

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 27, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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CareFusion 2200, Inc.

v.

Entrotech Life Sciences, Inc.

—
Opposition No. 91206212

—
Joseph R. Dreitler of Dreitler True LLC for CareFusion 2200, Inc.

Lisa M. Martens of Sheppard Mullin Richter & Hampton LLP for Entrotech Life
Sciences, Inc.

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Before, Kuhlke, Bergsman and Shaw, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Entrotech Life Sciences, Inc. seeks registration of the following
standard character marks:¹

1. CHLORADRAPE (Ser. No. 85499332) for “surgical drapes” in International Class 5;
2. CHLORABOND (Ser. No. 85499337) for “topical antimicrobial solutions for dermatologic use” in International Class 5;
3. CHLORABSORB (Ser. No. 85499345) for “medical and surgical dressings” in International Class 5; and

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¹ Filed on December 19, 2011 and based on allegations of a bona fide intent to use the marks in commerce under Section 1(b) of the Trademark Act.

4. CHLORADERM (Ser. No. 85499349) for “medical and surgical dressings” in International Class 5.

Opposer, CareFusion 2200, Inc., has opposed registration of Applicant’s marks on the ground that, as used in connection with Applicant’s goods, the marks so resemble Opposer’s previously used and registered marks, CHLORAPREP for “topical antimicrobial solutions”² and a “broad-spectrum antiseptic”³ and CHLORASHIELD for an “antimicrobial catheter patch dressing,”⁴ as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved applications. In this decision, we have endeavored to discuss evidence submitted under seal as “confidential” only in general terms as necessary to support our determination. The parties submitted the following evidence:

1. The trial testimony of Opposer’s witness Jennifer Raeder-Devens and accompanying exhibits, 79 TTABVUE;
2. The trial testimony of Applicant’s witness Dr. George J. Holinga and accompanying exhibits, 88 TTABVUE;
3. The trial testimony of Applicant’s witness James E. McGuire and accompanying exhibits, 89 and 90 TTABVUE;
4. The trial testimony of Opposer’s witness Jan Creidenberg and accompanying exhibits, 76 TTABVUE;
5. The trial testimony of Opposer’s rebuttal witness Jennifer Raeder-Devens and accompanying exhibits, 77 TTABVUE;

² Registration No. 1930248, Issued October 24, 1995; renewed.

³ Registration No. 4052849, issued April 11, 2011.

⁴ Registration No. 4488745, issued February 25, 2014.

6. The trial testimony of Opposer's rebuttal witness Carol Schultz and accompanying exhibits, 75 TTABVUE;
7. Opposer's Notice of Reliance which includes articles purporting to show the recognition of CHLORAPREP within the national medical community, the advantages of using CHLORAPREP prior to, during, and after medical procedures, and the value of and goodwill associated with the CHLORAPREP product, 73 TTABVUE;
8. Opposer's Notice of Reliance which includes three printouts from the TESS and assignment databases to show the title and status of Opposer's Registration Nos. 1930248, 4052849, and 4488745, 43 TTABVUE;
9. The discovery deposition of James E. McGuire and accompanying exhibits, filed under Notice of Reliance, 44 TTABVUE;
10. The discovery deposition of John Halsey and accompanying exhibits, filed under Notice of Reliance, 45 TTABVUE;
11. The discovery deposition of Dr. John Foor and accompanying exhibits, filed under Notice of Reliance, 46 TTABVUE;
12. Opposer's Notice of Reliance which includes a printout from the TESS and assignment databases to show the live status of Opposer's Application No. 86473970, for the mark CHLORAPREP MAX-TINT ORANGE, 48 TTABVUE;
13. Opposer's Notice of Reliance which includes printouts from the TESS and assignment databases purporting to show that third-party registrations of CHLORA-formative marks are not for goods similar to those offered by Opposer under its CHLORAPREP and CHLORASHIELD marks, or do not contain chlorhexidine, or are not for human use, 49 TTABVUE;
14. Opposer's Notice of Reliance which includes printouts from the TESS and assignment databases purporting to show that third-party registrations for goods competitive with Opposer's CHLORAPREP and CHLORASHIELD goods and/or for goods that contain chlorhexidine as an active ingredient do not use "CHLORA" anywhere in the marks, 50 TTABVUE;
15. Opposer's Notice of Reliance which includes two interrogatories and answers provided by Applicant, 51 TTABVUE;
16. Opposer's Amended Notice of Reliance which includes two interrogatories and answers provided by Applicant, 52 TTABVUE;

