ESTTA Tracking number: **ESTTA658687**

Filing date: **03/02/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205803
Party	Plaintiff Vertex Pharmaceuticals Incorporated
Correspondence Address	SHARONA H STERNBERG SUNSTEIN KANN MURPHY & TIMBERS LLP 125 SUMMER ST BOSTON, MA 02110-1618 UNITED STATES ssternberg@sunsteinlaw.com, ltittemore@sunsteinlaw.com, sab-reu@sunsteinlaw.com, bscruggs@sunsteinlaw.com
Submission	Rebuttal Brief
Filer's Name	Sharona H. Sternberg
Filer's e-mail	ssternberg@sunsteinlaw.com, ltittemore@sunsteinlaw.com, sab-reu@sunsteinlaw.com, samani@herculesbrand.com, strinid-ad@herculesbrand.com
Signature	/Sharona H. Sternberg/
Date	03/02/2015
Attachments	Vertex Trial Reply Brief 3-2-15.pdf(101144 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application:
Serial No.: 85/505,191
Filed: December 28, 2011
Applicant: Hercules Brand Corporation
Mark: VERTOX
For: Multi-vitamin preparations; vitamin and mineral supplements; vitamins
Published: May 29, 2012

VERTEX PHARMACEUTICALS INCORPORATED, Opposer, v. HERCULES BRAND CORPORATION Applicant.	Opposition No. 91205803

REPLY BRIEF OF OPPOSER
VERTEX PHARMACEUTICALS INCORPORATED

Lisa M. Tittemore
Steven A. Abreu
Sharona H. Sternberg
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, Massachusetts 02110-1618
(617) 443-9292

Attorneys for Opposer
Vertex Pharmaceuticals Incorporated

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Other Authorities

Rules

Vertex Pharmaceuticals, Incorporated ("Opposer" or "Vertex") submits this reply in support of Opposer's Trial Brief, dated January 16, 2015, and to address matters raised in Applicant's Trial Brief, dated February 13, 2015.

INTRODUCTION

Applicant's application to register the mark VERTOX should not be allowed because Opposer has demonstrated that there is a high likelihood of confusion between the very similar VERTEX and VERTOX marks, and Applicant did not have a bona fide intent to use or actual use its mark with the applied-for goods, as is required by the Lanham Act.

Applicant mischaracterizes the scope of the goods delineated in the parties' respective application and registrations, and improperly focuses on the way that the marks have been used in commerce during a limited period of time rather than considering the actual scope of the parties' filings with the USPTO. Indeed, the points made in Applicant's brief, when evaluated under the proper legal standards, demonstrate a high likelihood of confusion, particularly as the evidence of record shows that the goods claimed in the parties' respective application and registrations for the VERTOX and VERTEX marks are closely related and travel through overlapping channels of trade to a common customer base.

Additionally, Applicant's own admissions confirm that it had no bona fide intent to use or actual use of the mark in connection with multivitamins and vitamins. Thus, for the foregoing reasons and the reasons set forth in Opposer's opening trial brief, the Board should refuse the VERTOX application.

ARGUMENT

I. Applicant's Admissions Demonstrate the High Similarity of the VERTOX and VERTEX Marks, Overlapping Channels of Trade, and Common Consumers, Resulting in Clear Likelihood of Confusion

A. Applicant Improperly Defines the Scope of Goods in Opposer's Registrations and its own Application

Faced with overwhelming evidence of likelihood of confusion between the parties' related marks and goods, Applicant improperly attempts to narrow the scope of the goods covered in the parties' Registrations and Application. Opposer's Registrations cover a broad range of goods, including pharmaceutical preparations for specific diseases (Reg. 2,578,974, listed below).

Trademark	**Reg. No.**	**Reg. Date**	**IC**	**Goods and Services**
VERTEX	1,630,448	Jan. 1, 1991	42	Pharmaceutical research
 "VERTEX Logo"	2,578,974	June 11, 2002	5, 42	Pharmaceutical preparations for the diagnosis, treatment or prevention of hepatitis-C, autoimmune diseases, and HIV infection and AIDS (Cl. 5); pharmaceutical research services for others (Cl. 42)
VERTEX	2,704,913	April 8, 2003	5	House mark for pharmaceutical preparations
	3,531,356	Nov.11, 2008	5	House mark for pharmaceutical preparations

Opposer's NOR Ex. A (VERTEX Registrations).

