

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: November 13, 2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Synthon Holding B.V.

Serial No. 87464096

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of Rothwell, Figg, Ernst & Manbeck P.C.
for Synthon Holding B.V.

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Mary I. Sparrow, Managing Attorney.

Before Mermelstein, Lynch, and Larkin,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Synthon Holding B.V. (“Applicant”) seeks registration on the Principal Register of the mark SYNTHON in standard characters for the following goods and services:

Pharmaceutical preparations, substances and compositions for the treatment of cancer, multiple sclerosis and disorders of the central nervous system, neoplasms

and autoimmune diseases and those intended for the treatment of kidney and genitourinary disorders, cardiovascular disorders, metabolic and gastric disorders, blood disorders, bone disorders, hormonal disorders, treatment of pain, fungal and bacterial diseases and preparations used in the management of anesthesia; biological and biochemical drug and cultures for medical use, namely, biological tissue cultures for medical purposes; culture fluids for cultivating human, and animal cells and plants, plant cells and plant tissues; culture media for cultivating human, and animal cells and plants, plant cells and plant tissues; culture media for use in culturing eukaryotic cells; pharmaceutical biological and biochemical drugs for the treatment of neoplasms and autoimmune disease, in Int. Class 5;

Office functions relating to the registration of pharmaceutical preparations and components and pharmaceutical drugs; office functions relating to obtaining pharmaceutical registrations and compiling pharmaceutical registration files; business mediation of agreements regarding the purchase, sale and licensing of pharmaceutical registrations and pharmaceutical registration dossiers; business advice and information; business consultation; procurement of contracts for others for the purchase and sale of goods; business services, namely, compiling of pharmaceutical registration dossiers for others, in Int. Class 35;

Treatment of materials for the manufacture of pharmaceutical and biopharmaceutical preparations; manufacture, for others, of pharmaceutical and biopharmaceutical preparations and raw materials for the pharmaceutical industry, all in the field of treatment of cancer, multiple sclerosis and disorders of the central nervous system, neoplasms and autoimmune diseases and those intended for the treatment of kidney and genitourinary disorders, cardiovascular disorders, metabolic and gastric disorders, blood disorders, bone disorders, hormonal disorders, treatment of pain, fungal and bacterial diseases and preparations used in the management of anesthesia, in Int. Class 40;

Scientific laboratory services; scientific research and development; scientific and technological services, namely,

scientific analysis and testing services in the field of pharmaceuticals and pharmaceutical ingredients; scientific consultation services in the field of pharmaceuticals and pharmaceutical ingredients; scientific investigations for medical purposes; pharmaceutical research and development; pharmaceutical drug development services; laboratory research services relating to pharmaceuticals; consulting services in the fields of biotechnology and pharmaceutical research and development; biomedical research and consultancy; medical research; medical laboratories; chemistry and biology laboratories; scientific laboratory services; development of pharmaceutical products and ingredients; providing medical and scientific research information in the field of pharmaceuticals; providing medical and scientific research information in the field of clinical trials; quality management services, namely, quality evaluation and analysis, quality assurance and quality control, in the field of pharmaceuticals; laboratory research and laboratory analysis services relating to pharmaceuticals and pharmaceutical ingredients; research and scientific design of pharmaceutical products and ingredients for the pharmaceutical industry; research and development in the field of oncology, central nervous system, neoplasms and autoimmune diseases and life-threatening diseases; drug discovery; product quality testing; conducting clinical trials for pharmaceutical preparations; conducting quality control of pharmaceutical preparations; providing information and data relating to pharmaceutical research and developments, biopharmaceutical research and developments and medical research and developments, all in the field of treatment of cancer, multiple sclerosis and disorders of the central nervous system, neoplasms and autoimmune diseases and those intended for the treatment of kidney and genitourinary disorders, cardiovascular disorders, metabolic and gastric disorders, blood disorders, bone disorders, hormonal disorders, treatment of pain, fungal and bacterial diseases and preparations used in the management of anesthesia, in Int. Class 42;

Legal services relating to obtaining pharmaceutical registrations and compiling pharmaceutical registration files; providing legal services and information in the field

of intellectual property; legal advice in the field of intellectual property, in Int. Class 45.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark SYNTHEON in standard characters for the following services:

Custom manufacture of medical devices; Manufacture of medical devices to order and/or specification of others; Manufacturing services for others in the field of medical devices in Int. Class 40;

Design and testing for new medical device product development; Development of new technology for others in the field of medical devices; Industrial research in the field of medical devices; Medical and scientific research in the field of medical devices; Medical device research; Medical device research and development; Research and development and consultation related thereto in the field of medical devices; Research and development for new medical device products for others; Scientific research and development of medical devices; Medical device product development consultation; Medical device product development for others in Int. Class 42.²

After the Examining Attorney made the refusal final, Applicant appealed. For the reasons set forth below, we affirm in part and reverse in part the refusal to register.

II. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors

¹ Application Serial No. 87464096 is based on Sections 1(b) and 44(e) of the Trademark Act, 15 U.S.C. §§ 1051(b) & 1126(e), and has a filing date of May 25, 2017.

² Registration No. 3625206 issued May 26, 2009 on the Principal Register and has been renewed.

to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). “[I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the identification of goods [or services] within a particular class in the application.” *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126, n.5 (TTAB 2015); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

A. Similarity of the Marks

We first turn to the *du Pont* factor comparing the applied-for and cited marks, which we consider “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Coach Servs. v.*

Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

SYNTHON and SYNTHEON vary by only one letter, resulting in a similar appearance and sound. While Applicant correctly notes that the additional “E” in the cited mark may result in an additional syllable as the mark is likely to be pronounced, we nonetheless find this variation relatively insignificant. The marks look similar and would sound similar when consumers call for the goods or services with which they are used. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012). Also, regardless of the variation in pronunciation of the last syllable, consumers who hear the marks spoken by others might not notice, or could easily forget, the difference. *See id.* at 1912; *In re Energy Telecomms. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983) (“Slight differences in the sound of similar marks do not avoid a likelihood of confusion.”). We remain mindful that “marks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). The record lacks evidence that SYNTHON and SYNTHEON have any meaning. Rather, both appear to be coined terms and we therefore also find the connotation and commercial impression to be similar because the spelling and pronunciation is so similar. This *du Pont* factor weighs in favor of likely confusion.

B. The Goods and Services

“[L]ikelihood of confusion can be found ‘if the respective products [and services] are related in some manner and/or if the circumstances surrounding their marketing

are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.* 101 USPQ2d at 1722 (internal citations omitted). The relatedness of goods and services must be supported by substantial evidence. *Viterra*, 101 USPQ2d at 1907.

In analyzing the second *du Pont* factor, we look to the identifications in the application and cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The Examining Attorney argues very generally that “in the industries of pharmaceuticals and medical devices the goods and services in question are related.”³ Despite Applicant’s five classes of goods and services, the Examining Attorney’s Brief contains only three sentences on the relatedness of the goods and services, pointing to four examples of evidence in the record she says show that “pharmaceutical and pharmaceutical research companies also provide and develop medical devices.”⁴ This is the extent of the discussion, and her brief does not otherwise address the relatedness of Applicant’s specifically identified goods and services, even to explain or set forth the evidence of relatedness as to at least one good or service in each of the five international classes in the application as compared to at least one service recited in the Registration.

³ 7 TTABVUE 5 (Examining Attorney’s Brief).

⁴ *Id.*

While we agree that some of the evidence suggests that certain providers of goods and services generally cater to both the pharmaceutical and medical device industries,⁵ we cannot paint with such a broad brush in determining relatedness under this factor. We must turn to the prosecution history of the application to review the evidence and consider, on a class-by-class basis, whether substantial evidence shows the relatedness of at least one good or service per class to at least one service in the cited registration. *See Aquamar, Inc.*, 115 USPQ2d at 1126 n.5. The record does not contain third-party registrations as evidence under this *du Pont* factor. Instead, the evidence consists of webpages of various different types of businesses, ranging from legal and communications consultants to technical experts and engineers, to contract manufacturers, to pharmaceutical or medical device industry consultants.⁶

First, as to Applicant's Class 5 goods, the record lacks evidence that consumers are accustomed to encountering pharmaceutical products such as Applicant's under the same mark as medical device-related services such as Registrant's. While several websites introduced by the Examining Attorney involve consultants or experts who serve both pharmaceutical companies and medical device manufacturers, there is no

⁵ *E.g.*, June 22, 2017 Office Action at 14, 19 (plm.automation.siemens.com) (the Siemens website has a page entitled "Medical Devices and Pharmaceuticals"); *id.* at 20 (mckinsey.com) (website of McKinsey features the heading "Pharmaceuticals & Medical Products" and states, "Our R&D clients include major pharmaceutical companies, medical device manufacturers...").