17. Opposer's Notice of Reliance which includes one article from Allnurses.com purporting to rebut arguments or references made in Applicant's Trial Brief that rely upon documents submitted by Applicant, 74 TTABVUE;
18. Applicant's Notice of Reliance which includes Opposer's responses to Applicant's interrogatories and Applicant's request for admission, 61 TTABVUE;
19. Applicant's Notice of Reliance which includes third-party United States trademark applications for marks containing the term "CHLOR" or "CHLORI", 62 TTABVUE;
20. Applicant's Confidential Notice of Reliance which includes the discovery deposition of Jan Creidenberg, 63 TTABVUE;
21. Applicant's Notice of Reliance making of record third-party registrations for marks containing the letters "CHLOR" or "CHLORA" for goods relevant to this Opposition, 64 TTABVUE;
22. Applicant's Notice of Reliance making of record publicly available Internet materials purporting to establish the weakness of the CHLORAPREP mark and product and any goodwill Opposer alleges either may have, 65 TTABVUE;
23. Applicant's Notice of Reliance making of record publicly available Internet materials purporting to establish the co-existence in the marketplace of Opposer's CHLORAPREP and CHLORASHIELD marks with other marks containing the letters "CHLOR" or "CHLORA" for goods relevant to this Opposition, 66 TTABVUE;
24. Applicant's Notice of Reliance making of record publicly available Internet materials purporting to establish the purchasing conditions and the sophistication of the purchasers of the goods at issue in this Opposition, 67 TTABVUE;
25. Applicant's Notice of Reliance making of record publicly available Internet materials purporting to establish the scope of Opposer's use of its CHLORAPREP and CHLORASHIELD marks and the co-existence in the marketplace of Opposer's CHLORAPREP and CHLORASHIELD marks with other marks containing the letters "CHLOR" for goods relevant to this Opposition, 68 TTABVUE;
26. Applicant's Notice of Reliance making of record official government records relating to the marks at issue in this Opposition, 69 TTABVUE; and

27. Applicant's Confidential Notice of Reliance making of record Opposer's discovery response and documents produced to Applicant in this Opposition, 70 TTABVUE.

II. Evidentiary Objections

Applicant objects to the following evidence and testimony submitted by Opposer:⁵

1. The discovery deposition of Dr. John Foor;
2. The discovery deposition of John Halsey;
3. Opposer's Notice of Reliance regarding certain printed publications;
4. The trial testimony of Carol Schultz;
5. Portions of the trial testimony of Jan Creidenberg and several associated exhibits;
6. Opposer's exhibit purporting to identify "Third-Party Competitors" to Applicant's products and the related testimony of Jennifer Raeder-Devens;
7. Opposer's Notice of Reliance regarding third-party registrations of marks for surgical drapes, medical dressings, and skin preparations, or products related thereto; and
8. Opposer's Notice of Reliance offering Opposer's application to register CHLORAPREP MAX-TINT ORANGE.

Opposer objects to the following evidence and testimony submitted by Applicant:⁶

1. Portions of Applicant's Notice of Reliance relating to exhibits and testimony regarding Opposer's cancelled CHLORASHIELD mark for surgical drapes as moot; and
2. Exhibits and testimony relating to Opposer's settlement with the Department of Justice regarding Opposer's "alleged improper marketing of its ChloraPrep product" as irrelevant.⁷

⁵ Applicant's Br., App. B; 85 TTABVUE 49.

⁶ Opposer's Br., App. B; 82 TTABVUE 51.

⁷ Opposer's Objections to Portions of Applicant's Notices of Reliance, Appendix B, p. 2.; 81 TTABVUE 53.

We begin with Opposer's motion to strike the Foor and Halsey discovery depositions submitted by Opposer under notice of reliance.⁸ Foor is a vascular surgeon who has worked for both Opposer and Applicant. Foor brought the parties together to collaborate on the antimicrobial surgical drape and worked with Applicant to create a prototype. John Halsey has worked in the medical products field for a number of years and was hired by Applicant to market its chlorhexidine products.⁹ Applicant identified Foor as the "Medical Director of Applicant" in its responses to Opposer's First Set of Interrogatories and identified Halsey as the President of Entrotech Life Sciences in its First Amended Initial Disclosures. Applicant did not supplement or correct its responses or disclosures to advise Opposer that Foor and Halsey were removed from their positions prior to Opposer taking their discovery depositions.¹⁰ It was only upon deposing Foor and Halsey that Opposer learned they were no longer officers or directors of Applicant. Opposer requested that Applicant stipulate to the filing of Foor's discovery deposition but Applicant declined on the grounds that it had not had the opportunity to cross examine Foor during the discovery deposition.¹¹ Opposer nevertheless submitted the Foor and Halsey discovery depositions via notice of reliance. Opposer then sought a subpoena for Foor's testimony in the brief time remaining in its testimony period but Applicant

⁸ 45 and 46 TTABVUE.

⁹ Halsey deposition, pp. 25-28; 45 TTABVUE 28-31.

¹⁰ Fed. R. Civ. P. 26(e) states "A party who has made a disclosure under Rule 26(a)—or who responded to an interrogatory, request for production, or request for admission—must supplement or correct its disclosure or response . . . in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect"

¹¹ 47 TTABVUE 16.

filed a motion to quash the subpoena in district court arguing that Foor was a “non-party witness” and that the subpoena “fails to allow a reasonable time to comply, imposes an undue burden on him, and, seeks only duplicative testimony already taken during a nearly seven-hour deposition. . . .”¹² Opposer then moved to suspend or extend its testimony period to take Foor’s testimony deposition in the event the district court denied the motion to quash.¹³ The district court granted Applicant’s motion to quash the subpoena finding that it “failed to provide Foor with a reasonable time to prepare for and comply with the subpoena.”¹⁴ Following the district court’s decision quashing the subpoena, Opposer’s motion to suspend or extend its testimony period was deemed moot, and the motion to strike the Foor and Halsey deposition was deferred until final decision.¹⁵

In its motion to strike, Applicant argues that the depositions are not proper subject matter for a notice of reliance because, at the time of their depositions, neither Foor nor Halsey was “a party or . . . an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure” at the time his discovery deposition was taken. . . .”¹⁶

Opposer, on the other hand, argues that Applicant’s First Amended Initial Disclosures, served July 30, 2014, identified Halsey as the President of Entrotech Life

¹² 53 TTABVUE 23.

