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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allergan, Inc.
v.
KRL Group, Inc.

Opposition No. 91169544
to application Serial No. 78553180
filed on 01/25/2005

Kenneth L. Wilton and Julia K. Sutherland of Seyfarth Shaw for
Allergan, Inc.

Claudio Rivera for KRL Group, Inc.

Before Quinn, Taylor and Adlin,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

KRL Group, Inc. ("applicant") filed, on January 25, 2005,
an application to register the mark BOTULEX (in standard
characters) for "non-medicated skin care preparations for
topical application to the skin" in International Class 3.
Applicant alleges first use of the mark anywhere and in commerce
on October 2, 2004.

Allergan, Inc. ("opposer") opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when used in connection with applicant's goods, so resembles opposer's previously used and registered mark BOTOX (in typed or standard characters) for "pharmaceutical preparations, namely, ophthalmic muscle relaxants";¹ "pharmaceutical preparations for the treatment of neurologic disorders";² 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,"³ as to be likely to cause confusion.⁴

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

The record consists of the pleadings; trial testimony (with related exhibits) of Mark Chaplin, opposer's global strategic marketing manager, taken by opposer; status and title copies of opposer's pleaded registrations introduced by way of opposer's notice of reliance; and various documents submitted with

¹ Registration No. 1692384, issued on June 9, 1992; renewed.

² Registration No. 1709160, issued on August 18, 1992; renewed.

³ Registration No. 2510675, issued on November 20, 2001; renewed.

⁴ In its brief opposer specifically withdrew its claims of lack of ownership of the mark and fraud.

applicant's notice of reliance.⁵ The parties filed briefs.⁶

STANDING

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made of record its pleaded registrations of its mark BOTOX; in addition, opposer demonstrated its use of the mark BOTOX. Thus, opposer has shown that it is not a mere intermeddler. Opposer's use and/or registration of its mark establish that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

PRIORITY

In view of opposer's ownership of valid and subsisting registrations of its mark BOTOX, opposer's priority is not in issue with respect to the goods identified in those

⁵ Several of the documents are not proper subject matter for introduction by a notice of reliance. Other than hearsay objections, however, opposer has treated them of record, noting that some of the evidence is probative of opposer's case. Accordingly, we have considered the documents to be stipulated into the record, although in considering them we have kept in mind opposer's hearsay objections.

⁶ Applicant, in its brief, objected to opposer's testimony deposition on the ground that it was not timely filed with the Board. With regard to the filing requirements of Trademark Rule 2.125(c), the Board "will accept transcripts of testimony depositions at any time prior to the submission of the case for final decision." TBMP § 703.01(k) (2013). Inasmuch as the transcript was filed on July 12, 2013, the objection is overruled, and the Board has considered the testimony.

registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

LIKELIHOOD OF CONFUSION

Our determination under Section 2(d) 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. In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *du Pont* factors in the proceeding now before us, are discussed below.

FAME

We begin with this *du Pont* factor, on which opposer has introduced a significant amount of probative evidence. Indeed, applicant states "[i]t is clear that the BOTOX mark has achieved celebrity." (Brief, p. 1). 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 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). Because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); and *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer began using its mark BOTOX for pharmaceutical preparations in the late 1980's, and has continually used the mark since that time. Between 1998 and the end of 2011, opposer's revenues from goods sold under the mark BOTOX in this country were almost \$10 billion; the most recent figures show revenue for 2011 at nearly \$1.6 billion. (Chaplin dep., pp. 45-57).

Opposer has promoted its goods for cosmetic use in magazines (Elle, Glamour and Redbook), and medical journals (Journal of American Academy of Dermatology, and Skin and Allergy News), on television and radio, and on the Internet. Since 2002, opposer's advertising expenditures for promoting the cosmetic indication for the goods sold under the mark BOTOX exceed \$175 million; in the period 2005-2012, opposer spent

about \$15 million per year in the United States on its promotional efforts. (Chaplin dep., pp. 16-24).

The target audience for opposer's product comprises females, aged 30-60 years, with a household income of more than \$50,000. Among this group, opposer's own market research shows a brand awareness of the mark BOTOX of over 95%. (Chaplin dep., pp. 43-44). See *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (substantial evidence proving fame included internal brand awareness study).

Based on the record before us, we find that opposer's mark BOTOX is famous for pharmaceutical preparations for various indications, including cosmetic use for skin care. See *Allergan, Inc. v. Mira Life Group, Inc.*, 72 USPQ2d 1756, 1758 (C.D. Cal. 2004) (the Court found "the BOTOX® mark has become famous in the United States" based on evidence similar to that in the present proceeding). Contrary to the gist of applicant's argument that confusion with a famous mark is less likely to occur among consumers (Brief, pp. 10-11), the case law is clear that famous marks enjoy a wide latitude of protection. "Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.... When an opposer's trademark is a strong, famous mark, it can never be of little consequence." *Recot Inc.*

v. M.C. Becton, 54 USPQ2d at 1897, quoting *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984). The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456.

We find the *du Pont* factor focusing on fame weighs heavily in favor of finding a likelihood of confusion.

THE GOODS

We next turn to consider the second *du Pont* factor regarding the similarity/dissimilarity between the goods. It is well settled that the goods of the parties need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of 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 *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); and *Hilson Research, Inc. v. Society for*

Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). The issue, of course, 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). "When a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark." *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1310, citing *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1898.

