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

Proceeding	91226647
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91,226,647
In re: Serial No, 86/557,684 for
FOOD DUDES

DUDE IP, LLC Petitioner/Opposer	:	
v.	:	**RESPONSE TO APPLICANT'S MOTION TO COMPEL PRODUCTION**
FOOD DUDES DELIVERY, LLC Applicant	:	

OPPOSER RESPONSE TO MOTION TO COMPEL

Opposer Dude IP, LLC ("Opposer" or "Delivery Dudes") hereby files its response to the Motion to Compel Discovery filed by Applicant Food Dudes LLC ("Applicant"). The Motion is wholly without merit and must be denied.

I. Introduction

On May 18, 2017, the Interlocutory Attorney entered an order in the above-captioned matter stating that (a) Applicant's affirmative defense claiming that Opposer's registration at 4,101,367 had fallen abandoned could be heard by the Board, and (b) Applicant's defenses of failure to state a claim, that Opposer's claim is barred by the doctrine of waiver and estoppel, and Applicant's baseless claim that Opposer had engaged in fraud on the Trademark Office were summarily stricken. Opposer filed an answer to the Amended Counterclaim on June 2, 2017, a few days after Applicant had clarified certain discovery requests to Opposer in a May 31, 2017 letter.

Opposer corresponded with Applicant via email multiple times since May 18, 2017, including on June 5, 22 and 29, 2017, and Opposer provided documents to Applicant on multiple occasions between June 2, 2017 and July 4, 2017. Opposer made a good faith effort to provide responsive documents to Applicant, as well as amended interrogatories and documents requests that took into consideration the contents of Applicant's Amended Answer and Counterclaims as approved by the Board in the May 18, 2017 decision. Opposer also made a good faith effort to communicate its outstanding questions and objections to Applicant; Applicant made no effort to respond to Opposer's questions and objections outside the conversations between the parties on June 9, 2017 and between the parties and the Interlocutory Attorney on June 6, 2017.

Opposer believes that Applicant is on a fishing expedition, requesting documents that are not reasonably tailored to produce relevant evidence. Opposer further believes that Applicant is using motions practice to harass Opposer; given that Applicant did not even include the required statement that it made a good faith effort to resolve its issues with Opposer, perhaps Applicant is fully aware that it made no such effort.

Opposer has provided Applicant with hundreds of documents and lists of thousands of vendors and restaurants that Opposer has delivered goods from, among other documents. Applicant baselessly claims in its motion that Opposer has provided no documents in response to numerous document requests, but Opposer actually has provided documents in response to almost all of those requests; there are a few outstanding disputes as to the nature and extent of certain claims by Opposer of attorney-client privilege and with regard to trade secret in marketing plans, but Opposer truly believes that such disputes could have been worked out between the parties if Applicant had been truly willing to do so in good faith; at the very least, the issues before the Board could have been narrowed considerably.

Accordingly, Applicant's Motion must be denied. Applicant failed to include the required statements regarding good faith. Second, even if the statement had been included, Applicant failed to engage in the required good faith effort to resolve its differences with Opposer. Third, Applicant has not made a showing that its outstanding discovery requests ask for matter that is relevant to its claims or defenses, and proportional to the needs of the case. Fourth, Applicant does not overcome Opposer's legitimate objections including relevance and privilege. Opposer requests that its remaining objections be sustained as stated.

MEMORANDUM OF LAW

Discovery Parameters at the TTAB

A party seeking discovery before the Trademark Trial and Appeal Board may seek discovery of any non-privileged matter that is relevant to the party's claims or defenses and proportional to

the needs of the case, Trademark Rule 2.120(a)(1); E*milio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016); *Domond v. 37.37, Inc*., 113 USPQ2d 1264, 1268 (TTAB 2015). As Board proceedings concern only the right to registration, discovery in a Board proceeding generally is more limited than discovery in a trademark infringement action. Accordingly, a movant has the burden of demonstrating that it is entitled to certain discovery.

Opposer agrees that parties have a duty to cooperate under the Federal Rules of Civil Procedure and the Trademark Rules, and notes that Board looks with extreme disfavor on those who do not cooperate in the discovery process. TBMP §408.01 "Each party and its attorney or other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case." Id. *Also see Domond* ("Fed. R. Civ. P. 26(c)(1) requires that a party moving for a protective order include a certificate that the movant has in good faith conferred or attempted to confer with the other affected parties in an effort to resolve the dispute without Board action.")

At present, Applicant has been impatiently uncooperative in the discovery process, which resulted in Applicant filing its motion to compel one day after being told in writing by Opposer that additional documents would be provided in the coming days - and on the same day that over 100 documents were sent via Federal Express by Opposer to Applicant. Even if the Interlocutory Attorney sees merit in Applicant's premature demands, many if not all of those demands are now moot.

A Motion to Compel Discovery Must Be Supported by a Written Statement re Good Faith

Further, a motion to compel discovery must be supported by a written statement from the moving party showing that the party has made a good faith effort, by conference or correspondence, to resolve the issues with the other party, *and* that the parties were unable to resolve their differences. *Share This v. Rahid Chopra, Tarina Chopra and Anita Chopra* at Opposition No. 91209951 (May 4, 2014), *Giant Food, Inc. v. Standard Terry Mills, Inc*., 231 USPQ 626 (TTAB 1986) (movant failed to submit documentary evidence of good faith effort and thus the motion to compel was denied). Also see Trademark Rule 2.120(e)(1), 37 CFR § 2.120(e)(1); TBMP § 523.02 (June, 2017). Applicant did not include such written statement that it had made a good faith effort to resolve its differences with Opposer, nor state in writing that the parties were unable to resolve their differences. Accordingly, Applicant's Motion to Compel fails, and should not be granted.

The absence of this necessary, required and vital statement is grounds enough for the Board to deny Applicant's Motion to Compel. Applicant has not actually made a good faith effort to

resolve what issues they have with Opposer, and thus even if Applicant had claimed a good faith effort in writing in its motion, its motion would fail as "good faith" effort is not discharged where counsel has made an inquiry, but is merely dissatisfied with its adversary's response. In such circumstances the inquiring party must engage in additional effort to resolve the dispute. *Hot Tamale Mama…and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014) ("Trademark Rule 2.120(e)(1) calls for the moving party to show that it has made a good faith effort to resolve the issues presented in the motion, *and* that the parties were *unable to resolve their differences*... [T]he good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the dispute.") (emphasis in the original).

Where an applicant and/or its representative fails to make a good faith effort to resolve a discovery dispute, the party is also unable to include the required certification or statement in its motion. Lack of said certification or statement - on its own - has led federal courts to deny motions to compel. *Nwachukwu v. Karl*, 223 F. Supp. 2d 60, 71 n 7 (D.D.C. 2002); *Murthy v. Barberino Bros., Inc., 208 F.R.*D. 483 (D. Conn. 2001); *Burton v. R.J. Reynolds Tobacco Co*., 203 F.R.D. 624 (D. Kan. 2001); *Doe v. Nat'l Hemophilia Found.*, 194 F.R.D. 516 (D. Md 2000). The absence of a claim in Applicant's filing that a good faith effort was made is telling.

In *MacMillan Bloedel Limited v. Arrow-M Corp*., 203 USPQ 952, 953-954 (TTAB 1979), the Board explained that even where a party has completely failed to respond to discovery, the party seeking discovery has a duty to contact the adverse party to ascertain why it has received no response and whether the matter can be resolved amicably, see id. at 954; and second, in a subsequent precedent, explained that, following such contact, if the party seeking discovery is dissatisfied with the adverse party's answer, it may file a motion to compel, supported by the statement and accompanying showing required by Trademark Rule 2.120(e)(1). See *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 450 (TTAB 1979), *The Phillies v. Phila. Consol. Holding Corp*., 107 USPQ2d 2149, 2151 (TTAB 2013).

The Board said in *Hot Tamale Mama*:

> ...mere dissatisfaction with the adversary's answer to an initial inquiry, in itself, does not discharge the duty to undertake a good faith effort to resolve the dispute, particularly where the inquiring party has received no, minimal or incomplete substantive information in response to its initial inquiry. Rather, the point is to investigate the possibility of resolving the dispute. Although the reason why no discovery responses were served can be part possibly an important part of the discussion, it may be irrelevant to resolving the dispute in many cases. Regardless, the good faith efforts of the parties should be directed to understanding differences and actually investigating ways in which to resolve the

> dispute.... [E]stablishing the good faith effort that is a prerequisite for a motion to compel necessitates that the inquiring party engage in additional effort toward ascertaining and resolving the substance of the dispute. Here, that was not done.
>
> The record does not reflect an unresolvable situation – such as would have been the case if opposer were a defiant adversary who simply refused to engage in discovery or to provide applicant with any answer regarding the failure to serve discovery responses.

In this matter, likewise, Applicant engaged in no additional effort to ascertain and resolve the substance of this dispute After its receipt of Opposer's June 19, 2017 letter, or after its receipt of any of the documents sent by Opposer to Applicant since the acceptance of Applicant's Amended Answer and Counterclaim in mid-May. Despite Applicant's baseless attempts to infer and even claim that Opposer is some sort of defiant adversary, there is no evidence indicating that Opposer is such, as Opposer has produced hundreds of pages of documents to Applicant as well as reasonable answers to interrogatories, provided a time frame for additional production in its June 19, 2017 letter, and indicated its willingness to engage with Applicant to work out a time frame for supplemental production as additional documents were discovered in both the conference call with the Interlocutory Attorney and the June 19, 2017 letter.

As the Interlocutory Attorney is aware, Applicant and Opposer engaged in a discovery conference with the Interlocutory Attorney on June 6, 2017; the parties were unable to finish all of their discussion on that date and mutually agreed to have another phone conversation posthaste. Such conversation took place on June 9, 2017. Subsequent to that conversation, even before Applicant filed its Motion to Compel, Opposer had already amended its answers to its interrogatories in light of the new counterclaim and given the stricken defences originally promulgated by Applicant in its first filing, and provided Applicant with dozens of additional documents; further documents followed the week after, pursuant to the time frame set forth by Opposer in its June 19, 2017 letter to Applicant.

Pursuant to *Hot Tamale Mama…and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014), a good faith effort requires more than one telephone call, letter, or email exchange. The Board expects that the parties will engage in a meaningful effort to understand their differences and investigate ways to resolve their dispute. *Id.; Sentrol, Inc. v. Sentex Sys., Inc*., 231 USPQ 666, 667 (TTAB 1986). When a significant number of discovery requests are in dispute, the Board may decline to resolve the dispute on the theory that the parties could not have made a sufficient good-faith effort to resolve it themselves. *Sentrol*, 231 USPQ at 667. However, Opposer asks that the Board not merely decline to resolve this dispute, but rather deny Applicant's motion due to their failure to claim or manifest a good faith effort to resolve the

matter. Applicant is so bold-faced as to claim that Opposer's request in February, 2017 that "if [Applicant] wish[es] to have a phone conference regarding such documents, please let me know" (Littman Decl., Ex. I.) is a refusal to cooperate, when it is quite the opposite. Applicant never expressed any interest in scheduling such a phone conference regarding such documents at any time before its filing of its Motion to Compel.

Applicant may attempt to now suddenly claim they made some sort of good faith effort to resolve the issues it claims to still see, but in fact, they sent only one letter after their amended answer and counterclaim was accepted by the Board, and made no communication outreach with regard to substantive discovery matters after they received either the June 16 or June 19 emails from Applicant, although one of their assistants did reach out to Opposer in connection with an updated email to cc when sending materials.

The parties did engage in a conference with the Interlocutory Attorney (the "June 6, Phone Conference") in which a discussion of that letter transpired; Applicant and Opposer followed that up with a phone conversation on June 9, 2017, a fact which Applicant entirely left out of their filing.

Applicant also neglected to mention that on June 16, 2017, Opposer sent two emails that included a total of four documents comprising dozens of pages; the first email Opposer sent to Applicant that day also included production schedule information. In Applicant's Motion to Compel, they curiously neglected to include a copy of said email, which is attached hereto as Exhibit A; the salient section said:

> As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.

Opposer was, in fact able to respond more briskly than originally predicted, as, on June 19, 2017, Opposer notified Applicant in said June 19 letter that "additional responsive documents will follow when they have been properly marked and Bates-stamped." Approximately 26 hours later, without calling, emailing or otherwise reaching out to Opposer with regard to Opposer's extensive interrogatory response amendments or document request responses, Applicant filed its Motion to Compel. That cannot be reasonably seen as a good faith effort to resolve any differences, especially given the fact that had Applicant called or emailed Opposer, Applicant would have been informed that Opposer had already arranged for the pick-up by Federal Express of a stack of over 100 Bates-stamped documents, set for delivery on June 20, 2017.

Opposer explained in the June 6 Phone Conference that it was particularly complicated to compile complete annual sales figures from 2009 to 2012, and it would need additional time to do so; at no time in the June 6 Phone Conference, or in any subsequent communication, did Applicant demand it be provided immediately. Such sales figures were provided as they were compiled, with the 2013 figures submitted on July 4, 2017.

Applicant's Amended Answer and Counterclaim was only accepted by the TTAB on May 18, 2017; Opposer provided its amended responses to Applicant's interrogatories only 21 working days later, and provided additional document production even sooner than that. Such production and responses must be seen as prompt and reasonable. Further, Opposer's June 2017 production of documents and provision of its amended responses to discovery requests and interrogatories make Applicant's Motion to Compel utterly moot.

"Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary." *Panda Travel Inc., v Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009). Also see *Amazon Technologies Inc. v. Wax,* 93 USPQ2d 1702, 1705 (TTAB 2009), quoting *Nevada Power Co. v. Monsanto Co.*, 151 F.R.D. 118, 120 (D. Nev. 1993) (("In order for the meet and confer process to be meaningful and serve its intended purpose, the parties must present to each other the merits of their respective positions with the same candor, specificity, and support during informal negotiations as during the briefing of discovery motions."). See also *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions).

Each party and its attorney or other authorized representative also has to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. Fed. R. Civ. P. 26(g). See e.g., *Johnston Pump/General Valve Inc. v. Chromalloy American Corp*., 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (Board warned counsel for opposer that its conduct of discovery in the case was "uncooperative" and "improper" and that any further misconduct may result in the imposition of the estoppel sanction); *Luehrmann v. Kwik Kopy Corp*., 2 USPQ2d 1303, 1305 (TTAB 1987) (while party submitted responses late, the motion to compel was moot and party was not sanctioned); *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number); *Medtronic, Inc. v. Pacesetter Systems, Inc*., 222 USPQ 80, 83 (TTAB 1984) (it was clear from number and nature of opposer's discovery requests and applicant's blanket objections thereto that neither party was cooperating). See also *C. H. Stuart Inc. v. Carolina Closet, Inc.*, 213 USPQ 506, 507 (TTAB 1980) (opposer's "voluminous" discovery requests were "oppressive and nothing short of harassment" to applicant); *C. H. Stuart Inc. v. S. S. Sarna, Inc*., 212 USPQ 386, 387 (TTAB 1980) (Board granted applicant's motion for protective order;

opposer's "boiler-plate" discovery requests designed for an infringement action deemed harassment); *Varian Associates v. Fairfield-Noble Corp*., 188 USPQ 581, 584 (TTAB 1975) (applicant's motion to compel denied due to lack of good faith effort to resolve dispute).