Applicant's arguments attempt to reduce the goods associated with the VERTEX Marks to those that are available by prescription only, and to the current use of the marks in connection with certain pharmaceuticals now sold by Opposer. *See* Appl. Trial Br. at 5, 9, 12-16. However, the VERTEX Registrations contain no such limitation, and the law is clear that registrations for

"pharmaceuticals" covers a wide range of medical treatments, including both prescription and non-prescription products. Opp. Trial Br. at 25. *See, e.g., Blansett Pharm. v. Carmrick Labs.*, 25 U.S.P.Q.2d 1473, 147 (TTAB 1992). Nor do the VERTEX registrations contain any limitation as to channels of trade or intended customers. *See* TMEP § 1207.01(a)(iii) ("If the cited registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers.").[1]

Applicant improperly focuses on its own use of its mark in commerce as well. Applicant discusses its use of VERTOX in connection with "supreme greens." *See, e.g.,* Appl. Trial Br. at 11 ("Applicant's VERTOX mark, *when applied to its supreme greens product*, is sufficiently distinct from Opposer's service and house mark so as to avoid a likelihood of confusion.") (emphasis added). Of course, Applicant's evidence of use, which is inconsistent with the use claimed in its pending application, is completely irrelevant to a likelihood of confusion analysis in an opposition proceeding. In an opposition proceeding, the focus necessarily rests solely on the four corners of the application and registrations before the Board. *See e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014); TMEP §1207.01(a)(iii) ("if the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly identifying its related goods").

[1] Applicant also contends that Opposer's mark is not "famous," but that is a red herring and appears to impose on Vertex a standard that is not required under the law. *See* Appl. Trial Br. at 9. Moreover, Applicant does not – and cannot – refute Opposer's evidence that the VERTEX Marks are strong and have been used extensively. Opp. Trial Br. at 8-10.

Applicant's misleading characterizations of "the way each mark is used in commerce," Appl. Trial Br. at 12, is not only immaterial to a likelihood of confusion, but is also an improper attempt to narrow the scope of goods claimed in the parties' respective VERTEX Registrations and VERTOX Application.

B. The Goods are Highly Similar, Travel in Overlapping Channels of Trade and are Marketed to Common Customer Bases

1. The Parties' Claimed Goods are Related

The goods identified in the parties' VERTOX Application and VERTEX Registrations are highly similar. Applicant makes no attempt to refute Opposer's evidence that vitamins and multi-vitamins are complementary and often used together with pharmaceuticals. Opp. Trial Br. at 23-25. Applicant also admits that there is a "corporate association" between pharmaceuticals and nutritional supplements, which both "exist in the healthcare space," and "may be owned by the same company." Appl. Trial Br. at 8.

Applicant misrepresents Opposer's NOR Ex. E to boldly conclude that "in no instance has a pharmaceutical company promoted its acquisition of the nutraceutical," and that, as such, "in the minds of consumers, pharmaceuticals and nutraceuticals are distinct." *Id*. at 8, 15. In fact, the articles contained in Ex. E demonstrate that information regarding the acquisition of nutritional supplement companies by pharmaceutical companies has been circulated to the public.[2] Further, contrary to Applicant's assertions, these articles explicitly allege that the

[2] Opposer did not offer these articles for the truth of the opinions asserted therein, but rather to show that information regarding the overlap of the pharmaceutical and vitamin industries is available to the public. *See Blue Man Prod. Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005), *rev'd on other grounds*, No. 05-2037, slip op. (D.D.C. Apr. 3, 2008) (printed publications and news reports hearsay if offered to prove the truth of the statements made therein, but acceptable to show that the stories have been circulated to the public); TBMP 704.08(b) (Internet materials "can be used to demonstrate what the documents show on their face; however,

pharmaceutical companies that sell vitamins use the same marketing schemes and distribution and supply chains to sell both nutraceuticals and pharmaceuticals to the exact same retailers and consumers. *See, e.g.,* Opposer's NOR Ex. E at VRTX002250. Opposer has provided ample evidence related to the overlap between the pharmaceutical and vitamin industries, demonstrating the relatedness of the goods. Opp. Trial Br. at 14-16, 25-28. *See* TMEP § 1207.01(a)(vi) ("Evidence of relatedness might include news articles… showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are… sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration.").

2. The Parties' Claimed Goods Travel Through the Same Channels of Trade

Applicant erroneously attempts to distinguish the parties' channels of trade by focusing on the different government regulations for vitamins and pharmaceuticals, and the professional licensing required in the medical profession. *See* Appl. Trial Br. at 7-8, 13. However, because neither party restricts the channels of trade associated with their identifications of goods, it must be assumed that both parties' goods travel through "all trade channels normal for goods of this type in the healthcare field." *Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301, 2004 WL 1631116, *5 (TTAB 2004). *See also Pfizer Inc. v. Soft Gel Tech.*, 2003 WL 203128, *7 (TTAB January 29, 2003). As discussed, Opposer's registrations are not limited to prescription drugs, and all of the regulations cited by Applicant relate to certain federal and state regulations governing prescription pharmaceuticals. *See* Applicant's 5/30/2014 NOR Exhibits A-Q.