¹³ 47 TTABVUE.

¹⁴ District Court Opinion and Order, p. 6; 57 TTABVUE 7.

¹⁵ 91 TTABVUE 2-3.

¹⁶ 58 TTABVUE 4; 59 TTABVUE 4.

Sciences, and Applicant's responses to Opposer's First Set of Interrogatories, dated July 15, 2013 and November 8, 2013, identified Foor as the "Medical Director of Applicant."¹⁷ It was not until the Halsey deposition was taken on December 12, 2014 and the Foor deposition was taken on June 17, 2014 that it was discovered by Opposer that Halsey and Foor were no longer officers or directors of Applicant. Opposer characterizes Foor as a "major fact witness" who was "was actively involved [with the surgical drape project] during the time the parties were working together."¹⁸

The actions of both parties leave much to be desired. For its part, Applicant failed in its duty to update its responses and disclosures regarding the status of Foor and Halsey, particularly with regard to Halsey's status as an officer which changed as the parties were in the very process of scheduling his deposition. Applicant's objections to Opposer's efforts to take the testimony deposition of Foor are not well taken. Moreover, Applicant's characterization of Foor as a "non-party witness" is disingenuous in light of the fact that until shortly before his discovery deposition he was the "Medical Director of Applicant." Moreover, despite being removed from this position, Foor was at the center of the collaboration between the parties and he remains entitled to receive 50% of any potential revenues from the sale of the chlorhexidine-treated surgical drape.¹⁹ Thus, even if Foor is, strictly speaking, a "non-party witness," he maintains an association with Applicant and he has a direct interest in the success of Applicant's products. Significantly, Applicant's objection to

¹⁷ Opposer's memorandum in opposition to applicant's motions to strike, pp. 2-4; 79 TTABVUE 3-5.

¹⁸ *Id.* at 3.

¹⁹ Foor deposition, p. 20; 46 TTABVUE 22.

Foor's testimony deposition focused not on the merits of his likely testimony but on whether the testimony was convenient for Foor and the fact that it was "duplicative [of] testimony already taken during a nearly seven-hour deposition. . . ." ²⁰ It is inconsistent for Applicant to argue that the Foor discovery deposition should not be admitted but at the same time argue that additional testimony by Foor would have been duplicative. Simply put, Applicant can't have it both ways.

For its part, Opposer knew or should have known, as of the depositions of Foor and Halsey, that these witnesses were no longer directors or officers whose testimony could be entered by notice of reliance under rule 2.120(j)(1). Opposer had nine months and three months, respectively, to obtain the Foor and Halsey testimony depositions. Yet Opposer waited until less than three weeks remained in its testimony period to obtain Foor's testimony and never sought Halsey's testimony. Nevertheless, Opposer's efforts to take Foor's testimony were thwarted by Applicant.

In light of the foregoing, we exercise our discretion under 37 CFR § 2.120(j)(2) to admit the Foor and Halsey discovery depositions into the record, and overrule Applicant's motion to strike them. We hasten to add, however, that the outcome would be the same without the depositions. We find them useful only to provide background information on the goods at issue and the history of the parties' collaboration. Nothing in either deposition is outcome determinative, especially with regard to any of the likelihood of confusion factors.

²⁰ 53 TTABVUE 23.

Applicant's appendix of objections also references its motion to strike certain publications and a standalone bibliography submitted with Opposer's notice of reliance offering in evidence certain printed publications.²¹ Applicant objected to three publications because Opposer failed to specify the source and date of each of these publications, as required under Rule 2.122(e) of the Trademark Rules of Practice. Applicant also objected to the bibliography of 25 publications because the notice of reliance did not include copies of the publications²² and further asserted that "Opposer's substitute notice of reliance was filed outside of its initial testimony period, and, thus, is untimely."²³ In response to Applicant's original motion to strike, Opposer filed a cross-motion for leave to amend its notice of reliance to include the dates of the three publications as well as to include six of the publications listed in the bibliography.²⁴ The board granted as conceded Opposer's motion for leave to amend its notice of reliance in an order dated January 9, 2016 and noted the motion to strike was moot.²⁵

We see no reason to disturb the Board's prior determination. *Fujifilm SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014) (procedural defects are ones that "can be cured by the offering party as soon as it is raised by any adverse party, without reopening the testimony period of the offering party.")²⁶

²¹ 42 TTABVUE.

²² 60 TTABVUE.

²³ Applicant's Br., App. B, p. 2; 85 TTABVUE 50.

²⁴ 73 TTABVUE.

²⁵ 91 TTABVUE 3.

²⁶ We further note that reference to the prior motion to strike which was denied is in essence an untimely request for reconsideration.

