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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Alembic Pharmaceuticals, Inc.

Serial No. 88660605

Albert H. Manwaring, IV and Kirsten Zeberkiewicz of MORRIS JAMES LLP,
for Alembic Pharmaceuticals, Inc.

Chioma (Bata) Oputa, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

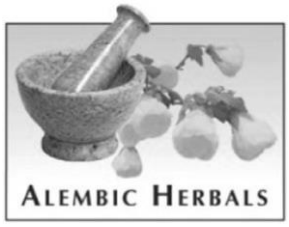
Before Shaw, Greenbaum and Dunn,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Alembic Pharmaceuticals, Inc. ("Applicant") has filed an application for registration on the Principal Register of the standard character mark ALEMBIC PHARMACEUTICALS for:

> Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations, for the treatment of allergic conjunctivitis, Alzheimer's disease, anxiety, bacterial infections, depression, epilepsy,

> infection, inflammation and allergies, ulcers, bacterial conjunctivitis, bipolar disorder, bronchoconstriction, erectile dysfunction, fungal infection, glaucoma, herpes, hypercholesterolemia, hypertension, hyperuricemia, hypoparathyroidism, influenza A and B, Parkinson's disease/syndrome, insomnia, intraocular pressure, paralysis, amnesia, unconsciousness, high cholesterol, neuropathic pain, arthritic pain and inflammation, ocular infections, overactive bladder, postoperative inflammation, ocular pain, cough, inflammatory and pruritic manifestations, rheumatoid arthritis, seizure, panic disorder, sleep disorder, transfusional iron overload, and moderate to severe scalp psoriasis; all of the foregoing prescribed by a licensed medical doctor with the prescriptions filled by a retail pharmacy licensed to sell prescription drugs, in International Class 5.[1]

The Examining Attorney issued a final refusal of registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the grounds that Applicant's mark is likely to cause confusion with the registered mark ALEMBIC HERBALS and design, displayed as 

, on the Principal Register for a variety of goods and services, including:

> Medicines for human purposes for strengthening the immune system and restoring normal bodily functions, the treatment, mitigation and prevention of diseases and disorders, namely, digestive diseases and disorders, central nervous system diseases and disorders, namely, brain diseases, movement disorders, ocular motility, respiratory diseases and disorders, excretory diseases and disorders, cardiovascular diseases and disorders,

[1] Application Serial No. 88660605 was filed on October 18, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use in commerce and anywhere as early as January 1, 1907.

> reproductive diseases and disorders, endocrinal diseases and disorders, immunological diseases and disorders, namely, autoimmune diseases, immunologic deficiency syndrome, hepatitis, dermatological diseases and disorders, skeletal diseases and disorders, namely, bone diseases, back pain, muscular diseases and disorders, namely, muscular dystrophy, inflammatory muscle diseases, sensory diseases and disorders, namely, blindness, in International Class 5.[2]

The cited mark's description reads: "The mark consists of a rectangle containing an image of a morter [sic] and pestle, with a flowering herbal plant to the right and the words 'ALEMBIC HERBALS' in capitalized letters underneath." The term HERBALS and the pictorial representation of the mortar, pestle, and flowering herbal plant are disclaimed apart from the mark as shown.

The Examining Attorney also issued final refusals of registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, for failure to function as a trademark, and, under Trademark Act Sections 1 and 45, for failure to provide evidence of use of the mark in commerce. *See* 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a).

After the refusal was made final, Applicant appealed and twice requested reconsideration. Both requests were denied. After Applicant filed its brief,[3] the Examining Attorney requested a remand of the application to reinstitute the Sections 1, 2, and 45 final refusal and the Sections 1 and 45 final refusal, which had been

[2] Registration No. 5683081, issued on February 26, 2019.

[3] Applicant attached exhibits to its initial appeal brief. The exhibits were previously submitted during examination and should not have been submitted with Applicant's brief. *ITC Entm't Grp. Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).

inadvertently omitted from the earlier final refusal. Following reinstitution of the final refusals, the appeal resumed and Applicant filed a supplemental brief incorporating the initial brief and addressing the reinstituted refusals. The case is fully briefed. We affirm the refusals to register.

I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) ("*DuPont*"); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider each *DuPont* factor that is relevant or for which there is argument and evidence of record. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). "Not all of the [*DuPont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)).

a. Similarity of the Goods, Trade Channels and Classes of Purchasers

We evaluate the relatedness of the respective goods based on their identifications in the subject application and cited registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *see also Octocom Sys. Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("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 the sales of goods are directed.").

Applicant's identification of goods lists a variety of "Generic prescription drugs, approved by the U.S. Food and Drug Administration, namely, prescription drugs in the nature of pills, tablets, capsules, caplets, liquid drops, sachets and pharmaceutical preparations . . . filled by a retail pharmacy licensed to sell prescription drugs." Registrant's identification of goods includes a variety of "medicines for human purposes for strengthening the immune system and restoring normal bodily functions, the treatment, mitigation and prevention of diseases and disorders." The respective identifications both include medicines for treating a similar range of illnesses. For example, Applicant's drugs treat Alzheimer's disease, inflammation, bronchoconstriction, erectile dysfunction, arthritic pain, and scalp psoriasis. These illnesses are similar to, if not the same, as those treated by Registrant's medicines, namely brain diseases, respiratory diseases and disorders,

reproductive diseases and disorders, dermatological diseases and disorders, back pain, and inflammatory muscle diseases.

We find that Applicant's and Registrant's goods are in-part legally identical inasmuch as Registrant's broadly-worded "medicines for human purposes for . . . the treatment, mitigation and prevention of diseases and disorders" could include Applicant's more specialized "generic prescription drugs, approved by the U.S. Food and Drug Administration . . . filled by a retail pharmacy licensed to sell prescription drugs," given that the goods are for treating similar illnesses.[4] *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of goods necessarily encompasses Registrant's narrowly identified goods").

Applicant nevertheless argues that the respective goods are different because:

> Registrant's so-called medicines are not generally accepted in the licensed medical community to treat diseases and conditions, for which the FDA has approved the Applicant's drug for treatment. Hence, the Applicant's prescription pharmaceutical products are not "competitive" with the Registrant's herbal products that are not generally accepted in the licensed medical community "to diagnose, treat, cure or prevent any disease."[5]

[4] The terms "drug" and "medicine" are synonymous. A "drug" is defined as "a substance used as a medication or in the preparation of medication." Https://www.merriam-webster.com/dictionary/drug, accessed September 12, 2022. We take judicial notice of this definition. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

[5] Applicant's Initial Br., p. 14, 6 TTABVUE 15.