As Ms. Sachdev was with her motion for a protective order at the end of discovery, *Emilio Pucci International BV v. Rani Sachdev*, 18 USPQ2d 1383 (TTAB 2016), Applicant is now with its Motion to Compel. Applicant made no effort to resolve whatever issues it had with Opposer before filing said motion. Just as it is improper for a party to move for a protective order to harass one's adversary by forcing the adversary to engage in motion practice, *Fort Howard Paper Co. v. G.V. Gambina Inc*., 4 USPQ2d 1552, 1553 (TTAB 1987), it is improper for a party to file a Motion to Compel to harass one's adversary by forcing the adversary to engage in motion practice. The Board reasonably looks with disfavor on upon the use of harassing tactics in discovery through any discovery device. *Carolina Closet, Inc.*, 213 USPQ 506 (TTAB 1980).

Opposer also notes that the Board makes a concerted effort to provide attorneys, as well as members of the public, with tips on practicing before the Trademark Trial and Appeal Board.[1] At present, the failure is not the responding party's response; it is the inquiring party's request. It is difficult, even now, for Opposer to be completely sure of which interrogatories and document requests Applicant is asking for more documents and/or answers in response to. For example, at page five of Applicant's Motion, Applicant incorrectly states that Opposer did not supplement its responses to Applicant's Document Requests ("Opposer continues to state that it is looking for more documents and that it has documents in its possession, custody, or control, but they have yet to be produced.") even though Applicant knows full well that Opposer submitted documents to Applicant in January, and supplemented its production in February, March and June, and has provided additional supplements in July. Exhibit B.

Opposer Has Provided Numerous Responsive Documents and Information

Applicant falsely claims that it "has not received any responsive documents" in connection with Document Requests 5, 7-9, 12, 15-17, 21, 23-24, 27-29, 31-32. (Applicant Motion, Page 7.) However, inaccurate claims by Applicant are set forth below, along with information about what Opposer has actually produced, even where Opposer has objected to certain requests. Opposer hereby requests that its remaining objections be sustained.

- Applicant claims in its motion that Opposer has not produced any documents "related to any third parties' use in commerce in the United States of Opposer's Marks, or any mark containing the word DUDES in connection with delivery services" even though Opposer

[1] https://cdn2.hubspot.net/hubfs/454850/TTAB%20Tips%202017%20Revised%20Feb.%207-1.pdf

has produced documents relating to Opposer's lawsuit against an Australian company that briefly used the mark DELIVERY DUDES in the United States.

- Applicant claims in its motion that Opposer has not produced any "documents in any way related to delivery services sold under a tradename or mark containing the word DUDES at the time" Opposer's application was filed; apart from the fact that this is a vague and ambiguous inquiry as three registrations were listed in Opposer's Opposition, Applicant produced a screenshot from its 2014 website, as well as other documents, in response thereto.
- Applicant claims in its motion that Opposer has not produced any documents "containing, comprising or any way related to assignments, licenses or other agreements through which Opposer claims any trademark right or interest in Opposer's Marks" but has also admitted that Opposer has produced the 2012 assignment of the DELIVERY DUDES mark, goodwill and domain name to Opposer's predecessor in interest from Marc Veneziano. Opposer notes that it is confused as to why Applicant believes that Opposer - who paid Veneziano for his trademark, domain name and goodwill - should be obligated to confirm that it "collected $10" in connection with this transaction, or for some inexplicable reason admit that its valid trademark assignment which included an assignment of the mark and goodwill associated therewith is a naked assignment, when it is most certainly not. Applicant's demand for such an admission might be appropriately included in a Request for Admission but it is not a proper inquiry in an interrogatory.
- Applicant claims in its motion that Opposer has not produced any "documents containing, comprising or related to assignments, licenses or permissions you have given to third parties to use a mark containing the words DUDES and/or DELIVERY, but also admits that Opposer has produced some license and franchise agreements; when Applicant asked on May 31 for those agreements to be produced without redaction, Opposer did so, and provided a representative sample of such agreements to Applicant on June 16, 2017.
- Applicant claims in its motion that Opposer has not produced any documents "sufficient to identify the period or periods of time Opposer used each of Opposer's Marks and on which of Opposer's services, including but not limited to restaurant take-out delivery services" but Opposer has produced screenshots of websites, as well as advertisements, receipts and other documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents "related to any lawsuits, oppositions, cancellations or other legal actions in which [Opposer was] involved relating to any dispute regarding the use or ownership of a mark or trade dress containing the words DELIVERY and/or DUDES" but Opposer has produced documents relating to Opposer's lawsuit against an Australian company that briefly used the mark DELIVERY DUDES in the United States, and has explained that while it believed it was not obligated to produce documents that were publicly available and easily accessible

online in the records of the US Patent and Trademark Office pursuant to *Domond*, as well as TBMP 414(10), it would do so; those documents have been produced as of this filing and thus the motion to compel such production is moot.

- Applicant claims in its motion that Opposer has not produced any documents "related to any settlement, consent or other agreement with a third party relating to the use of a mark containing the words DUDES or DELIVERY" but Opposer has produced the Veneziano agreement and has produced other documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents "reflecting or relating to any actual confusion between a third party's goods sold under a mark containing the words DELIVERY and/or DUDES and Opposer or Opposer's Services sold under Opposer's Marks"; Opposer has produced such documents, including Opposer's internal discussion of job postings that evidence actual
- Confusion, which it had also informed Applicant about in 2015 before this matter commenced.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's contention that its "use of DELIVERY DUDES trademarks to identify Opposer's Services and Opposer as their source has been "widespread, continuous and exclusive", but Opposer has produced numerous advertisements, receipts, promotional materials, website pages and more in response to this document request.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's contention that registration of Applicant's mark "is likely to damage the distinctiveness, goodwill, reputation and secondary meaning created and established within the DELIVERY DUDES mark by virtue of the confusion, mistake and deception likely to occur between the respective marks in derogation of Petitioner's rights, all to the Opposer's irreparable damage", but Opposer has produced dozens of documents in response to this request.
- Applicant claims in its motion that Opposer has not produced any documents to support Opposer's date of first use of each of its marks but Opposer has produced documents that show the first use of DELIVERY DUDES by Opposer's predecessor in interest in October of 2005; Opposer is still searching for documents that feature Opposer's use of the DD DELIVERY DUDES logo mark in March of 2012 as that is the date of first use cited in Opposer's 2014 application to register that mark, but have thus only been able to find, in its diligent search of its archives, and thus, produce, documentation showing use of the mark in October 2012. Opposer also is still searching for documents that feature Opposer's first use of its DELIVERY DUDES marks, and has produced other documentation of use of the DELIVERY DUDES mark in June and July of 2009, as well as use by Opposer's predecessor in interest in various years before 2012.
- Applicant claims in its motion that Opposer has not produced any documents sufficient to "identify the restaurants from which Opposer performs take-out delivery services under

any of Opposer's Marks", but Opposer has produced lists of restaurants as well as advertising and website screenshots that list such restaurants.

- Applicant claims in its motion that Opposer has not produced any documents "containing or comprising agreements between Opposer and restaurants, grocery stores or other food retailers under which Opposer is allowed to perform take-out delivery services under any of Opposer's Marks" but Opposer has produced a selection of documents responsive to this request.
- Applicant claims in its motion that Opposer has not produced any documents in response to its query regarding quantity of services and gross revenue; Opposer notes that on June 20, 2017 it advised Applicant that "we have only been able to create a complete and accurate chart of annual sales figures for the company for 2014, 2015 and 2016; we will provide that as an Attorney Eyes Only document this week. We are still working to compile the figures for 2009-2013." Opposer produced such information on June 22, 2017 and supplemented it twice with sales figures for other years.
- Applicant claims in its motion that Opposer has not produced any documents in response to its request for publicly available documents that are freely available for download at the USPTO website; Opposer notes that there are hundreds of pages available in multiple documents, and it is still in the process of gathering and Bates-stamping all of them. Opposer has produced many documents that have been publicly filed at the USPTO including assignments and specimens.
- Applicant claimed in its motion at page 15 that "Opposer has not produced any evidence of use, particularly on restaurant delivery services5 , before 2013" but on the next page admitted that Opposer provided receipts; said receipts are dated as far back as 2009.[2]
- Applicant claimed in its motion at page 16 that Opposer had only provided redacted license and franchise agreements, but Opposer provided four unredacted license and franchise agreements on June 16, in conjunction with an email in which Opposer stated, "Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not Bates-stamped, but I am happy to do so next week..." Accordingly, Applicant's demand that Opposer be compelled to provide documents that it produced before Applicant filed its motion to compel is unfounded and moot, and a demonstration of Applicant's lack of good faith in connection with reaching any resolution of outstanding disputes with Opposer.

In its May 31, 2017 letter, Applicant further claimed that it had not received certain answers and documents, Opposer herein sets forth an accurate status update with regard to each of these issues.

[2] Applicant also cites a "July 19, 2017" letter at Page 15; Opposer assumes that Applicant is referring to its June 19, 2017 letter.

- Applicant claims it has not received any information regarding use by Opposer's predecessor in interest between 2005 and 2012; however, Opposer has provided screenshots of Amazon pages and websites that show use of the mark in at least 2006, 2007, 2010 and 2011.
- Applicant claims it has not received sales figures; Opposer has informed Applicant multiple times that sales figures for 2009-2013 are complicated to assemble correctly, but they have been produced, making Applicant's complaints on this issue moot.
- Applicant correctly states that Opposer has not provided a complete list of vendors, or restaurants and stores that Opposer delivered goods to customers from between 2009 and 2013, or that Opposer's predecessor in interest delivered goods to customers from post-2005. However, Opposer has provided receipts and website printouts from those years from a number of such entities and Opposer believes that said selection is satisfactory. Opposer requests that its objections to providing additional receipts be sustained as stated.
- Applicant correctly states that Opposer has not provided any marketing plans that differ from Opposer's current marketing practices; Opposer has no such marketing plans that would be responsive to this request at present, and reserves the right to amend its answer to this Interrogatory Number 4 if such plans are created and responsive. However, Opposer has produced marketing documentation, and has objected to Applicant's demand for additional marketing documentation as such documents by their nature constitute trade secrets; Applicant requests that its objections to providing such documents be sustained as stated.
- Applicant claims that Opposer has not provided materials that include third-party names; however, Opposer has provided such documents to Applicant.
- In connection with Opposer's privilege log, Opposer believes that the log it has produced and updated is sufficiently responsive and requests that its objections to providing such documents be sustained as stated.
- In connection with the purchase of the mark and domain name from Opposer's predecessor in interest, Opposer remains baffled by Applicant's insistence that the Assignment entered into by the parties in 2012 which documents the assignment of the mark, domain name and goodwill for good and valuable consideration is somehow considered lacking by Applicant. In June, Opposer found additional documents in connection with communications between Opposer and its predecessor in interest, and produced them. Applicant's complaints on this issue now appear to be moot.
- In connection with Interrogatories 13 and 14, Opposer notes that discovery is not yet close to over, and any motion to compel production on these matters is premature.

Given that discovery is still open, and Opposer is still finding additional documents that are responsive to Applicant's document requests, Opposer continues to produce them as they are

discovered. Given the fact that Opposer's pre-2014 records are not stored in the same system as its records since that time, a fact about which Opposer has informed Applicant, those earlier records have to be recovered and searched separately, which is a time consuming process that Opposer is nonetheless continuing to do, so that it can fully respond to all reasonable document requests and interrogatories.

Opposer also contends that its specific objections detailed in response to certain discovery requests and interrogatories are valid and legitimate, and requests that the Board sustain its outstanding objections, set forth in the amended responses to interrogatories and document requests that it sent to Applicant on June 19, 2017, just ten days after the parties' conference call regarding discovery. It is laughable for Applicant to contend that none of their interrogatories or document requests are burdensome, when Opposer has offered multiple times to provide a selection or sample of documents that are responsive to specific requests, and Applicant accepted said offer as sufficient in the June 6, 2017 conference with the Interlocutory Attorney.

Opposer notes that Applicant is engaging in discovery requests as if this were a federal court proceeding. However, the Board has a specific and limited jurisdiction, under which the Board "is empowered to determine only the right to register." TBMP § 102.01 (3d ed. 2011). "[T]he scope of discovery in Board proceedings is generally narrower than in court proceedings." TBMP 402.01, quoting *Frito-Lay North America Inc. v. Princeton Vanguard LLC*, 100 USPQ2d 1904, 1907 (TTAB 2011). While Opposer "has a duty" to satisfy the legitimate "discovery needs of its adversary" TBMP § 408.01 (3d ed. 2011) it has no duty to satisfy illegitimate discovery demands or disproportionate demands. See, Sedona Principles Comment 2.b ("Electronic discovery burdens should be proportional to the amount in controversy and the nature of the case. Otherwise, transaction costs due to electronic discovery will overwhelm the ability to resolve disputes fairly in litigation."). When alleging that a responding party's responses to individual discovery responses are inadequate, a propounding party should, as a threshold matter, first cite authority to establish that the information sought by each discovery request at issue is properly discoverable. See generally TBMP Section 414. In its Motion, in particular on pages 12 and 13, Applicant has not cited to any authority that the individual interrogatories at issue in its motion seek discoverable information.

This is not a litigation over whether Applicant can use the mark where it was using it before the filing date of Opposer's earliest application that vested to registration. The matter before the Board is only whether Applicant can register its FOOD DUDES mark in connection with the listed services on the principal register of the US Patent and Trademark Office. Given that, even acknowledging that discovery to overcome Applicant's unsupportable abandonment claim should be and has been produced by Opposer, the principles of proportionality with regard to discovery requests obligate the party making the requests to ensure that said requests are neither

harassing nor oppressive; the party is expected to consider the scope of the requests as well as to confer in good faith about the proper scope of discovery so as to minimize the need for motions. Applicant's discovery requests were disproportional at the start, but Opposer has nonetheless provided documents responsive to each request or provided a reasonable explanation why it has not done so.

Opposer has priority of registration, even if the '367 registration is set aside. A trademark or service mark registration on the principal register is presumed valid, as, for purposes of establishing priority, Applicant may at the very least rely on the filing dates of its applications. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010); see also, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). Any registration of a mark registered on the principal register, owned by a party to an action, "shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein." 15 U.S. Code § 1115.

Opposer has nonetheless provided printouts of the publicly available registration and application files that Applicant could have and should have accessed in March of 2016 when this matter began[3] as well as myriad other documents in response to Applicant's vague and over-broad document requests and irrelevant interrogatories.

Discovery Must Be Proportional to the Issues

A mere "belief that documents must exist simply is not enough to grant a motion to compel that would require [a party] to go back to square one and begin its document collection efforts anew." *Ford Motor Co.*, 257 F.R.D. at 428; see also *Covad Communications Co. v. Revonet, Inc.*, 258 F.R.D. 5, 13-14 (D.D.C. 2009). Further, Applicant has not supported its allegation that responsive documents must exist, or that Opposer has failed to produce such documents. "Parties are advised to be precise in their requests and to have as their first consideration how to significantly limit the expense of such production." *Frito Lay.*

[3] Opposer notes that Applicant claims that Opposer has 'concealed' the cancellation proceeding it filed over five years ago against Marc Veneziano; it is not actually possible to conceal something that is publicly available, especially when it is listed on the Summary page that appears when one types "DELIVERY DUDES" into http://ttabvue.uspto.gov/ttabvue/, and has been accessible to Applicant since before it filed its answer in this matter. Opposer also explicitly stated in its December response to Applicant's request for production of documents that Applicant's "request seeks documents that are publicly available from the US Patent and Trademark Office". Opposer informed Applicant of where they could access said documents easily, for free, and in an electronic, searchable form. "TTABVUE [is] the Board's publically available docket history system... Board proceedings are open to the public." *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232 (TTAB 2015)

Opposer looks to the Board ruling in *Frito Lay* for guidance on what discovery is proportional and reasonable. Applicant has not explained, whether in this pleading or in communication with Opposer, how or why "the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties' resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues." See e.g. Fed. R. Civ. P. 26(b)(2)(C)(iii).