⁶ Some of the Examining Attorney's evidence seems to involve only pharmaceuticals and related services (e.g., AVOMEEN website and Exova website at January 25, 2018 Office Action at 2-8), and thus does not show the relatedness of such goods and services to Registrant's medical device-related services. Also, the ARBRO Pharmaceuticals website indicates that its pharmaceutical and medical device testing laboratories are all located in India, so we do not find this evidence probative of the relatedness of the goods in the United States. January 25, 2018 Office Action at 9-10.

indication that these companies provide the type of Class 5 goods at issue. The only potentially directly relevant relatedness evidence for this class is the website of Johnson & Johnson, which lists under “Our Products” both “Medical Devices” and “Prescription Products,” and provides an overview of health care products including medical technology products that doctors and nurses use “to perform hip replacements, implant coronary stents, and run tests for metastatic breast cancer” and “prescription medicines [that] treat a wide array of conditions, ranging from migraines and rheumatoid arthritis to cancer and serious infections.”⁷ However, under the circumstances, this single example does not establish a prima facie case of relatedness as to Applicant’s Class 5 goods.

Turning next to Applicant’s Class 35 services that at their broadest include “business consultation,” we confront a similar lack of evidence. While some of the marketplace evidence involves business consultation such as Applicant’s, we find no clear indication among the webpages in the record that consumers are exposed to these types of services offered under the same mark as medical device manufacture or medical device research and development, as set forth in the cited registration. Thus, on this record, we cannot find these services related.

For Applicant’s Class 40 services involving the treatment of materials for, and manufacture for others of, pharmaceutical and biopharmaceutical preparations, we

⁷ TSDR June 22, 2017 Office Action at 10-11 (jnj.com). The Stratos website mentions “ACELRX Pharmaceuticals” as well as various medical devices, but it appears to be a company that assists with “Product Design & Strategy” rather than a direct provider of pharmaceuticals and medical-device related services under the same mark. *Id.* at 16-18 (stratos.com).

similarly find that, with perhaps one exception, the web evidence relating to these types of services does not show them offered under the same marks as the services in the cited registration.⁸ The record is insufficient to show the relatedness of these services.

We find that on their face, Applicant's Class 42 services overlap with the services recited in the cited registration, making them legally identical in part. Applicant's "medical research" services in this class encompass Registrant's "medical device research" services in the same class. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992) ("Registrant's goods are broadly identified as computer programs recorded on magnetic disks, without any limitation as to the kind of programs or the field of use. Therefore, we must assume that registrant's goods encompass all such computer

⁸ The AMP (Alliance Medical Products) website describes the company as "a contract manufacturer with a unique blend of pharmaceutical, medical device and laboratory expertise...." AMP also promotes that "[w]hether you're a pharmaceutical/biotechnology or medical device company ... [AMP] has the scalability to meet your special manufacturing requirements and timelines." June 22, 2017 Office Action at 25-26 (amp-us.com). The only other evidence that at first seems potentially relevant falls short. The Battelle website includes a page titled "Pharmaceutical & Medical Devices," and notes that Battelle helps "pharmaceutical and medical device companies get new therapies to market faster and more efficiently. Our integrated science, technology and engineering offerings feature some of the world's greatest minds creating and improving innovative, commercial-ready device technologies and enhancing the safety and efficacy of life-saving pharmaceuticals." *Id.* at 12-13 (battelle.org). However, we cannot conclude that this includes manufacturing services or materials treatment. We have a similar assessment of the Dynamic Automation website, which appears to promote manufacturing machinery that may be used in both industries, but not necessarily any of the recited services at issue here. January 25, 2018 Office Action at 15 (dynamicautomation.com).

programs including those which are for data integration and transfer.”). Similarly, Applicant’s “scientific research and development” services encompass Registrant’s “scientific research and development of medical devices” services in the same class. Evidence submitted by the Examining Attorney also supports the relatedness of the relevant services.⁹ This factor supports likely confusion as to Applicant’s Class 42 services.

Finally, as to the legal services in Class 45, the only evidence of such services, the websites of the Nutter law firm¹⁰ and of LEVICK’S,¹¹ give no indication that they also provide services such as Registrant’s. We therefore lack the necessary evidence to find Applicant’s Class 45 services related to Registrant’s services.

⁹ For example, PPD’s website touts its “Pharmaceutical Expertise” and “resources to conduct global clinical trials across six continents” and states that “PPD has partnered with biotechnology companies to help them deliver life-changing and lifesaving therapeutic and diagnostic products.” Under the heading “Medical Device,” it also promotes that “Clients can accelerate the process of bringing their new products to market with the experience, resources and global reach of PPD’s medical device development team.” June 22, 2017 Office Action at 9 (ppdi.com); *see also* January 25, 2018 Office Action at 22-23 (ppdi.com). The website of CECON Science & Engineering Consultants uses the slogan “Experts at Finding Technical Experts” and includes a page for “Pharmaceutical/ Biopharmaceutical/ Medical Devices/Regulatory” promoting “comprehensive technical support in all areas of the drug development life cycle” as well as “medical device experts [who] understand bio materials, system design and regulatory requirements necessary to develop, manufacture and integrate such devices into to [sic] living systems.” January 25, 2018 Office Action at 18-21 (cecon.com).

