

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Hearing: September 22, 2011

Mailed: November 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Abbott Laboratories

v.

Pet-Ag, Inc.

Opposition No. 91170148
to applications
Serial Nos. 76623502 and 76623503

Robert M. Newbury, Joseph N. Welch II, Bradley L. Cohn, and
Kristen S. Knecht of Pattishall Mcauliffe Newbury et. al.
for Abbott Laboratories

Robert E. Browne, Maurice E. Finnegan, III, and Luis M.
Lozada of Neal Gerber & Eisenberg LLP for Pet-Ag, Inc.

Before Zervas, Wolfson, and Shaw, Administrative Trademark
Judges.

Opinion by Wolfson, Administrative Trademark Judge:

On December 7, 2004, Pet-Ag, Inc. ("applicant") filed
applications for the marks CATSURE and DOGSURE,¹ in standard
characters, for "food supplements for cats" and "food

¹ Serial No. 76623502 for the mark CATSURE and Serial No.
76623503 for the mark DOGSURE, both filed December 7, 2004.

supplements for dogs" in International Class 5, on the basis of applicant's bona fide intent to use the marks in commerce. Abbott Laboratories ("opposer") opposes the registration of applicant's marks on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposer alleges that it is the owner of registrations for the marks ENSURE,² PEDIASURE,³ and NEOSURE⁴ for nutritional products and supplements, and that applicant's marks, CATSURE and DOGSURE, so resemble opposer's registered marks as to be likely to cause confusion, mistake, or deception among purchasers.⁵ Opposer also opposes registration on the ground of dilution under Section 43(c), 15 U.S.C. §1125(c).

Applicant has denied the salient allegations in the notice of opposition.

² Reg. No. 965204 for the mark ENSURE for "liquid nutritive preparations for oral or gavage feeding" issued on July 31, 1973; 10-year renewal granted January 8, 2004.

Reg. No. 1485012 for the mark ENSURE (in standard character form) for "dietary food supplements; namely, vitamins and minerals in a flavored pudding base" issued on April 19, 1988; 10-year renewal granted April 8, 2008.

³ Reg. No. 1475612 for the mark PEDIASURE (in standard character form) for "pediatric nutritive preparation" issued February 9, 1988; 10-year renewal granted February 12, 2008.

⁴ Reg. No. 2269656 for the mark NEOSURE (in standard character form) for "infant formula" issued on August 10, 1999; 10-year renewal granted August 27, 2008.

⁵ Opposer also alleges that it owned the mark PROSURE (in standard character form) for "nutritional supplements" (Reg. No. 2613559). The registration was cancelled on May 16, 2009.

The Stipulated Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

On November 18, 2010, the Board approved the parties' "Joint Motion for Entry of Stipulated Terms for Accelerated Case Resolution," ("Joint Motion") wherein the parties stipulated that they would file a joint stipulation of facts for use of the Board in deciding this proceeding; that fact testimony may be presented by declaration, including declarations previously filed in the case; that responses to interrogatories and requests to admit would be allowed into evidence; to admit a previously taken deposition transcript; and to the "authenticity and introduction into evidence of all documents which have been produced by either party during discovery or by any third party pursuant to subpoena."⁶ On December 10, 2010, pursuant to their Joint Motion, the parties filed a "Stipulated Joint Statement of Facts of the Parties for Accelerated Case Resolution," ("Stipulation") reciting undisputed facts in the case pertaining to the parties' products and trademarks.

⁶ Joint Motion for Entry of Stipulated Terms for Accelerated Case Resolution, filed November 3, 2010.

In addition to the December 10, 2010, submission of stipulated facts, each party has filed declaration testimony and evidence in this proceeding.

Opposer's Record

Opposer filed a notice of reliance to introduce the following testimony and evidence into the record during its testimony period:

1. Status and title copy of opposer's registration for the mark ENSURE for "liquid nutritive preparations for oral or gavage feeding;"⁷
2. Status and title copy of opposer's registration for the mark ENSURE for "dietary food supplements; namely, vitamins and minerals in a flavored pudding base;"⁸
3. Status and title copy of opposer's registration for the mark PEDIASURE for "pediatric nutritive preparation;"⁹
4. Status and title copy of opposer's registration for the mark NEOSURE for "infant formula;"¹⁰
5. Status and title copy of opposer's registration for the mark COMPLETE, BALANCED NUTRITION for "liquid or powder nutritive supplements for human use;"¹¹
6. Copy of the December 10, 2010 Stipulation, with attached exhibits;
7. Copy of applicant's response to opposer's first set of interrogatories, Interrogatory Nos. 5, 7, and 9;

⁷ Reg. No. 965204.

⁸ Reg. No. 1485123.

⁹ Reg. No. 1475612.

¹⁰ Reg. No. 2269656.

¹¹ Reg. No. 2082582, issued on the Supplemental Register.

