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T. Fleming
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U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Icosa Company
v.
ICOS Corporation

Opposition No. 84,379 to application Serial No. 74/006,535
filed November 17, 1989.

Katie E. Sako of the firm of Christensen, O'Connor, Johnson &
Kindness for Icosa Company.

Daniel Laster of the firm of Perkins Coie for ICOS Corporation.

Before Simms, Cissel & Hohein, Members.

Opinion by Simms, Member:

Icosa Company (opposer), a Washington corporation, has
opposed the application of ICOS corporation (applicant) to
register the mark ICOS for "research and development relating to
therapeutic and diagnostic products relating to human

diseases."(1) In the notice of opposition, opposer asserts that

applicant's mark so resembles the trade name "Icosa" previously

used by opposer in the health care field in connection with the

distribution of therapeutic and preventative health care products

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(1) Application Serial No. 74/006,535, filed November 17, 1989.
The application is an intent-to-use application filed pursuant to
Section 1(b) of the Act, 15 USC 1051(b).

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including vitamins, minerals, fibers, lipids and health foods, as to be likely to cause confusion, to cause mistake or to deceive. Opposer also asserts that it has used the trademark ICOSA in connection with many of these goods. Finally, opposer asserts that applicant's mark falsely suggests a connection with opposer under Section 2(a) of the Act, 15 USC 1052(a).⁽²⁾

In its answer applicant has denied the essential allegations of the opposition. As "affirmative defenses," applicant has charged that there is no likelihood of confusion because of differences in the marks and the services as well as the channels of trade. More particularly, applicant asserts that it is a research and biopharmaceutical company involved in the research of serious chronic inflammatory diseases such as arthritis, multiple sclerosis and asthma and the development of treatments for such diseases. In its answer, applicant also indicates that its customers are doctors, scientists, hospital professionals, research companies, laboratories and biomedical institutions and that, to the extent that opposer sells its services to some of the same customers, there is no likelihood of confusion because applicant's customers are technically sophisticated and exercise substantial care in selecting biotechnological services. Finally, applicant asserts that it adopted its mark in good faith without knowledge of opposer's trade name and trademark and that there have been no instances of actual confusion.

(2) Opposer has not pressed this ground in its brief and we have not, therefore, considered this ground in our decision.

The record of this case consists of testimony (and exhibits) taken by both parties; certain of applicant's discovery responses relied upon by opposer's notice of reliance; and an article from a printed publication submitted pursuant to applicant's notice of reliance. The parties have filed briefs, but no oral hearing of argument was requested.

According to the testimony of opposer's president, Joel Strickland, since 1988 opposer has been engaged in the distribution and sale of such goods as health foods, vitamins, minerals, food supplements, homeopathic remedies, books, magazines and housewares. However, it does not appear that opposer sold any goods with labels bearing the trade name or trademark "Icosa Company" until July 1990. Strickland dep., 52, 56 and 81. At that time opposer also began using stationery bearing its company name. Initially, opposer's customer's were friends and relatives, but now approximately 70 percent of opposer's customers are members of the general public. From the home of opposer's president as well as a storefront location (open one day a month), opposer's sales have grown from about \$500 in 1989 to approximately \$40,000 in 1991. Approximately ten percent of opposer's business is involved in the sale of vitamins, minerals and food supplements.

While opposer does do some business by mail order, the primary business is conducted as follows: Opposer sells catalogs of suppliers (on which it places labels bearing its name); customers who purchase these catalogs make their selections and place orders with opposer; and those customers pick up their orders on

the day of the month when opposer's store is open. Most of opposer's promotion is through word of mouth, although opposer is also listed in the phone book. However, opposer conducts no newspaper or magazine advertising. There have been no instances of actual confusion but there have been at least two cases where inquiry has been made concerning whether opposer is related to applicant.

Applicant's record includes the testimony of its executive vice president of finance and administration and chief financial officer, Janice LeCocq. Located near Seattle, Washington, applicant is a biopharmaceutical company with approximately 100 employees. Applicant has done and continues to do research in the field of chronic inflammatory diseases such as multiple sclerosis, rheumatoid arthritis, asthma and inflammatory bowel disease. The following testimony by Ms. LeCocq, given during a discovery deposition, further explains applicant's research services:

Q. I must be really dense today. I'm not understanding what kind of research services you intend to provide under this mark.

A. Well, if I can give you an example of the Glaxo arrangement -- and I won't go beyond the Glaxo arrangement because that's proprietary beyond that -- but the Glaxo arrangement is within the field of cell activation there's a signal transduction pathway, the way cells get activated, which is related to a family of enzymes called phosphodiesterases, and those enzymes are involved in a wide range of cells [sic] activation. There have been a number of therapeutics that have been attempted to be developed on the market, but those tend to have side-effects that are not attractive. We have the belief that if you can inhibit a subset of those enzymes, that is, on a tissue-specific or organ-specific basis, you can develop better therapeutics. We have proprietary knowledge and we have expertise that is of very high quality in the area of cell activation and we have technologies that allow us to identify gene families

and the products of those genes beyond what is currently available in other pharmaceutical companies. Glaxo has compounds, expertise in bringing products to market that we don't have. So we provide what is broadly described as molecular biology and cell biology expertise with respect to the signal transduction pathway and the genes that control it, to that relationship.

* * * * *

MR. NG: ...I want to know what therapeutic products relating to human diseases, what that encompasses as intended by ICOS.

