

**THIS OPINION IS NOT A
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Vertex Pharmaceuticals Inc.

v.

Hercules Brand Corp.

—
Opposition No. 91205803
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Sharona H. Sternberg, Lisa M. Tittlemore, and Steven A. Abreu of Sunstein
Kann Murphy & Timbers LLP, for Vertex Pharmaceuticals Inc.

Hercules Brand Corp., *in pro per*.¹
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Before Kuhlke, Wellington, and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On December 28, 2011, Hercules Brand Corp. (“Applicant”) applied to register VERTOX, in standard character form, for “multi-vitamin preparations; vitamin and mineral supplements; vitamins,” in International Class 5.”² On June 27, 2012, Vertex Pharmaceuticals Inc. (“Opposer”), filed

¹ Documents were filed by various officers of Hercules Brand Corporation.

² Application Serial No. 85505191 was originally filed under Section 1(b). On February 22, 2012, Applicant filed an Amendment to Allege Use (AAU) , alleging dates of first use on October 24, 2011, and first use in commerce on February 16, 2012.

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an opposition to the registration of Applicant's mark on the ground that Applicant's mark is likely to cause confusion with Opposer's marks. Opposer asserted in its Notice of Opposition, as amended, that it owns the mark VERTEX, in typed drawing format³ for "house mark for pharmaceutical preparations,"⁴ and for "pharmaceutical research"⁵ as well as the mark VERTEX, and design, as shown below, for "house mark for pharmaceutical preparations"⁶ and for "pharmaceutical preparations for the diagnosis, treatment or prevention of hepatitis-C, autoimmune diseases, and HIV infection and AIDS"⁷:



Opposer further asserted that Applicant did not have a bona fide intent to use its VERTOX mark in commerce in connection with the applied-for goods

³ "Prior to November 2, 2003, 'standard character' drawings were known as 'typed' drawings. The mark on a typed drawing was required to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark." TMEP § 807.03(i) (April 2014).

⁴ Registration No. 2704913, Registered April 8, 2003 in International Class 5. Sections 8 and 15 affidavit accepted and acknowledged. Renewed.

⁵ Registration No. 1630448, Registered January 1, 1991 in International Class 42. Sections 8 and 15 affidavit accepted and acknowledged. Renewed twice.

⁶ Registration No. 3531356, Registered November 11, 2008 in International Class 5. Section 8 affidavit accepted.

⁷ Registration No. 2578974, Registered June 11, 2002 in International Class 5. Sections 8 and 15 affidavit accepted and acknowledged. Renewed.

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at the time the application was signed, that Applicant did not use its VERTOX mark in connection with the applied-for goods as of the filing date of the AAU and that, therefore, the application is void *ab initio* for lack of bona fide intent to use and nonuse.

In its Answer, Applicant denied the salient allegations of the amended Notice of Opposition. Both parties filed briefs, and Opposer filed a reply brief.

The Record and Evidentiary Issues

The record consists of the pleadings; the file of the involved application; and Opposer's Notice of Reliance Exhibits A through O, dated March 31, 2014, which includes, *inter alia*, printouts from the USPTO TSDR (Trademark Status and Document Retrieval) database consisting of copies of Opposer's pleaded registrations showing their current status and title, as well as Opposer's submission of the trial testimony of Virginia Carnahan, Opposer's Vice President, Global Marketing, dated March 28, 2014. The record further consists of two Notices of Reliance submitted by Applicant, dated May 30, 2014 (Exhibits A through Q) and October 3, 2014 (Exhibits A through H).

In its trial brief, Applicant referred to what it considers the appropriate characterization of a "multivitamin" pursuant to "NIH (National Institute of Health, Office of Dietary Supplements). Multivitamin/mineral Supplements Fact Sheet for Health Professional. January 2013." 45 TTABVUE 17.⁸ In its

⁸ Citations to TTABVUE are references to the Board's online case file database.

reply brief, Opposer objected to this reference, as the fact sheet is not of record. Since Applicant did not identify the referenced fact sheet in either of its two notices of reliance, and since the fact sheet does not appear to be of record, the objection is sustained.⁹

Priority and Standing

Standing is a threshold issue that must be proven in every *inter partes* case. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("The facts regarding standing . . . must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading]."). To establish standing in an opposition, opposer must show both "a real interest in the proceedings as well as a 'reasonable' basis for his belief of damage." See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

As a result of Opposer's submission of status and title copies of its Registration Nos. 2704913 (VERTEX), 1630448 (VERTEX), 2578974 (VERTEX, and design) and 3531356 (VERTEX, and design), as well as the testimony by Ms. Carnahan in reference thereto, Opposer has established its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Likewise, in view of these pleaded and proven

⁹ We note, nonetheless, that consideration of the reference would not affect our decision.

registrations priority is not in issue with respect to the marks and the goods and services set out in the registrations. *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee 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 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard 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.”). We discuss the *du Pont* factors for which there is relevant argument and evidence. For purposes of our likelihood of confusion analysis, we focus on the most relevant pleaded registration, Registration No. 2704913 (VERTEX).