8. The declaration of Augustin Martinez III, Director of ENSURE for North America at Abbott Nutritional Products, with attached exhibits;
9. The declaration of Tammy S. Smalls, Director of Toddler and Kid Marketing at Abbott Nutritional Products, with attached exhibits;
10. The declaration of Rhonda Hoffman, Director of Infant Formula at Abbott Nutritional Products, with attached exhibits;
11. The declaration of Michael T. Dluzynski, Controller for Pediatric Products at Abbott Nutritional Products;
12. The declaration of Jason Grudell, Marketing Manager for PROSURE at Abbott Nutritional Products, with attached exhibits;
13. The declaration of Peter B. Thompson, Product Manager for Medical Devices and Nutritionals at Abbott Animal Health;
14. The declaration of Jennifer B. Hayden, Account Executive for Abbott Creative Network;
15. The declaration of Ronald Hollar, Senior Manager, Global Third-Party Manufacturing for Abbott Nutritional Products;
16. The declaration of Jessica M. Marasa, Paralegal at Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, with attached exhibits;
17. The declaration of Louise B. Tennis, Paralegal at Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, with attached exhibits;
18. Excerpts from the December 18, 2007 discovery deposition of George K. Gill, applicant's Chairman and CEO;
19. Samples of opposer's promotional materials;¹²

¹² We note that a party's own promotional materials are not properly submitted under a notice of reliance. See Trademark Rule 2.122(e). In this regard, we construe the parties' Joint Motion as providing for cross-filings of evidence under notice of

20. Internet print-outs from opposer's websites (www.ensure.com, www.pediasure.com, www.welcomeaddition.com, www.prosure.com, www.abbott.com, and www.abbottstore.com) purporting to show opposer used at least two of its marks appearing together;
21. Internet print-outs from opposer's websites purporting to identify categories of opposer's products;
22. Internet print-out from abbottstore.com purporting to show retail prices for opposer's NEOSURE products;
23. Internet print-outs from third-party websites purporting to show retail prices of opposer's ENSURE, PEDIASURE and NEOSURE products and of applicant's DOGSURE and CATSURE products;
24. Copy of spreadsheet produced by applicant purportedly to show comparison of dietary formulations of ENSURE, DOGSURE, and CATSURE products.
25. Samples of applicant's press releases for DOGSURE and CATSURE products;
26. Samples of applicant's marketing and promotional materials for DOGSURE and CATSURE products;
27. Copy of a consumer questionnaire (filed under seal);
28. Copy of a presentation regarding applicant's products entitled "PetAg Takes The Bite Out of Aging;"
29. Copy of alleged meeting agenda notes (filed under seal);
30. Copy of letter dated August 9, 2000 (filed under seal);

reliance, as both parties have done. Opposer's Exhibits 24-39 and 33 also comprise material that is not normally appropriate for filing under notice of reliance; applicant's Exhibits Nos. 2-6, 8-21, 23, 25-28, 30 and 32 would also not normally be filed under a notice of reliance.

31. Newspaper and magazine clippings relating to applicant's products purporting to show the products have been equated to opposer's products;
32. Internet print-outs from www.supercoolpets.com purporting to equate DOGSURE and CATSURE supplements with ENSURE products; and
33. Copy of the Asset Purchase Agreement between opposer and applicant (filed under seal).

Applicant's Record

Applicant filed a notice of reliance to introduce the following testimony and evidence into the record during its testimony period:

1. Screenshots of products printed from applicant's website on March 3, 2011;
2. "Qualitative Research for Packaging for Ensure Final Report" prepared by opposer (filed under seal);
3. Copy of an internal presentation conducted by opposer regarding sales of ENSURE products (filed under seal);
4. "Ensure CPS Team Fact Book" (filed under seal);
5. "Ensure 2007 Business Review" (filed under seal);
6. "Ensure User Profile & Opportunity Assessment Worksession Presentation" (filed under seal);
7. Copy of TTAB notice of dismissal of Opposition No. 91171861 (Abbott Laboratories Corp. v. The Procter & Gamble Company);
8. E-mails dated November 13, 2006 and November 16, 2006 between opposer and a third-party regarding third-party's use of the mark INNOSURE, Serial No. 78864359;
9. "Pediasure User Study Presentation" (filed under seal);

10. "Similac 2009 Marketing and Business Plan" (filed under seal);
11. Letter dated January 1, 1999 purporting to show name change of infant formula Similac NeoCare to Similac NeoSure, and copy of advertising for NEOCARE formula;
12. E-mail from applicant to opposer (filed under seal);
13. Copy of opposer's internal e-mail (filed under seal);
14. Copies of opposer's internal e-mails (filed under seal);
15. Copy of e-mail from opposer to applicant (filed under seal);
16. Copy of opposer's internal e-mail (filed under seal);
17. Copy of opposer's internal e-mail (filed under seal);
18. "Ross/PetAg Meeting Notes" (filed under seal);
19. "Ross/PetAg Product Schedule" (filed under seal);
20. Copy of opposer's internal facsimile (filed under seal);
21. Copy of opposer's internal letter (filed under seal);
22. Copy of PR News Wire dated February 11, 2008 entitled "Petitioner Owner Survey Finds Misconception About Aging Pets; Debunks Myths, Offers Advice on Improving Senior Petitioner Care";
23. Copy of opposer's internal e-mail (filed under seal);
24. Internet print-out from www.petag.com of applicant's General News article entitled