This argument is unpersuasive. The cited registration does not limit Registrant's medicines to "herbal products sold over the counter without a prescription, "not accepted in the licensed medical community," or "not FDA approved." Accordingly, we must assume that Registrant's medicines include all "medicines for human purposes for . . . the treatment, mitigation and prevention of diseases and disorders," including ones, such as Applicant's, that are generally accepted in the licensed medical community or FDA approved.

We cannot assume, as Applicant urges, that the goods "are distinct and travel in separate trade channels."[6] Rather, we must look to the registration and application, and not to extrinsic evidence about Registrant's and Applicant's actual goods, customers, or channels of trade. *See Stone Lion*, 110 USPQ2d at 1162 ("It was proper, however, for the Board to focus on the application and registrations rather than on real-world conditions . . . ."); *Octocom*, 16 USPQ2d at 1787; *In re Embiid*, 2021 USPQ2d 577, at *28 (TTAB 2021) ("[W]e may not import restrictions into the identification[s] based on alleged 'real world conditions' of the sort argued by Applicant, or consider extrinsic evidence regarding Applicant and Registrant themselves.") (internal citation omitted).

Regarding classes of consumers and channels of trade, Applicant argues further that "the relevant consumers for Applicant's products are drug wholesalers, retail chain drug stores, and pharmacists, whereas Registrant's consumers are ordinary

[6] *Id.* at 12, 6 TTABVUE 13.

consumers. Applicant's goods are only available behind a prescription counter where Registrant's goods are not found."[7] This argument is unpersuasive as well.

Because the goods described in the application and the cited registration are in-part legally identical, we presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).[8]

The *DuPont* factors regarding the similarity of the goods, trade channels and classes of consumers weigh in favor finding a likelihood of confusion.

b. Similarities of the Marks

We now consider whether Applicant's and Registrant's marks are similar when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *See Stone Lion,* 110 USPQ2d at 1160 (quoting *Palm Bay Imps.,* 73 USPQ2d at 1689). The test under this *DuPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar that confusion as to the source of the goods offered under the respective marks is likely to result. *See In re i.am.symbolic, llc,* 866 F.3d

[7] *Id.* at 13, 4 TTABVUE 14.

[8] To be clear, we do not dispute that there may be a difference in the trade channels and for prescription and over the counter (OTC) medicines. As explained, the issue here is that Registrant's identification of goods may include both.

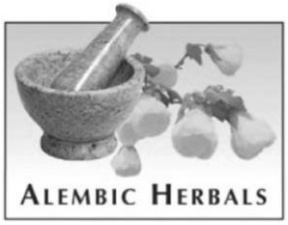
1315, 123 USPQ2d 1744, 1748 (TTAB 2017). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

As noted above, Applicant argues that its consumers are "drug wholesalers, retail chain drug stores, and pharmacists."[9] The Examining Attorney does not argue otherwise. Accordingly, we accept this characterization of Applicant's and Registrant's consumers, to the extent the goods are legally identical.

The similarity or dissimilarity of the marks is determined by considering the marks in their entireties, and hence our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005 , 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). However, while we must consider the marks in their entireties, it is appropriate to accord greater importance to the more distinctive elements in the marks in determining whether the marks are similar. *Nat'l Data*, 224 USPQ at 751 ("[T]here 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 consideration of the marks in their entireties.").

[9] Applicant's Br., p. 12, 6 TTABVUE 14.

Moreover, "[i]t is also well established that, when the goods at issue are identical, 'the degree of similarity necessary to support a conclusion of likely confusion declines.'" *Viterra*, 101 USPQ2d at 1912 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)).

The term "alembic" is defined as "an apparatus of glass or metal, like a retort, formerly used for distilling."[10] Applicant's mark is ALEMBIC PHARMACEUTICALS in standard characters. Registrant's mark, 

, comprises the words ALEMBIC HERBALS with a design of a mortar and pestle with herbal plants.

We find the term ALEMBIC to be the most dominant element of both marks. It is the first word in both marks. The first term in a mark is often the dominant portion of a mark. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t 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 Imps.,* 73 USPQ2d at 1692; *Century 21 Real Estate* 23 USPQ2d at 1700.

In Applicant's mark, PHARMACEUTICALS is less dominant because it has been disclaimed and it is highly descriptive or generic when used in connection with

[10] Https://www.collinsdictionary.com/us/dictionary/english/alembic, accessed September 12, 2022. We take judicial notice of this definition as well. This definition is derived from the American, and not the British, version of the Collins Dictionary. *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1592 n.4 (TTAB 2018) ("We note that Collins Dictionary offers a British and an American version. This entry by the Examining Attorney is from the British version, which does not necessarily evidence perceptions of the term by consumers in the United States.").

Applicant's prescription drugs. Descriptive and disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). In Registrant's mark, the other matter—the word HERBAL, the mortar and pestle, and the herbs—is less significant because the word and design elements are descriptive and have been disclaimed as well.

In addition, the design elements of Registrant's mark are subordinate to the wording ALEMBIC HERBALS. It is an often-recited principle that when a mark consists of a literal portion and a design portion, the literal portion is usually more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services; therefore, the literal portion is normally accorded greater weight in determining whether marks are confusingly similar. *See Viterra,* 101 USPQ2d at 1911; *CBS Inc. v. Morrow,* 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("[I]n a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.").

Because the dominant portion of Registrant's mark is identical to the dominant portion of Applicant's mark, we find that the marks, considered as a whole, are similar in sound, meaning, and commercial impression as well. That is, both marks convey the same commercial impression of ALEMBIC, "an apparatus of glass or metal, like a retort, formerly used for distilling."

Applicant argues that "[t]he addition of the word 'Pharmaceuticals' in the applied-for mark gives the mark a different commercial impression than the 'Alembic

Herbals' trademark."[11] According to Applicant, "'Alembic Herbals' gives an impression of herbs or medicinal plants and Chinese traditional medicine, whereas in contrast, 'Alembic Pharmaceuticals' gives an impression of prescription drugs manufactured by pharmaceutical companies and approved by the U.S. Food and Drug Administration."[12] We find this argument to be unpersuasive, particularly because "alembic" has a very specific meaning and is unlikely to have differing connotations or commercial impressions despite the addition of other matter.