In its motion, Applicant implies that Opposer has to prove the date of first use of its word marks and logo marks; however, given the limited jurisdiction of the TTAB and the fact that the only issue before the board is the registerability of Applicant's FOOD DUDE mark in connection with the services stated in its application, in view of Opposer's ownership of valid and subsisting registrations for the goods identified therein, Opposer's priority is not in issue. *King Candy, Inc. v. Eunice King's Kitchen, Inc*., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). *Also see Sigma-Tau Industrie Farmaceutiche Riunite S.p.A. v. SigmaPharm Laboratories, LLC* at Opposition Nos. 91196802 and 91196807 (TTAB 2015) ("Because Opposer has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the mark and the goods covered by the pleaded registrations.").[4]

Even if Applicant is able to show abandonment of Opposer's DELIVERY DUDES registration at 4,101,367, that has no impact on the relevance and impact of Opposer's valid and subsisting registrations at 4,702,834 and 4,702,835, and Applicant is not now permitted under the rules of the TTAB to engage in a collateral attack on such registrations. The TBMP explicitly states that "priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark, provided that there is no counterclaim or separate petition to cancel the pleaded registration." There is no such counterclaim or separate petition to cancel two of Opposer's pleaded registrations and thus, priority is not in issue. *L.C. Licensing Inc. v. Berman,* 86 USPQ2d 1883, 1887 (TTAB 2008) (pleaded registrations show current ownership and that each is valid and subsisting; priority is not an issue). *Fort James Operating Co. v. Royal Paper Converting Inc*., 83 USPQ2d 1624, 1626 (TTAB 2007) (having submitted status and title copies of its pleaded registrations, opposer not required to prove acquired distinctiveness of marks).

If the merits of Applicant's motion are reviewed despite the fact that Applicant's motion is devoid of a statement that they have made a good faith effort to resolve their differences with opposer, and a statement that the parties have been unable to resolve said differences, as is

[4] This decision is available in the online records of the TTAB at http://ttabvue.uspto.gov/ttabvue/v?pno=91196802&pty=OPP&eno=92 and a copy of the decision is submitted alongside this Response.

required by the Board, the Board should conclude that many of Applicant's requests are vague, irrelevant, overbroad and not designed to result in the discovery of relevant evidence - and that nonetheless, Opposer has produced documents that respond to those vague, irrelevant, overbroad and inappropriately drafted requests and Opposer's remaining objections should be sustained, especially as, even if they are, Opposer will still be obligated to supplement its production with additional responsive documents, and update its interrogatory answers if any change.

In addition, Opposer has produced a privilege log of documents protected by attorney-client privilege. Information protected by the attorney-client privilege is not discoverable unless the privilege has been waived; and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. See, for example FRCP 26(b)(3); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167 (TTAB 1975); *Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974). While Applicant claims that documents created by Opposer and its attorneys in the lead-up to, and during, the 2012 cancellation proceeding, were not created in connection with litigation, such argument must fail. The Board's "About" page at https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board explicitly describes a proceeding before the Board as a litigation, stating that the "TBMP provides practitioners with basic information generally useful for litigating cases before the TTAB." Further, Opposer raised reasonable relevancy and proportionality objections in connection with various of Applicant's requests. Opposer's claims of privilege and attorney-client work product must be upheld, and Opposer requests that its objections including its objections to being forced to void privilege, be sustained as stated.

Many Requested Documents Are Publicly Available

The TTAB has held that materials that are publicly available on the internet and acquired by a party in anticipation of trial are generally not required to be produced in discovery. *Capital City, LLC v. Select Brands, LLC*, 2013 WL 5402086 at *3 (TTAB Aug. 26, 2013) (denying motion to strike internet material from notice of reliance because "many of the documents introduced under [the notice of reliance] are not of the type whereby we can conclude they were solely within the possession of petitioner prior to trial") (citing *Rocket Trademarks Pty. Ltd. v. Phard. S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011)).

This is in keeping with Fed. R. Civ. P. 26(b)(2) which explicitly allows for limitations on discovery where such discovery is "unreasonably cumulative or duplicative, or can be obtained from another source that is more convenient, less burdensome, or less expensive." *Domond v. 37.37, Inc*., 113 USPQ2d 1264, 1268 (TTAB 2015).
Opposer did not actually have copies of the entire trademark files in December, and obtained downloads from the USPTO only during discovery after the June 6, 2017 phone call with the Interlocutory Attorney due to the the Interlocutory Attorney's statement that it would be considerate to do so. Opposer still reasonably believes that per *Rocket Trademarks*, *Domond* and *Capital City*, it is not obligated to produce such documents, and maintains its objection to the production of publicly available documents, especially those that Applicant has already admitted to accessing and reviewing.

Additional Issues

Applicant's criticism of the clarity of eight year old receipts, as well as its criticisms of the Veneziano agreement, appear to be an attack on the probative value of Opposer's evidence. The Board will not entertain any motion challenging or otherwise relating to the probative value or sufficiency of a party's trial evidence, *Hunter Industries Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 n.11 (TTAB 2014), and thus these attacks should be given no consideration in the Board's decision regarding Applicant's Motion.

Applicant incomprehensibly and baselessly claims that Opposer's 2012 Petition for Cancellation is evidence that Opposer did not use its DELIVERY DUDES mark in interstate commerce before 2012; this entire claim appears to be based on a misreading of a line in said Petition. Applicant parses and twists Opposer's words in a self-serving misreading of Opposer's statement that it had "been actively rendering services in commerce in South Florida since 2009. Petitioner desires to obtain a registration in the Mark in order expand his current business and engage in interstate commerce with the Mark..." "Engage in" cannot be read as "commence" or "begin", and it is odd for Applicant to attempt to do so. In addition, the Board's longstanding policy states that intrastate sales may be found to have such an effect on interstate commerce that the activities constitute acceptable use in commerce for purposes of trademark registration, there must be a showing that the activities have such an effect. See *In re Gastown*, 326 F.2d 780, 140 USPQ 216, 218 (CCPA 1964).

CONCLUSION
The matters complained of by Applicant in its premature Motion to Compel fall into three categories:

- They appear to refuse to accept any of Opposer's objections.

- They deny that they have received answers and documents that are responsive to each of their inquiries and requests.
- Their impatience and refusal to wait the additional days that Opposer stated that it would need, on June 19 2017, to produce additional documents that became responsive only after Applicant's Amended Answer was accepted on May 18, 2017, means that any items in its Motion to Compel that might have been considered legitimate were already in the process of being copied and bates-stamped by Opposer, and thus said matters were moot by June 20, 2017 or in the days thereafter.

In its Motion, Applicant makes no claim that it engaged in a good faith effort to resolve its differences with Opposer, or that such differences were insurmountable; Applicant's impatience to file its Motion to Compel one day after being told that Opposer would provide additional documents within the next few days, may be seen to imply that Applicant filed its Motion to Compel to force Opposer to engage in irrelevant motions practice and to harass Opposer, both of which are frowned upon by the Board.

Accordingly, Opposer requests (a) that their objections to specific document requests and interrogatories be accepted and sustained as stated, (b) that their privilege log be deemed acceptable as provided, and (c) Applicant's Motion to Compel be denied.

Respectfully submitted,
/hht/
Heidi Howard Tandy, Esq.
Attorney for Opposer/Counterclaim-Defendant Dude IP, LLC
July 4, 2017

CERTIFICATE OF SERVICE

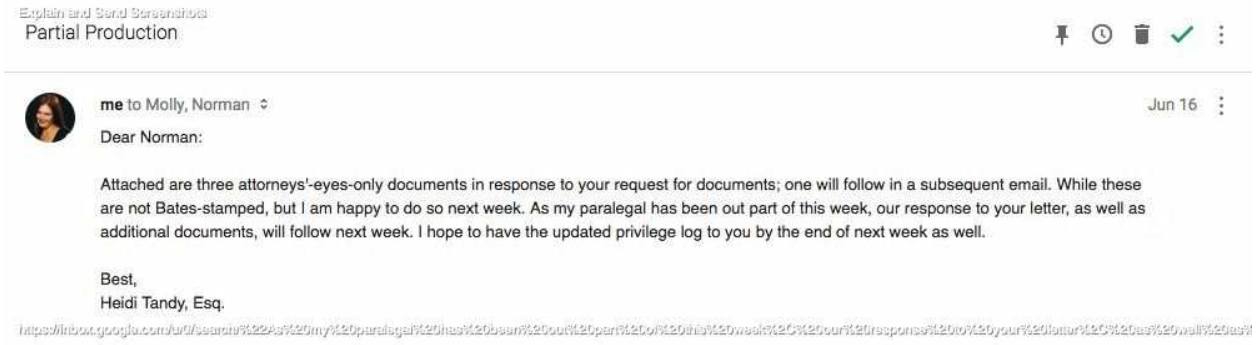
I hereby certify that a true and complete copy of the foregoing Response to Applicant's Motion to Compel has been served on Norman Abramson, Esq. via email to Norman.Abramson@gpmlaw.com on July 4, 2017

_____/hht/_____

Heidi Howard Tandy, Esq.

Counsel for
Opposer/Counterclaim-Defendant
Dude IP, LLC

Exhibit A



Explain and Send Screenshots

Partial Production

me to Molly, Norman Jun 16

Dear Norman:

Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not Bates-stamped, but I am happy to do so next week. As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.

Best,
Heidi Tandy, Esq.

https://mail.google.com/mail/u/0/#search/%22As%20my%20paralegal%20has%20been%20out%20part%20of%20this%20week%2C%20our%20response%20to%20your%20letter%2C%20as%20well%20as%

Exhibit B

Additional Production

me to Norman, Molly Mar 13

Norman,

On Friday, my office sent additional production to you on a flash drive via FedEx; if it doesn't arrive by the close of business today, please let me know. Our privilege log should be arriving to you later this week.

Please let me know if there are any questions.

Best,
Heidi Tandy, Esq.

Dude IP, LLC v. Food Dudes Delivery, LLC, Opposition No. 91226647

Littman, Molly R. to me, Norman, Fran Feb 13

Hello Heidi,

This email is in regard to Opposer's supplemental document production received on February 2, 2017 and following up on our meet and confer summary letter of December 26, 2016. As you are aware, one of the issues we sought additional documents and information on are communications and transactions Opposer had with Delivery Dudes, LLC and/or Marc Veneziano. (*See* Request Nos. 25 and 26).

Of the documents produced, only one relates to these requests. Document Bates No. DD0001925 is a communication between Marc Veneziano and Opposer regarding the prospective purchase of the deliverydudes.com domain. However, no further communications between Veneziano and/or Delivery Dudes, LLC and Opposer were produced. In addition to failing to provide any other communications, there are no documents related to the purchase of the domain name or the registration for the DELIVERY DUDES trademark owned by Veneziano. Are additional documents going to be produced or is it Opposer's position that there are no other responsive documents?

Food Dudes continues to request that Opposer produce all documents regarding or referring to Marc Veneziano and/or Delivery Dudes, LLC, the deliverydudes.com domain, or the assignment of the DELIVERY DUDES trademark.

Sincerely,
Molly

Partial Production

me to Molly, Norman Jun 16

Dear Norman:

Attached are three attorneys'-eyes-only documents in response to your request for documents; one will follow in a subsequent email. While these are not Bates-stamped, but I am happy to do so next week. As my paralegal has been out part of this week, our response to your letter, as well as additional documents, will follow next week. I hope to have the updated privilege log to you by the end of next week as well.

Best,
Heidi Tandy, Esq.

DELIVERY DUDES REVENUE 2014-2016 CONFIDENTIAL ATTORNEY EYES ONLY

me to me, Norman.Abramson, Molly.Littman, Katie.Schadewald, Jennifer.Veldhuizen Jul 3

Pursuant to the terms of the Protective Order entered into earlier this year between the parties, the attached document updates our June 22, 2017 response, and is produced on an Attorneys' Eyes Only basis; it has been marked accordingly.

Best,
Heidi Tandy, Esq.

Supplemental Privilelge Log - Delivery Dudes Production

L

Leanne Posch to Norman.Abramson@gpmlaw.com, me Mar 23

(On behalf of Heidi Tandy, Esq.)

Mr. Abramson,

Please see the attached document to be produced in discovery re the Delivery Dudes v Food Dudes matter. Please confirm receipt.

Sincerely,

Leann Posch, Legal Assistant
Fuller Lawyers, P.A.
1691 Michigan Avenue
Suite 360
Miami Beach, FL 33139
Phone: 305-445-7150
Fax: 305-447-4674

Delivery Dudes Production - Privilege Log

L

Leanne Posch to Norman.Abramson@gpmlaw.com, me Mar 16

(On behalf of Heidi Tandy, Esq.)

Mr. Abramson,

Please see the attached document to be produced in discovery re the Delivery Dudes v Food Dudes matter. Please confirm receipt.

Sincerely,

Leann Posch, Legal Assistant
Fuller Lawyers, P.A.
1691 Michigan Avenue
Suite 360
Miami Beach, FL 33139
Phone: 305-445-7150
Fax: 305-447-4674
E-mail: lposch@fullerlawyers.com

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Hearing:
November 12, 2014

Mailed:
February 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sigma-Tau Industrie Farmaceutiche Riunite S.p.A.
v.
SigmaPharm Laboratories, LLC

Opposition No. 91196802
Opposition No. 91196807

Paola A. Strino of Lucas & Mercanti LLP for Sigma-Tau Industrie Farmaceutiche Riunite S.p.A.

Jeffrey P. Weingart and Susan Schlesinger of Meister Seelig & Fein LLP for SigmaPharm Laboratories, LLC.

Before Rogers, Chief Administrative Trademark Judge, and Bergsman and Shaw, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

On April 13, 2009, Sigma Pharm Laboratories ("Applicant") filed four intent-to-use applications and two use-based applications, for three marks: **SigmaPharm**,

in standard characters,[1] **SigmaPharm Laboratories**, in standard characters,[2] and **SigmaPharm Laboratories** and design (below).[3]

Applicant seeks registration of each of the three marks for the goods and services set forth below. The two applications based on a claim of use are the service mark applications for the **SigmaPharm Laboratories** mark and the **SigmaPharm Laboratories** and design mark. Each of these two applications claims a date of first use of the mark, for the identified services, as of January 1, 2006.

> Pharmaceutical preparations, namely, a drug delivery system comprising solid dosage delivery agents and a wide variety of therapeutic agents in molecular or amorphous state, in the form of tablets, capsules and powder dosage forms, prepared using company's patented technology platforms which will result into more bioavailable and stable dosage forms of therapeutic agents for the treatment of hypertension, hypercholesterolemia, depression, atherosclerosis, thyroid deficiency syndrome, organ rejection, hepatitis and, HIV and fungal infections, in International Class 5; and
>
> Research and development of pharmaceutical products and preparations for the treatment of hypertension, hypercholesterolemia, depression, atherosclerosis, thyroid deficiency syndrome, organ rejection, hepatitis and, HIV and fungal infections, in International Class 42.

[1] Serial Nos. 77712535 and 77712553.

[2] Serial Nos. 77712545 and 77712558 (the use-based, services application).