- "PetAg's Aging Petitioner Care Awareness Survey - Results";
25. E-mails between applicant and opposer (filed under seal);
 26. Copy of opposer's internal presentation 2007 (filed under seal);
 27. Copy of opposer's internal presentation 2008 (filed under seal);
 28. Copy of opposer's internal presentation 2009 (filed under seal);
 29. Declaration of Darlene Frudakis, President and Chief Operating Officer of PetAg, Inc.;
 30. Opposer's Answers to Applicant's First Set of Request for Admissions;
 31. Declaration of Dr. Jean Heidker, Director of Research and Development for PetAg, Inc., with accompanying exhibits;
 32. Deposition of George K. Gill, Chairman and CEO of PetAg, Inc., dated December 18, 2007;
 33. Declaration of George K. Gill dated March 18, 2011, with accompanying exhibits;
 34. Declaration of Luis M. Lozada, associate attorney with the law firm of Neal, Gerber & Eisenberg LLP, applicant's attorneys, with accompanying exhibits.

Evidentiary Objections

Each party has objected to portions of the other party's evidence.

Opposer objects to an e-mail that applicant seeks to admit.¹³ Because the e-mail has been filed under seal, we

¹³ Applicant's Ex. 23.

refer to it only in general terms and do not discuss its contents. Opposer objects to the introduction of the e-mail as making an improper reference to potential settlement discussions. Applicant argues that the reference is not improper under the Federal Rules of Evidence. At the time the reference was made, although this proceeding had not yet commenced, an extension of time to oppose had been filed. Accordingly, we consider the reference to be prohibited by the Rules and decline to consider the reference contained in the e-mail.

Opposer further claims that paragraph 2 of the e-mail, as well as paragraph 15 of the Frudakis declaration¹⁴ and paragraph 14 of the Gill declaration,¹⁵ improperly reference a manufacturing agreement that was in place between the parties from May 10, 2002 to February 7, 2007.¹⁶ Our prior order (dated December 15, 2009) denied applicant's motion for leave to amend its answer to add a defense of unclean hands based on the manufacturing agreement. Applicant argues that its declarants mention the agreement only to show that the parties had a prior working relationship. Opposer, in reply, states that it does not object to mention

¹⁴ Applicant's Ex. 29. The Frudakis declaration has not been filed under seal.

¹⁵ Applicant's Ex. 33. The Gill declaration has not been filed under seal.

¹⁶ According to the Frudakis and Gill declarations, the manufacturing agreement was first entered into "over 15 years

of the agreement for this purpose, and we admit the evidence for this purpose. To the extent the statements may bear on the basis for termination of the agreement, we have not considered them.

Opposer further objects to applicant's statements regarding the significance of applicant's European Union and Japanese trademark registrations.¹⁷ The statements made in the declarations have no bearing on registrability of the marks in this country, and we have given them no further consideration.

Finally, opposer has objected to portions of the Frudakis declaration that refer to alleged discussions at a meeting as hearsay.¹⁸ We may admit the statements as proving the fact that Ms. Frudakis asked other employees if they recalled a certain draft of a meeting agenda. We have not, however, considered Ms. Frudakis' statements as proving one way or the other whether the draft meeting agenda reflects what actually happened at the meeting.

Applicant has objected to paragraph 2 of the declaration of Jennifer B. Hayden regarding an alleged conversation she overheard on the grounds of hearsay.¹⁹ For the same reasons as articulated with respect to Ms.

ago," and the "current form of this arrangement" was dated May 10, 2002. Frudakis Dec., p. 4; Gill Dec., p. 4-5.

¹⁷ Frudakis Dec. para. 15; Gill Dec. para. 14.

¹⁸ Specifically, opposer objects to paragraph 13 on this ground.

¹⁹ Opposer's Ex. 14. The declaration was not filed under seal.

Frudakis' declaration, we admit the objected-to statements of Ms. Hayden's declaration as testimony of what she heard and not as proof of the truth of the matters asserted therein.

Applicant further objects to any references to opposer's mark PROSURE, as Registration No. 2613559 for the mark was cancelled on May 16, 2009, and opposer discontinued production and sale of the product in or around 2008 without an intent to resume use of the mark "in the foreseeable future."²⁰ While a cancelled registration "does not provide constructive notice of anything," *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989), it is admissible under 37 C.F.R. § 2.122(e) as an official record. Opposer may rely on it for whatever probative value it may have in showing that opposer promoted its PROSURE mark as part of a purported family of "-sure" marks. To the extent the prior, now cancelled, registration has any evidentiary value, however, it is limited to the time that the mark was registered; i.e., from August 27, 2002 to May 16, 2009. See *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1021 n.4 (TTAB 2011).

²⁰ Stipulated Joint Statement of Facts No. 87; Opposer's Answers to Applicant's First Set of Requests for Admission, Request No. 38.

Standing

Because opposer has properly made its pleaded registrations of record showing opposer as owner and that the registrations are subsisting, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record showing opposer as owner and that the registrations are subsisting, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Family of Marks

We first consider opposer's argument that, in addition to any confusion vis-à-vis its marks individually, there is a likelihood of confusion with its family of "-sure" marks. Upon careful review of the evidence of use of opposer's marks, we find that opposer has not established ownership of a family of "-sure" marks.