At most, the presence of the added matter, PHARMACEUTICALS in Applicant's mark and HERBALS and a design in Registrant's mark, suggests that the respective goods may have some different ingredients. Nevertheless, given the dominance of the term ALEMBIC, and the weakness of the other matter in the marks, consumers are likely to view the marks as connoting differing formulations from the same source. That is, Registrant's ALEMBIC HERBALS and design mark denotes medicines which include herbal ingredients, whereas Applicant's ALEMBIC PHARMACEUTICALS mark denotes medicines without herbal ingredients.

We also are unpersuaded by Applicant's arguments that "the Examining Attorney has neglected to consider the mark in its entirety."[13] It is well settled that, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Detroit Athletic Co.*, 903

[11] Applicant's Br., p. 8, 6 TTABVUE 9.

[12] *Id.* at 9, 6 TTABVUE 10.

[13] *Id.* at 7, 6 TTABVUE 8.

F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. *Id.* "Indeed, this type of analysis appears to be unavoidable." *Nat'l Data*, 224 USPQ at 751.

Here, given the in-part identical nature of the goods, the use of the term ALEMBIC in the marks could be viewed by consumers as delineating different product lines from a common source—one containing herbal ingredients and the other without herbal ingredients. In sum, we find that the marks are very similar, particularly in connotation and commercial impression.

The *DuPont* factor regarding the similarity of the marks favors a finding of likelihood of confusion.

c. Purchasing Conditions

The fourth *DuPont* factor involves "[t]he conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. Applicant argues that consumers are "not likely to be confused about the source of the goods. Confusion is less likely where the purchasing class comprises sophisticated purchasers."[14] The Examining Attorney does not argue with Applicant's contention that its prospective consumers exercise a higher degree of care. Instead, the Examining Attorney simply argues that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that

[14] *Id.* at 15, 6 TTABVUE 16.

they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion."[15]

As discussed above, the respective goods include medicines prescribed by physicians, sold by pharmacies, and used by end consumers seeking to cure illnesses. This suggests that consumers will engage in sophisticated purchasing. We agree that because of the nature of the goods, consumers are likely to engage in a higher than ordinary degree of care in purchasing.

This *DuPont* factor weighs against likely confusion.

d. Lack of actual confusion

Applicant argues that there has been no actual confusion regarding the marks: "Alembic is not aware of a single instance of actual confusion, or of any evidence to indicate that actual confusion has ever existed between Alembic's use of the mark 'Alembic Pharmaceuticals' and the mark 'Alembic Herbals' or any other mark incorporating the term Alembic."[16]

Generally, the "lack of evidence of actual confusion carries little weight, especially in an ex parte context" and that is the case here. *Majestic Distilling,* 65 USPQ2d at 1205 (internal citation omitted). We have little evidence pertaining to the nature and extent of use of the marks by Applicant and Registrant so we cannot conclude that there has been a meaningful opportunity for confusion to have occurred. *Double Coin Holdings Ltd. v. Tru Dev.,* 2019 USPQ2d 377409, at *9 (TTAB 2019) (explaining that

[15] Examining Attorney's Br., 19 TTABVUE 19.

[16] Applicant's Br., p. 17, 6 TTABVUE 18.

"for the absence of actual confusion to be probative, there must have been a substantial opportunity for confusion to have occurred"); *Barbara's Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends on there being a significant opportunity for actual confusion to have occurred). Applicant states that its parent company "has been in the pharmaceutical business for over 100 years,"[17] but the parent company is based in India and it is not clear how long or how widely Applicant has been selling its drugs in the U.S. market. Nor do we have any information regarding Registrant's sales.

We also do not know whether Registrant is aware of any instances of actual confusion. *Guild Mortgage*, 2020 USPQ2d 10279, *7 ("[I]n this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story."); *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) (absence of actual confusion in ex parte cases "entitled to limited probative weight" because the Board generally has no information regarding whether registrant is aware of any actual confusion and it is difficult to determine whether there has been a significant opportunity for confusion to have occurred). In any event, the test under Section 2(d) is not actual confusion but likelihood of confusion. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1027 (TTAB 1984).

Accordingly, the absence of any actual confusion is neutral in our likelihood of confusion analysis.

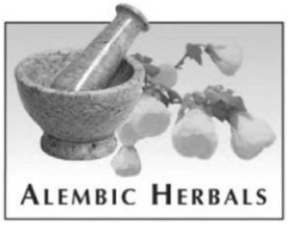
[17] *Id.* at 17, 6 TTABVUE 18.

e. Conclusion

As discussed above, the goods are in-part identical and we presume the trade channels and classes of purchasers are identical as well. Further, the marks are similar in sound, meaning, and commercial impression. The first, second, and third *DuPont* factors support a finding of likelihood of confusion.

The fourth *DuPont* factor contradicts a finding that confusion is likely because purchasers of the goods would exercise a higher degree of care in purchasing. However, the fact "[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar [goods]. 'Human memories even of discriminating purchasers . . . are not infallible.'" *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)). The "[s]ophistication of buyers and purchaser care are relevant considerations but are not controlling on this factual record." *Id.*

The remaining *DuPont* factors are neutral.

We find the record establishes that consumers who are familiar with the goods identified in the cited mark, 

, who encounter the goods under Applicant's mark, ALEMBIC PHARMACEUTICALS, are likely to believe that the goods emanate from a single source.

II. Trade name refusal and refusal for lack of use in commerce

The Examining Attorney initially refused registration of the mark under Trademark Act Sections 1 and 45 on the ground that the printer's proof filed with the application does not show use of the mark in commerce. At the time the specimen was submitted, Applicant was seeking registration of the proposed mark for services, not goods.[18] After amending the application to seek registration for goods, Applicant submitted substitute specimens comprising pictures of actual product packaging. Registration was then refused under Trademark Act Sections 1, 2, and 45 on the ground that the proposed mark is used only as a trade name to identify Applicant's business and does not function as a trademark to indicate the source of Applicant's goods and to identify and distinguish them from others.[19] Applicant next submitted web page excerpts, and the Examining Attorney maintained the refusal to register the mark under Trademark Act Sections 1 and 45 on the ground that the substitute specimens are merely advertising and do not show use of the mark in commerce.[20]

Section 45 of the Trademark Act, 15 U.S.C. § 1127, states that a mark "shall be deemed to be in use in commerce—

> (1) on goods when—
>
> > (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods

[18] Office Action of April 21, 2020. *See* 37 C.F.R. § 2.56. Inasmuch as these printer's proofs use the proposed mark in the same way as Applicant's other packaging, the refusal to register based on the ground that the proposed is used only as a trade name for goods applies as well[18]

[19] Office Action of July 30, 2020.