As will be seen *infra*, none of the remaining testimony or exhibits sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss the remaining objections in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

III. The Parties

Opposer, CareFusion 2200, is a medical products company that sells, *inter alia*, antimicrobial products for use in medical procedures. In 1994, CareFusion's predecessor began selling CHLORAPREP, a pre-surgical skin antiseptic preparation containing chlorhexidine gluconate ("CHG"), a powerful antiseptic. As discussed more thoroughly, *infra*, CHLORAPREP sales steadily increased and additional CHLORAPREP products were added to the product line. In 2014, Opposer began selling a surgical dressing impregnated with CHG, under the name CHLORASHIELD.

Applicant, Entrotech Life Sciences, is one of a family of research and development companies affiliated with Entrotech, Inc., the original owner of the applications.²⁷

Applicant describes the Entrotech family of companies as:

[A]n alternative to the overly-corporatized old guard of companies – such as Opposer – operating in the advanced materials space. Entrotech's home is the lab, not the conference room; it is a meritocracy rewarding innovation, not contributions to a healthy EBITDA; it invests in

²⁷ The applications were assigned to the current Applicant on July 16, 2012.

innovation, not refining what is already established and proven; and it prizes efficiency and collaboration over blind adherence to antiquated business methods.²⁸

Applicant is seeking to develop and market medical devices containing chlorhexidine freebase (“CHX”). CHG and CHX are related molecules with similar antimicrobial properties, but they have dissimilar chemical properties, especially with regard to solubility.²⁹ The solubility of the chlorhexidine molecules affects their ability to be applied to various surfaces such as dressings and surgical drapes.

In the fall of 2008, the parties began collaborating on the development of a surgical drape featuring chlorhexidine. Surgical drapes are adhesive sheets applied to the skin to protect against infection during surgical procedures. It was anticipated that Applicant would use its technical “expertise” to develop and the manufacture the drape³⁰ whereas Opposer would use its “sales and distribution” expertise to market the drape.³¹ The collaboration between Applicant and Opposer ended in the fall of 2011 due to a number of factors, including vastly differing corporate cultures. Following the end of the parties’ collaboration, Applicant filed the four applications identified above.

IV. Standing and Priority

Because Opposer’s pleaded registrations are of record, valid and subsisting, Opposer’s standing to oppose registration of Applicant’s marks is established and its priority is not in issue as to the goods listed in the registrations. *See Empressa*

²⁸ Applicant’s Br., p. 4; 84 TTABVUE 12.

²⁹ McGuire Discovery Deposition, p. 51; 44 TTABVUE 54.

³⁰ Jennifer Raeder-Devens Deposition, p. 370; 77 TTABVUE 113.

³¹ McGuire Discovery Deposition, p. 70-71; 44 TTABVUE 73-74.

Cubana Del Tabaco v. Gen. Cigar Co., 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

V. Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the goods and the similarities between the marks. *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 nature and similarity or dissimilarity of the goods, the established, likely-to-continue trade channels, and the classes of purchasers*

We first consider the similarity of the goods. We base our evaluation on the goods as they are identified in the applications and registrations. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

It is settled that it is not necessary that the respective goods be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s goods are “surgical drapes,” “topical antimicrobial solutions for dermatologic use,” and “medical and surgical dressings.” Opposer’s goods are “topical antimicrobial solutions,” a “broad-spectrum antiseptic,” and an “antimicrobial catheter patch dressing.”

Applicant’s goods are, in part, identical to Opposer’s goods. In particular, Applicant’s “topical antimicrobial solutions for dermatologic use” are included within Opposer’s “topical antimicrobial solutions.” Similarly, Opposer’s “antimicrobial catheter patch dressing” goods are included within Applicant’s “medical and surgical dressings.” Because these goods are identical, we must presume that they move in the same channels of trade and are offered to the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Am. Lebanese*

Syrian Associated Charities Inc. v. Child Health Research Inst., 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

Applicant argues that “there is no doubt that Opposer and Applicant advertise the products offered under their respective marks through different channels and by different means.”³² This argument is unpersuasive. Because Applicant has identified its goods without restriction as to the trade channels through which they will be offered, the identical goods are presumed to travel in all normal channels and to all prospective purchasers for the relevant goods. *Coach Servs.*, 101 USPQ2d at 1722.

Additionally, we find that Applicant’s remaining goods, “surgical drapes,” are closely related to Opposer’s antimicrobial solutions and antiseptics, inasmuch as the record shows these goods are often used by medical professionals to disinfect the skin before the application of a surgical drape. Notably, Applicant does not argue that the surgical drapes are not closely related to Opposer’s antimicrobial solutions and antiseptics. Indeed, the entire purpose of the parties’ collaboration was to join these two goods into a single product, namely, a surgical drape featuring an antimicrobial solution or antiseptic.

Regarding the channels of trade and likely classes of consumers for surgical drapes and antimicrobial solutions, even if we accept Applicant’s argument that it will not advertise its products, we nevertheless find that these goods are likely to be sold to the same consumers, namely, purchasers of medical and surgical supplies for

³² Applicant’s Br. at 30.

hospitals, surgical centers, doctor's offices and other places where medical procedures are performed.³³

In view of the above, we find that the goods, channels of trade, and classes of purchasers are related for purposes of our likelihood of confusion determination.