The Court of Appeals for the Federal Circuit, our primary reviewing court, has defined a family of trademarks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. ...

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., 932

F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

In the case at hand, opposer has stipulated that it never used the marks ENSURE, PEDIASURE, NEOSURE, and PROSURE together in a single advertisement or promotional brochure²¹ and that since it discontinued the PROSURE product, it has never used the marks ENSURE, PEDIASURE and NEOSURE together in its advertisements or promotional brochures.²² While opposer advertises PEDIASURE and ENSURE products on the same webpage, e.g., www.abbottstore.com, other "non-family" marks are also advertised on the same page, such as Similac and Juve,²³ and there is no reference distinguishing the two "-sure" marks as

²¹ Applicant's Request for Admissions, Request No. 33.

²² Stipulation, No. 105.

²³ Opposer's Ex. 19.

being part of a family. Moving further away from the concept of a family of marks, the NEOSURE product is promoted as "SIMILAC NEOSURE."²⁴ Finally, although at one time opposer appears to have marketed its PROSURE drinks as being "from the makers of ENSURE," and PROSURE and ENSURE bottles appeared together in advertising,²⁵ since the PROSURE mark was discontinued in 2008, it does not appear to have been the subject of further public exposure.

Opposer has not provided any direct evidence that it promotes the marks as a family or that the public perceives the marks as a family. As noted above, "[s]imply using a series of similar marks does not of itself establish the existence of a family." *J. & J. Snack*, 18 USPQ2d at 1891. The requisite showing of a family of marks has not been made.

We now turn to the issue of likelihood of confusion with respect to opposer's mark ENSURE. We focus our likelihood of confusion analysis in this decision on the registered mark ENSURE, which is more similar to applicant's mark than either PEDIASURE or NEOSURE as discussed *infra*. If applicant's marks CATSURE and DOGSURE so resemble opposer's mark ENSURE that confusion as to source would be

²⁴ Opposer's Ex. 22.

²⁵ Stipulation, Ex. E.

likely, we need not address whether there is a likelihood of confusion between applicant's marks and opposer's other pleaded marks PEDIASURE and NEOSURE.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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").

A. The fame of opposer's mark ENSURE

Opposer contends that its ENSURE mark "has been famous since long before Pet-Ag's earliest possible priority

date."²⁶ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or

²⁶ Opposer's Trial Brief, p. 21.

services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309. Finally, because of the extreme deference that we accord 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 that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

In this case, as the parties have done in considering the inherent strength of the mark under the factor of fame, we have considered the inherent strength of the mark based on the nature of the mark itself as well as its commercial strength. See *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed.) ("The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

Because opposer's mark has been registered on the Principal Register without a claim to acquired distinctiveness under Section 2(f), it is considered to be at worst suggestive and not merely descriptive of the goods. Applicant argues that the mark is inherently weak, however,

because of its similarity to the common word "insure."²⁷ We may take judicial notice of the fact that the word "insure" is defined as: "1: to provide or obtain insurance on or for 2: to make certain especially by taking necessary measures and precautions."²⁸ See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We may also take judicial notice of the meaning of the word "ensure" as being "to make sure, certain, or safe : GUARANTEE" and that ensure and insure are synonyms.²⁹ Applicant does not argue that the mark is laudatory, or explain what about opposer's product, or how opposer's product, makes the product or the user sure, certain or safe. Further, the record does not show that the meaning of either word, "insure" or "ensure," has been ascribed to opposer's mark. Even if the mark suggested the idea of "certainty" or "safety," it would still be considered at worst somewhat suggestive.

We next consider the commercial strength of opposer's mark. The parties stipulated that opposer began making and selling ENSURE nutritional supplements and meal replacement

²⁷ Applicant's Trial Brief, p. 28.

²⁸ At www.merriam-webster.com/dictionary/insure.

²⁹ See www.merriam-webster.com/dictionary/ensure.

products in 1972.³⁰ From 1972 through 2006, opposer sold over \$6 billion worth of ENSURE products.³¹ In each year from 2006 to 2010, opposer sold over \$350 million worth of ENSURE products.³² Each of the past four years has seen an increase in sales, with sales in 2010 in excess of \$500 million.³³ There is, however, no testimony or evidence regarding what percentage share of the market ENSURE products command.³⁴

Opposer has also made of record the gross advertising dollars spent to advertise and promote the ENSURE products. From 1997 through 2006 Abbott spent over \$334 million in advertising.³⁵ Between 2006 and 2010, opposer spent in excess of \$125 million in advertising.³⁶ During those four years, opposer's annual advertising expenses ranged from over \$20 million in 2008 to over \$30 million in 2010.³⁷ Opposer advertises through "mainstream media such as

³⁰ Stipulation, No. 7.

³¹ Stipulation, No. 16.

³² Stipulation, Nos. 18-22.

³³ Stipulation, Nos. 22.

³⁴ In a paragraph of the Martinez declaration marked as confidential, opposer claims a high brand awareness of consumers polled in a market research study. However, a copy of the study was not included in the record, and no information regarding, e.g., the nature of the study, methods used to obtain sampling, its purpose or scope, were included. Martinez Dec., p. 5.