[20] Office Action of January 6, 2021.

> makes such placement impracticable, then on documents associated with the goods or their sale, and
>
> (B) the goods are sold or transported in commerce[.]"

A "printer's proof," showing a label's general appearance, margins and color, is not an acceptable specimen to demonstrate use of the mark "on the goods." 37 C.F.R. § 2.56(b)(1) and (c) ("An artist's rendering, a printer's proof, a computer illustration, digital image, or similar mockup of how the mark may be displayed, or a photocopy of the drawing required by § 2.51, are not proper specimens.").

Similarly, advertising material is generally not acceptable as a specimen for goods to show use of the mark in commerce. *In re MN Apparel LLC*, 2021 USPQ2d 535, at *15 (TTAB 2021) (citing *In re Siny Corp.*, 920 F.3d 1331, 2019 USPQ2d 127099, at *2-3 (Fed. Cir. 2019)). Nevertheless, a web page, or similar specimen is acceptable to show trademark use as a display associated with the goods only if it includes: (1) a picture of the relevant goods, (2) the mark appears sufficiently near the picture of the goods so as to associate the mark with the goods, and (3) information necessary to order the goods (e.g., sales form, price list, instructions for ordering, etc.) or a visible weblink to order the goods. *See Lands' End, Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); *In re Dell, Inc.*, 71 USPQ2d 1725, 1727 ("[A] website page which displays a product, and provides a means of ordering the product, can constitute a 'display associated with the goods'").

A "trade name" is defined in Section 45 as "any name used by a person to identify his or her business or vocation." Designations used merely as a trade name cannot be registered under the provisions of the Trademark Act. *See In re Supply Guys, Inc.,* 86

USPQ2d 1488, 1491 (TTAB 2008); *In re Diamond Hill Farms*, 32 USPQ2d 1383, 1384 (TTAB 1994); *In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985) ("[T]here was a clear intention by the Congress to draw a line between indicia which perform only trade name functions and indicia which perform or also perform the function of trademarks or service marks.").

A term may function as both a trade name and a service mark. As the Court of Appeals for the Federal Circuit has explained, a "trade name which also has significance as either a trademark or service mark may be registered." *Martahus v. Video Duplication Servs. Inc.*, 3 F.3d 417, 27 USPQ2d 1850 (Fed. Cir. 1993). "The distinction between trade name use and either trademark or service mark use is often a difficult one to make and is nebulous in character." *In re Unclaimed Salvage & Freight Co.*, 192 USPQ 165, 167 (TTAB 1976).

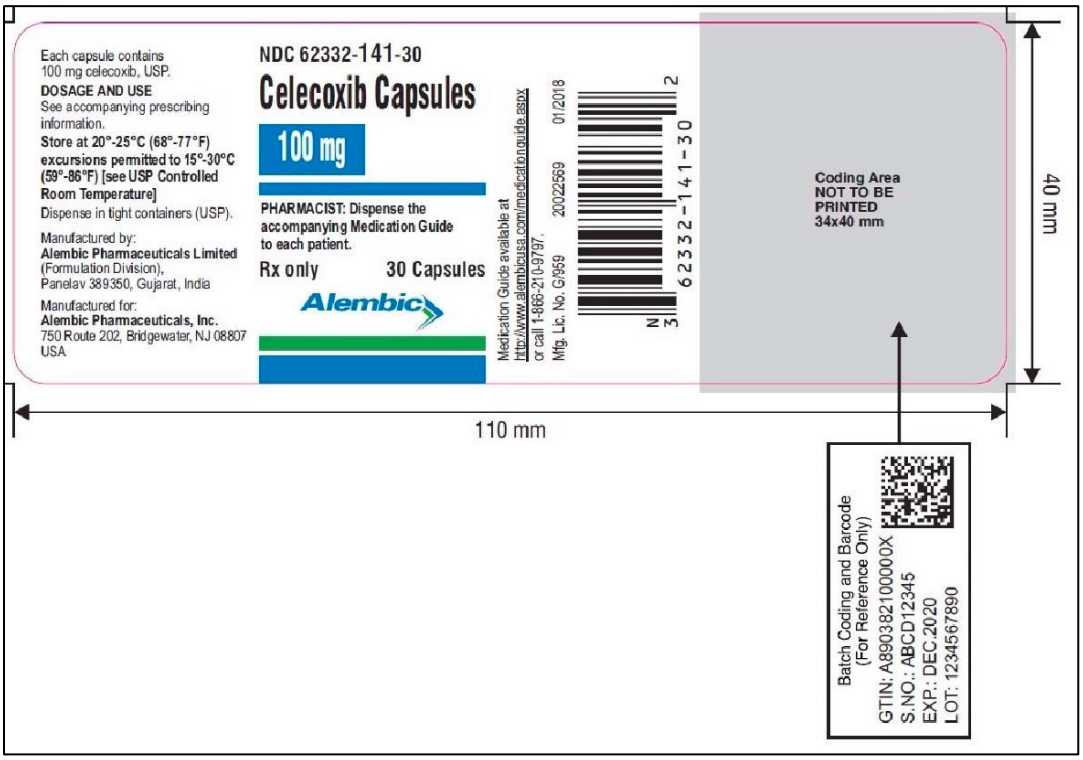
"The question of whether a name used as a trade name also functions as a trademark is one of fact, and is determined from the manner in which the name is used and the probable impact on purchasers and prospective purchasers." *Diamond Hill Farms*, 32 USPQ2d at 1384. Factors to consider include whether Applicant has: used its full corporate name or entity designation; capitalized its name; utilized its name in the same lettering style as other matter; used its name in a significantly bolder or larger style of type; or displayed its name in a contrasting color. *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991).