B. The number and nature of similar marks in use on similar goods

This *du Pont* factor focuses on the usage by third-parties of similar marks in connection with related goods or services in the marketplace. "The purpose of a defendant introducing third-party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the bases of minute distinctions."

Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). "The weaker an Opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection."

Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millennium Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Applicant and Opposer have made of record a number of third-party registrations and examples of registered marks containing the term CHLOR, CHLORA, CHLORO, or CHLORI. The following registrations are the most similar to the parties' marks:

³³ Criedenberg Test., pp. 54-58; 76 TTABVUE 55-59.

Mark	Reg. No.	Identification of Goods	Product Use
Chloragard	4,071,394	Antiseptic catheter surface sold as an integral component of catheters, in International Class 10	Catheter with chlorhexidine solution chemically bonded to its surface
CHLORASEB	4,012,226	Antibacterial and antifungal sprays for use on pets and animals, in International Class 5	2% chlorhexidine antiseptic spray for pets and animals
CHLORAZENE	1,530,509	Antiseptic powder, in International Class 5	Whirlpool antiseptic
CHLORADINE	3,608,454	Antimicrobial solution for teat dip; disinfectant for veterinary use, in International Class 5	Teat Dip; 2% CHG formula for prepping animal surfaces prior to surgery
CHLORACEL	649,510	Sodium aluminum chlorhydroxy lactate and other aluminum chlorhydroxy compounds, in International Class 1	Antiperspirant
CHLORO-SOL	2,717,529	All-purpose disinfectant spray and towelettes premoistened with disinfectants, in International Class 5	Bleach disinfectant solution for decontamination of healthcare surfaces
CHLOROSTAT	1,600,325	Antimicrobial skin cleanser, in International Class 5	Topical antimicrobial chlorhexidine solution
CHLORLITE	2,328,894	Concentrated laundry destainer, in International Class 3	Hypochlorite-based stain remover
CHLORCID	2,057,459	Dental preparations, namely, disinfecting solutions for irrigating, debriding and disinfecting a root canal, in International Class 5	Dental preparations
CHLOROPTIC	888,556	Ophthalmic preparations, in International Class 5	Ophthalmic preparations
CHLORALOY	1,012,945	Sheets of synthetic polymer material for	Shower pan liner waterproofing

		construction purposes, particularly shower lines, in International Class 19	membrane; made from chlorinated polyethelene
CHLORAZONE	2,219,205	Synthetic polymer in the form of solid slabs, strips and other pre-formed solid shapes, used to manufacture a wide variety of products intended to be in regular contact with water, in International Class 1	Rubber toilet flapper designed to withstand chemicals in water, specifically free chlorine and chloramines
CHLORASEPTIC	837,014	Pharmaceutical preparation for the relief of throat and mouth soreness, in International Class 5	Sore throat pain relief lozenges and sprays
CHLORAGUARD	2,395,110	Fabric protectant, namely, dye treatment for bleach resistant protection sold as a component of carpets, in International Class 27	Bleach resistance for carpets
CHLORAXIS and design	4,147,430	Dietary and nutritional supplements, in International Class 5	Green coffee bean extract used in weight loss supplements

In addition, Applicant has made of record internet evidence of third-party common law use of marks containing the terms CHLOR, or CHLORA used on disinfectants or antibiotics whose active ingredient contains some form of the element chlorine. The following examples are the most similar to the parties' marks:

Mark	Goods
CHLOR-XTRA	Sodium hypochlorite solution; used for irrigation, debridement and cleansing of root canals during and after instrumentation; 66 TTABVUE 80-81
CHLORA CLENS	Pet wound care spray that includes chlorhexidine; 66 TTABVUE 93-94
CHLORA-DIP	Veterinary teat dip that includes chlorhexidine; 66 TTABVUE 96
CHLORA TABS	Antibiotic product containing chloramphenicol; 66 TTABVUE 98-101

Mark	Goods
CHLORACOL	Antibiotic product containing chloramphenicol used to treat bacterial eye infections; 66 TTABVUE 103-106

Applicant first argues that these registrations show that “Opposer’s marks are composed of descriptive components and, thus, are weak” and, moreover, the marks “follow the established naming convention of using CHLOR to describe a product that includes chlorhexidine or chlorine and, in many cases, includes antiseptic properties.”³⁴ We disagree that these registrations show that CHLORA is a descriptive component. Opposer’s marks include the term CHLORA, not merely CHLOR, or the term CHLORO. As Opposer points out, although CHLOR- and CHLORO- appear in the dictionary, there is no dictionary definition for the term CHLORA.³⁵ Nor do we have any evidence that the relevant consumers would view these terms as equivalents. Thus, it does not follow that a mark that includes the term CHLORA, rather than merely CHLOR, or CHLORO, must be considered weak and entitled to only a narrow scope of protection. Instead, we find Opposer’s CHLORAPREP and CHLORASHIELD marks to be at least suggestive marks when considered on the continuum of distinctiveness.