³⁵ Stipulation, No. 27.

³⁶ Stipulation Nos. 28-32. The revenue and advertising figures were designated as confidential in the Martinez declaration, opposer's Ex. 8. However, confidentiality is deemed waived inasmuch as the figures were made available in the public versions of opposer's brief as well as in the public version of the Stipulation.

³⁷ Stipulation Nos. 28-32.

national television advertisements, national and local magazines, trade journals, national and local newspapers, free standing inserts ('FSI') distributed in national newspapers, Catalina grocery store coupons, radio advertisements, trade shows, and online."³⁸ The parties stipulated that opposer's FSI distribution has reached "many millions of consumers"³⁹ and that in 2007, "over 24 million ENSURE grocery store coupons were generated."⁴⁰ In March 2006, opposer conducted a business study entitled "Abbott Animal Health Liquid Nutritional Survey," wherein a percentage of veterinarians indicated they have, in their practices, "used or sent home" ENSURE products.⁴¹ Although the percentages are classified as confidential, they are not insignificant. However, there is no direct evidence of brand recognition in the media or by the general public.

On balance, although opposer's ENSURE mark has been used for nearly 40 years, the record is not sufficient to establish that opposer's mark ENSURE is famous for purposes of likelihood of confusion. In particular, while the sales figures are impressive, there is no context in which to place raw statistics, evidence of the level of brand awareness among consumers, or evidence of opposer's market

³⁸ Martinez Dec., p. 3.

³⁹ Stipulation No. 24.

⁴⁰ Stipulation No. 25.

⁴¹ Stipulation No. 33, Ex. B; filed under seal.

share. Opposer's mark is commercially strong, but on this record, would not be considered famous. Nonetheless, this factor favors opposer.

B. Third-party use of similar marks in use on similar goods

Applicant argues that due to the alleged wide-spread use by numerous third parties in the dietary supplement and food replacement field of marks ending in the suffix "-sure," opposer's mark ENSURE has been diluted by a crowded field. Attached to the declaration of Luis M. Lozada are copies of 70 third-party registrations for such marks, together with proof of use in commerce for all but 16 of them.⁴²

As for these sixteen registrations, their probative value is minimal. "[I]t is axiomatic that third-party registrations are entitled to little probative value in the absence of evidence of actual use." *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1548 (TTAB 1990); see also *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009).

As for the remainder, the majority cover dietary and nutritional supplements for human consumption in International Class 5. Seventeen registrations cover nutritional or other products for animals⁴³ and one covers a number of dietary and nutritional supplements for both

⁴² Applicant's Ex. 34.

⁴³ These registrations are generally in International Class 5, although six of them are in Class 31, which covers "foodstuffs for animals." 37 C.F.R. § 6.1.

animals and humans.⁴⁴ Nine are for marks that include "sure" as the first element of the mark rather than at the end. For example, the mark SHURFINE is registered for "pet food."⁴⁵ The mark SURE SIGHT is registered for "dietary supplements, mineral supplements."⁴⁶

Applicant argues that "given the numerous registrations of marks that incorporate the 'SURE' component for dietary supplements and food replacement products, and the extensive use of the 'SURE' component at common law, ... consumers have been educated to distinguish between the different 'SURE' marks on the basis of minute distinctions."⁴⁷ We agree that the third-party registrations, coupled with the evidence that they are in use in commerce, have probative value. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); see also, 2 *McCarthy on Trademarks and Unfair Competition* § 11:88 (4th ed.). The goods

⁴⁴ Reg. No. 3594686, issued March 24, 2009, for the mark BEE SURE for, *inter alia*, "animal feed supplements; bee pollen for use as a dietary food supplement; calcium supplements; dietary and nutritional supplements; dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary supplements for animals; dietary supplements for pets; feed supplements for pets, livestock, race horses show dogs, fish; liquid nutritional supplement; meal replacement and dietary supplement drink mixes; non-medicated additives for animal feed for use as nutritional supplements" in International Class 5. Applicant has shown that the mark is in use in commerce; Lozada Dec., Ex. AJ.

⁴⁵ Reg. No. 1683923; Lozada Dec., Ex. AF.

⁴⁶ Reg. No. 2647848; Lozada Dec., Ex. AS.

⁴⁷ Applicant's Trial Brief, p. 21-22.

identified in the registrations exist in fields which are the same as, or not far removed from, opposer's field of use. In the field of dietary supplements and meal replacements for human consumption, the evidence shows that marks ending in "-sure" are common. Several marks are registered for "dietary supplements" without further limitation.⁴⁸ However, in applicant's field of use, that is, in connection with animal dietary or nutritional supplements or meal replacements, the field is not so diluted that opposer's mark would be considered weak. Of the 17 registrations that cover animal products, four involve a vaccine for swine, and five cover products for care of livestock such as bovines. Only three registrations appear to cover pet food or pet food supplements.⁴⁹

⁴⁸ For example, COGNISURE for "dietary supplements" (Reg. No. 3561966); HEARTSURE for "vitamins, herbal and nutritional dietary supplements" (Reg. No. 2124204); NUTRISURE for "vitamin and mineral supplements" (Reg. No. 2660969); OMEGASURE for, *inter alia*, "vitamins, nutritional supplements, mineral supplements, dietary drink mix for use as a meal replacement; meal replacement and dietary supplement drink mixes" (Reg. No. 2987381); PHARMASURE for "dietary supplements" (Reg. No. 2518097); REGENASURE for "dietary supplements" (Reg. No. 2825928); SUGARSURE for "dietary and nutritional supplements" (Reg. No. 3917903); XANOSURE for "dietary supplements" (Reg. No. 3752363); HERBAL SURE for "vitamins, mineral supplements and nutritional supplements" (Reg. No. 3739015); and LIPO-SURE for "dietary supplements" (Reg. No. 3577148).