As noted above, Applicant submitted three sets of specimens during examination: a printer's proof for product packaging; pictures of product packaging comprising pill

bottles, blister packaging for capsules, and boxes for the blister packaging; and web page excerpts from its corporate profile and from a corporate statement explaining that some of its products were not covered by a U.S. Food and Drug Administration recall. We discuss each type of specimen in turn.

a. The product packaging

With its Application, Applicant submitted the following printer's proof.[21]

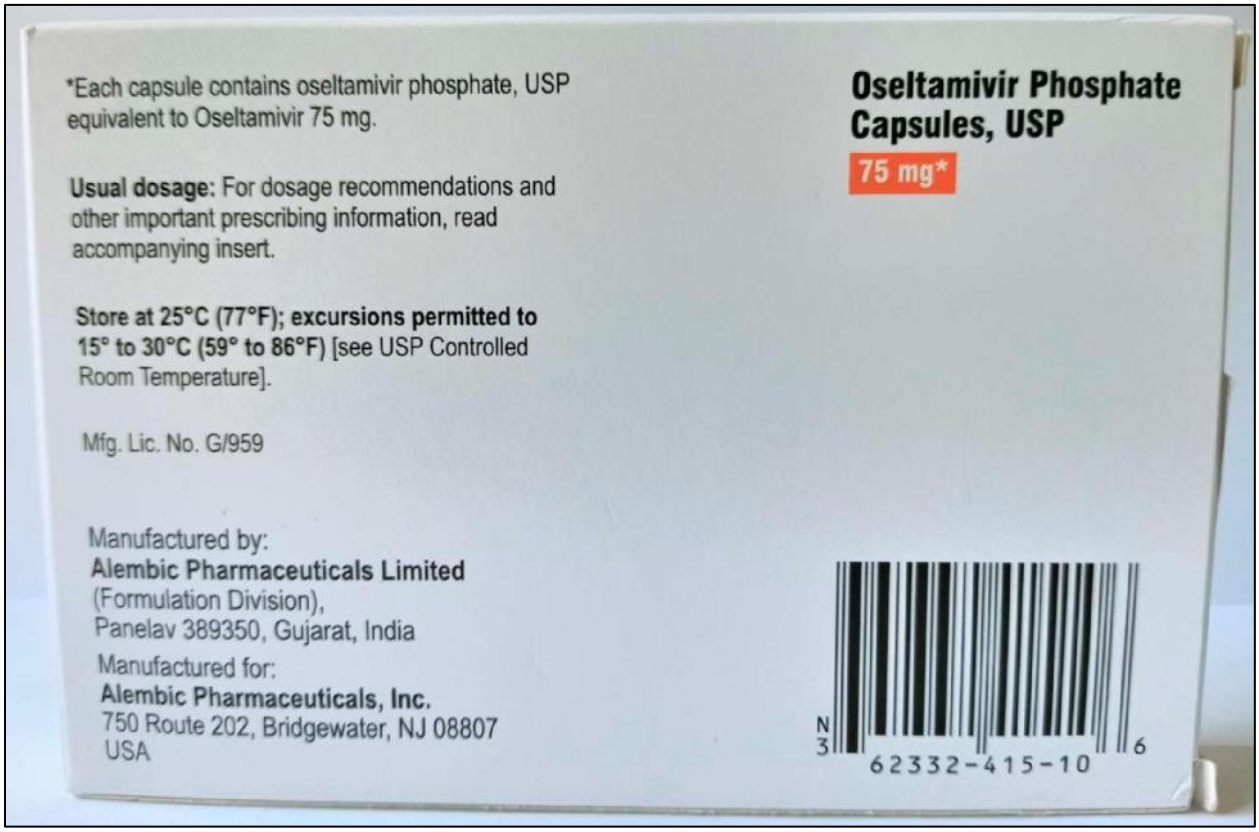


This printer's proof is not a proper specimen to show use of the proposed mark in commerce. 15 U.S.C. § 1127 and 37 C.F.R. § 2.56. It also uses the proposed mark merely as a trade name, as discussed below.

Applicant's first substitute specimens consist of eleven pictures of various types of product packaging. One representative example, shown below, comprises the back of

[21] Application of October 18, 2019 and March 27, 2020 Response to Office Action.

a box, and provides general information about the product including ingredients, dosage, storage, and manufacture.[22]



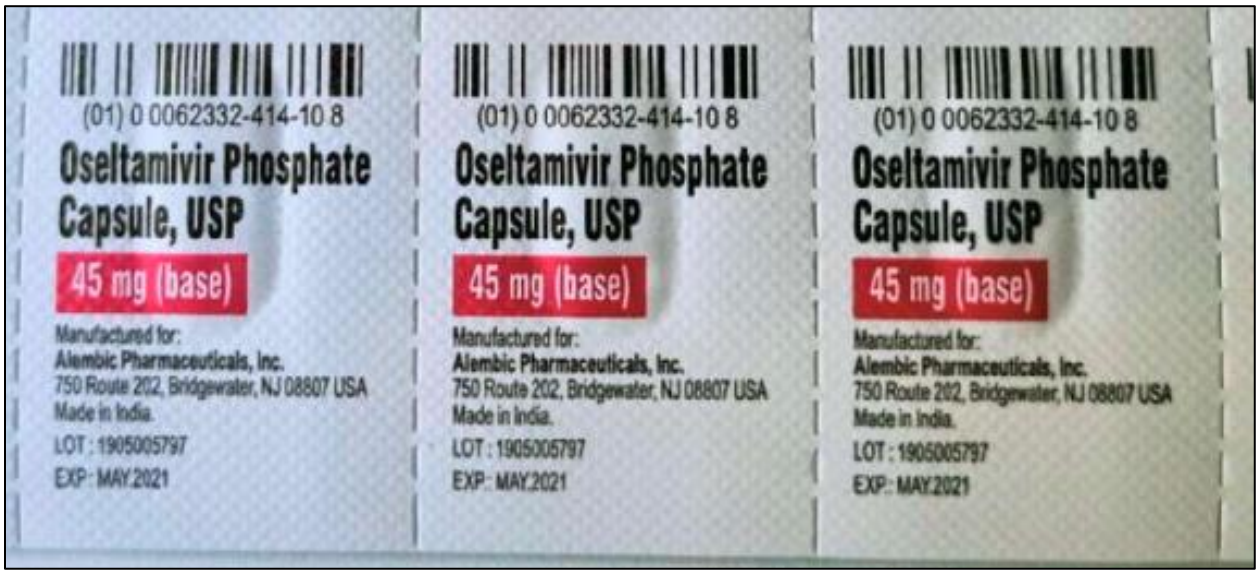
The proposed mark, ALEMBIC PHARMACEUTICALS, is used only as part of the following wording:

> Manufactured by:
> **Alembic Pharmaceuticals Limited**
> (Formulation Division)
> Panelav 389350, Gujarat, India
>
> Manufactured for:
> **Alembic Pharmaceuticals, Inc.**
> 750 Route 202, Bridgewater, NJ, 088077
> USA

[22] July 1, 2020 Response to Office Action.