Applicant nevertheless points to the large number of third-party marks containing the term CHLOR to suggest that “consumers – particularly sophisticated consumers – are not likely to be confused between any two marks in the crowd.”³⁶ Applicant’s argument is unpersuasive.

³⁴ Applicant’s Br. at 22; 84 TTABVUE 30.

³⁵ Opposer’s reply Br., pp. 2-3; 87 TTABVUE 3-4.

³⁶ Applicant’s Br., p. 23; 84 TTABVUE 31.

As an initial matter, many of the listed marks are used on goods which are clearly unrelated to the parties' goods, such as antiperspirants, stain remover, shower pan liner waterproofing membrane, rubber toilet flappers, and extracts used in weight loss supplements. These third-party registrations are of limited probative value. *See In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (finding third-party registrations to be of limited probative value because the goods identified in the registrations "appear to be in fields which are far removed from [the goods at issue]").

In addition, we do not find many of the listed marks to be particularly relevant because they contain the terms CHLOR-, CHLORO-, or CHLORI- rather than CHLORA, the term found in the parties' marks. That is, the coexistence of numerous CHLOR-, CHLORO-, or CHLORI- formative marks does not resolve the issue before us as to whether consumers can distinguish several CHLORA-formative marks, especially for identical or closely-related goods.

Finally, none of the identified marks are used in connection with "surgical drapes" or "medical and surgical dressings" and only a few of the marks are used in connection with disinfecting preparations for medical use. Nearly all of the marks that use the term CHLORA, CHLOR, or CHLORO in connection with disinfecting preparations or antibiotics appear to be used in connection with products that have different uses from the parties' topical antimicrobial solutions or antiseptics. For example, three of the listed CHLORA-formative marks, CHLORASEB, CHLORA CLENS, and CHLORA DIP, are used in connection with veterinary products whereas the parties' goods are intended to be used on humans. Two other CHLORA-formative marks,

CHLORA TABS and CHLORACOL, are used in connection with the antibiotic chloramphenicol, not a topical solution. Similarly, two of the marks, CHLORCID and CHLOR-EXTRA, are used in connection with dental preparations. And one mark, CHLORO-SOL, is used in connection with a bleach disinfectant solution for healthcare surfaces. The use of these marks on products differing from the parties' goods diminishes their probative value as well. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (“The relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on similar goods.’”) quoting *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548-49, 14 USPQ2d 1840, 1842 (Fed. Cir. 1990). Only the CHLORAG+ARD and CHLOROSTAT marks are used on closely-related goods, but the existence of these two marks does not suggest that consumers “have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay*, 73 USPQ2d at 1693.

In sum, we cannot conclude that the foregoing third-party use of marks similar to Opposer's CHLORAPREP and CHLORASHIELD marks is so widespread as to “condition” the consuming public that Opposer's marks should be accorded only a narrow scope of protection or exclusivity of use. That is, we do not find that because some CHLOR-formative marks can coexist when used on differing goods, then any CHLORA-formative marks can co-exist, especially when they are used on identical or closely-related goods. *See Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 153 USPQ 406, 407 (CCPA, 1967) (“[T]he existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark.”).

C. Strength of Opposer's marks

In determining the strength of a mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark. *See Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (“In assessing the overall strength of [a] mark, we consider both its inherent strength based on the nature of the mark itself and its commercial strength, based on the marketplace recognition value of the mark.”); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); McCarthy on Trademarks and Unfair Competition § 11:83 (4th ed. 2016) (“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 [registration].”). Commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board of India*, 80 USPQ2d at 1899. Opposer argues that the marks are “conceptually and commercially strong.”³⁷

1. Inherent strength

Opposer’s marks are CHLORAPREP and CHLORASHIELD. As discussed *supra*, the term CHLOR- is sometimes used to indicate the presence of the element chlorine. Opposer has modified CHLOR- to add the letter “A” as well as to add the terms PREP and SHIELD. The term PREP can be seen as a shortening of the terms preparatory

³⁷ Applicant’s Br., p. 32; 81 TTABVUE 39.

or preparation, thus CHLORAPREP suggests a pre-operative preparation containing the element chlorine. Similarly, the term SHIELD refers to a protective device or layer, thus CHLORASHIELD suggests a protective covering also containing the element chlorine. Because of the addition of the letter “A” to CHLOR, the shortening of preparation to PREP, and because of the literal meaning of SHIELD, we find Opposer’s marks, when used in connection with Opposer’s goods, to be at least suggestive. However, even though we have found the marks to be suggestive, it does not follow that the mark’s inherent strength obviates the likelihood of confusion of purchasers encountering Applicant’s and Opposer’s marks on identical or closely-related goods. *Maytag Co. v. Luskin’s Inc.*, 228 USPQ 747, 750 (TTAB 1986); *See also King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (“The likelihood of confusion is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and a ‘strong’ mark.”).

2. Commercial strength.

With regard to the market strength of Opposer’s marks, the question involves the extent to which the relevant public recognizes CHLORAPREP and CHLORASHIELD as marks denoting Opposer’s antimicrobial solutions, antiseptic, and dressings. The relevant public in this case includes doctors, nurses, and staff responsible for selecting or purchasing medical supplies.

