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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allergan, Inc.
v.
BioCentric Laboratories, Inc.

Opposition No. 91161603
to application Serial No. 78320975
filed on October 30, 2003

Kenneth L. Wilton of Seyfarth Shaw for Allergan, Inc.

Rebecca Spaar for BioCentric Laboratories, Inc.

Before Quinn, Hohein and Bergsman, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

BioCentric Laboratories, Inc. has filed an application
to register the mark SEATOX for "cosmetic[s]." ¹

Allergan, Inc. has opposed registration on the ground
that applicant's mark, when applied to applicant's goods, so
resembles opposer's previously used and registered mark
BOTOX for pharmaceutical preparations as to be likely to
cause confusion. More specifically, opposer has pleaded
ownership of three registrations of the mark BOTOX covering

¹ Serial No. 78320975, filed on October 30, 2003, alleging a bona fide intention to use the mark in commerce.

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the following goods: "pharmaceutical preparations, namely, ophthalmic muscle relaxants";² "pharmaceutical preparations for the treatment of neurologic disorders";³ and "pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pain."⁴

Applicant, in its answer, has denied the salient allegations of likelihood of confusion.

The record consists of the pleadings;⁵ the file of the involved application; trial testimony, with related exhibits, taken by opposer;⁶ and certified copies of opposer's pleaded registrations, showing that such registrations are subsisting and owned by opposer, and

² Registration No. 1692384, issued on June 9, 1992; renewed.

³ Registration No. 1709160, issued on August 18, 1992; renewed.

⁴ Registration No. 2510675, issued on November 20, 2001; Section 8 affidavit accepted, Section 15 affidavit filed.

⁵ Statements made in pleadings cannot be considered as evidence in behalf of the party making them; instead, such statements must be established by competent evidence during trial. Inasmuch as applicant did nothing during its testimony period, the factual statements in its answer have no evidentiary value. Further, it is noted that applicant attached exhibits to its answer. Exhibits attached to a pleading, however, are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter made of record during trial. Trademark Rule 2.122(c); TBMP § 704.05(a) (2d ed. rev. 2004). Because those exhibits were not made of record during trial, they have not been considered.

⁶ In addition to the testimony of opposer's vice president, opposer took the testimony of Rebecca Spaar, applicant's chief executive officer.

copies of third-party registrations and applications of TOX-suffix marks, all introduced by way of opposer's notices of reliance. Applicant did not take testimony or offer any other evidence.⁷ Both parties filed briefs on the case.⁸

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made its pleaded registrations of record and, further, has shown that it is not a mere intermeddler. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

⁷ Applicant filed, long after the close of its testimony period, numerous documents captioned "Submission No. 9." In response to opposer's motion to strike, applicant withdrew the submission. Accordingly, those documents have not been considered.

⁸ Opposer's brief was timely filed in compliance with an earlier order. Accordingly, opposer's request for an extension of time is deemed moot. Applicant's brief was filed one day late, and opposer has moved to strike the untimely brief, also pointing out that the Board earlier warned applicant that strict compliance with the rules of practice was expected in this proceeding. In view of the late filing, the brief will not be considered. We hasten to add, however, that even if considered, the brief would not compel a different decision on the merits in this case. Further, so as to remove any question, even if the brief were considered, factual statements made in a party's brief can be given no consideration unless they are supported by evidence properly introduced at trial. In this case, applicant did not introduce any evidence at trial, and Ms. Spaar's testimony taken by opposer does not support the factual statements in applicant's brief. Thus, applicant's statements in its brief have no evidentiary value. TBMP § 704.06(b) (2d ed. rev. 2004). In addition, the exhibits attached to the brief would not be considered as evidence in reaching a decision inasmuch as the exhibits were not made of record during trial. TBMP § 704.05(b) (2d ed. rev. 2004).

