnight in Washington, DC.

Given the circumstances, including the de minimis delay, we find that applicants have met the standard for excusable neglect, and we hereby reopen their testimony period so that the filing of the notice of reliance will be treated as timely. See *FirstHealth of the Carolinas Inc. v. CareFirst of Maryland Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) (Board has discretion to reasonably interpret the meaning of "excusable neglect" in the context of its own regulations).

Opposer also objects that, although "the Notice purports to make of record some 36 official records and publications, yet only three publications are attached as exhibits." Brief, p. 3. In actuality, the notice of reliance lists, under "1. Official Records of the United States Patent and Trademark Office," 30 application serial numbers and marks, and the registration numbers for those marks that have been registered. However, as opposer has pointed out, the applications and/or registrations

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themselves have not been submitted. Applicants did not attempt to submit the documents when this was brought to their attention by opposer's objection, nor do we have any explanation from applicants as to why the documents were not submitted, since applicants did not submit a trial brief. Clearly we cannot consider evidence that was never made of record, and to this extent, opposer's objection is sustained. As for the remaining documents, listed as "2. Printed publications from the Internet," one of the documents (Exhibit EE), purporting to show opposer's use of its mark, does not include the URL and the date it was printed, and therefore does not meet the requirements for making Internet material of record by notice of reliance. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).<sup>7</sup>

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<sup>7</sup> Even if this document were properly of record, it would not affect our decision herein. Applicants state in their notice of reliance that this exhibit, EE, shows the opposer's mark in several colors, and exhibits FF and GG "show its blatant infringement with Wal-mart's Equate product that the Opposer has done nothing to abate." Although applicants did not file a brief, and therefore have not further explained their position, it appears that they are making some sort of laches claim regarding opposer's asserted inaction with respect to the activities of a third party. Applicants never asserted laches as an affirmative defense and, therefore, to the extent they were attempting to raise such a claim in their notice of reliance, it is untimely. We also point out that a party cannot claim that a plaintiff is barred by laches from taking action against a defendant based on a claim of inaction by the opposer toward a third party.

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The record, then, includes the pleadings; the files of the opposed applications; and the testimony of Andrea Crouch, vice president of brand management for opposer Chattem. Opposer also made of record, through its first notice of reliance, its requests for admission served on applicants; because applicants failed to answer them, they are deemed to be admitted. See Fed. R. Civ. P. 36(a)(3): "A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney." Applicants do not contend that they served responses to the requests for admission, nor have they moved to withdraw or amend the deemed admissions. Thus, the requests for admission submitted with opposer's first notice of reliance are deemed admitted. With its second notice of reliance, opposer submitted specimens from the file of a third party's registration for DENTAPLEX, as well as a copy of the registration certificate; and pages from various websites, for the purpose of showing the meaning of Rx and the sale of nutritional and dietary supplements for oral health.

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Applicants did not take any testimony.<sup>8</sup> As discussed infra, the documents it submitted by notice of reliance, and which were acceptable to be made of record by this means, are their exhibits FF and GG, which are webpages from the Walmart.com website.

Only opposer filed a brief.

Standing

As noted, the opposition was brought by Signal which, at the time the notice of opposition was filed, was the owner of the pleaded registrations. Patent and Trademark Office records show that this company merged into Chattem in 2012. Andrea Crouch, Chattem's vice president of brand management, testified that Chattem acquired the ACT brand from Johnson and Johnson in 2007, and she was not aware of any company called Signal. There is no further explanation about the relationship between Signal and Chattem, such as, for example, that it was operating as part of Chattem in such a way that Ms. Crouch would not have been aware that it was a separate company. What is clear is that Signal owned the registrations for the marks at the time the oppositions were filed, that Chattem now owns the

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<sup>8</sup> Their notice of taking testimony of applicant James Spencer by written questions was the subject of opposer's motion to quash. Because applicants did not respond to this motion, it was granted as conceded.

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registration through the merger of Signal into Chattem, and that Chattem's activities in marketing and selling the ACT-branded products were for the ACT marks owned by Signal at one time. See *Somerset Distilling Inc. v. Speymalt Whisky Distributors Ltd.*, 14 USPQ2d 1539, 1541 (TTAB 1989)

(although witness's testimony failed to delineate relationship between owner of registration and opposer, it is clear that the sales and promotion of the trademarked products referred to the mark owned by opposer). Because both Signal and Chattem have shown that at the time Signal brought this proceeding, and during Chattem's prosecution of it, they were not mere intermeddlers, they each have established their standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority

Because opposer has made its pleaded registrations of record, priority is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, opposer has established its earlier use. Opposer has shown that its predecessor-in-interest, Johnson and Johnson, introduced ACT oral care products in the early 1980s, far earlier than the January 13, 2011

filing date of applicants' applications which, in the absence of any evidence as to applicants' use, is the earliest date on which they can rely.