Opposer has used the mark CHLORAPREP to identify its topical antimicrobial solutions since at least as early as 1994. The CHLORASHIELD mark was added to Opposer’s line of products in 2013. The CHLORAPREP products are sold to a wide variety of medical providers, including hospitals, ambulatory care centers, blood

banks, dialysis centers, nursing homes and home health care providers and to companies that put together procedure kits.³⁸ Sales of CHLORAPREP products have grown dramatically over the years. For example, during the period from 2003 to 2012, annual sales grew from tens of millions of dollars to several hundred million dollars.³⁹ Cumulative sales of CHLORAPREP products now total in the billions of dollars. These sales have been substantial by any standard.

Opposer also spends millions of dollars each year to promote its CHLORAPREP products via advertising, trade shows, online communications, paid speakers, market research, work with advertising agencies, public relations, and funding of product studies.⁴⁰ Opposer's market share is significant with CHLORAPREP products reported to be used in "anywhere from 35 percent for peripheral IVs to more like 85 to 90 percent for central [catheter] lines."⁴¹ Similarly, in the "surgical space," CHLORAPREP products are reported to be used in nearly 60 percent of surgical "procedures that are appropriate for a single-use applicator with an alcoholic chlorhexidine gluconate solution."⁴²

Additionally, CHLORAPREP has been mentioned by name in a number of medical articles and clinical studies.⁴³ For example:

1. "Comparison of **ChloraPrep** and Betadine as preoperative skin preparation antiseptics." Poster presented at the 40th Annual Meeting of the Infectious Disease Society of America, Chicago, IL (October 25, 2002);

³⁸ Criedenberg Test., pp. 54-58; 76 TTABVUE 55-59.

³⁹ *Id.* at 26-27; 76 TTABVUE 463.

⁴⁰ *Id.* at 122-123; 76 TTABVUE 1095.

⁴¹ *Id.* at 128; 76 TTABVUE 129.

⁴² *Id.*

⁴³ 73 TTABVUE; (emphasis added).

2. “The Effectiveness of **Chloraprep**[™] in the Reduction of Blood Culture Contamination Rates in the Emergency Department.” *Journal of Nursing Care Quality*, Vol. 23, No. 3:272-6 (July-September 2008);
3. “A Clinical Study Comparing the Skin Antisepsis and Safety of **ChloraPrep**, 70% Isopropyl Alcohol, and 2% Aqueous Chlorhexidine.” *Journal of Infusion Nursing*, Vol. 25, No. 4:244-49 (July/August 2002);
4. “**ChloraPrep** highly effective for presurgical pathogen removal.” *Law & Health Weekly* (2005);
5. “Chlorhexidine-based antiseptic solutions effectively reduce catheter-related bacteremia.” *Pediatric Nephrology*, 24:1741-47 (2009) (mentions **CHLORAPREP** by name);
6. “Improving Quality of Surgical Care and Outcomes: Factors Impacting Surgical Site Infection after Colorectal Resection.” *The American Surgeon*, Vol. 80, No. 8:759-63 (August 2014) (mentions **CHLORAPREP** by name);
7. “Chlorhexidine-Alcohol versus Povidone-Iodine for Surgical-Site Antisepsis.” *The New England Journal of Medicine* 362, 1:18-26 (January 2010) (mentions **CHLORAPREP** by name); and
8. “Comparison of Chlorhexidine and Tincture of Iodine for Skin Antisepsis in Preparation for Blood Sample Collection.” *Journal of Clinical Microbiology*, Vol. 42, No. 5:2216-2217 (May 2004) (mentions **CHLORAPREP** by name).

We find that Opposer’s CHLORAPREP mark is a strong mark that has become recognized by the relevant public, at least when used in connection with antimicrobial solutions and antiseptic.

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

We now turn to the similarity or dissimilarity of the parties’ marks in their entirety as to appearance, sound, connotation and commercial impression. *Du Pont*, 177 USPQ at 567; *Palm Bay*, 73 USPQ2d at 1692. We note that when trademarks appear on substantially identical goods, the degree of similarity needed to support a conclusion of likelihood of confusion declines. *Coach Servs.*, 101 USPQ2d at 1722.

Applicant's marks are CHLORADRAPE, CHLORABOND, CHLORABSORB, and CHLORADERM. Opposer's marks are CHLORAPREP and CHLORASHIELD.

In terms of appearance, all of the marks are compound or telescoped terms⁴⁴ that begin with the term CHLORA. As the first element in each mark, CHLORA is the element most likely to be impressed upon consumers and remembered by them. *See Palm Bay*, 73 USPQ2d at 1692 (prospective purchasers tend to focus on the first word, prefix, or syllables of a trademark).

In terms of sound, CHLORADRAPE, CHLORABOND, and CHLORADERM are similar in pronunciation to CHLORAPREP and CHLORASHIELD inasmuch as in all of the marks the term CHLORA is followed by a single-syllable term. CHLORABSORB is slightly different from the other marks in that it can be seen as a telescoping of the terms CHLORA and ABSORB, but we think it likely that it will be nevertheless be pronounced similarly to the other marks, that is, with the major break in syllables occurring between CHLORAB and SORB. This leads to only a minor difference in the pronunciation of CHLORABSORB as compared to the other marks.