A. At the present time our research program contemplates products that fall into two general categories: Potentially biological or derivatives of biological, such as monoclonal antibodies, receptors, and on the other side, things that would be considered more traditional pharmaceuticals, that is, small molecules that could be administered in oral dosage form or inhaled or things that you think of now as more traditional pharmaceuticals.

Q. So it's the present intent of ICOS to remain in those two areas that you have just mentioned?

A. Given that I defined those fairly broadly, that is, pharmaceuticals and biologicals, it is the present intent of the company to stay within those areas.

(LeCocq dep., 19-20, 23-24)

Applicant's research services are offered to major pharmaceutical companies as well as to academic and research institutions, doctors and medical practitioners, and corporations. Applicant's competitors include large pharmaceutical and biopharmaceutical companies as well as other biotechnology companies. In return for the performance of applicant's services, applicant receives compensation in the form of money as well as rights to certain technology. Applicant conducts no advertising in scientific journals. Business is attracted mainly by the reputation of the scientists and other employees of applicant.

Before applicant agrees to perform its research services for others, applicant's employees meet with a potential customer and the parties may eventually sign a contract after one or more such meetings have been held.

Priority

While there is some dispute with respect to the precise date on which opposer may be considered to have first used its trade name, applicant has conceded that opposer used the name Icosa Co-op (later Icosa Company) as a trade name since at least February 1989, prior to the November 17, 1989, filing date of its intent-to-use application.(3)

Likelihood of Confusion

There can be no doubt that the terms "Icosa Company" and "ICOS" are very similar in sound, appearance and meaning. Indeed, both terms have derivation from the Greek root word *icos* meaning "twenty."(4) If opposer's trade name and applicant's service mark were used in connection with commercially related goods and

(3) While opposer claims priority of use since February 1988, a careful reading of opposer's record reveals only that the first sale of goods by opposer was in 1988. However, the testimony is somewhat vague with respect to how opposer's trade name may have been used in connection with any sale of goods at that time, and there is no documentary support for the use of any trade name or trademark at that time. The testimony is clear that by July 1990 opposer began affixing labels bearing the name Icosa Company to the vitamins, minerals and food supplements which it sold. Of course, opposer's registration of its name in the state of Washington in 1988 is largely irrelevant to the question of priority because any superior rights must emanate from some type of exposure of the mark to the purchasing public. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 11 USPQ2d 1638 (Fed. Cir. 1989).

(4) More particularly, applicant's mark appears to have its derivation from the word "icosahedron" meaning a twenty-sided figure.

services, there might well be a likelihood of confusion. However, for the reasons set forth below, we find that applicant's use of its mark in connection with research and development services relating to human diseases would not be likely to cause confusion with opposer's trade name (and trademark) used in connection with the selling of a variety of goods including vitamins, minerals and food supplements.

While opposer argues that its vitamins, minerals and food supplements are "therapeutic products" which are similar or identical to the "therapeutic...products" recited in applicant's identification of services, applicant's recited services are in reality a different activity from opposer's catalog retail services and goods which travel in different channels of trade to a different class of customer. The relatively sophisticated biomedical pharmaceutical research services which applicant offers are clearly dissimilar from the retail sales and services of opposer.

While opposer argues that the specific channels of trade in which applicant operates are irrelevant since there is no limitation in applicant's description of services, opposer has, we believe, misunderstood the cases on which it relies and taken out of context the language it quotes. Where goods or services in an application or registration are broadly described and there are no limitations in the description with respect to the channels of trade or classes of purchasers, we must presume, according to precedent, that the scope of the application or registration encompasses all goods or services of the nature and type

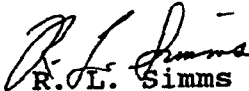
described, that the identified goods or services move in all channels of trade that would be normal for such goods or services, and that the goods or services would be purchased by all potential customers for such products. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The particular channels of trade and classes of customers reflected by the evidence become irrelevant in those cases. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, however, applicant describes its services as research and development services for therapeutic and diagnostic products relating to human diseases. Because it is not at all clear what the normal channels of trade or classes of customers are for these services, we may look to the evidence of record to determine what channels of trade or classes of customers may be involved in the rendering of the identified services. As noted above, applicant's services may be rendered to major pharmaceutical companies as well as to research institutions and universities. These channels of trade and classes of customers are completely different from the customers of opposer's retail services--individuals and food-buying groups interested in purchasing a variety of goods including toiletries, vitamins, minerals and food supplements, as well as other goods. When properly analyzed, it can be seen that applicant's services are significantly different from the goods and services sold and

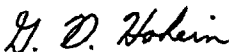
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performed by opposer. (5) It is also clear that the care exercised in the purchasing of applicant's research and development services, which is usually done after lengthy contractual negotiations, would lessen what little possibility, let alone probability, there is for confusion.

Decision: The opposition is dismissed.


R. L. Simms


R. F. Cissel


G. D. Hohein
Members, Trademark
Trial and Appeal Board

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(5) While opposer argues that it has performed some "research services" (brief, 8), this "research" can only be described as unscientific at best. According to opposer's record, its president and a friend attempted to learn the effects of ingesting wheatgrass. This effort was by no means a true scientific test. No rigid analytical procedures were apparently followed, no records were apparently kept, no staff was involved in the gathering of data and no laboratory analyzed any results. Applicant's services, on the other hand, involve clinical trials and are subject to regulatory review.