[3] Serial Nos. 77712521 and 77712565 (the use-based, services application).

In the four relevant applications, Applicant disclaimed the exclusive right to use the word "Laboratories." In the applications featuring the design element, Applicant included a description of the mark stating: "[t]he logo depicts the Greek character 'phi' inside the Greek character 'sigma.'"

Sigma-Tau Industrie Farmaceutiche Reunite S.p.A. ("Opposer") filed Notices of Opposition against the registration of Applicant's marks on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), and that Applicant's marks consist of matter that falsely suggest a connection with Opposer pursuant to Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a). Opposer pleaded ownership of the two registrations listed below both for "pharmaceutical products for use in the treatment of carnitine deficiency and cardiovascular disease," in International Class 5:

1. Registration No. 1663145 for the mark SIGMA-TAU PHARMACEUTICALS, INC., in typed drawing form.[4] Opposer disclaimed the exclusive right to use the term "Pharmaceuticals, Inc."; and

2. Registration No. 1666394 for the mark comprising the lower case Greek letter "sigma," shown below.[5]

[4] Issued November 5, 1991; second renewal.

[5] Issued December 3, 1991; second renewal.

I. Preliminary Issues

A. Improper designation of confidential testimony and evidence as confidential.

On September 25, 2012, the parties filed a "Stipulated Protective Agreement" restricting the dissemination of "information that a Producing Party claims to be proprietary business information or technical information relating to a trade secret or other confidential research, development, financial, intellectual property, marketing, or commercial information within the meaning of Fed.R.Civ.P. 26(c)."[6] Fed.R.Civ.P. 26(c)(7) protects confidential, trade secret, and commercially sensitive information by allowing a party to limit the access to such information or by permitting the information to be revealed only in a designated way. The Board approved the stipulated protective agreement in an order dated September 26, 2012 and reminded the parties "that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement."[7]

Based on our review of the entire record, very little, if any, of the testimony and evidence introduced into evidence is proprietary business information or technical information relating to trade secrets or truly confidential matters. Nevertheless, the parties improperly designated testimony and evidence as confidential that is not. For example, the parties designated the identity of the three major wholesalers in the pharmaceutical industry as confidential even though

[6] 27 TTABVUE 4. All citations to the record will be to TTABVUE, the docketing system for the Trademark Trial and Appeal Board, from Opposition No. 91196802. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

[7] 28 TTABVUE 1.

they are the well-known in the industry. Also, the parties designated the identity of retailers who sell Opposer's over-the-counter products as confidential even though one of Opposer's publicly available webpages lists the retailers where Opposer's products may be purchased.[8]

Because of the improper designation of testimony and evidence by the parties as confidential, it is clear to us that much of what is designated "confidential," is not. Therefore, in rendering our decision, we will not be bound by the parties' designations. The filings and orders in Board proceedings are intended to be publicly available and the improper designation of materials as confidential thwarts that intention. Further, it is more difficult to make findings of fact, apply the facts to the law, and write decisions that are comprehensible to readers unfamiliar with the evidence when certain facts may not be discussed. The Board needs to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. Therefore, in this opinion, we will treat as confidential only testimony and evidence that is clearly so.

B. Objections.

The parties have lodged numerous [evidentiary?] objections. None of the evidence sought to be excluded is outcome determinative. Moreover, the Board is capable of assessing the relevance, and strength or weakness of, the objected-to testimony and evidence, including any inherent limitations, and this precludes the

[8] 58 TTABVUE 51. At the oral hearing, the Opposer withdrew the confidentiality designation as to the identity of the wholesalers and retailers. Applicant did not object.

need to strike the objected-to testimony and evidence. Given these facts, coupled with the number of objections, we see no compelling reason to discuss the specific objections. As necessary and appropriate, we will point out any limitations applied to the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. Absent such stated limitations, we have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections raised by the parties and we have accorded the subject testimony and evidence whatever probative value it merits.

C. Voluminous record.

The record in these proceedings is large and most of the testimony and evidence is more appropriate for a trademark infringement action than a trademark opposition which is more limited in scope. Suffice it to say, we have carefully considered all of the testimony and evidence, as noted above, introduced into the record and all of the arguments presented by the parties. If testimony, evidence or argument is not specifically discussed in the decision, we have not found it to be persuasive.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application files. Opposer attached to its Notices of Opposition printouts from the electronic database records of the USPTO showing current status and title of Opposer's pleaded registrations, thereby making

them of record. Trademark Rule 2.122(d)(1), 37 CFR § 2.122(d)(1). In addition, the parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Opposer's first notice of reliance comprising certified copies of its pleaded registrations showing the current status and title to Opposer's pleaded registrations;[9]

2. Opposer's second notice of reliance on the following items:[10]

a. Applicant's responses to Opposer's Interrogatory Nos. 3, 8 and 12;[11] and

b. Excerpts from the discovery deposition of Spiro Spireas, Ph.D., Applicant's Chairman and CEO;[12]

3. Opposer's third notice of reliance on excerpts from Applicant's website pursuant to *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) ("if a document obtained from the Internet identifies its date of publication or

[9] 54 TTABVUE. As noted above, Opposer's pleaded registrations were made of record as exhibits to the Notices of Opposition and, therefore, it was not necessary to introduce them a second time through the notice of reliance.

[10] Opposer also included Applicant's responses to Opposer's request for production of documents. 56 TTABVUE 34 – 41. *See also* 59 TTABVUE 34. Trademark Rule 2.120(j)(3)(ii), 37 CFR § 2.120(j)(3)(ii), provides that "[a] party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone." In view thereof, we have not considered the documents attached to Applicant's responses to Opposer's request for production of documents.

[11] 56 TTABVUE 5 – 10.

[12] 55 TTABVUE 12 – 34 and 56 TTABVUE 11 – 33. The testimony was designated "highly confidential," but it did not include any testimony that falls within the penumbra of confidential, trade secret, or commercially sensitive.

date that it was accessed and printed, and its source *(e.g.*, the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e).");[13]

4. Opposer's fourth notice of reliance on documents retrieved from the Internet pursuant to *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d at 1039;[14]

5. Opposer's fifth notice of reliance on documents retrieved from the Internet;[15]

6. Testimony deposition of Dr. Gianfranco Fornasini, Opposer's Senior Vice President of Scientific Affairs, with attached exhibits;[16]

7. Testimony deposition of Nichol M. Muzrim, former employee of Opposer who was Opposer's Northeast Regional Sales Manager, Senior Manager for the Oncology Portfolio, and Interim Vice President of Commercial Operations, with attached exhibits;[17] and

8. Opposer's rebuttal notice of reliance on the following items:

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[13] 57 TTABVUE 5-14.

[14] 58 TTABVUE. The Board, in *Safer*, explained that Internet documents introduced through Trademark Rule 2.122(e) "are admissible only to show what has been printed, not the truth of what has been printed." *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d at 1040. Thus, for example, the evidence regarding Opposer's revenues in the United States derived from the consolidated financial statements (58 TTABVUE 6 – 21) is hearsay. The probative value of the evidence in the consolidated financial statements is discussed more fully in the fame analysis below.

[15] 59 TTABVUE 6 – 33.

[16] 63 TTABVUE 4 – 273.

[17] 64 TTABVUE 4 – 226.

a. Documents retrieved from the Internet;[18]

b. Documents which Opposer purports to be USPTO records;[19]

c. Additional excerpts from the discovery deposition of Spiro Spireas, Ph.D.;[20]

d. Excerpts from the discovery deposition of Nichol M. Muzrim introduced into evidence pursuant to Trademark Rule 2.120(j)(4), 37 CFR § 2.120(j)(4), purportedly "to make not misleading what was offered by [Applicant]";[21] and

e. Excerpts from the discovery deposition of Dr. Giancarlo Fornasini introduced into evidence pursuant to Trademark Rule 2.120(j)(4), 37 CFR § 2.120(j)(4), purportedly "to make not misleading what was offered by [Applicant]."[22]

B. Applicant's testimony and evidence.

1. Applicant's first notice of reliance on copies of Opposer's registrations for the marks CARNITOR (Reg. No. 1439777), MATULANE (Reg. No. 0897704), and PROXEED (Reg. No. 2420415);[23]

2. Applicant's second notice of reliance on the following items;

a. Copies of Opposer's registrations for ABECELT (Reg. No. 1974363), ADAGEN (Reg. No. 1717411), CYSTARAN (Reg. No. 4407365),

[18] 77 TTABVUE 10 – 47.

[19] 77 TTABVUE 48 – 72.

[20] 76 TTABVUE 73 – 76. This portion of the transcript was designated as confidential.

[21] 77 TTABVUE 77 – 101.

[22] 77 TTABVUE 102 – 130.

[23] 66 TTABVUE 5 – 20.

DEPOCYT (Reg. No. 2390316), ONCASPAR (Reg. No. 1809883), and VSL#3 (Reg. No. 2653252);[24]

b. Copies of third-party registrations for marks with the term "Sigma";[25]

3. Applicant's third notice of reliance on documents retrieved from the Internet;[26]

4. Applicant's fourth notice of reliance on Opposer's responses to Interrogatory Nos. 9, 15, and 23;[27]

5. Applicant's fifth notice of reliance on excerpts from the discovery deposition of Nichol M. Muzrim;[28]

6. Applicant's sixth notice of reliance on excerpts from the discovery deposition of Spiro Spireas, Ph.D., which should be considered in fairness so as not to make misleading what was offered by Opposer;[29] and

7. Testimony deposition of Spiro Spireas, Ph.D., with attached exhibits.[30]

[24] 67 TTABVUE 8 – 44.

[25] 67 TTABVUE 46 – 131.

[26] 68 TTABVUE 12 – 223.

[27] 69 TTABVUE 2 – 12.

[28] 71 TTABVUE is the publicly available transcript and 70 TTABVUE is the transcript that contains what the parties designated as confidential testimony.

[29] 73 TTABVUE is the publicly available transcript and 72 TTABVUE is the transcript that contains what the parties designated as confidential testimony.

[30] 75 TTABVUE is the publicly available transcript and 74 TTABVUE is the transcript that contains what the parties designated as confidential testimony.

III. Standing

Because Opposer has properly made of record its pleaded registrations, Opposer has established its standing. *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, 189 (CCPA 1982).

IV. Priority

Because Opposer has properly made of record its pleaded registrations, Section 2(d) priority is not an issue in the opposition as to the mark and the goods covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). However, Opposer has also alleged "proprietary trademark rights under common law, through the long and exclusive use of Opposer's trademarks on a wide variety of pharmaceutical preparations *and related services*."[31] (emphasis added). Opposer did not further identify the services in the Notice of Opposition or in its brief.

In a case involving asserted common-law rights, "the decision as to priority is made in accordance with the preponderance of the evidence." *Hydro-Dynamics Inc. v. George Putnam & Company Inc.,* 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). As indicated above, Applicant filed its applications on April 13, 2009 and, therefore, Opposer must prove that it used its mark on "pharmaceutical preparations and related services" prior to that date unless Applicant can prove earlier dates of first use. *Zirco Corp. v. American Telephone and Telegraph Co.,* 21

[31] 1 TTABVUE 8.

USPQ2d 1542, 1544 (TTAB 1991) (allegations of common law rights after the filing date of applicant's application are inadequate to support the ground of priority of use and likelihood of confusion and, therefore, fail to state a claim upon which relief can be granted). *See also Embarcadero Technologies Inc. v. RStudio Inc.,* 105 USPQ2d 1825, 1833-84 (TTAB 2013). The April 13, 2009 filing date corresponds to Applicant's testimony and other evidence regarding the first use of its marks in connection with pharmaceutical preparations. For example, Applicant's website lists April 2009 as the date Applicant launched its first product, Amiloride HCl Tablets through its distributor Rising Pharmaceuticals, Inc.;[32] Spiro Spireas testified that Applicant's distributor first started marketing Applicant's products in 2009;[33] and Applicant's response to Opposer's Interrogatory No. 12 identifying April 4, 2009 as the date Applicant commenced national sales through a wholesale distributor.[34]

Based on the testimony of Spiro Spireas, which we characterize as definite, consistent and without contradiction, *see B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945) (oral testimony directed to establishing priority "is obviously strengthened by corroborative documentary evidence, and it should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability"), we find that Applicant began using its marks even earlier than its filing dates in connection with

[32] 68 TTABVUE 20 – 21.

[33] 75 TTABVUE 152 – 153.

[34] 56 TTABVUE 10.

research and development services for other pharmaceutical companies, specifically, in "the beginning of 2006."

> In the beginning of 2006, I believe, there were contracts between [Applicant] and services that [Applicant] was offering to other companies - - other pharmaceutical companies.
>
> So I would put it around the beginning of 2006, for sure, that the logo and the name was used in papers, and in invoices, and this kind of stuff - - with full collaboration with other pharmaceutical companies - - in developing products with them.[35]

There was no other testimony or evidence regarding Applicant's first use of its marks in connection with pharmaceutical preparations. Therefore, Applicant's date of first use for its marks in connection with pharmaceutical preparations is the filing date of its applications, April 13, 2009.

The testimony that applicant began using its marks for services in the beginning of 2006 requires further consideration. We note that Applicant's application to register **SigmaPharm** for services is based on intent to use but Applicant's applications to register the two **SigmaPharm Laboratories** marks for services claim January 1, 2006 as a date of first use. The testimony thus is consistent with two of the three applications. Applicant has not attempted to prove dates earlier than those claimed in these two applications, so there is no requirement that its proof of use be "clear and convincing."[36] On the other hand, a

[35] 75 TTABVUE 58 – 59.

[36] *Martahus v. Video Duplication Services, Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1852 n.7 (Fed. Cir. 1993) (registrant who seeks to prove first use prior to the alleged date of first use has "the burden of establishing that use by clear and convincing evidence instead of mere

date of first use claimed in an application is not proof of first use and use must be proven by competent evidence. While we find the Spireas testimony consistent with asserted dates of use and competent evidence to establish Applicant's use of the **SigmaPharm Laboratories** marks for services as of "the beginning of 2006" we cannot equate this testimony with a date of January 1, 2006. Pursuant to our precedent, we interpret a phrase such as "the beginning of 2006" to be the last day of that period.[37] In the absence of more definite testimony as to the first use of the **SigmaPharm Laboratories** marks for services, we consider the testimony sufficient to establish use as of June 30, 2006. Certainly many would consider "the beginning" of a year to mean the first week, month or quarter, but since we look to the last day of an indefinite period, the most we can conclude is that applicant used these two marks for services in the first half of the year, as the second half would no longer be considered "the beginning" of a year.

The testimony and evidence establishes that Opposer has used and continues to use its marks SIGMA-TAU PHARMACEUTICALS, INC. and the sigma logo on

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preponderance of the evidence."); *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552, 152 USPQ 599, 600 (CCPA 1967) (plaintiff's assertion of a date of first use prior that asserted in its application for registration, requires that "proof of such earlier date must be clear and convincing and oral testimony given long after the date sought to be proved must be carefully scrutinized.").