---

documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.").

Confronted with undeniable evidence concerning the overlap in the parties' channels of trade, Applicant responds by drawing upon speculation and facts not in evidence. Applicant provides no factual support for its arguments regarding pharmaceuticals or where and how pharmaceuticals are sold. Appl. Trial Br. at 14. Applicant's exhibits regarding licensing regulations do not support Applicant's assertion that "the identity of a manufacturer is not even a factor to be discussed with the patient." *Id*. at 12. Instead, the record evidence shows that health care professionals counsel patients on the concurrent use of both pharmaceuticals and vitamins, often to treat the exact same symptoms. Carnahan Trial. Test. 46:11-47:12; Carnahan Trial Exs. 11-12; Opposer's NOR Ex. E. *See also* Applicant's 5/30/2014 NOR Ex. D (defining the practice of medicine as "diagnosing, treating, operating or prescribing for any human disease, pain, injury, deformity, or physical condition."). Applicant even concedes that vitamins and multivitamins are sold at the same pharmacies as pharmaceuticals. Appl. Trial Br. at 14.

3. The Parties' Claimed Goods Share A Common Customer Base

Additionally, because the parties' Application and Registration do not contain limitations regarding the end-users, the goods share an overlapping customer base – namely, the general public. Despite Applicant's emphasis on the doctor and pharmacist "gatekeepers," the relevant consumers for Opposer's' pharmaceuticals includes patients and caregivers as well. Opp. Trial Br. at 28-29. Notably, Applicant has not provided any evidence that the relevant consumers will be any less confused due to the regulations found in Applicant's 5/30/2014 NOR Ex. A-Q, and factual assertions with no support in the record carry no weight. TBMP 704.06(b). Applicant additionally provides no factual support for its arguments regarding the sophistication of consumers of pharmaceuticals. In any event, confusion is still likely when the marks and goods are similar even when pharmaceuticals are prescribed by physicians and dispensed by pharmacists. Opp. Trial Br. at 29 (citing cases).

Applicant mistakenly directs the Board to the perceived sophistication of Opposer's consumers, while forgetting that Applicant's own *unsophisticated* consumers are at a high risk of being confused. In fact, Applicant makes numerous admissions regarding the expansive and unsophisticated customer base for VERTOX. Applicant admits that "any person with the funds to do so may self-diagnosis (sic), prescribe and purchase nutraceuticals at his own discretion." Appl. Trial Br. at 9. Applicant describes its "audience" as "comprised of individuals who wish to take a food in pill form for nutritional purposes – 'any adult.'" *Id*. at 13 (citing Cheatham Dep. 79:1-4). Applicant also freely admits that its customer base is not sophisticated and that "nutraceuticals may be purchased with *less care* on the part of the end user." *Id*. (emphasis added).

Thus, the closely similar VERTEX and VERTOX marks, the relatedness of the parties' goods and services, channels of trade, and consumers all contribute to create a high likelihood of confusion.

II. Applicant's Admissions Confirm There was No Bona Fide Intent to Use or Use of the Mark in Connection with the Applied-for-Goods

Although the goods described in the VERTOX Application are claimed as a "Multi-vitamin preparations; vitamins and mineral supplements; vitamins," Applicant has failed to use the VERTOX mark with those goods. To try to forestall this inevitable conclusion, Applicant makes numerous inconsistent and unsupported statements in its brief, for example, characterizing its "supreme greens" product as a "food." Appl. Trial Br. at 7, 8, 12, 13, and 16. Applicant then makes the unsubstantiated leap that "in light of the vitamins in the food that make up the product, VERTOX is appropriately described as a "Multi-Vitamin Preparations; Vitamins and Mineral Supplements; Vitamins." Appl. Trial Br. at 16. There is no record evidence supporting this claim.