As can been seen from the printer's proof and the foregoing picture, ALEMBIC PHARMACEUTICALS, appears in mixed-case boldface type as part of the names and addresses of "Alembic Pharmaceuticals Limited" and "Alembic Pharmaceuticals, Inc." These names appear in the same size, the same typeface, and the same color as all of the surrounding informational text. Other informational text on the back of the packaging such as the name of the drug, "Usual Dosage:", and "storage instructions also appears in bold. The name of the drug appears in significantly larger boldface type.

Another example, cropped below, comprises blister packaging for capsules and includes the name of the drug, the wording "Manufactured for:", Applicant's name and address, "Made in India," as well as production information and an expiration date. Only the name of the drug and the name Alembic Pharmaceuticals, Inc. appear in boldface type. The name of the drug appears in significantly larger boldface type.



As can been seen from the foregoing picture, there is no mention of Alembic Pharmaceuticals Limited. The proposed mark, ALEMBIC PHARMACEUTICALS, is used only as part of the following wording:

> Manufactured for:
> **Alembic Pharmaceuticals, Inc.**
> 750 Route 202, Bridgewater, NJ, 088077
> USA
> Made in India

All of the other product packaging specimens generally display the proposed mark in the manner shown in the examples above.

The Examining Attorney argues that these product packaging specimens show only trade name use:

> [T]he specimen submitted on July 1, 2020 shows the applied-for mark used on the back of applicant's goods, where product information is typically placed, in the "Manufactured by" section. This does not demonstrate trademark use because "Alembic Pharmaceuticals Limited" and "Alembic Pharmaceuticals, Inc." appears where customers would look for product information, including the name of the party that manufactures the goods. Thus, ALEMBIC PHARMACEUTICALS, as used on applicant's packaging, is a trade name that identifies applicant as a business entity rather than a mark that identifies applicant's goods and distinguishes them from those of others.[23]

In response, Applicant argues that "submitted specimens feature the designator "Alembic Pharmaceuticals" in a larger, more prominent font. Thus, the designator,

[23] Examining Attorney's Br., 19 TTABVUE 20.

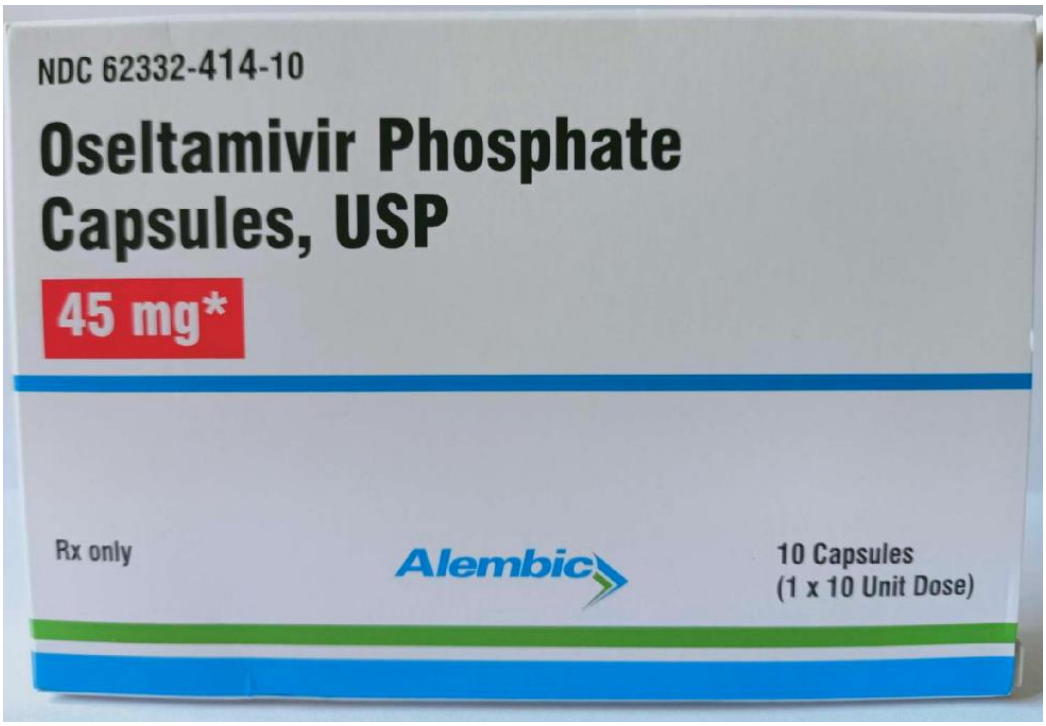
'Alembic Pharmaceuticals,' as depicted in the specimens, creates a separate commercial impression on the consumer and, therefore, functions as a trademark."[24]

Strictly speaking, Applicant is incorrect in stating that its product packaging uses ALEMBIC PHARMACEUTICALS in a larger font. Only the name of the drugs and the amount of the active ingredients generally appear in a larger font. Rather, the only difference between Applicant's proposed mark and the surrounding text is the use of boldface type. Moreover, it is not just "Alembic Pharmaceuticals" that is in bold, it is the entire corporate names "Alembic Pharmaceuticals Limited" and/or "Alembic Pharmaceuticals, Inc." that appear in bold.

When we consider Applicant's proposed mark in light of the factors outlined in *Univar*, 20 USPQ2d at 1869, we find Applicant's usage does not rise to the level of a trademark. Specifically, Applicant: uses its full corporate name or entity designation; does not capitalize its name; utilizes its name in the same lettering style as other merely informational matter; uses its name in the same size and style of type as other matter; and does not display its name in a contrasting color. *Id.* The use of boldface type for "Alembic Pharmaceuticals Limited" and/or "Alembic Pharmaceuticals, Inc." is insufficient to support a finding the that mark is anything but a trade name.