In terms of connotation and commercial impression, all of the marks are a combination of the terms CHLORA and another term suggesting the use of the product. DRAPE, BOND, DERM, ABSORB, PREP, and SHIELD all suggest the

⁴⁴ A compound word mark is comprised of two or more distinct words that are represented as one word. A telescoped mark is comprised of two or more words that share letters. Trademark Manual of Examining Procedure § 807.12(e) (April 2016).

intended purpose or use of the various goods and, therefore, are less dominant than the first word, CHLORA.

Applicant relies heavily on the weakness of the term CHLORA to show that confusion is not likely, citing cases in which courts or the Board found no likelihood of confusion when both marks at issue shared a common term. However, we do not believe that these cases require the same conclusion in the present case, where the goods are identical or closely related and where the term CHLORA has not been widely used on similar goods.

Thus, although the marks have different suffixes, when we compare them in their entireties, we find that on the whole they are similar in appearance, sound, connotation and commercial impression. This *du Pont* factor favors a finding of likelihood of confusion.

E. Conditions of sale and purchaser sophistication

Applicant argues that “it is clear that the circumstances under which the parties’ products are purchased mitigate against a likelihood of confusion.”⁴⁵ We disagree.

The goods of the parties are disposable, single use, and inexpensive items ranging in cost from \$.30 to \$6.00.⁴⁶ Applicant’s products will be similarly priced.⁴⁷ There is no evidence of record to indicate whether the purchase by hospitals of these goods will be subject to the same level of care as, for instance, expensive medical devices used for diagnostic and treatment purposes that are highly technical in nature and

⁴⁵ Applicant’s Br., p. 31; 84 TTABVUE 39.

⁴⁶ Criedenberg Test., pp. 129-131; 76 TTABVUE 130-132.

⁴⁷ McGuire Test., p. 257; 89 TTABVUE 258.

may be presumed to be subject to careful purchase. Even assuming, *arguendo*, that purchases of Applicant's and Registrant's goods would involve a deliberate decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective goods, especially when the goods are, in part, legally identical and otherwise closely-related.

In this case, the legal identity of the goods and similarity of the marks outweigh any sophisticated purchasing decision. *See HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods.). *See also In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers . . . are not infallible."). This factor is neutral.

F. Bad faith

Opposer argues that Applicant adopted its marks in bad faith in an effort to trade off the goodwill associated with Opposer's marks. Opposer bases this allegation in part on Applicant's knowledge of Opposer's business and products learned during the parties' collaboration. The record shows that the parties' collaboration was fraught with frequent misunderstandings and miscommunications. For example, Opposer alleges that Applicant knew Opposer intended to call its surgical drape

CHLORADRAPE, but Applicant denies ever hearing the product called this.⁴⁸ Similarly, Opposer alleges Applicant deceived Opposer by secretly intending to use CHX in the surgical drape, rather than CHG as originally expected, which required more extensive FDA approval thereby lengthening the product delivery schedule. Applicant admits that it never intended to use CHG but defends the intentional deception as simply a prudent business strategy.⁴⁹

Establishing bad faith requires a showing, by a preponderance of the evidence, that a party intentionally sought to trade on the goodwill or reputation associated with another's marks. *See Big Blue Prods. Inc. v. Int'l Bus. Machs. Corp.*, 19 USPQ2d 1072 (TTAB 1991). However, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy. *See Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) ("[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.").

The filing of an application for a mark that may resemble the mark of another is not, on its face, evidence of bad faith. Nevertheless, "a party which knowingly adopts a mark similar to one used by another for related goods should not be surprised to

⁴⁸ McGuire Test., p. 317; 89 TTABVUE 318.

⁴⁹ *Id.* at 283-285; 89 TTABVUE 284-285.

find scrutiny of the filer's motive." *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1442 (TTAB 2012).

While we have concerns about the propriety of Applicant's business practices, based on this record, we cannot conclude that respondent acted in bad faith. The only evidence here merely pertains to Applicant's prior knowledge and not to Applicant's intent. More likely, Applicant's filing of applications for marks resembling those of Opposer reflect a fundamental misunderstanding of an established principle of trademark law—that a newcomer has a duty to avoid adopting a mark which is likely to cause confusion with the mark of another. As the Court of Appeals for the Federal Circuit has explained:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises "but one inference—that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark," and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 223 USPQ 1281, 1285, (Fed. Cir. 1984) quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962). Accordingly, this factor is neutral.

Conclusion

After considering all of the evidence of record and argument pertaining to the *du Pont* likelihood of confusion factors, including any not specifically discussed herein, we find that because the goods are in part identical and otherwise closely

related, the channels of trade and consumers are presumed to overlap, Opposer's marks are well-known, and the marks are similar, there is a likelihood of confusion between Applicant's marks and the Opposer's marks when used in connection with the identified goods. Consumers familiar with Opposer's goods sold under its CHLORAPREP and CHLORASHIELD marks would be likely to believe, upon encountering Applicant's CHLORADRAPE, CHLORABOND, CHLORABSORB, and CHLORADERM marks for identical or closely-related goods, that the parties' goods originate with or are associated with or sponsored by the same entity.

Decision: The opposition is sustained and registration of the marks is refused.