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Further, in view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

Our determination herein is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1848. In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

Inasmuch as opposer introduced evidence bearing on the fame of its mark BOTOX, we first turn to consider this du Pont factor. Fame of the prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63

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USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the Federal Circuit stated in *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305:

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the duPont factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark...casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ...recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Opposer has been marketing a pharmaceutical preparation under the mark BOTOX since about 1991, and its use of the mark has been continuous thereafter. Tom Albright, opposer's vice president of global strategic marketing, testified that in 2002, the United States Food and Drug

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Administration (FDA) approved opposer's BOTOX brand product for a cosmetic indication, and opposer began touting its product as giving the user "temporary improvement in the appearance of moderate to severe frown lines between the brows in people 18 to 65 years of age." (Albright dep., p 23, ex. no. 14). Upon the FDA's approval of opposer's BOTOX brand product for a cosmetic indication, opposer was required, when it promoted its product for that indication, to use the term "Cosmetic" next to the BOTOX mark. Thus, while the product sold under the BOTOX mark did not change, when marketed for purposes of the cosmetic indication (as opposed to therapeutic indications), the mark appears as "BOTOX® Cosmetic."

Once the FDA approved the cosmetic indication for opposer's product, sales under the mark increased dramatically. During the period 1999-2004, opposer's total revenues under the mark in the United States approached \$1.7 billion. In 2002-2003, opposer's annual advertising expenditures were approximately \$12-\$14 million. In 2004 and going forward, annual advertising expenditures have been in the range of \$25-\$35 million. Opposer advertises its goods on television and its website, and in magazines and newspaper inserts.

Ms. Spaar admitted that applicant had knowledge of opposer's BOTOX mark and product at the time of applicant's

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selection of its mark SEATOX. She replied, "I haven't lived under a rock. Everybody has heard of BOTOX. Everybody knows who you are." (Spaar dep., p. 83).

The record establishes opposer's continuous use of its mark BOTOX for over fifteen years. Opposer's revenue and advertising numbers are impressive, and Ms. Spaar's statement is tantamount to a concession that opposer's mark is famous.

Accordingly, we find that opposer's BOTOX mark is famous for a pharmaceutical preparation that has, inter alia, a cosmetic indication. This factor weighs heavily in opposer's favor.

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

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The marks BOTOX and SEATOX are similarly constructed, two-syllable coined terms. The marks are similar in sound and appearance in that both begin with a single syllable and end in a TOX-suffix. As to connotation, applicant, in explaining the meaning of its mark, contends that the "SEA" portion of its mark "is for the MSM and the Red Seaweed Extract from the sea," and that "TOX" is "for detoxifying." (Interrogatory No. 3). We find that any specific differences in meaning, as well as in sound and appearance between the marks BOTOX and SEATOX, are outweighed by the similarities, especially in light of the absence on this record of any instances of third-party use of similar marks. Further, the marks at issue engender sufficiently similar overall commercial impressions that consumers, when encountering the BOTOX and SEATOX marks, are likely to believe that the products sold thereunder emanate from a common source. The similarity between the marks weighs in opposer's favor.

The record includes copies of four Class 3 DETOX-suffix registrations obtained by third parties prior to April 2002 (the date of the FDA approval of opposer's product for a cosmetic indication), and twenty-five Class 3 TOX-suffix applications filed by third parties after April 2002. As asserted by opposer, prior to the FDA approval, there were no active Class 3 registrations of marks with a TOX-suffix

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for skin care products (although the register did include marks ending in DETOX). After the FDA approval, the record shows that over twenty-five applications were filed by third parties to register TOX-suffix marks for cosmetics in Class 3. Opposer contends (Brief, p. 17):

The explanation for this contrast is two-fold. First, the TOX suffix, in and of itself, has no logical meaning in the cosmetic world and in fact would seem to convey the exact opposite of any quality one would want a cosmetic product to have. Second, third parties apparently believe that use of a TOX-suffix will help associate their products with the BOTOX product. While not dispositive, this evidence supports the conclusion that consumers, when faced with a similar product incorporating a TOX-suffix, are likely to believe that that product is a derivative of or is somehow associated with the BOTOX product, and emanates [from] the same source.