We find this mark to be the most relevant of Opposer’s pleaded registrations for our *du Pont* analysis. Accordingly, if we find a likelihood of confusion as to

this pleaded registration, we need not find it as to the others. On the other hand, if we don't reach that conclusion, we would not find it as to the other pleaded registrations either. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that 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 terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The mark in Opposer's Registration No. 2704913 is VERTEX. Applicant's mark is VERTOX, which differs only by its penultimate letter. The

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pronunciation of the marks is likely to be highly similar. As for the commercial impression, both marks appear to be arbitrary for their respective goods or services. Opposer's witness testified in this regard. *See* Carnahan depo.

Q: Does the name Vertex have a special meaning in the pharmaceutical industry?

A: No, it does not have an innate meaning in the pharmaceutical industry except as Vertex the pharmaceutical company.

38 TTABVUE 14.

We find therefore, that the marks are highly similar in sight, sound and commercial impression, and the first *du Pont* factor weighs in favor of finding likelihood of confusion.

The Goods and Channels of Trade

The identification of goods covered by Opposer's Registration No. 2704913 for VERTEX includes "house mark for pharmaceutical preparations," while Applicant's mark identifies "multi-vitamin preparations; vitamin and mineral supplements; vitamins." We begin by observing that Opposer's identification is broadly worded and encompasses pharmaceutical preparations to treat any type of condition, including vitamin deficiencies. The identification "pharmaceutical preparations" could include prescription vitamin supplements. *See S.S. Kresge Co. v. J-Mart Industries, Inc.*, 178 USPQ 124 (TTAB 1973) (sustaining opposition by K MART for pharmaceutical

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preparations and vitamins against J-MART for medicines and pharmaceutical preparations, namely, ear drops and sleeping capsules).

Ms. Carnahan testified as to the use of Vertex's products as follows:

Q: What kinds of products does Vertex currently sell?

A: We sell pharmaceuticals, drug therapies for specific diseases.

38 TTABVUE 20

She further testified that besides other conditions for which it is or may be used, Vertex is currently used in connection with "HIV, hepatitis C, as well as cystic fibrosis." *Id.* at 16.¹⁰ Opposer further submitted a number of articles showing that vitamin supplements are also used to treat these same conditions, as Exhibit 12 to the Carnahan deposition and as Exhibit D to its notice of reliance. In this regard, Ms. Carnahan testified as follows:

Q: Would people suffering from conditions treated by Vertex also take vitamins?

A: Yes. I'd say an overall consumer trend is healthy living, so they take vitamins, supplements.

38 TTABVUE 49

Some excerpts from the submitted articles include the following:

NDNR: Hepatitis C: An Update on Comprehensive Assessment and Treatment Protocols; By Lyn Patrick, ND
Vitamin D3 deficiency is a serious problem in liver disease, and vitamin D deficiency in HCV infection can reduce the chance of responding to standard treatment, as well as increase the risk for fibrosis. Vitamin D has been shown to suppress hepatitis C viral replication in vitro, and supplementation with 2000 IU/d of

¹⁰ These conditions are mentioned in Registration No. 2578974.

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vitamin D resulted in a dramatic increase in the response to standard therapy in all genotypes.

Ndnr.com

40 TTABVUE 38-40

Journal of Hepatology: Clinical Application of Basic Science: Vitamin D for your patients with chronic hepatitis C?

By Adeeb H. Rahman, Andrea D. Branch;

Vitamin D is increasingly becoming recognized as an important physiological regulator with pleiotropic functions outside of its classic role in skeletal homeostatis. A growing body of clinical evidence highlights the prevalence and risks of vitamin D deficiency in patients suffering from chronic hepatitis C infection, and vitamin D supplementation has been proposed as an adjunct to current standards of care.

40 TTABVUE 44

Los Angeles Times: Promising cancer therapy treatment: Vitamin C: Feb. 5, 2014 By Monte Morin

New research suggests that vitamin C might make cancer drugs more effective. But past discredited claims about the vitamin's effectiveness in treating cancer are likely to hinder further study.

<http://articles.latimes.com>

31 TTABVUE 74

Ms. Carnahan further testified that various companies that sell pharmaceutical preparations also sell vitamins.

Q: Based on your years of experience working in the pharmaceutical industry, are you aware of any pharmaceutical companies that also sell vitamins?

A: Yes, most of the – many of the large pharmaceutical companies, Pfizer or Bayer, sell vitamins.

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When you look at it, they're both distributed through pharmacies, so from a distribution model that people have set up, they're in the same place, such as like a Target or a Walgreens.