[37] *See Bass Pro Trademarks LLC v. Sportsman's Warehouse, Inc.,* 89 USPQ2d 1844, 1856 (TTAB 2008) ("even if we used the February/March, 1995 date of respondent's first use … respondent's date of first use can be no earlier than March 31, 1995, the last day of the specified time period."); *Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period).

all of its products. With respect to "pharmaceutical preparations," Dr. Fornasini testified as follows.[38]

> Q. Now, based on your experience with [Opposer], does [Opposer] use the sigma logo and the company name in connection with its products and services?
>
> * * *
>
> A. Yes.
>
> Q. How does it use that?
>
> A. The name of the company and the logo in the label of the products, in the box of the product and in the package insert of the product, and we also have official cover letters that contain name of the company and logos that we are using for communicating externally with other company, other agency.[39]

Ms. Muzrim corroborates Opposer's use of the name Sigma-Tau Pharmaceuticals, Inc. with the sigma logo. Ms. Muzrim identified an invoice for VSL#3 dated February 28, 2007 displaying both of the marks in Opposer's pleaded registrations.[40] Ms. Muzrim also identified an invoice for MATULANE dated June 15, 2007 displaying both of the marks in Opposer's pleaded registrations.[41] Further, Nichol Muzrim testified that all of Opposer's marketing materials feature the marks in Opposer's pleaded registrations.[42]

The record also establishes the following facts:

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[38] 63 TTABVUE 25.

[39] 63 TTABVUE 25.

[40] 70 TTABVUE 21 – 22 and 44.

[41] 70 TTABVUE 21 – 22 and 45.

[42] 64 TTABVUE 66.

1. Opposer began selling CARNITOR for the treatment of carnitine deficiency in 1985;[43]

2. Opposer began distributing MATULANE for the treatment of Hodgkin's lymphoma in 2000;[44]

3. Opposer has been selling VSL#3 since 2005.[45] VSL#3 is not a prescription drug.[46] VSL#3 is "medical food" used to treat irritable bowel syndrome and ulcerative colitis;[47] and

4. Opposer has been selling ProXeed, a dietary supplement to improve sperm quality, since 2000.[48]

Because we find that Opposer has used its marks SIGMA TAU PHARMACEUTICALS, INC. and the sigma logo on all of its products, Opposer has established common law rights in the two marks displayed in its pleaded registrations, as those marks are used for Opposer's VSL#3, a medical food for the treatment of irritable bowel syndrome and ulcerative colitis, for Opposer's MUTALANE used to treat Hodgkin's lymphoma, and for Opposer's ProXeed, a dietary supplement to improve sperm control.[49]

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[43] 63 TTABVUE 44 and 70 TTABVUE 33.

[44] 63 TTABVUE 50 and 52 and 70 TTABVUE 33.

[45] 70 TTABVUE 34.

[46] 64 TTABVUE 107 and 70 TTABVUE 57 and 62.

[47] 58 TTABVUE 51, 63 TTABVUE 41, 48, 64 TTABVUE 50, and 70 TTABVUE 70.

[48] 70 TTABVUE 34 and 70 and 76 TTABVUE 96.

[49] Opposer's common law use of CARNITOR to treat carnitine deficiency is cumulative because it is covered by its pleaded registrations which include pharmaceutical products to treat carnitine deficiency.

On the other hand, the testimony and evidence regarding the Opposer's first use of its marks for services is not as clear as the evidence and testimony for the pharmaceutical products. Nichol Muzrim testified that Opposer offers a patient assistance program "to help providers and their patients through resources such as reimbursement support, patient assistance program, or co-pay assistance."[50] However, Ms. Muzrim did not testify as to when Opposer began offering those services.

Dr. Fornasini testified about Opposer's research and development of pharmaceuticals. When asked what Opposer does to put a product on the market, Dr. Fornasini testified that Opposer "is involved in the research and development activity, which means that we design, study in animal and later in human being and patients to generate information to establish the safety and efficacy of the investigational product that could eventually one day be approved by Food and Drug Administration."[51]

When asked what kind of products and services Opposer provides, Dr. Fornasini testified that Opposer "provide [sic] drug products for the treatment of different diseases, and we also provide nonprescription product, like dietary supplement or medical foods for direct consumer distribution."[52] He did not provide

[50] 64 TTABVUE 35 – 36.

[51] 63 TTABVUE 57.

[52] 63 TTABVUE 28. *See also* 63 TTABVUE 30 – 33 and 40 – 41 where Dr. Fornasini identified specific drugs as examples of products or service used in connection with various diseases.

any specific testimony about services. The following questions and answers are representative of the testimony from Dr. Fornasini:

> Q. Earlier in your testimony you said that Sigma-Tau Pharmaceuticals, Inc. provides products and services in connection with supplements?
>
> A. Yes.
>
> Q. Okay. And what condition does Sigma Tau Pharmaceuticals, Inc. provide supplements for?
>
> A. So the dietary supplement [sic] are not used for treat any disease, so are helping to restore biological function or provide additional important biological component for the wellbeing of a subject. …[53]

Based on the testimony and evidence, Opposer conducts research and development services to create new drugs for its own portfolio of pharmaceuticals; that is, the research and development services are primarily for the benefit of Opposer. The evidence in the record bearing on whether Opposer conducts research and development services on a commercial basis for others is limited.[54] *See for example,* an undated press release from the Department of the Army, discussed in more detail below, reporting that Opposer "will help finalize the research and development of a new and promising treatment for severe malaria. … [Opposer] will complete the research studies and prepare submission to the U.S. Food and Drug Administration (FDA) for marketing clearance."[55]

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[53] 63 TTABVUE 34 – 35.

[54] Dr. Fornasini testified that Opposer often collaborates with others to expedite the development of a drug. 63 TTABVUE 57 – 59.

[55] 59 TTABVUE 10. *See also* 59 TTABVUE 26.

Research and development is a normally expected and routine activity in connection with manufacturing pharmaceuticals. It is not what the USPTO would consider a registrable service. *Cf. In re Dr. Pepper Co.*, 836 F.2d 508, 509, 5 USPQ2d 1207, 1208 (Fed. Cir. 1987) ("[I]t has become a settled principle that the rendering of a service which is normally 'expected or routine' in connection with the sale of one's own goods is not a registrable service whether denominated by the same or a different name from the trademark for its product."); *In re Landmark Commc'ns, Inc.*, 204 USPQ 692, 695 (TTAB 1979) (noting that "to be separately recognizable, as services, an applicant's activity must be qualitatively different from anything necessarily done in connection with the sale of goods").

The above-noted Army press release was the basis of a news story in the April 2007 issue of *"The Point,"* "a newsletter for and about the people of the U.S. Army Medical Research and Material Command."[56] Subsequently, Opposer issued an April 7, 2009 press release announcing that Opposer and Danisco BioActives were developing a biologic drug to prevent necrotizing enterocolitis.[57] Thus, even if we assume that Opposer's collaboration with the U.S. Army Medical Research and Material Command to develop and then market a drug to treat malaria and a partnership with another company to develop a drug to prevent necrotizing enterocolitis constitute research and development services that create trademark rights, April 2007 appears to be the earliest date on which Opposer conceivably

[56] 59 TTABVUE 12 – 13.

[57] 59 TTABVUE 25.

could rely for its claim of priority based on services, rather than pharmaceutical products.

Though extensive testimony was taken of Dr. Fornasini, that testimony did not specifically address when Opposer first started using Opposer's marks to identify these asserted research and development activities. Dr. Fornasini testified that when he joined Opposer in 1996, Opposer was using Sigma-Tau Pharmaceuticals, Inc. for the name of the company and that he believed that the name was used since 1987 in connection with Opposer's products and services.[58] He also testified that he believed Opposer was using the "sigma logo" at the same time it used the name Sigma-Tau Pharmaceuticals in connection with Opposer's products and services.[59] Dr. Fornasini testified that "I cannot with certainty remember whether this was 1987, 1988, but surely much earlier than the time I joined [Opposer]."[60]

The testimony of Dr. Fornasini regarding the first use of marks for Opposer's services does not have the specificity necessary to establish when Opposer first used its marks in connection with research and development services. There is no testimony to the effect that as of a specific date, Opposer began using the marks in its pleaded registrations to render research and development services in the field of pharmaceutical preparations.

[58] 63 TTABVUE 22.

[59] 63 TTABVUE 23-24.

[60] 63 TTABVUE 26-27.

Moreover, because there is no documentary evidence to corroborate Dr. Fornasini's testimony, such testimony "should carry with it conviction of its accuracy and applicability." *B.R. Baker Co. v. Lebow Bros.,* 66 USPQ at 236 ("When, in cases like the one at bar, the oral testimony of a single witness, testifying long after the events happened, is relied upon to prove priority, such testimony, while entitled to consideration, should be most carefully scrutinized."). Dr. Fornasini's testimony does not establish Opposer's first use of its marks in connection with research and development services because he does not know when Opposer first started using the SIGMA marks in connection with research and development services. Significantly, even though he started to work for Opposer in 1996, Dr. Fornasini did not testify that Opposer was rendering research and development services at least as early as then.

It was incumbent for Opposer to have a witness testify from personal knowledge as to the date of first use of Opposer's marks in connection with research and development services. If no such person is employed by Opposer, Opposer could have attempted to prove its date of first use by authenticating business records kept in the ordinary course of business which proves such use. *Nat'l Blank Book Co. v. Leather Crafted Products,* 218 USPQ 827, 828 (TTAB 1983).

Since April 2007 therefore is the earliest date on which Opposer may rely in connection with its research and development services, Opposer failed to prove prior common law use of its marks in connection with any services. Therefore, the issue of likelihood of confusion vis-à-vis Applicant's services requires Opposer to prove that

Applicant's use of its marks in connection with the research and development services is likely to cause confusion with the marks in Opposer's pleaded registrations used in connection with pharmaceutical products, for Opposer's evidence of prior use of its SIGMA marks for services is lacking.

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of Opposer's marks.

Opposer contends that the marks in its pleaded registrations are famous.[61] Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.,* 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton,* 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, "the length

[61] 81 TTABVUE 7 – 8.

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

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

In its brief, Opposer argues that its marks are famous for the following reasons:

1. "Opposer submits that its marks have been used in U.S. commerce consecutively for at least twenty-five years.";[62]

[62] 81 TTABVUE 37. As noted above, Opposer has been selling CARNITOR, a drug for treating carnitine deficiency, with labels that display the marks in Opposer's pleaded registrations since 1985. Further, Nichol Muzrim testified that all of Opposer's marketing materials feature the marks in Opposer's pleaded registrations. 64 TTABVUE 66.

2. "U.S. sales of Opposer's products have been substantial, generating for example, in 2012 alone, more than one hundred million dollars in revenues, and several hundred [sic] of millions in sales in previous years.";[63]

3. "The current annual budget for marketing and advertising of products bearing Opposer's Marks is four million dollars, without including the cost of marketing activities performed directly by Opposer's employees.";[64]

4. "Opposer's Marks have been heavily advertised in numerous types of media, including in print, point-of-sale displays, specialized newspaper, internet websites, brochures, etc.";[65]

5. "Every year, Opposer participates in at least 40 conferences, directed at medical professionals, distributors, patient associations, etc.";[66]

6. "Opposer is recognized by industry leaders as a prominent pharmaceutical company and a main provider of related research and development services.";[67]

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[63] 81 TTABVUE 37. This evidence was derived from Opposer's consolidated financial statements which, as noted above, is hearsay. Dr. Fornasini could not authenticate the consolidated financial statements, which were prepared by others, 63 TTABVUE 87 – 100, although he knew what they were and what they were supposed to represent. 63 TTABVUE 88. Likewise, Nichol Muzrim testified that she did not have any personal knowledge regarding the revenue figures set forth in the consolidated financial statements. 64 TTABVUE 83.

[64] 81 TTABVUE 37. Nichol Muzrim testified that in 2012, Opposer's marketing budget was over $4 million. 64 TTABVUE 65.

[65] 81 TTABVUE 37.

[66] 81 TTABVUE 37. Nichol Muzrim testified that she "conducted and coordinated between 30 and 40 conferences a year. These conferences took place all over the United States. They varied in size. Some could be as small as 50 attendees; some were as large as 15,000 attendees." 64 TTABVUE 66 – 67.

[67] 81 TTABVUE 38.

7. "Opposer has often been the recipient of industry awards for its commitment to the research and manufacturing of life-saving and life-enhancing medication.";[68] and

8. "Opposer has been prominently featured in mainstream media as well as specialized publications, in connection with certain large, news-worthy financial operations."[69]

The underlying premise of Opposer's claim to fame is that the marks in Opposer's pleaded registrations "are the company's main source identifiers and they appear on virtually all Opposer's products and product packaging sold in the United States, as well as in product inserts, on websites, press releases, marketing materials [sic]."[70] However, this premise is not supported by the evidence of record.

The marks in Opposer's pleaded registrations are house marks that appear on containers, packaging and advertising along with product marks such as CARNITOR, MUTALANE, VSL#3, etc.[71] Shown below is a package for Opposer's CARNITOR brand levocarnitine.[72]

[68] 81 TTABVUE 39.

[69] 81 TTABVUE 39.

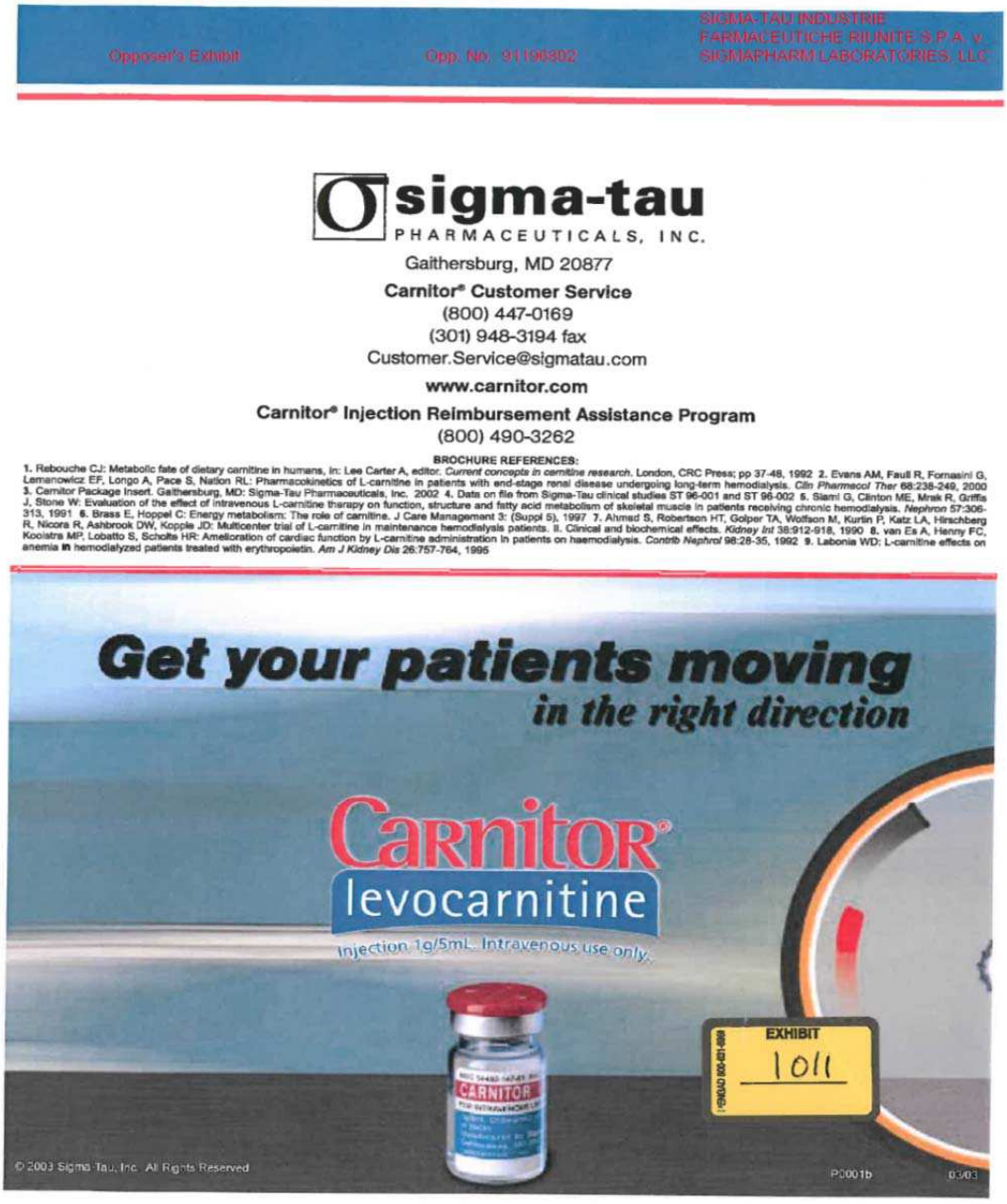
[70] 81 TTABVUE 37.