⁴⁹ Reg. No. 1683923 for the mark SHURFINE for "pet food"; issued April 21, 1992, Lozada Dec., Ex. AF; Reg. No. 28311795 for the mark NUTRA-SURE for "feed supplements for pets not sold in or otherwise distributed through grocery, drug, or convenience stores"; issued April 13, 2004; Lozada Dec., Ex. AT (apparently inadvertently misidentified in the declaration as Ex. AT); and Reg. No. 734810 for the mark SHUR-GAIN for "feed supplement for pets and small animals, including dogs, cats, mink, rabbits, and

We find that the factor regarding the existence of the third-party marks favors applicant.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). While the marks must be compared in their entirety when analyzing their similarity or dissimilarity, there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The parties' marks look and sound alike. All three marks consist of two syllables, and share the final syllable "-sure." As for their meaning, to the extent the presence of the term "-sure" engenders the sense of "being free from

chinchillas"; issued July 24, 1962; Lozada Dec., Ex. AV (apparently inadvertently misidentified in the declaration as Ex. AX).

doubt,"⁵⁰ the same meaning is conveyed in all three marks. In terms of their commercial impressions, the "-sure" component slightly dominates applicant's marks, because the terms "dog" and "cat" merely describe a feature of the goods, i.e., that the products are intended for consumption by dogs and cats. Opposer's mark, which may be considered a word found in the dictionary, is not dominated by the "-sure" element; there is no descriptive attribution to the prefix "-en." Nonetheless, the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. Although the differences may be seen when the marks are compared side-by-side, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). Here, the marks

⁵⁰ We may take judicial notice of the definition of "sure" as: 1.free from doubt as to the reliability, character, action, etc., of something: to be sure of one's data. 2.confident, as of something expected: sure of success. 3.convinced, fully persuaded, or positive: to be sure of a person's guilt. 4.assured or certain beyond question: a sure victory. 5.worthy of confidence; reliable; stable: a sure messenger. At <http://dictionary.reference.com/browse/sure>.

are closer in their overall similarities than in their differences. This factor favors opposer.

D. The similarity or dissimilarity and nature of the goods described in the application and registrations.

Opposer's registrations for the mark ENSURE cover "liquid nutritive preparations for oral or gavage feeding" and "dietary food supplements; namely, vitamins and minerals in a flavored pudding base." Applicant's CATSURE and DOGSURE applications are for "food supplements for cats" and "food supplements for dogs."

The goods are similar in their intended usages, that is, they are consumed to provide nutrition. However, they are intended to be consumed by different users. Opposer's goods are intended for human consumption and applicant's goods are intended for animals. Jean Heidker explained how applicant's products differ from those targeted to humans; in terms of their composition, and based on her comparisons of the products, Dr. Heidker concluded that "the use of human nutritional aids for pets is not a good practice because such products are not suitable for senior pets. Specifically, products, such as ENSURE, do not have the correct nutrient profile and may not be properly utilized by an older animal."⁵¹ And as noted *infra*, opposer has its own

⁵¹ Heidker Dec., p. 2.

brand of supplement for pets, CLINICARE, and does not market ENSURE as being for animals.⁵²

The products, however, share some common characteristics. Opposer sells ENSURE vanilla-flavored liquid supplements or meal replacements to provide for dietary and nutritional needs.⁵³ Applicant sells CATSURE and DOGSURE supplements as "uniquely formulated to provide full nutritional needs in a highly palatable, vanilla-flavored liquid similar to products created for humans."⁵⁴

Although the parties do not intend the products as equivalents, and have formulated them differently, the record reflects media references to them as being comparable. For example, in an online article about the Global Pet Expo held in 2006, the writer states: "CatSure and Dogsure are meant to do the same for pets as Ensure does for people."⁵⁵ Again, at www.PreparedFoods.com, in an article entitled "New Product Trends," the writer notes: "Dogsure and Catsure promise to provide the full range of nutritional needs in a vanilla-flavored liquid 'similar to products created for humans,' per

⁵² Tennis Dec., p. 8; Stipulation No. 10 Ex. A.

⁵³ Stipulation No. 9.

⁵⁴ Opposer's Ex. 25, "*Petitioner Industry Pioneer Introduces First-to-Market Products That Meet Challenges of the GRRR-Aying of American Pets*," applicant's Press Release issued March 16, 2006.