We have no way of knowing the validity of opposer's claim relative to the intentions of third parties, but suffice it to say that the pre-2002/post-2002 contrast in filings would appear to be other than coincidental. In any event, the current record, upon which our decision is based, is devoid of any third-party registrations or uses of TOX-suffix marks in the cosmetics field.

Insofar as the goods are concerned, it is well established that the goods of the parties need not be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of

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confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue is not whether purchasers would confuse the goods but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Although opposer's product is given by an injection administered by a physician, and applicant's product is an over-the-counter cream, these differences are not reflected in the respective identifications of goods. As stated earlier, the record establishes that opposer's BOTOX brand product has a cosmetic indication, namely to improve the appearance of wrinkles on the forehead. Applicant's identification of goods is broadly worded and, therefore, we must assume that the goods encompass all types of cosmetics, including those that are intended to reduce the appearance of wrinkles on the skin. And, in point of fact, Ms. Spaar admitted that applicant's product is designed to reduce

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wrinkles. Applicant states, in its advertising, that its SEATOX brand product functions "by relaxing the muscles, as opposed to paralyzing them with chemical injections." The advertisement further indicates that applicant's product reduces wrinkles "without the paralysis as with Botox® injections," and that a user may "[m]inimize fine lines and wrinkles without the expense (\$400 per injection), the pain or side effects." (Spaar dep., ex. nos. 29 and 30).

Thus, while the products are specifically different, the goods are nevertheless related as evidenced by applicant's telling comparison of its product with opposer's product. Moreover, Mr. Albright testified that opposer considers over-the-counter creams to compete with its BOTOX brand product for a cosmetic indication:

Well, over-the-counter creams and lotions are the first mechanisms of treatment that patients use when they're looking in the mirror and they see unnecessary frown lines between their eyes.

And so they'll try putting creams and lotions on there to try to either make the lines go away or prevent formation of new lines. And so they'll try that for many years before they'll finally resort to BOTOX cosmetic. (Albright dep., p. 32).

Both products would appear to serve the same function or purpose, namely, to reduce wrinkles of the user.

Neither opposer's goods nor applicant's goods are limited as to trade channels, and we therefore presume that

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the respective goods move through the channels normal for these types of goods. *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992). Those trade channels, such as drug stores and supermarkets with pharmaceutical sections, are overlapping. Moreover, the same types of consumers, namely ordinary consumers who are interested in reducing their skin wrinkles, would purchase such products.

The similarities between the parties' products, as well as the overlap in trade channels and class of customers for the products, are factors that weigh in opposer's favor in finding a likelihood of confusion.

We have carefully considered all of the evidence pertaining to the relevant du Pont factors, as well as all of the arguments with respect thereto (including any arguments not specifically discussed in this opinion), and we conclude that opposer has proven its likelihood of confusion ground of opposition. Specifically, given the fame and commercial strength of opposer's mark, the degree of similarity in the parties' marks and goods, and the overlap in trade channels and customers, we find that applicant's mark SEATOX is sufficiently similar to opposer's mark BOTOX that confusion is likely.

We conclude that purchasers familiar with opposer's pharmaceutical preparation sold under its famous mark BOTOX

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would be likely to believe, upon encountering applicant's mark SEATOX for cosmetics, that the goods originated with or were somehow associated with or sponsored by the same entity. Such consumers, familiar with opposer's mark BOTOX for pharmaceutical preparations may believe, as suggested by opposer, that applicant's mark SEATOX identifies a related product emanating from opposer, perhaps an adjunct or complementary product with a formulation that includes a sea-based ingredient.

A newcomer has both the opportunity and the obligation to avoid confusion. Consequently, a party that knowingly adopts a mark similar to one used by another for the same or closely related goods does so at its own peril; all doubt on the issue of likelihood of confusion must be resolved against the newcomer. This is especially the case where the established mark is one that is famous. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456; *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); and *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985).

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.