We make our determination regarding the similarities between the parties' goods, channels of trade and classes of purchasers based on the goods as they are identified in the application and registrations, respectively. *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

In 2002, the United States Food and Drug Administration ("FDA") approved opposer's pharmaceutical preparations for a cosmetic indication, namely, for the temporary improvement in the appearance of glabellar lines, more commonly known as "frown" lines or wrinkles that appear in the middle of the forehead. The product did not change when the FDA approved it

for a cosmetic indication. When the FDA approved opposer's product offered under the mark BOTOX for a cosmetic indication, it required opposer to adopt, for purposes of promoting its product for such use, the term "Cosmetic" to appear next to the mark BOTOX. (Chaplin dep., pp. 14-15). Thus, when opposer's product is marketed for purposes of a cosmetic indication, the mark appears as "BOTOX Cosmetic."

Applicant's goods are identified as "non-medicated skin care preparations for topical application to the skin." Inasmuch as there is no limitation in the identification, applicant's goods must be construed to encompass skin care preparations that are intended to reduce the appearance of wrinkles and lines. When so construed, applicant's goods are similar to opposer's pharmaceutical preparations for a cosmetic indication, namely, to reduce wrinkles and frown lines.

As shown by applicant's packaging, applicant has adopted the word "Cosmetic" in connection with its use of BOTULEX, while describing its product as an "Injection-Free BOTOX Alternative."



The packaging highlights applicant's effort to market its product as an alternative to opposer's product. As Mr. Chaplin testified: "Ultimately when you use a cream or lotion, you know, again, you're looking at maybe reducing the appearance of fine lines, wrinkles, making yourself look a bit younger, make yourself a little bit fresher, so ultimately they are a competition to the injectables." (Chaplin dep., p. 43).

The distinction pointed out by applicant, namely, that consumers need a prescription to obtain opposer's injectable product, is of little consequence when we consider the fact that applicant markets its product as a competitive alternative to opposer's product. Further, that the goods sold under the marks are classified in different classes, a major point argued by applicant, is irrelevant. See *Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) (classification is for the convenience of the Office).

The similarity between the goods is a factor weighing in favor of a finding of a likelihood of confusion.

TRADE CHANNELS and PURCHASERS

Inasmuch as there are no restrictions in applicant's identification or the identifications in opposer's registrations, it is presumed that the identifications encompass all goods of the type described, that they move in all normal trade channels for such goods, and that they are available to

all potential consumers for such goods. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973); and *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006). The normal trade channels for pharmaceutical preparations and cosmetics for skin care include drug stores, pharmacies, and mass merchandisers and supermarkets with pharmacy sections. See *Jean Patou, Inc. v. Theon Inc.*, 29 USPQ2d at 1774 (product having dual use as cosmetic and pharmaceutical remains in the same trade channels). Thus, applicant's argument based on differences in trade channels, which are not reflected in the identifications of goods, is unavailing.

In this connection, we agree with opposer's assessment that "notwithstanding the fact that opposer's BOTOX[®] product is a pharmaceutical preparation, it is not inconceivable, and is indeed likely, that it would be offered for sale together with skin creams as an adjunct or complement to the BOTOX[®] product in drug stores or supermarkets or general merchandise stores with pharmacies." (Brief, p. 12).

With respect to prospective and actual customers, as revealed by applicant's packaging (shown above), applicant markets its product to the same customers as opposer, as an alternative to opposer's product. Simply put, both parties market their goods to the same ordinary consumers who are

interested in reducing the appearance of skin wrinkles and lines.

The overlap in trade channels and classes of purchasers weighs in favor of a finding of a likelihood of confusion.

THE MARKS

We must compare opposer's mark BOTOX (in typed or standard characters) to applicant's mark BOTULEX (in standard characters) as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). The test, under the first *du Pont* 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 in terms of their overall commercial impression 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).

The marks BOTOX and BOTULEX are similar in appearance and, more likely than not, would be similar in sound.⁷ Both marks

⁷ The parties argue back and forth over how consumers will pronounce the marks. Applicant goes into great detail in explaining differences

begin with the letters "BOT-" and end with "X." As to meaning, the evidence shows that opposer's product contains "botulinum toxin." (Chaplin dep., p. 7). Opposer prominently discloses this fact in its advertising for the product. (See, e.g., Chaplin dep., Ex. Nos. 6, 7 and 10). Consumers familiar with this ingredient of opposer's BOTOX product may believe that applicant's mark BOTULEX likewise connotes that applicant's product includes the same or similar "botulinum toxin" ingredient, especially given that applicant promotes its product as an alternative to opposer's product. Given these similarities, the marks engender similar overall commercial impressions. See *Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1065 (Fed. Cir. 2012) (finding MILANZA confusingly similar to famous marks POTENZA and TURANZA).

The similarity between the marks weighs in favor of a finding of likelihood of confusion.

CONCLUSION

The relevant *du Pont* factors involving likelihood of confusion between the marks weigh decidedly in favor of opposer. We have carefully considered all of the evidence of record, as

between the marks in terms of pronunciation. There is no correct pronunciation of a trademark, however, and it obviously is not possible for a party to control how purchasers will vocalize its mark. *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006).

well as all of the arguments with respect thereto, including any arguments not specifically discussed in this opinion (as for example, applicant's irrelevant arguments that it has registered its mark in foreign countries and that it has obtained a favorable decision from a foreign Trademark Office).

We conclude, based on a preponderance of the evidence, that consumers familiar with opposer's pharmaceutical preparations sold under the famous mark BOTOX are likely to mistakenly believe, upon encountering applicant's mark BOTULEX for non-medicated skin care preparations for topical application to the skin, that the goods originate with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points argued by applicant raises a doubt about our finding of a likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user and registrant. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1707 (Fed. Cir. 1992); and *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

Decision: The opposition is sustained, and registration to applicant is refused.