[71] 68 TTABVUE 23 – 29.

[72] 63 TTABVUE 263 and 265

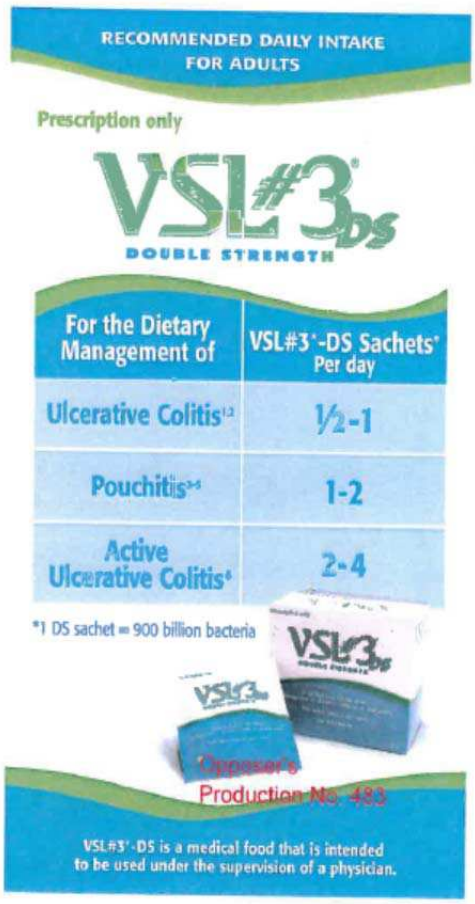
Below is "an advertisement for Carnitor" from a print campaign.[73]

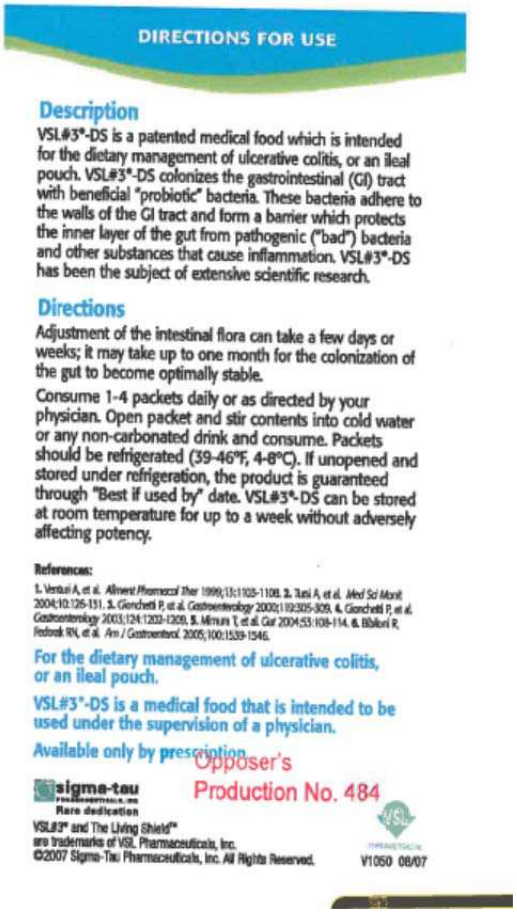
[73] 63 TTABVUE 69 and 253. The medical inserts also prominently feature the marks in Opposer's pleaded registrations. *See* 58 TTABVUE 22.



Shown below is a print advertisement for VSL#3, an over-the-counter, nonprescription medical food. "On this ad, you see the product, the description of the product, as well as the fact that it is [Opposer's] product."[74]

[74] 64 TTABVUE 32.





While the marks in Opposer's pleaded registrations may appear on the packaging and advertisements, the product name is the dominant element that appears on packaging and advertising. This is because consumers focus on the brand name or the generic name of the pharmaceutical products. In his discovery deposition, Spiro Spireas testified that "[e]verybody buys products by name of the product, either the brand name of the product or the generic name of the product."[75] "[W]hen a purchaser buys amiloride tablets, they buy it as the generic equivalent to

[75] 56 TTABVUE 13. The discovery deposition of Spiro Spireas was introduced into evidence by Opposer. *See also,* 72 TTABVUE 9 ("the patient or the pharmacist or the doctor are not driven by who makes it or sells it. … They don't care about that. They care about Antabuse or disulfiram, branded or generic.").

the brand product that I don't remember the name of, and they don't care where they buy it from, because whatever they buy from, or whatever product they buy is approved by the FDA."[76]

> The whole thing is driven by uniqueness of the product and price of the product as compared to other products, generic products, so that differentiating factors here are not who manufactures the product. The differentiating factors are the name of the brand name product.[77]
>
> * * *
>
> People are not taking your product because it's [Opposer's]. People are taking your product because it's whatever, and the doctors who have prescribed the product who have been educated by your sales force say that this product is good for you.[78]

Dr. Fornasini testified that Opposer markets its pharmaceuticals by the brand name.[79] "[T]he practice of almost all pharmaceutical companies" is to "show the product name in larger font as compared to other information that would appear on the bottle."[80] Doctors prescribe pharmaceuticals using the brand name.[81] Doctors do not use the manufacturer's name.[82] Nichol Muzrim concurred that pharmaceuticals are marketed and prescribed by their brand name.[83]

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[76] 56 TTABVUE 15 – 16.

[77] 56 TTABVUE 16.

[78] 56 TTABVUE 17.

[79] 63 TTABVUE 126. *See also* 70 TTABVUE 59 (Q: So is this product known as Carnitor or Sigma-Tau Pharmaceuticals, Inc.? A: It's Carnitor SF.").

[80] 63 TTABVUE 132 – 133.

[81] 63 TTABVUE 136 – 137 and 164.

[82] 63 TTABVUE 164.

[83] 64 TTABVUE 117 – 118 and 142.

We find that Opposer is a successful company in the field of pharmaceutical preparations specializing in pharmaceutical products for rare diseases. In addition, Opposer sells a medical food product to treat ulcerative colitis and irritable bowel syndrome and a dietary supplement to improve sperm quality. The evidence, however, does not support finding that the marks in Opposer's pleaded registrations are famous. The testimony and evidence establishes that marketing of pharmaceutical products and the revenues raised by their sale are based on promotion of the products by their product names or generic names, not house marks, such as those displayed in Opposer's pleaded registrations.

In proving that a product mark used in connection with a famous house mark was famous in its own right, the Federal Circuit made the following observation:

> If a product mark used in tandem with a famous house mark … has independent trademark significance, it should not be a great burden to substantiate the point. … [C]onsumer awareness of the product mark apart from the fame of the associated house mark, whether demonstrated directly or indirectly, is a reliable test of the independence of the product mark.

Bose Corp. v. QSC Audio Products Inc., 63 USPQ2d at 1308. Likewise, if house marks used in tandem with product marks have independent trademark significance, it should not be a great burden for Opposer to prove the marketplace strength of its house marks. In these consolidated proceedings, unlike *Bose,* there is no evidence that the house marks (*i.e.,* the marks displayed in Opposer's pleaded registrations) are recognized independently from their product marks.

The record fails to show that the marks in Opposer's pleaded registrations have been "heavily advertised" and there is no evidence regarding the renown or consumer awareness of the marks in Opposer's pleaded registrations.[84] For example,

1. Though Opposer points to it as evidence of fame, in the PhRMA 2008 Annual Report, the photograph of Opposer's COO is buried in the excerpt made of record as one of many members of the PhRMA Board of Directors;[85]

2. Opposer introduced an excerpt from *"The Point,"* "a newsletter for and about the people of the U.S. Army Medical Research and Material Command."[86] The excerpt was a news article derived from a press release[87] announcing that Opposer was going to collaborate with the U.S. Army Medical Research and Material Development Command to develop a new treatment for malaria. The author of the article did not note anything about the reputation of Opposer, let alone the renown of its marks. There is no evidence regarding the distribution of this newsletter and how many people may have seen the news article.; and

[84] Opposer introduced Internet evidence to show the "strength and historical use of Opposer's mark, and to show extensive third parties' references to Opposer's name and trademarks in multiple publications, and in close association with the name of major pharmaceuticals." 59 TTABVUE 4.

[85] 59 TTABVUE 6 – 9. Moreover, as an industry publication, this has not been shown to be the type of report that consumers of Opposer's products, or even physicians prescribing Opposer's products, would be expected to see.

[86] 59 TTABVUE 12 – 13.

[87] 59 TTABVUE 10 – 11.

3. An excerpt from the ASTMH website (astmh.org) touting the success of that organization's 57th annual meeting in December 2009.[88] ASTMH thanked Opposer as one on a list of 12 supporters.

This evidence shows that Opposer is an active member of the pharmaceutical industry, not that the marks in its pleaded registrations are well known. In this regard, Ms. Muzrim, Opposer's witness, testified that, after 12 years in the pharmaceutical industry,[89] the first time she heard of Opposer was in the middle of 2009 when Opposer was attempting to acquire ONCASPAR, DepoCyt, ADAGEN, and ABELCET from Enzon Pharmaceuticals.

We find that the evidence and testimony of record is insufficient to find that the marks in Opposer's pleaded registrations are famous or even well-known.

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

Applicant contends that "[n]ot only are there a substantial number of valid and co-existing trademark registrations for trademarks that include the word "SIGMA" in connection with pharmaceutical and other medical goods and related services, but, such trademarks are actually in use."[90] Opposer, on the other hand, points out that there is no evidence of any third-party use of the small Greek letter "sigma" or that any of the third-party marks have any consumer recognition.[91]

[88] 59 TTABVUE 15 – 16.

[89] 70 TTABVUE 36 – 37.

[90] 83 TTABVUE 22.

[91] 81 TTABVUE 45 – 46.

At the outset of the analysis of this *du Pont* likelihood of confusion factor, we note that Sigma Chemical Company, a third party, filed a request for an extension of time to oppose Opposer's application to register the mark SIGMA-TAU.[92] Sigma Chemical Company owns Registration No. 0671723 for the mark SIGMA for "biochemical and organic medicinal preparations."[93] Pursuant to agreement between Opposer and Sigma Chemical Company, Opposer sought to amend the drawing of its mark to SIGMA-TAU PHARMACEUTICALS, INC. from SIGMA-TAU.[94] The USPTO subsequently registered Opposer's mark SIGMA-TAU PHARMACEUTICALS, INC.

Although Opposer's actions during prosecution of its application to resolve a potential opposition are neither an "admission" nor a substitute for the Board reaching its own ultimate conclusion as to likelihood of confusion, we find it to be a fact "illuminative of shade and tone in the total picture confronting the decision maker." *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP,* 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Stabilisierungsfonds fur Wein v. Zimmermann-Graeff KG*, 209 USPQ 434, 436 (TTAB 1980) (finding opposer's contrary opinions in prosecution while opposition was pending "strongly illuminate the shade and tone of the total picture").

[92] 70 TTABVUE 116.

[93] 67 TTABVUE 52.

[94] 70 TTABVUE 116.

Applicant introduced the third-party registrations listed below:[95]

Mark	Reg. No.	Goods/Services
SIGMA PHARMACEUTICALS	3621388	Wholesale distributorship services in the fields of ophthalmic *pharmaceuticals* and products
SIGMA	2069249	Ophthalmoscopes
SIGMA	0671728	*Biochemical and organic medicinal preparations*
SIGMA-ALDRICH	3341087	Chemical compounds for use in the manufacture of *pharmaceutical preparations*; apparatus and instruments for scientific laboratory research in the chemical and biochemical fields; custom manufacture of chemicals for use in the manufacture of research pharmaceuticals; product development, namely, development of chemicals, compounds and ingredients for pharmaceuticals[96]
	4011310	Laboratory apparatus, namely, centrifuges and components therefor, namely, angle rotors, swing-out rotors with and without windshield, buckets, lids, adapter or tubes and bottles

[95] 67 TTABVUE 46 – 131. We normally would not consider 3590136 for the mark SIGMACARE and design for medical treatment mattresses and other medical furniture used for treating patients, Registration No. 3915422 for the mark SIGMACEPTOR for pharmaceutical research services, or Registration No. 3018061 for the mark COMPACT SIGMA for shock wave therapy apparatus because they were based on Section 44 of the Trademark Act and not use in commerce. However, because applicant has also submitted evidence of use of these marks, we have considered the marks in our analysis of third-party use.

[96] This third party also owns Registration No. 3443059 for the mark SIGMA-ALDRICH and design for the above-noted services.

Mark	Reg. No.	Goods/Services
SIGMAX	3846586	Orthopedic materials and articles, namely, support bandages and bands for ankles, calves, knees, thighs, backs, shoulders, elbows, fingers and wrists; braces for limbs and joints for orthopedic use; support bandages for protecting muscles; elastic tubular bandages; nonmedicated compresses; elastic bandages[97]
SIGMA	3184359	Orthopaedic joint implants; surgical instruments for use with orthopaedic joint implants
SIGMASPECTRUM	4087520	Computer software for database management of *drug catalogs* and data logging for an electronic medical device
	3255569	Electronic storage of clinical data for remote consultation by healthcare professionals in the care of patients; software used by healthcare professionals in the care of patients[98]
COMPACT SIGMA	3018061	Shock wave therapy apparatus, namely, lithotripters
	3590136	Therapeutic medical beds, mattresses, and mattress overlays; medical stretchers; medical examination tables for patients; medical patient treatment chairs, namely, commode chairs for medical patients
SIGMACEPTOR	3915422	Pharmaceutical and biopharmaceutical discovery, research and development services, namely, the discovery, research and product development of pharmaceuticals and biologic agents for the prevention and treatment of cancer and human neurological and neurodegenerative disorder

[97] This third party also owns Registration 3839315 for the mark SIGMAX and design for the same goods noted above.

[98] This third party also owns Registration No. 355568 for the mark SIGMA POINT and the upper case Greek letter SIGMA design, Registration No. 3345730 for the mark SIGMACARE, and Registration No. 3255567 for the mark SIGMA HEALTH and the upper case Greek letter Sigma, all registered for the same services noted above.

Applicant confirmed that the marks in the listed third-party registrations, including the marks registered under Section 44 of the Trademark Act 15 U.S.C. § 1126, are in use by introducing excerpts from the third-party websites listed below:

1. Sigma Pharmaceuticals (sigmapharmaceuticals.com) advertising the sale of "a full line of ophthalmic products."[99]

2. Sigma-Aldrich (sigma-aldrich.com) featuring *inter alia* chemicals in the field of life sciences.[100] The Sigma-Aldrich website also advertises "PharmaGrade" chemicals for biopharmaceutical manufacturing, including amino acids and buffers.[101]

3. The Heine website (heine.com) promoting HEINE SIGMA 150 ophthalmoscopes for measuring pupil size.[102]

4. The DePuy website (depuy.com) promoting SIGMA knee implant systems.[103]

5. The Sigma Zentifugen GmbH website (sigma-zentrifugen.de) promoting that company's laboratory centrifuges with applications for biotechnology, life-science, medical diagnostics and pharmacological technology.[104]

[99] 68 TTABVUE 78.