¹⁰ June 22, 2017 Office Action at 24 (nutter.com). The webpage for the Nutter law firm’s Life Sciences: Biotechnology, Pharmaceuticals & Medical Devices Practice Group states, “our interdisciplinary team provides biotech, pharma and medical device clients with a comprehensive service solution – from intellectual property and transactional advice to government enforcement, products liability and regulatory matters.”

¹¹ January 25, 2018 Office Action at 11-14 (levick.com). The LEVICK’S website describes its “Pharmaceutical and Medical Device team” as providing legal and communications services to the pharmaceutical and medical device industries.

C. Trade Channels and Classes of Consumers

Turning to the trade channels and consumers, as to Applicant's services in International Class 42, because they are legally identical in part to Registrant's, we presume that the services also move in identical channels of trade and are available to identical classes of potential consumers. *See Inter IKEA Sys. B.V. v. Akea*, 110 USPQ2d 1734, 1743 (TTAB 2014); *L. & J.G. Stickley, Inc. v. Cosser*, 81 USPQ2d 1956, 1971 (TTAB 2007) ("Because the goods of both parties are at least overlapping, we must presume that the purchasers and channels of trade would at least overlap."). In addition, the relatedness evidence discussed above demonstrates that services such as Applicant's Class 42 services and those in the cited registration are featured together on the same websites, and would be encountered by the same consumers.

As to Applicant's remaining classes of goods and services, however, for the same reasons discussed above regarding relatedness, the record lacks sufficient evidence to show that these goods and services move in the same trade channels or to the same classes of consumers as the services in the cited registration. To the extent that any information about the channels of trade and classes of consumers can be discerned from the identifications themselves, they appear to differ in the application, which primarily is focused on the pharmaceutical industry, and in the cited registration, which primarily is focused on the medical device industry. For Applicant's Classes 5, 30, 35, 40, and 45, this factor weighs against likely confusion.

D. Sophisticated Purchasing

Relying on the nature of the goods and services apparent from the face of the identifications in the application and cited registration, Applicant contends that the goods and services at issue “are sold to sophisticated purchasers and not impulse purchasers.”¹² In her brief, the Examining Attorney does not argue against this premise, but contends that sophistication in a particular field does not immunize the consumers from source confusion. She also implies that some of the relevant consumers may include “the public,” and emphasizes that we must assess likely confusion from the standpoint of the least sophisticated potential purchaser.

Some of Applicant’s services and all of Registrant’s services would seem to involve relatively careful purchasing conditions and more sophisticated purchasers in their respective specialized industries. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (“Just from the record description of goods and services here one would expect that nearly all of opposer’s and applicant’s purchasers would be highly sophisticated.”). However, for the Class 5 pharmaceuticals, “we must be sensitive to the fact that patients from the general public will not exercise the degree of care exhibited by medical professionals.” *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004). By the same token, the Class 35 “business advice and information; business consultation” and the Class 45 “legal advice in the field of intellectual property” also encompass services for small businesses or individual entrepreneurs who would not necessarily be

¹² 4 TTABVUE 10 (Applicant’s Brief).

sophisticated or exercise great care. We therefore must consider ordinary members of the public as potential purchasers of the Class 5 goods and the Class 35 and 45 services, and “Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’” *See Stone Lion Capital Partners*, 110 USPQ2d at 1163.

We find that as to Applicant’s services in Classes 40 and 42, this factor weighs against likely confusion, and for Applicant’s Class 5 goods and Class 35 and 45 services, for which the consumers are not necessarily sophisticated, this factor is neutral.

Decision: Based on the similarity of the marks, the legally identical services in International Class 42, with presumptively identical trade channels and classes of consumers, confusion is likely, regardless of any degree of sophistication of the relevant Class 42 consumers. The refusal to register Applicant’s mark as to the services in International Class 42 is affirmed.

However, as to the remaining classes, despite the similarity of the marks, our findings on the other relevant *du Pont* factors regarding the lack of relatedness of the goods and services and the lack of similar trade channels and classes of consumers who, for certain of the services, would exercise great care in purchasing, render confusion unlikely. The refusal to register Applicant’s mark as to the goods in International Class 5 and the services in International Classes 35, 40 and 45 is reversed.