This finding is buttressed by Applicant's trademark use of ALEMBIC by itself elsewhere on the substitute specimen packaging. The front of Applicant's packaging, shown below, demonstrates trademark use of ALEMBIC without the wording PHARMACEUTICALS.

[24] Applicant's Reply Br., p. 8, 20 TTABVUE 9.



Consumers, when presented with "Alembic" by itself on the front of the packaging and "Alembic Pharmaceuticals Limited" and/or "Alembic Pharmaceuticals, Inc." elsewhere on the packaging, are likely to view the former as a trademark and the latter as a trade name. This substitute specimen cannot support registration because it does not include the entire proposed mark, ALEMBIC PHARMACEUTICALS.

In sum, we find Applicant's product packaging specimens show use of the proposed mark ALEMBIC PHARMACEUTICALS merely as a trade name. In addition, the original specimen comprising a printer's proof, does not show use of the mark in commerce.

b. The web page excerpts

As noted above, Applicant also submitted two web page excerpts, or screenshots, one from its corporate profile and the other consisting of a press release regarding a drug recall. Both are reproduced below.

Alembic Pharmaceuticals, Inc

Alembic Pharmaceuticals, Inc is a subsidiary of Alembic Pharmaceuticals Ltd., the oldest pharmaceutical company in India, employing more than 13,000 people globally. Alembic Pharmaceuticals Ltd is one of the most well-respected, established, and integrated pharmaceutical companies in Asia and supplies products to over 90 countries. Alembic Pharmaceuticals Ltd is listed on the Bombay Stock Exchange and National Stock Exchange under the stock symbol APLLTD. Alembic is a vertically integrated organization with expertise spanning the entire pharmaceuticals value chain: research and development (R&D), manufacturing and marketing of finished dosage formulations, active pharmaceutical ingredients, and intermediates.

RESEARCH AND DEVELOPMENT A KEY STRENGTH

Alembic's strong growth and success are built on a foundation of strong and innovative R&D. In 2019, Alembic invested approximately 14% of sales into R&D with over 90% focused on abbreviated new drug applications (ANDAs) for the US market. With 2 research facilities in India (Vadodara and Hyderabad) and 1 in the US (West Caldwell, New Jersey) and a team of over 500 scientists, Alembic has been a leader in development of active pharmaceutical ingredients, generic drug formulations (ANDAs), and novel drug delivery systems. Alembic currently boasts 109 drug master files, 110 approved ANDAs, 12 tentative approvals, and 1 NDA/505(b)(2), as well as 189 ANDAs filed in total. Alembic announced plans to file an additional 100 ANDAs over the next 3 years. In addition, Alembic has an FDA-approved bio-equivalence center to support ANDA filings.

FACILITIES

Alembic supplies products for 5 FDA-approved facilities in India. These facilities have supplied product to the US market for over 10 years. These facilities are in compliance with standards of the US FDA, UK, and others, and all have recently been inspected by the US FDA.

US FOCUS AND GROWTH

Alembic Pharmaceuticals Ltd, via its subsidiary Alembic Pharmaceuticals, Inc, has identified the US as its key focus market. Alembic has experienced tremendous growth in the US since its first launch in October 2015 and now sells over 72 products in the U.S. representing more than 250 stock-keeping unit (SKUs) under its own label. 2019 marked the launch of key dermatology and ophthalmic products for Alembic in the US. Alembic intends to launch another 10-plus products before year end 2020 and will launch 8 to 10 products each year over the next 3 years. In addition, Alembic has finished completion of an oncology injectables facility and has begun filing for product approvals. In total, Alembic has 250 ongoing projects, which include targets in dermatology, injectables, and ophthalmics. "Alembic has experienced tremendous growth in the US market over the past several years and is poised for continued success as new projects come to market. It's exciting to be part of a dynamic organization focused on growth and servicing our customers," said Eric Purcell, vice president of sales and marketing at Alembic Pharmaceuticals, Inc.

Contact
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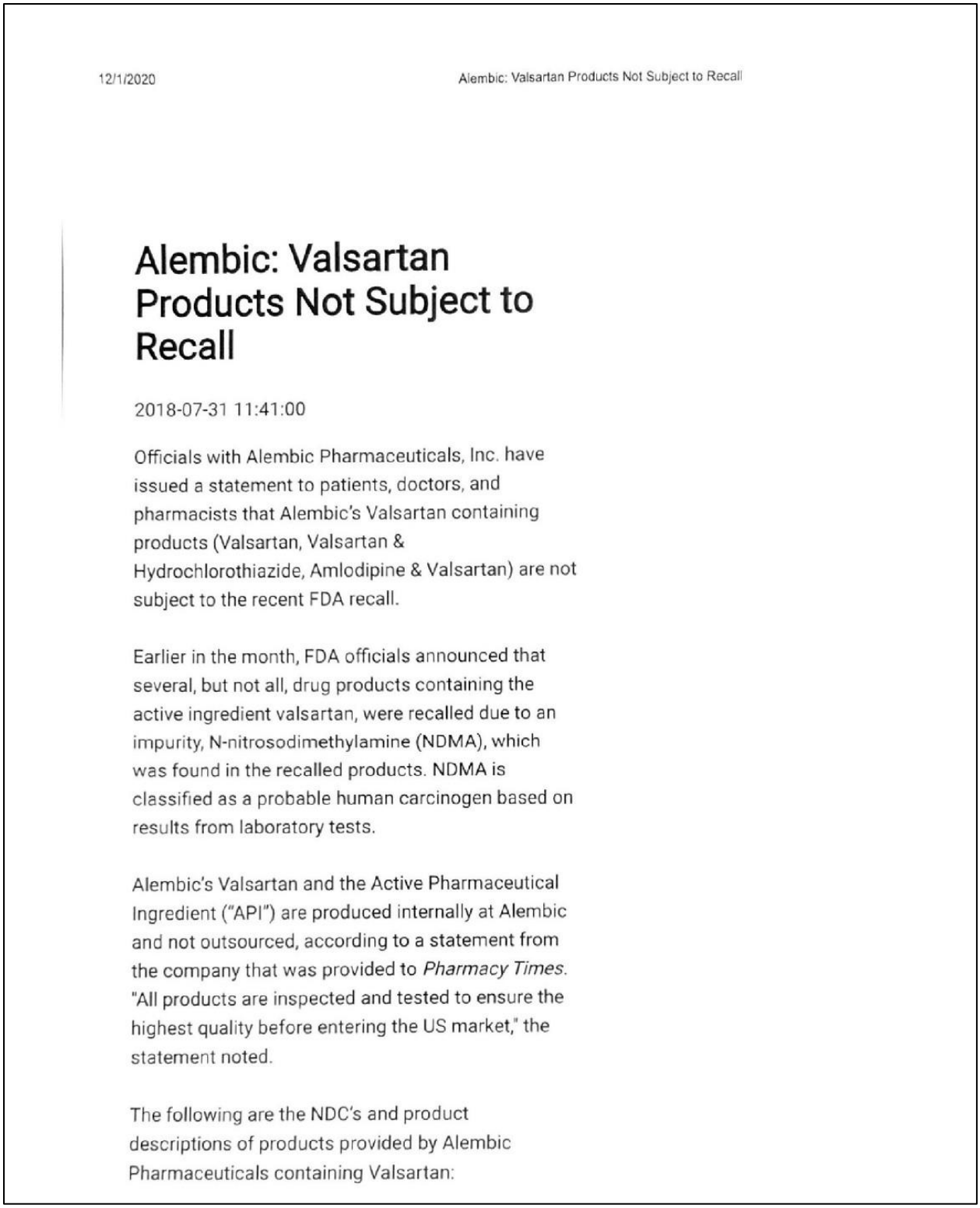
For more information, visit alembicusa.com.



