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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Opposition No. 79,037

The NutraSweet Company

v.

Pfizer Inc.

MAILED

NOV 23 1992

Before Sams, Rooney and Simms, Members.

Opinion by Simms, Member:

11/23/92

On June 16, 1992, the United States Court of Appeals for the Federal Circuit vacated our September 30, 1991, decision dismissing the opposition to registration by applicant of the mark NOVASWEET for a synthetic sugar substitute, and remanded this case for reconsideration in light of a recent decision by that court, Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (1992). The Board then requested the parties to file briefs to aid it in the disposition of this case.

In this proceeding opposer challenged applicant's right to register the mark NOVASWEET on the basis of opposer's mark NUTRASWEET (with and without design) for nutritive, low-calorie sugar substitute products, previously used and registered by opposer and its predecessors.⁽¹⁾ Opposer believes that applicant's mark is so similar to opposer's that confusion is

(1) Applicant's product has not yet been approved by the Food and Drug Administration and is not commercially available.

likely. The Board held that there were no genuine issues of fact for trial and that summary judgment was appropriate. Specifically, there were no genuine issues with respect to opposer's priority, the similarity of the goods (branded ingredients), the channels of trade and the fame of opposer's mark to the trade and the consuming public. The Board stated, 5-6:

Even though opposer's mark must be considered famous and the goods of the parties identical, we believe that applicant's mark is sufficiently different in sound, appearance and meaning or commercial impression from opposer's mark that confusion is unlikely. In our opinion the public will be aware of the differences in the marks and not attribute applicant's product to the source of opposer's. See *The B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988).

The Board granted applicant's cross motion for summary judgment and dismissed the opposition.

It is applicant's position that, notwithstanding the court's decision in Kenner, this opposition should be dismissed. Applicant argues that the Board did not hold the fame of the mark NUTRASWEET to be a liability but instead decided this case on the basis that there are significant differences in the respective marks of the parties which outweigh the fame of opposer's mark. The overall sound of the respective marks, their different connotations ("nutritional" v. "new" or "bright star") and the distinctive swirl logo used by opposer in promoting its mark support the Board's finding, applicant argues. Moreover, according to applicant, professional buyers responsible for purchasing ingredients on behalf of major food and beverage

manufacturers are highly knowledgeable and sophisticated purchasers. Also, it is applicant's position that the sophistication of the calorie-conscious consumer is a factor weighing in applicant's favor. Applicant also maintains that, contrary to the implication of bad faith of the applicant in Kenner, here applicant has expended substantial sums in research and development to bring a new patented compound to the market which has certain advantages (longer stability and shelf life in processed foods, better results in candy and baked goods etc.) over opposer's sweetener.

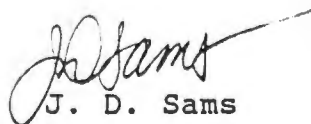
Opposer, on the other hand, argues that under Kenner, the Board should give a dominant role in the likelihood of confusion analysis to a famous mark. That is because, according to opposer, the danger of confusion with respect to relatively inexpensive items is increased where a famous mark is involved since less care is taken by consumers in selecting those products. Opposer reiterates that the parties' sweetening ingredients involved in this opposition proceeding are substantially identical and competing ingredients which are included in impulse-purchase food and beverage items sold to the same class of unsophisticated consumers.

After careful consideration of the arguments of the parties and in view of the court's recent decision in Kenner, we are persuaded that we gave too much weight to the differences in the marks and not enough weight to the fame of opposer's mark. (2)


(2) We continue to believe that there are no genuine disputes with respect to any of the relevant du Pont factors.

We are persuaded that the marks, whose first syllables begin with the letter "N," whose second syllables ends in the letter "A" and whose last syllable is identical, and which have similar cadences are so similar that confusion is likely. These similarities, we now believe, outweigh the differences in connotation. In view of the fact that more protection against confusion is allowed for famous marks because purchasers are less likely to perceive differences from the famous mark, we conclude that applicant's mark NOVASWEET for a sweetening ingredient is so similar to opposer's famous registered mark NUTRASWEET for a substantially identical product that confusion is likely. See also *Century 21 Real Estate Corp. v. Century Life of America*, ___ F.2d ___, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (when the marks are used on substantially identical goods the degree of similarity needed to support the conclusion of likelihood of confusion declines).

Accordingly, opposer's motion for summary judgment is granted and applicant's cross motion for summary judgment is denied. The opposition is sustained and registration to applicant is refused.


J. D. Sams


L. E. Rooney


R. L. Simms
Members, Trademark
Trial and Appeal Board