[100] 68 TTABVUE 80.

[101] 68 TTABVUE 82 – 86.

[102] 68 TTABVUE 88 – 89.

[103] 68 TTABVUE 91 – 93.

[104] 68 TTABVUE 95 – 101.

Although the website has a German URL, it provides contact information for the company's U.S. representative.[105]

6. The eHealth Solutions, Inc. website (sigmacare.com) advertising medical records software and data management under the mark SigmaCare and SigmaCare with an upper case Greek letter "sigma."[106]

7. The Sigma-Care Development Co., Ltd. website (sigmabed.com) advertising the sale of SIGMA-CARE hospital beds, emergency stretchers, overbed tables and a shower trolley.[107] While Sigma-Care Development Co. is a Taiwanese company, the website indicates that it has a webpage for the United States and that the company displayed its products at the FIME trade show in Miami, Florida, August 8 – 10, 2012.

8. The Nippon Sigma Co., Ltd. website (sigmax.co.jp) advertising SIGMAX splints, casting tape, support belts, knee, ankle and wrist supports, cervical collars, compression devices, and knee braces.[108] Although Nippon Sigma Co. is a Japanese company using a Japanese URL, the website identifies Sigmax America located in Newport Beach, California as the company's contact in the United States.

[105] 68 TTABVUE 101.

[106] 68 TTABVUE 103 – 106.

[107] 68 TTABVUE 108.

[108] 68 TTABVUE 110 – 116.

9. The Anavex Life Sciences Corporation website (anavex.com) promoting the SIGMACEPTOR discovery platform for drug development.[109]

> The compounds emanating from the SIGMACEPTOR Discovery Platform act through sigma receptors, a relatively new class of receptors that is able to activate multiple pathways and provide treatment solutions in many types of diseases. We are at an appropriate stage to evaluate the potential of compounds (ligands) that activate these receptors to effective dosing, safety and efficacy.[110]

10. The Baxter International, Inc. website (sigmapumps.com) advertising the SIGMA Spectrum Infusion System for the use and maintenance of a drug library for the application of medications.[111]

11. The Dornier MedTech website (dornier.com) advertising the COMPACT SIGMA modular lithotripter "with a multi-functional patient table and X-ray C-arm to create the complete solution for lithotripsy and endourological procedures."[112]

While the third-party registrations introduced by Applicant are not evidence that those marks have been used, or that consumers have been exposed to them, Applicant introduced evidence demonstrating that the marks are in use. The Internet websites are of limited probative value because they give no indication as to actual sales, when the mark was first used, and customer familiarity, *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001),

[109] 68 TTABVUE 118.

[110] *Id.*

[111] 68 TTABVUE 121

[112] 68 TTABVUE 123.

nonetheless, those websites "show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein." *Rocket Trademarks Pty Ltd., v. Phard S.p.A.,* 98 USPQ2d 1066, 1072 (TTAB 2011).

While the term SIGMA is inherently distinctive when used in connection with pharmaceutical products, the term SIGMA has been used and registered numerous times by third parties for pharmaceutical products and other products in the medical field serving to suggest that the term SIGMA is weak or not unique in the field. *See Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d at 1798 (TTAB 2001); *Bost Bakery, Inc. v. Roland Industries, Inc.,* 216 USPQ 799, 801 n.6 (TTAB 1982); *In re Sien Equipment Co.,* 189 USPQ 586, 588 (TTAB 1975) (the suggestive meaning of the word "Brute" in connection with material handling equipment explains the numerous third-party registrations incorporating that word with other wording or material no matter how little additional significance they may add to the word "Brute" *per se*); *In re J. R. Carlson Laboratories, Inc.* 183 USPQ 509, 510 (TTAB 1974).

C. The similarity or dissimilarity and nature of the goods and services.

As indicated above, Applicant is seeking to register its mark for the goods and services set forth below:

> Pharmaceutical preparations, namely, a drug delivery system comprising solid dosage delivery agents and a wide variety of therapeutic agents in molecular or amorphous state, in the form of tablets, capsules and powder dosage forms, prepared using company's patented technology platforms which will result into more

> bioavailable and stable dosage forms of therapeutic agents for the treatment of hypertension, hypercholesterolemia, depression, atherosclerosis, thyroid deficiency syndrome, organ rejection, hepatitis and, HIV and fungal infections, in International Class 5; and
>
> Research and development of pharmaceutical products and preparations for the treatment of hypertension, hypercholesterolemia, depression, atherosclerosis, thyroid deficiency syndrome, organ rejection, hepatitis and, HIV and fungal infections, in International Class 42.

1. Pharmaceutical preparations/products.

The description of goods in Opposer's pleaded registrations is "pharmaceutical products for use in the treatment of carnitine deficiency and cardiovascular disease," in International Class 5.

Where, as here, likelihood of confusion is asserted with registered marks, the issue is resolved on the basis of the goods named in the registrations and the goods and services named in the applications at issue. Facts relative to the marks' actual use that Applicant may argue prevent likelihood of confusion cannot be taken into consideration unless set forth in its application

> The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Syst. Inc. v. Houston Computers Svcs. Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

As the Court of Customs and Patent Appeals, the predecessor of our primary reviewing court, stated in *Tuxedo Monopoly*

> Here, appellant seeks to register the word MONOPOLY as its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration unless set forth in its application. *Toro Co. v. Hardigg Industries, Inc.*, 549 F.2d 785, 790, 193 USPQ 149, 155 (CCPA 1977.

Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

The goods of the parties, as defined by the description of goods in the applications and registrations, are "pharmaceutical preparations" and "pharmaceutical products" for the treatment of various conditions. "Pharmaceutical" is a noun defined as "a drug or medicine."[113]

A "drug" is defined as a "[t]herapeutic agent; any substance, other than food, used in the prevention, diagnosis, alleviation, treatment, or cure of disease."[114]

Opposer's description of goods are pharmaceutical products (*i.e.,* drugs or medicine) used to treat *inter alia* cardiovascular disease. "Cardiovascular disease" is defined as "any disease of the heart or blood vessels, including atherosclerosis,

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[113] *Merriam-Webster* online (Merriam-webster.com). 68 TTABVUE 12.

[114] **STEDMAN'S MEDICAL DICTIONARY**, p. 585 (28th ed. 2006). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

cardiomyopathy, coronary artery disease, peripheral vascular disease, and others."[115]

Applicant's description of goods are pharmaceutical preparations (*i.e.,* drugs or medicine) used to treat *inter alia* hypertension, hypercholesterolemia, and atherosclerosis.

"Hypertension" is defined as "high blood pressure; transitory or sustained elevation of systemic arterial blood pressure to a level likely to induce cardiovascular damage of other adverse consequences."[116] The entry in **STEDMAN'S MEDICAL DICTIONARY** also explains that "[b]ecause of its wide prevalence and its impact on cardiovascular health, [hypertension] is recognized as a major cause of disease and death in industrialized societies." Hypertension is listed as type of cardiovascular disease in the **MANUAL OF CARDIOVASCULAR MEDICINE**, p. 514 (3rd ed. undated) ("Unless promptly recognized and treated, hypertensive crisis can lead to cardiovascular, renal, and central nervous system [CNS] organ disease and death.").[117]

[115] **TABER'S CYCLOPEDIC MEDICAL DICTIONARY**, p. 395 (22nd ed. 2013). *See also* **STEDMAN'S MEDICAL DICTIONARY**, p. 314 (cardiovascular).

[116] **STEDMAN'S MEDICAL DICTIONARY**, p. 927. See also **TABER'S CYCLOPEDIC MEDICAL DICTIONARY**, p. 1171 ("Hypertension is one of the major risk factors for coronary artery disease, heart failure, stroke, peripheral vascular disease, kidney failure, and retinopathy. … controlling [hypertension] … helps to prevent cardiovascular illnesses.").

[117] 58 TTABVUE 29 – 30.

"Atherosclerosis" is "characterized by irregularly distributed lipid deposits in the intima of large and medium-sized arteries, causing narrowing of arterial lumens and proceeding eventually to fibrosis and calcification."[118]

"Hypercholesterolemia" is defined as "the presence of an abnormally large amount of cholesterol in the blood."[119] Hypercholesterolemia is discussed as a type of cardiovascular disease in the **TEXTBOOK OF CARDIOVASCULAR MEDICINE**, p. 514 (3rd ed. undated) ("[Hypercholesterolemia] is characterized by elevated L.D.L.-C levels … with normal triglycerides and a family of hypercholesterolemia or premature cardiovascular disease.").[120]

We find that the term "cardiovascular disease" set forth in the description of goods in Opposer's pleaded registrations encompasses hypertension, hypercholesterolemia, and atherosclerosis set forth in Applicant's Class 5 description of goods and, therefore, Applicant's description of goods in Class 5 which includes "pharmaceutical preparations … for the treatment of … hypertension, hypercholesterolemia, … atherosclerosis …" is in part legally identical to Opposer's description of goods comprising "pharmaceutical products for use in the treatment of … cardiovascular disease."

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[118] **STEDMAN'S MEDICAL DICTIONARY**, p. 174. See also **TABER'S CYCLOPEDIC MEDICAL DICTIONARY**, p. 224 ("The most common form of arteriosclerosis, marked by cholesterol-lipid-calcium deposits in the walls of arteries that may restrict blood flow. … If a plaque within a blood vessel suddenly ruptures, the blood vessel may close and organs or tissues may infarct."

[119] **STEDMAN'S MEDICAL DICTIONARY**, p. 918. See also **TABER'S CYCLOPEDIC MEDICAL DICTIONARY**, p. 1162.

[120] 58 TTABVUE 32 – 334.

2. Research and development services.

As indicated above, Opposer failed to prove that its common law use of the marks in its pleaded registrations were used in connection with research and development services prior to Applicant's first use (at least as early as June 30, 2006), since April 2007 is the earliest date on which Opposer might conceivably rely. Therefore, we analyze whether Applicant's "research and development of pharmaceutical products and preparations for the treatment of hypertension, hypercholesterolemia, … [and] atherosclerosis" is related to Opposer's "pharmaceutical products for use in the treatment of … cardiovascular disease."

Both parties conduct research and development for pharmaceutical products and preparations, as well as, manufacturing such products.

Opposer introduced an excerpt from the PhRMA 2008 Annual Report.[121] PhRMA is an acronym for the Pharmaceutical Research and Manufacturers of America. Thus, PhRMA is an organization of pharmaceutical researchers and manufacturers.

Also, Opposer introduced an excerpt from its website announcing its acquisition of ONCASPAR, ADAGEN, DepoCyt, and ABELCET from Enzon Pharmaceutical.[122] The announcement described Enzon Pharmaceutical as "a pharmaceutical company that has successfully conducted its own research, studying new molecules for the treatment of rare diseases in the oncological field. The drugs

[121] 59 TTABVUE 6 – 9.

[122] 77 TTABVUE 41.

acquired by [Opposer] are, in fact, indicated for the treatment of patients who fail to respond to treatment with traditional drugs." But this is a reference to research by the acquired company to develop its own products. This evidence does not prove that research services, as a separate marketable service for others, come from the same source as pharmaceutical products.

In the record is Registration No. 3443059 for the mark SIGMA-ALDRICH and design, owned by Sigma-Aldrich Biotechnology L.P., a third party, for manufacturing chemicals for research pharmaceuticals and for the development of chemicals for use in pharmaceuticals. The specific services are set forth below:

> Custom manufacture of chemicals for use in the manufacture of research pharmaceuticals and for use in pharmaceutical research, in Class 40; and
>
> Chemical and scientific research for others; product development of chemicals, compounds and ingredients for use in manufacture, pharmaceuticals, research and scientific purposes, in Class 42.[123]

This evidence shows two different types of services are related; not that pharmaceutical products are related to research and development services.

In view of the foregoing, we find the evidence of record is insufficient to prove that Applicant's "research and development of pharmaceutical products and preparations for the treatment of hypertension, hypercholesterolemia, … [and] atherosclerosis" is related to Opposer's "pharmaceutical products for use in the treatment of … cardiovascular disease."[124]

[123] 67 TTABVUE 64.

[124] This finding of fact is based on all the facts and circumstances made of record.

D. Established, likely-to-continue channels of trade and classes of consumers.

1. Pharmaceutical products and preparations.

Because Applicant's pharmaceutical preparations described in the applications are in part legally identical to Opposer's pharmaceutical products described in Opposer's pleaded registrations, we must presume that the channels of trade and classes of purchasers are the same. *See In re Viterra Inc.,* 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute,* 101 USPQ2d 1022, 1028 (TTAB 2011).

2. Research and development services.

There is no testimony, evidence or argument specifically directed to how either party markets its research and development services. Because Opposer has the burden of proof and Opposer failed to introduce any evidence regarding the channels of trade or classes of consumers relating to pharmaceutical research and development services, Opposer failed to meet its burden and the record is insufficient to find that the Applicant's research and development services move in the same channels of trade and are directed to the same classes of consumers as Opposer's pharmaceutical products.

E. Degree of care.

Section 20 cmt. h of the **RESTATEMENT [THIRD] OF UNFAIR COMPETITION** (1995) provides the following explanation about the standard of consumer care:

> The care expected of purchasers against which the likelihood of confusion is measured is determined by the marketing environment in which the goods or services are ordinarily bought or sold. Some factors to be considered are the manner in which the goods are purchased … the manner in which the goods are marketed … and the class of prospective purchasers.

Opposer has argued that even though consumers of pharmaceuticals (*i.e.,* "hospitals, urgent care centers, other providers of medical services, and the patients") may exercise a high degree of care, that high degree of care does not preclude them from mistaking one trademark for another.[125] In addition, Opposer has argued that because of the concern for the safety of consumers of pharmaceutical products, the Board must guard against the possibility of a general consumer mistakenly choosing the wrong product because of the mark used thereon.[126] In other words, we must assume a lesser degree of care so as to provide better protection for a general consumer of a pharmaceutical product. However, as discussed earlier in our analysis of whether the marks in Opposer's pleaded registrations are famous, the marketing of pharmaceuticals is based on the product mark or generic name of the drug, not the house mark of the manufacturer. There is no evidence or testimony that any of the ultimate consumers of pharmaceutical

[125] 81 TTABVUE 42.

[126] 81 TTABVUE 43.

products consider the manufacturer of the drug in their purchasing decision or when filling a prescription. Thus, the house marks at issue in these consolidated proceedings have little if any effect on the degree of care exercised when purchasing decisions are being made or prescriptions are being filled for the pharmaceutical products in Class 5. The house marks at issue in this case may or may not be more likely to be familiar to, and perhaps used by, professionals in the pharmaceutical or medical fields. These consumers will be expected to exercise a greater degree of care; and they need not be protected from possible harm in the same way that ultimate consumers might need to be, when product marks are involved.

Further, even though there is no evidence or testimony regarding the marketing of the research and development services, the house marks must play a greater role in the marketing of research and development services than in the sale of pharmaceuticals because the product names or generic drug names would not be part of the marketing efforts in connection with the research and development services.