Likelihood of Confusion

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

We begin with the factor of fame, since fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Opposer did not acquire the mark ACT until 2007, and did not provide sales and advertising figures prior to that time. However, it did submit limited evidence showing that the mark ACT was first used by Johnson and Johnson in the early 1980s, and was promoted by that company; specifically, opposer submitted ads and press releases from the Johnson and Johnson files, including an ad in the November/December 2004 *Journal of Practical Hygiene and Oral Hygiene*, an ad from May 2004 in

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Parents.Com, and a press release, dated January 20, 2004, announcing a relationship with celebrity spokesperson Lisa Rinna in connection with the launch of its ACT Plus Freshening product.

Sales of ACT oral care products were \$62 million in 2008, \$72 million in 2009, \$75 million in 2010, \$76 million in 2011 and \$81 million in 2012, while opposer's advertising expenditures for those years were, respectively, \$8 million, almost \$13 million, \$11 million, \$10 million and \$11 million. Ms. Crouch testified that advertising is primarily done through television, but that opposer also uses print advertising, radio and digital media. Opposer promotes its ACT products to dentists and dental hygienists using direct mail, print ads in professional journals, exhibits at trade shows, and samples provided to dentists. Approximately \$800,000 of its sales come through professional coupons that dentists give their patients, and opposer also sells about \$2 million worth of products directly to dental offices.

Opposer's witness testified that ACT oral care products are among the leading brands in the industry; in retail sales, it ranks at either three or four in the category, with LISTERINE being number one, CREST number two, and ACT and SCOPE battling it out for numbers three

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and four. Ms. Crouch also testified, in terms of dental professionals, that ACT is the number one fluoride mouthwash recommended by dentists and dental hygienists, test., p. 14, although she did not give any details as to how that information was obtained.

Although opposer's sales and advertising figures for 2012 and the preceding four years are in the millions, raw numbers alone are not necessarily sufficient to prove fame, since such figures may be misleading. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). For example, the ranking of ACT products at either three or four for retail sales could represent a limited market share, as compared with the brands ranking number one and number two. Opposer has not provided evidence of its actual market share, so that we would have some context for its sales ranking and sales figures. Opposer's evidence regarding its promotional efforts is quite limited; although Ms. Crouch testified in general terms that "We primarily use television advertising, but we've also used print advertising, radio, digital, and then we have an important professional effort, as well," p. 8, opposer did not present details about its advertising to the general public, such as number of minutes of television advertising in a year, the television

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channels and programs on which the ads appeared, the publications and dates of its print advertising, etc.<sup>9</sup> 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. *Edward Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). We find that opposer has not met its burden of proving that the ACT mark is famous.<sup>10</sup> However, the evidence that it has submitted, along with the fact that ACT is an arbitrary term for mouthwashes and dental rinses, is sufficient to show that ACT is a strong mark; to this extent, this du Pont factor favors opposer.

Turning next to the marks, applicants' marks ACTRX and ACTRX in stylized form are very similar to opposer's mark ACT; the only difference is that applicants' mark also

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<sup>9</sup> Ms. Crouch mentioned in passing that "we had utilized Christie Brinkley when we utilized ACT Total Care," test. p. 17, but this was the extent of the information; no other details about the advertising campaign were provided.

<sup>10</sup> Nor has opposer submitted evidence that would show fame of opposer's other pleaded mark, ACT RESTORING.

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includes "RX."<sup>11</sup> Opposer has submitted evidence that RX means "a medical prescription,"<sup>12</sup> as well as evidence that "RX," is used by third parties, including several state prescription programs, thus showing that consumers understand this meaning of the term. See, for example, New York City website page entitled "Big Apple Rx-Free Prescription Discount Card," Exhibit 7 to opposer's second notice of reliance. Applicants are also deemed to have admitted, by not responding to the requests for admission, that their goods "will only be sold as prescription medicines." Request for Admission 1. As a result, consumers will view the RX portion of applicants' marks as describing a characteristic of the goods, and will consider the word ACT as the source-identifying element. Further, even if applicants' marks were to be used in connection with non-prescription supplements, the RX portion of their marks would have a suggestive connotation, indicating that

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<sup>11</sup> Opposer has confined its arguments regarding likelihood of confusion to its mark ACT, and we therefore do the same. We also point out that because opposer's ACT mark is arguably closer to applicants' marks than its ACT RESTORING mark, if likelihood of confusion is found on the basis of this mark, that would be a sufficient basis on which to sustain the opposition, and there would be no need to consider the issue of likelihood of confusion with respect to ACT RESTORING. On the other hand, if there were no likelihood of confusion between applicants' marks and ACT, there would be no likelihood of confusion with ACT RESTORING. See Max Capital Group Ltd., 93 USPQ2d 1243 (TTAB 2010).

<sup>12</sup> Merriam-Webster Unabridged, Exhibit No. 3 to opposer's second notice of reliance.

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the supplements are of a greater strength or efficacy, similar to that of a prescription product. It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Because, for the aforesaid reason, we give greater weight to the element ACT in applicants' marks, we find that opposer's mark ACT and applicants' marks are similar in appearance, pronunciation, connotation and commercial impression.