12/1/2020 Alembic: Valsartan Products Not Subject to Recall

Alembic: Valsartan Products Not Subject to Recall

2018-07-31 11:41:00

Officials with Alembic Pharmaceuticals, Inc. have issued a statement to patients, doctors, and pharmacists that Alembic's Valsartan containing products (Valsartan, Valsartan & Hydrochlorothiazide, Amlodipine & Valsartan) are not subject to the recent FDA recall.

Earlier in the month, FDA officials announced that several, but not all, drug products containing the active ingredient valsartan, were recalled due to an impurity, N-nitrosodimethylamine (NDMA), which was found in the recalled products. NDMA is classified as a probable human carcinogen based on results from laboratory tests.

Alembic's Valsartan and the Active Pharmaceutical Ingredient ("API") are produced internally at Alembic and not outsourced, according to a statement from the company that was provided to *Pharmacy Times*. "All products are inspected and tested to ensure the highest quality before entering the US market," the statement noted.

The following are the NDC's and product descriptions of products provided by Alembic Pharmaceuticals containing Valsartan:

The Examining Attorney argues that these web page excerpts comprise advertising, which is unacceptable as specimens for goods. Citing *See In re Yarnell*

Ice Cream, LLC, 2019 USPQ2d 265039, at *15-16 (TTAB 2019) (quoting *Siny*, 2019 USPQ2d 127099, at *2-3), the Examining Attorney argues that "[t]he law is clear that advertising is not acceptable as a specimen for goods."[25]

Applicant argues that these specimens show the mark associated with the goods because the "screenshots include the designator 'Alembic Pharmaceuticals' prominently on the top of the page and include detailed descriptions of Alembic products."[26] The "detailed descriptions" in the screenshots that Applicant refers to are woefully vague, however, and provide only general information about Applicant's products. For example, the first screenshot states: "Alembic currently boasts 109 drug master files, 110 approved ANDAs, 12 tentative approvals, and 1 NDA/505(b)(2) as well as 189 ANDAs filed in total" and has "250 ongoing projects," including "targets in dermatology, injectables and ophthalmics.").[27] The press release mentions several medicines but does not offer any for sale.

There is nothing on either web page specimen that transforms them from mere advertising to online point of sale displays. "[T]o be more than mere advertising, a point-of-sale display associated with the goods must do more than simply promote the goods and induce a person to buy them; that is the purpose of advertising in general. The specimen must be 'calculated to consummate a sale.'" *MN Apparel*, 2021

[25] Examining Attorney's Br., 19 TTABVUE 22.

[26] Applicant Supplemental Br., p. 14, 17 TTABVUE 15.

[27] *Id.* An "NDA" is a new drug application, and an "ANDA" is an abbreviated new drug application.

USPQ2d 535, at *16 (quoting *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2003 (TTAB 2014)).

Inasmuch as Applicant's web page excerpts contain no such information "calculated to consummate a sale," we agree with the Examining Attorney that Applicant's web page excerpts are merely advertising and therefore are unacceptable to show use of the proposed mark in commerce.

c. The record as a whole

Lastly, Applicant argues that "when the specimens are considered ***collectively*** it is clear that the applied-for mark is used 'in commerce.'"[28] The Examining Attorney disagrees, stating: "Applicant has not submitted a single specimen which sufficiently shows evidence of use of the mark in commerce."[29]

We find that, whether taken individually or as a whole, Applicant's specimens do not support a finding that ALEMBIC PHARMACEUTICALS is anything more than a trade name. Simply put, we find nothing in the record which persuades us that purchasers and prospective purchasers of Applicant's products would perceive the term ALEMBIC PHARMACEUTICALS, as it is used on the goods, as anything other than Applicant's trade name.

d. Conclusion

We find that, as used by Applicant on its specimens, ALEMBIC PHARMACEUTICALS would be perceived by purchasers and prospective purchasers

[28] Applicant Supplemental Br., p. 9, 17 TTABVUE 10.

[29] Examining Attorney's Br., 19 TTABVUE 23.

as a trade name serving to identify Applicant as a business entity, rather than as a mark which identifies and distinguishes Applicant's goods from those of others. *See Diamond Hill Farms*, 32 USPQ2d at 1384 (holding that DIAMOND HILL FARMS, as used on containers for goods, is a trade name that identifies applicant as a business entity rather than a mark that identifies applicant's goods and distinguishes them from those of others). We also find that ALEMBIC PHARMACEUTICALS has not been used in commerce as a trademark.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed. The refusals to register under Sections 1, 2, and 45 of the Trademark Act on the grounds that the proposed mark is merely used as a trade name, and because it has not been used in commerce, are likewise affirmed.