38 TTABVUE 78-79.

Opposer submitted as Exhibit E to its notice of reliance evidence that pharmaceutical companies also sell vitamins. Some excerpts include the following:

Fox News.com: Many Vitamins, Supplements Made by Big Pharmaceutical Companies: Some of the same companies that mass-produce drugs in huge chemical labs also churn out vitamin and herbal pills sold in bottles with rainbows, sunrises and flowers on their labels.

31 TTABVUE 77

HealthUncut:the antidote to poor health advice: The big Lie-The Pharmaceutival and Nutritional Supplement industry Divide: November 23, 2012; But, here's what we don't hear being banded about, those supplements you buy, there's every chance the company is simply a subsidiary of the vast drug industry, and your money is going straight into their coffers. Just this week the pharmaceutical company Reckitt outbid Bayer to purchase Schiff nutrition for \$1.4 billion. This marks the third large acquisition of its type this year.

31 TTABVUE 79

The Wall Street Business: By Serena Ng and Jonathan D. Rockoff March 31, 2013

Like a lot of aging Americans, consumer products and drug companies are hoping vitamins will give them an energy boost. Proctor & Gamble Co., drug maker Pfizer Inc. and Arm & Hammer owner Church & Dwight Co. all acquired makers of dietary supplements last year. More deals are expected as companies bet baby boomers and rising health care costs will drive demand for products that promise health in a bottle.

Online.wsj.com

31 TTABVUE 81

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Applicant argues that vitamins are unrelated to pharmaceutical preparations since, even if they are both carried by a pharmacy,¹¹ vitamins are not given out by the pharmacist. However, this is not the legal test, and indeed the evidence and case law indicate that vitamins may be prescribed, even if they are also over-the-counter items not dispensed by a pharmacist. In view of Opposer's broadly worded identification, we find that the goods are closely related and that they are likely to travel in the same channels of trade. These factors also weigh in favor of finding a likelihood of confusion.

Conditions of Sale

Applicant urges us to consider the consumer sophistication and degree of purchaser care likely to be exercised for the goods at issue in this proceeding, arguing that consumers of its vitamins and Opposer's pharmaceutical preparations are likely to be more sophisticated. However, there is nothing in the identification of goods that would limit the goods of either from being sold to the general public, as noted by Applicant's officer, Mr. Cheatham:

Q: Who do you sell the product to?

A: We sell the product to consumers and we also sell the product to retailers.

Q: What kind of consumers?

A: Adults.

Q: So just the general population adults?

¹¹ Applicant testified that its customer list includes several pharmacies. *See* Cheatham depo. 31 TTABVUE 130-136, and Exhibit 23 thereto.

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A: That's right.

31 TTABVUE 110-111.

To the extent pharmaceutical preparations may be dispensed by prescription, our case law has noted that confusion may be found where, as here, the marks are highly similar and the goods are related. *See Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004):

We acknowledge that such persons are sophisticated and are not prone to carelessness. Nonetheless, we find that confusion is likely, even among these healthcare professionals, where these similar goods are marketed under the similar marks involved herein; there is no reason to believe that medical expertise as to pharmaceuticals will ensure that there will be no likelihood of confusion.

The decision further aptly notes that we must consider the least sophisticated consumer, and that pharmaceutical preparations are increasingly marketed to the general public. *Id.*; quoting *KOS Pharmaceuticals Inc.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004) (“Court have noted that drugs are increasingly marketed directly to potential patients through, for example ‘ask-your-doctor-about-Brand-X’ style advertising.” [citations omitted])

As pointed out by Opposer, our precedent dictates that concerns of public safety also weigh in favor of finding likelihood of confusion where medical goods are concerned. *Id.*; citing *Blansett Pharmacal Co. V. Carmrick Labs. Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) (“We note also that where the marks are used on pharmaceuticals and confusion can lead to serious

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consequences, it is even more important to avoid that which will cause such confusion. [cites omitted]). See also *Clifton v. Plough, Inc.*, 341 F.2d 934, 144 USPQ 599, 600 (CCPA 1965) (Although finding that “[t]he products of the parties are sold over the counter to the general public and either may be purchased without a doctor’s prescription,” the Court further noted, “[a]s stated by the board, it is necessary, for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals.”).

We find the conditions of sale to weigh in favor of finding likelihood of confusion.

Conclusion

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, in comparing applicant’s VERTOX mark to the mark VERTEX in Opposer’s Registration No. 2704913, we conclude that the marks are highly similar, the goods are related, and are likely to be marketed through similar channels of trade to consumers that include the general population. We also take into account in this regard the issues of public safety inherent in the identified goods. Specifically, we must consider the possibility that consumers in need of Opposer’s pharmaceutical preparations may purchase Applicant’s vitamins mistakenly believing them to be complementary or achieving the same results. On the balance, we find a likelihood of confusion between Applicant’s mark VERTOX and Opposer’s mark VERTEX.

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DECISION: The opposition is sustained on the ground of likelihood of confusion.¹²

¹² In light of our conclusion, we do not find it necessary to address Opposer's other pleaded grounds of lack of bona fide intent to use the mark and nonuse of the mark.