Even if the VERTOX "supreme greens" in the VERTOX product contains vitamins/multivitamin ingredients, the VERTOX product is not itself a multivitamin or vitamin, as confirmed by the testimony of Applicant's own Rule 30(b)(6) witness. Cheatham Dep. 43:5-18 ("The Vertox product that we produced is a dietary supplement made up of antioxidant ingredients. It's not a multivitamin product."); 68:3-13; 206:4-5. A trademark must be registered for the product as a whole, not one of its ingredients. TMEP §1402.05(a) ("If the mark does not pertain solely to a component or ingredient rather than the finished or composite product, the identification should not specify the component or ingredient as the goods."). Foods, such as spinach or cereal, for example, cannot be registered as vitamins just because they happen to contain them. *See* Cheatham Dep. 205:19-23 ("Q: So let's say [the] vegetable spinach, for example, if it contains vitamins, would you call that a vitamin? A: Well, in the case of a vegetable, I would call it a food that contains a vitamin or a functional food that contains a vitamin."). If the VERTOX product is indeed a food, it should have been registered as such.

Further, the exhibits Applicant cite are inadmissible hearsay, and Applicant makes no attempt to describe how or why they relate to its product. Appl. Trial Br. at 10-11, 16. Applicant's 10/30/2014 NOR Exhibits E-H contain various internet articles that cannot be relied upon for the opinions they assert. TBMP 704.08(b); *Blue Man Prod. Inc.*, 75 USPQ2d at 1813. Moreover, while these exhibits state broadly that certain foods, such as fruits and vegetables, contain vitamins, Applicant has not identified a single vitamin contained in its supreme greens product. *See* Cheatham Dep. 67:19-68:8; 73:7-13.

Applicant impermissibly quotes an NIH guideline that is not of record for the proposition that a "multivitamin supplement may contain any level of nutrients and as such can refer to a wide variety of characteristics and compositions." Appl. Trial Br. at 16. Evidentiary materials

cited in Applicant's brief, including the NIH and CDC website, can be given no consideration unless they were properly made of record during the time for taking testimony. TBMP 704.05(b). Not only is this NIH guideline inadmissible, but it does not even support Applicant's assertions.

In actuality, the NIH guideline lists examples of how multivitamins have been defined by medical researchers, who have defined a multivitamin as "any supplement containing three or more vitamins and minerals but no herbs, hormones, or drugs, with each component at a dose less than the tolerable upper level determined by the Food and Nutrition Board..." NIH Multivitamin/mineral Supplements Fact Sheet for Health Professionals, January 2013 (available at *http://ods.od.nih.gov/factsheets/MVMS-HealthProfessional*). The VERTOX product clearly fails this definition. Not only does Applicant claim that its VERTOX "supreme greens" contain herbs, but Applicant could not list *any* vitamin, let alone three, contained therein. Opposer's NOR Ex. I (VERTOX label describing the product as a formulation of "naturally grown vegetables, herbs, sprouted grains, and fruit"); Cheatham Dep. 67:19-68:8; 73:7-13. Applicant's own 30(b)(6) witness even explicitly admitted that its product "is not a multivitamin," and is "not actually used in connection with multivitamins," a fact Applicant conveniently ignored in its brief. Cheatham Dep. 43:5-18; 72:13-73:6.

There is simply no evidence in the record supporting Applicant's contentions that the VERTOX product is a vitamin or multivitamin. Applicant had ample opportunity to provide testimony regarding its product, but it failed to do so and cannot do so now by relying on conclusory statements and improper citations. Accordingly, VERTOX Application must be refused as void *ab initio* due to Applicant's lack of a *bona fide* intention to use and non-use of the mark in connection with the identified goods. *See In re Petroglyph Games, Inc.*, 91 U.S.P.Q.2d 1332 (TTAB 2009) (the identification of goods "must be specific, definite, clear,

accurate and concise"; the "accuracy of the identification … in the original application is important") (citing TMEP § 1402.01); TMEP § 1109.03 ("The applicant may not file a statement of use until the applicant has made use of the mark in commerce on or in connection with *all* goods/services specified in the notice of allowance, unless the applicant files a request to divide.' (citing 37 C.F.R. §2.88(c)) (emphasis added).

SUMMARY

For the foregoing reasons, Opposer respectfully requests that the Board sustain the opposition and refuse registration of the mark VERTOX shown in Application Serial No. 85/505,191.

Dated: Boston, Massachusetts
March 2, 2015

VERTEX PHARMACEUTICALS INCORPORATED

By its attorneys,

/s/ Sharona H. Sternberg

Lisa M. Tittemore
Steven A. Abreu
Sharona H. Sternberg
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, Massachusetts 02110-1618
(617) 443-9292
ssternberg@sunsteinlaw.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing document has been served, by email on March 2, 2015, to Applicant's Representative of Record, Sara Amani, 27 Seaview Boulevard, Port Washington NY 11050, samani@herculesbrand.com.

/s/ Sharona H. Sternberg_____
Sharona H. Sternberg