⁵⁵ Marasa Dec., p. 2 Ex. 4, printout of "All New Pet Products Presented at Global Pet Expo" in *Steve Dale's Pet World* from www.stevedalepetworld.com.

the company."⁵⁶ A second online service, at www.BurrellesLuce.com, reviewed applicant's products as follows: "PetAg of Hampshire, Ill., unveiled DogSure and CatSure, the pet equivalent of Ensure, a popular liquid meal replacement for seniors."⁵⁷

Further, opposer has submitted a fairly large number of consumer comments stating that people use ENSURE supplement or meal replacement for their dogs or cats or consider ENSURE to be "like" CATSURE or DOGSURE. Some examples are listed below:

In a posting from www.askmehelpdesk.com, pahambelton wrote:

I still reinforce that with Nutri-Cal and CatSure (like Ensure, but for cats).⁵⁸

In a posting from www.allexperts.com, Patti wrote: The product I listed above, "Dogsure" is the veterinary equivalent to Ensure, some dogs just like the human flavors better.⁵⁹

In a second posting from www.allexperts.com, Patti wrote:

Brands to look for are:...DogSure Meal Replacement Food Supplement[.] You could even try the human version of "DogSure", called "Ensure".⁶⁰

In a posting from www.justanswer.com, Joan wrote: I have worked with Vets that suggest Ensure or Boost for older dogs that are debilitated, but prefer to use Dogsure if available.⁶¹

⁵⁶ Opposer's Ex. 31. We emphasize that the statement has not been considered for the truth of the matter asserted, only that such statement appeared in an online news article.

⁵⁷ Id.

⁵⁸ Marasa Dec., p. 3 Ex. 10.

⁵⁹ Marasa Dec., p. 3 Ex. 11.

⁶⁰ Marasa Dec., p. 3 Ex. 12.

⁶¹ Tennis Dec., p. 1 Ex. 1.

In a posting from <http://answers.yahoo.com>, Crystal wrote:

Try getting dogsure[sic]. its ensure [sic] for dogs (ensure is a weight gain/maintain supplement).⁶²

In a posting from <http://blastomycosis.ca/forum>, Deb wrote:

He doesn't care to eat or dring [sic], so I use a water bottle with Dogsure (human version is Ensure).⁶³

In a posting at www.petadvicenow.com, Joan wrote:
[T]here is a product called DogSure, which is the dog version of Ensure. You can get the DogSure from most of the larger Pet Stores.⁶⁴

In a posting at www.justanswer.com, Micki wrote:
You asked about Ensure, and there is a very similar product for cats called PetAg CatSure.⁶⁵

In a posting at www.handicappedpet.net, CarolC wrote:
There has been info on this message board about DogSure and CatSure which are like Ensure for pets. ... However, CliniCare has been around since 1996 apparently and really *is* by the makers of Ensure even though the other brand is taking advantage of name recognition.⁶⁶

We conclude from these postings that some people appear to believe that ENSURE products are sufficiently beneficial for their pets that ENSURE supplements may be substituted for applicant's DOGSURE and CATSURE supplements. Others appear to believe that the goods are equivalent. These references corroborate the similarity of the goods.

⁶² Tennis Dec., p. 2 Ex. 2.

⁶³ Tennis Dec., p. 2 Ex. 3.

⁶⁴ Tennis Dec., p. 2 Ex. 5.

⁶⁵ Tennis Dec., p. 3 Ex. 8.

⁶⁶ Opposer's Ex. 32.

For these reasons, we find that the goods are related. This factor favors opposer.

E. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Opposer sells ENSURE supplements and meal replacements to institutional entities, such as hospitals, long-term care facilities, and oncology and renal care centers.⁶⁷ ENSURE products are also sold to members of the general public seeking health benefits, through grocery stores, drug stores, club stores, mass merchandisers and discount merchandisers, small retail outlets, and online retail websites.⁶⁸ In addition, opposer has shown that it promotes itself as a seller of "veterinary products," including "nutritional supplements." Peter B. Thompson, Product Manager for medical devices and nutritionals at Abbott Animal Health, attests that "[s]ince 1997, [opposer] has marketed and sold CLINICARE, a liquid nutritional supplement and meal replacement product specially formulated for dogs and cats."⁶⁹

Applicant sells to members of the general public who have cats and dogs as pets, as well as online and through pet and veterinarian distributor catalogs and through

⁶⁷ Stipulation No. 11.

⁶⁸ Stipulation No. 12; Martinez Dec., p. 2.

⁶⁹ Thompson Dec., p. 1.

general circulation magazines.⁷⁰ Although a consumer is likely to encounter both companies' products in the same grocery store, there is a distinction. Applicant's DOGSURE and CATSURE products are sold only in pet stores or in the pet sections of stores.⁷¹ Opposer's ENSURE products are not intended to be sold in pet stores,⁷² but there are no limitations in opposer's registrations precluding this possibility.⁷³ Applicant's identifications of goods, on the other hand, contain a restriction, i.e., that they are for dogs or cats; thus even assuming that the parties' goods are actually sold in the same stores, they are likely to be found in different sections of the grocery or drug store. There is no "per se" rule that all products sold within supermarkets are related by virtue of the fact that they are sold in the same establishment.⁷⁴ Here, the goods are likely to be viewed as interchangeable by some consumers because some veterinarians either give or send ENSURE supplements home with their clients, and some consumers may use the products for similar purposes. Nonetheless, the trade channels are different. Because the differences in

⁷⁰ Stipulation Nos. 136, 137.