As for the goods, opposer has submitted evidence that nutritional supplements can be used for oral health. See, for example, Exhibit 2 to second notice of reliance, for Dentaplex, advertised as a "Vitamin Mineral Supplement for Healthy Teeth & Gums," and stating on its label: "A nutritional supplement designed for optimal oral health"; Exhibit 13 for Pharmaden line of pharmaceutical grade nutritional supplements sold through dental professionals; and Exhibit 14, for Pro Flora Oral Health by BioGenesis, described as a "unique, chewable probiotic formula

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specifically formulated to support the oral and nasal cavities." Thus, applicants' goods and opposer's anti-cavity mouth rinse are complementary in nature, in that both can be used for oral health. In addition, opposer has shown that companies that make and sell prescription drugs may also make and sell mouth rinses; specifically, opposer itself has sold the prescription drug Allegra, as well as its ACT fluoride mouthwash.<sup>13</sup>

Applicants, through their deemed admissions, have admitted that their goods will be sold through drug stores, food and grocery stores, mass merchandisers, internet retailers, mail order, vitamin and nutraceutical specialty retailers and health care professionals. Opposer's ACT products are sold in food, drug and mass accounts and through online retailers such as Drugstore.com.

We recognize that applicants' goods, according to their admission, will be sold only as prescription medicines. However, this does not obviate the likelihood of confusion. First, even though applicants' goods will be obtained at a prescription counter, and opposer's goods are sold "over-the-counter," i.e., available on store shelves for self-service pick-up, the same classes of consumers,

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<sup>13</sup> The Allegra allergy medication was a prescription product until 2011, when it became available over-the-counter.

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namely, the general public, will encounter both goods, and because of the related nature of their purposes, may even purchase both in the course of a single shopping trip. This can lead to reverse confusion, as a consumer who has just picked up oral care supplements bearing applicants' ACTRX or ACTRX (stylized) marks and who sees ACT on an anti-cavity mouth rinse is likely to assume that the latter product emanates from the same source as the prescription product. Second, the fact that applicants' goods are currently intended to be sold only as prescription products does not mean that they must always be sold in this manner. Applicants' goods are identified in their applications simply as "dietary and nutritional supplements; nutritional supplement for eliminating toxins from the body; nutritional supplements." This identification encompasses non-prescription goods as well. Because registrations issuing from these applications would entitle applicants to use their marks on any of the goods falling within the identification, we must presume that their goods encompass non-prescription oral health supplements. See Section 7(b) of the Trademark Act, (a registration is prima facie evidence of the owner's exclusive right to use the mark in connection with the goods or services specified in the certificate); *In re Smith and Mehaffey*, 31 USPQ2d 1531,

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1532 (TTAB 1994) (we must consider the goods to travel in all channels appropriate for goods of this type). Such non-prescription oral health care supplements could be found near other oral health care products, such as opposer's mouth rinse.

The du Pont factors of the relatedness of the goods and the channels of trade favor opposer.

As for the conditions of purchase, we find that applicants' products would be purchased with care. If they were sold as prescription products, the dispensing pharmacists would be providing them, and they must be considered sophisticated and careful. If the goods were sold as non-prescription items, because of their nature as supplements it is fair to assume that the purchasers would exercise some degree of care in choosing them. As a result, this du Pont factor would favor applicants. However, even careful purchasers are not likely to recognize that ACTRX and ACTRX (stylized) for supplements represent a separate source from ACT anti-cavity mouth rinse. Although we accept that consumers will note the additional element RX in applicants' marks, because of the suggestive or descriptive meaning of this element with respect to the products, they are likely to view ACT as the source-identifying element of the mark, and assume that the

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supplements emanate from the same source as ACT anti-cavity mouth rinse. This is particularly true because opposer uses ACT in combination with other terms, e.g., ACT TOTAL CARE, ACT ANTICAVITY KIDS, ACT RESTORING.

Opposer has noted that there is no evidence of actual confusion, but also points out that such evidence is not necessary in order to prove likelihood of confusion, and that here, where there is no evidence that applicants have actually used their marks, "there could hardly be any evidence of actual confusion." Brief, p. 13. We agree. This du Pont factor is neutral.

These are the only du Pont factors discussed by opposer, and on which any evidence has been submitted. To the extent that any other du Pont factors are considered to be relevant, we treat them as neutral.

As discussed above, we find that the du Pont factors of the similarity of the marks, goods, channels of trade and the strength of opposer's mark ACT favor opposer. Although the factor of the conditions of purchase favor applicants, the other factors far outweigh this one; while consumers will note the differences in the marks, this will not result in their concluding that the marks represent different sources for the goods.

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The opposition on the ground of likelihood of confusion between opposer's mark ACT and applicants' marks is sustained.

Dilution

One of the requirements for finding dilution is that the plaintiff's mark must be famous. See Section 43(c) of the Trademark Act. Because we have found that opposer's mark is not famous for likelihood of confusion purposes, it cannot be treated as famous for the ground of dilution. Accordingly, opposer has failed to prove an essential element of the dilution claim, and the opposition on the ground of dilution is dismissed.

Decision

The opposition is sustained solely on the ground of likelihood of confusion based on opposer's mark ACT for anti-cavity mouth rinse.