⁷¹ Stipulation Nos. 140, 142; Gill Dec., p. 4.

⁷² Stipulation No. 106.

⁷³ See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

⁷⁴ See, e.g., *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 152-53 (CCPA 1978); and

the trade channels weigh in favor of applicant, but the similarities in the classes of purchasers weigh in favor of opposer, overall, the third *du Pont* factor is neutral.

F. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

The parties' respective products are relatively inexpensive. A 24-pack of 8 oz. bottles or cans of ENSURE supplement typically sells at retail for approximately \$33-\$38, or about \$1.38-\$1.58 per can.⁷⁵ The retail price for an 11-oz. single can of CATSURE or DOGSURE supplement is approximately \$7.00.⁷⁶ It has often been stated that purchasers of relatively inexpensive products are held to a lesser standard of purchasing care and, thus, are more likely to be confused as to the source of the goods. See *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant argues that the "noticeable difference in the price points" between the parties' respective products results in careful inspection of the packaging for the

Federated Foods, Inc. v. Fort Howard Paper Company, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

⁷⁵ Stipulation No. 15; opposer's Ex. 23.

⁷⁶ Stipulation No. 134; opposer's Ex. 23.

selected product and differentiates the goods.⁷⁷ We are not persuaded by this argument because both companies' products are inexpensive items that do not require great deliberation. Further, we must consider the goods as they are identified in the respective registrations and application. Because there is no restriction as to price, we must presume that the products would be sold "at all the usual prices" at which ENSURE, DOGSURE or CATSURE supplements would be sold. *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1933 (TTAB 2011). The products are ordinary consumer items available at a relatively low cost. An average feeding of applicant's DOGSURE supplement, for a toy dog, is 2-4 ounces daily; for a small dog it is 4-8 ounces daily; and for a small cat, it is 4-8 ounces daily of CATSURE supplement.⁷⁸ Thus, even at \$7.00 per can the cost is relatively inexpensive and may account for 2 or 3 servings. See *Eveready Battery Company, Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009) (purchasers of casual, low cost ordinary consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods).

This *du Pont* factor also favors opposer.

⁷⁷ Applicant's Trial Brief, p. 34.

G. Applicant's Intent

Under the thirteenth *du Pont* factor, evidence of applicant's bad faith adoption of his mark is relevant to our likelihood of confusion analysis. Opposer argues that its internal records, as well as those produced by applicant, and statements made by certain of applicant's representatives, show that applicant adopted its DOGSURE and CATSURE marks with the intent to trade on opposer's marks. Applicant has denied that it adopted its marks in bad faith.

The parties stipulate that Mr. Gill, applicant's Chairman and CEO, was aware of opposer's ENSURE mark at least as early as 2002.⁷⁹ Mere awareness of the brand, of course, is insufficient cause for a finding of bad faith. *See Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1564, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987) ("an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark").

Applicant asserts that it selected its DOGSURE and CATSURE marks "after a full search by an independent agency disclosed no conflicts."⁸⁰ The fact supports applicant's position that it acted in good faith.

The confidential evidence that we have been asked to interpret, primarily e-mails, show that applicant was aware

⁷⁸ Opposer's Ex. 6H.

⁷⁹ Stipulation No. 130.

of opposer's concern over applicant's use of the marks, but do not go so far as to compel the conclusion that applicant intended to trade off of the goodwill of opposer's ENSURE brand. Applicant's President states in her declaration that applicant "never would have followed up on such an agenda item [alleged to have been posted in the internal document]"⁸¹ and that "we have never heard any person comment on any similarities between our CATSURE and DOGSURE marks and Abbott's ENSURE brand."⁸² In light of the conflicting evidence, we consider this *du Pont* factor to be neutral.

H. Balancing the factors.

In view of the facts that opposer's mark ENSURE is commercially strong, the marks are similar, and the goods related and available to the same classes of consumers at relatively low cost, we find that applicant's registration of the marks DOGSURE and CATSURE is likely to cause confusion with opposer's mark ENSURE for "liquid nutritive preparations for oral or gavage feeding" and "dietary food supplements; namely, vitamins and minerals in a flavored pudding base." These factors, going in opposer's favor, outweigh those that go in applicant's favor, namely the differences in the trade channels and the existence of the

⁸⁰ Gill Dec., p. 2.

⁸¹ Frudakis Dec., p. 4. Not filed under seal.

third-party marks. While the trade channels are different, they include retail stores to which the same classes of consumers go to shop for both companies' products in a single location and at the same time. Likewise, while the third-party uses show that the ENSURE mark exists in a somewhat crowded field, the existence of these third-party uses has not rendered opposer's mark weak.

Decision: The opposition is sustained under Trademark Act Section 2(d) and registration to applicant is refused. Inasmuch as we have found a likelihood of confusion and refused registration under Section 2(d), we need not reach opposer's alternative ground of dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).

⁸² Frudakis Dec., p. 3.