Dr. Fornasini testified that Opposer develops products independently or partners with other pharmaceutical companies or institutions such as the National Institute of Health or universities.[127] Presumably, pharmaceutical companies and

[127] 63 TTABVUE 57. *See also* 59 TTABVUE 10 (Department of Army press release announcing that the U.S. Army Medical Material Development Activity Command was partnering with Opposer to develop a drug to treat malaria – undated), 59 TTABVUE 25 (An April 7, 2009 press release announcing that Opposer and Danisco BioActives are developing a biologic drug to prevent necrotizing enterocolitis), 59 TTABVUE 26 (an announcement posted on the BioSpace website (biospace.com) that Dyax Corp. and Opposer have partnered to develop and commercialize a drug for the treatment of hereditary angioedema).

research institutions and universities exercise a high degree of care when selecting research partners. Accordingly, we find that in connection with research and development services, the relevant consumers exercise a high degree of care.

F. The nature and extent of any reported instances of actual confusion.

As noted in the priority discussion, Applicant began using its marks in connection with research and development services for other pharmaceutical companies in 2006 and Applicant's constructive date of first use for its marks in connection with pharmaceutical preparations is the filing date of its applications, April 13, 2009. Opposer began selling its CARNITOR pharmaceutical for the treatment of carnitine deficiency in 1985. There have been no reported instances of confusion.

Applicant asserts that "Opposer's Marks and Applicant's Marks have been co-existing for approximately eight years (related to services offered) and for at least five years (related to goods offered) being in the marketplace" without any instances of confusion and this weighs against finding that there is a likelihood of confusion.[128] In response, Opposer contends that Applicant's evidence of its first use and continuous use of its marks is "for lack of better words, unclear and ambiguous."[129]

[128] 83 TTABVUE 51.

[129] 86 TTABVUE 23; 87 TTABVUE 23 (confidential submission although none of the redacted information is confidential). We disagree with Opposer's contention regarding the credibility of Applicant's witness Spiro Spireas regarding Applicant's first use of its mark. We find that his testimony is consistent with his interrogatory answers (56 TTABVUE 10). Moreover, Opposer extensively cross-examined Dr. Spireas.

The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its marks for a significant period of time in the same markets as those served by Opposer under its marks. *Citigroup Inc. v. Capital City Bank Group, Inc.,* 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd,* 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.,* 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.,* 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders,* 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring").

The parties are not direct competitors.[130] Opposer's goods and services focus on orphan drugs for diseases that afflict no more than 200,000 people.[131] However, Opposer also sells the over-the-counter products VSL#3, a medical food, and

[130] 63 TTABVUE 119.

[131] 63 TTABVUE 119.

ProXeed, a dietary supplement.[132] Opposer sells "to health care providers, which may include physicians, nurses, nurse practitioners, pharmacist, directors of pharmacy, hospital administrators, wholesalers, patients."[133] Opposer's wholesalers include McKesson Pharmacy Systems, Cardinal Healthy, Accredo and Amerisourcebergen.[134] VSL#3 is sold through physicians and retail chains.[135] Those retail chains include, *inter alia*, CVS, Walgreens, and Walmart.[136]

Applicant's goods and services focus on generic pharmaceutical products.[137] A generic pharmaceutical is a biochemical equivalent to a branded product.[138] Applicant sells its products through distributors, wholesalers, drug chains, and group purchasing organizations, but not directly to patients.[139] Group purchasing organizations include independent pharmacies and hospitals who buy together to reduce costs.[140] Applicant's wholesalers include Cardinal Health, McKesson and Amerisourcebergen.[141] Applicant also sells to drug chains such as CVS, Rite Aide, Walgreens, and Walmart.[142]

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[132] 70 TTABVUE 70 and 89; 63 TTABVUE 62.

[133] 64 TTABVUE 60 – 61 and 63; 69 TTABVUE 9.

[134] 64 TTABVUE 61 – 62; 63 TTABVUE 134 – 135.

[135] 64 TTABVUE 62.

[136] 58 TTABVUE 51.

[137] 75 TTABVUE 16.

[138] 75 TTABVUE 17.

[139] 75 TTABVUE 72, and 87 – 88.

[140] 75 TTABVUE 87 – 88.

[141] 75 TTABVUE 87.

[142] 75 TTABVUE 73 and 87.

Based on this evidence, we find that there has been reasonable opportunity for confusion to have occurred because the parties sell through the same wholesalers and through some of the same retailers and that, therefore, the lack of any reported instances of confusion weighs against finding that there is a likelihood of confusion.

G. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, meaning, and commercial impression.

With the evidence discussed above in regard to the various *du Pont* factors in mind, particularly the role of the marks in the sales process, the number of and nature of similar marks in use on similar goods and services, and the lack of any reported instances of confusion, we turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.,* 177 USPQ at 567. In a particular case, "finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar.'" *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) (citations omitted). *See also In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that "[t]he proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). *See also 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 mem.,* 972 F.2d 1353 (Fed. Cir. June 5, 1992).

1. Opposer's mark SIGMA-TAU PHARMACEUTICALS, INC.

One of the marks in Opposer's pleaded registrations is SIGMA-TAU PHARMACEUTICALS, INC., in typed drawing format. Opposer disclaimed the exclusive right to use "Pharmaceuticals, Inc."

Applicant's marks include **SigmaPharm** (standard character form), **SigmaPharm Laboratories** (standard character form), and **SigmaPharm Laboratories** and design shown below.[143]

Applicant disclaimed the exclusive right to use the word "Laboratories" where it appears in the marks.

With respect to Applicant's mark **SigmaPharm Laboratories** and design, while we must consider the mark in its entirety, we recognize that it is **SigmaPharm Laboratories** that is likely to be impressed upon the purchaser's memory because it is the words that they will remember and use. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 and 1911 (Fed. Cir. 2012) (*citing CBS*

[143] Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (April 2014).

Inc. v. Morrow, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013).

While the marks cannot be dissected and considered piecemeal, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Stone Lion Capital Partners,* 110 USPQ2d at 1161.

Because Opposer disclaimed the exclusive right to use the descriptive term "Pharmaceuticals, Inc." and Applicant disclaimed the exclusive right to use the descriptive term "Laboratories," the term SIGMA-TAU is the dominant element of Opposer's mark and the term **SigmaPharm** is the dominant element of Applicant's marks. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf,* 55 USPQ2d at 1846, *quoting, In re National Data Corp.,* 224 USPQ at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.,* 60 USPQ2d 1699, 1702 (TTAB 2001)

(disclaimed matter is often "less significant in creating the mark's commercial impression").

Our analysis, therefore, ultimately focuses on the similarity or dissimilarity of SIGMA-TAU as part of Opposer's mark SIGMA-TAU PHARMACEUTICALS, INC. and **SigmaPharm** as part of Applicant's marks **SigmaPharm**, **SigmaPharm Laboratories** and **SigmaPharm Laboratories** and design**.** The marks obviously are somewhat similar in terms of sight, sound, connotation and commercial impression because both parties' marks include the word SIGMA. Just as obviously, the marks are dissimilar in terms of sight, sound, connotation and commercial impression because Opposer uses "Tau" as a suffix attached to the word "Sigma", while Applicant uses the abbreviation "Pharm" as a suffix.

Where, as here, there are multiple users of the term "Sigma" in the pharmaceutical and medical field, it is very important that the marks be considered in their entireties. Opposer's use of TAU as a suffix attached to the word "Sigma" is significant because it serves to indicate a different origin from Applicant's **SigmaPharm** marks which use "Pharm" as a suffix.

In none of the marks of the parties, is the common term "Sigma" set out separately or emphasized as the most prominent element of the marks.[144] A comparison of the marks does not give that impression that the term "Sigma" is being emphasized over any other part of the marks. Thus, to the extent that a

[144] We disagree with Opposer's argument that word "Sigma" is the most prominent element of the marks because it is the first part of the marks. 81 TTABVUE 29. "The issue of whether a portion of a mark is dominant turns on the facts of each case," *Tektronix, Inc. v. Daktronics, Inc.,* 534 F.2d 915, 189 USPQ 693, 695 (CCPA 915), not as a matter of law.

doctor, patient, distributor, or retailer of pharmaceuticals looks to the source of a pharmaceutical or to a house mark of the parties in making purchasing decisions, the purchasers focus on the entire mark and, in such cases, the difference between SIGMA-TAU and **SigmaPharm** is significant. The lack of any reported instances of confusion after a reasonable opportunity of confusion to have occurred supports this finding of fact.

In considering the marks (SIGMA-TAU PHARMACEUTICALS, INC. versus **SigmaPharm**, **SigmaPharm Laboratories**, and **SigmaPharm Laboratories** and design) in their entireties, we find that the dissimilarities in appearance, sound, connotation and commercial impression outweigh the similarities.

2. Opposer's design mark

This leaves the comparison of Opposer's design mark , which is described in the registration as the Greek letter "sigma," with Applicant's marks **SigmaPharm**, **SigmaPharm Laboratories**, and Applicant's composite mark shown below which is described as "the Greek character 'phi' inside the Greek character 'sigma'":

A word and the symbol therefor are legal equivalents and must be regarded as having the identical significance in determining the question of likelihood of confusion. *Shunk Manufacturing Company v. Tarrant Manufacturing Company*,

318 F.2d 323, 137 USPQ 881, 883 (CCPA, 1963); *Squirrel Brand Co. v. Green Gables Investment Co.,* 223 USPQ 154, 155 (TTAB 1984); *In re Endevco Corp.*, 144 USPQ 362, 365 (TTAB 1964).

As noted above, Opposer registered its lower case Greek letter "sigma" mark with knowledge that Sigma Chemical Company owned a registration and uses the mark SIGMA for "biochemical and organic medicinal preparations," thus, indicating that at least as of the time of registration, Opposer believed that its lower case Greek letter "sigma" mark for "pharmaceutical products for use in the treatment of carnitine deficiency and cardiovascular disease" was not likely to cause confusion with the mark SIGMA for "biochemical and organic medicinal preparations." *Cf. Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 779 (TTAB 1979) ("A number of different trademark owners have believed, over a long interval of time, that various PLUS marks can be used and registered side by side without causing confusion provided there are minimal differences between the marks."); *Jerrold Electronics Corp. v. The Magnavox Company,* 199 USPQ 751, 758 (TTAB 1978) (third-party registrations "reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various 'STAR' marks can coexist provided that there is a difference."). In this regard, the Federal Circuit has often admonished that those in the industry know better than Examining Attorneys and judges the conditions in the market. *See Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988), *quoting du Pont,* 177 USPQ at 568:

> Decisions of men who stand to lose if wrong are normally more reliable than those of examiners and judges.

and

> It can safely be taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in *causing* public confusion.

See also Bongrain International (American) Corp. v. Delice de France Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) ("[I]n trademark cases involving agreements reflecting parties' views on the likelihood of confusion in the marketplace, that [parties] are in a much better position to know the real life situation than bureaucrats or judges and therefore such [consent] agreements may, depending on the circumstances, carry great weight.").

Having already found that Applicant's word marks **SigmaPharm** and **Sigma Pharm Laboratories** are not so similar to Opposer's word mark SIGMA-TAU PHARMACEUTICALS, INC. as to support a conclusion that confusion is likely, and having found that Opposer's word mark SIGMA-TAU PHARMACEUTICALS, INC. is closer to Applicant's word marks than Opposer's design mark, we likewise find that Applicant's marks **SigmaPharm** and **SigmaPharm Laboratories** are not similar enough to Opposer's design mark to support a conclusion that confusion is likely.

This leaves Applicant's composite mark. While we noted above that in the case of a composite mark containing both words and a design, the word portion is normally accorded greater weight because purchasers will use the literal portion to request the goods or services, this does not mean that the design portion of the

mark may be ignored. We assess the similarity of any two marks on a case-by-case basis. *In re Viterra,* 101 USPQ2d at 1910. In this case, that assessment necessarily takes into account that we are comparing design elements, as well as the term **SigmaPharm Laboratories**. Here, the design portion of Applicant's mark creates a commercial impression that is distinct from the literal portion of the mark.

The purchasers and prospective purchasers who know the Greek alphabet will recognize Opposer's mark as the Greek letter "sigma" and Applicant's mark as the Greek letters "sigma phi" used in connection with **SigmaPharm Laboratories**. Since the Greek letters are the legal equivalents of the terms they represent, to consumers who recognize the Greek alphabet, the term "sigma" is not particularly unique or distinctive in connection with pharmaceuticals and other medical equipment, because of the demonstrated prevalence of SIGMA marks. In view thereof, these consumers would not perceive the marks to be similar.

On the other hand, to purchasers and prospective purchasers who are not familiar with the Greek alphabet, the designs are simply logos acting as indicia of origin for the respective goods or services. In this situation, we focus on the recollection of the average purchaser of the good involved, who normally retains a general rather than a specific impression of trademarks. *See L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). "In this regard, consideration must be given to the fact that a person's recollection of design marks is often imprecise and of a vague or hazy nature." *Freedom Federal Savings and Loan Association v. Heritage Federal Savings and Loan Association*, 210 USPQ 227, 231 (TTAB 1981). Under

these circumstances, the analysis is determined on the basis of the visual similarity of the marks.

Under this second scenario, Opposer's mark is an oval with a horizontal line extruding from the top (if the line is recognized) within a box. The design element of Applicant's mark is a concentric oval with a horizontal line extruding from the top (if the line is recognized) with a vertical line through the center. In comparing the marks, we find that the differences in the marks outweigh the similarities.

H. "Any other established fact probative of the effect of use."

As noted throughout this decision, each case must be decided on its own specific facts. "This final factor accommodates the need for flexibility in assessing each unique set of facts." *In re Strategic Partners Inc.,* 102 USPQ2d 1397, 1399 (TTAB 2012). Opposer contends that in these proceedings "a lesser *quantum* of confusing similarity is required because the products are drugs and medicinal preparations."[145] Applicant argues to the contrary that the facts in this case do not require a "greater care standard" because the marks at issue are house marks, not trademarks for pharmaceutical products.[146] The end users of pharmaceutical products may need to be familiar with brand names and generic names for particular drugs they may be prescribed but would not rely on house marks to differentiate prescription products or guard against drug interactions. If such product marks or generic drug names were here involved, the standard of care

[145] 81 TTABVUE 12 and 42 – 45.

[146] 83 TTABVUE 28 – 29.

argued by Opposer to be applicable might be significant; but because we deal with house marks, that are more likely to be significant to prescribing physicians and health care providers, we find the test argued by Opposer to be inapplicable. The test concerns itself with errors that may be made by ultimate consumers of medicines and prescribers and health care providers would exercise a higher degree of care.

Labels for pharmaceuticals must have *inter alia* the product name, the NDC number recognized by the FDA, generic chemical name, and the name of the manufacturer.[147] Applicant's witness Spiro Spireas provided the following testimony about pharmaceutical labels:

> Q. Is it the practice and requirement to have the product name larger than any of the other information on the pharmaceutical label?
>
> A. That's not only the practice, that's also the law - - both, the law and the practice - - that the biggest name, and in the most obvious position, has to be the name of the product contained in the container that the label is affixed to.[148]
>
> * * *
>
> A. … But I must say this: It is the law, that the name of the chemical - - the actual chemical name of the product - - has to be written underneath the branded product.
>
> So I have knowledge - - and a pharmacist like myself will have knowledge - - of what is the chemical in this product immediately under the branded name product - - the branded name.

[147] 75 TTABVUE 38.

[148] 75 TTABVUE 47.

> So the chemical is levocarnitine; and the branded name is Carnitor®. So that's established nomenclature.[149]
>
> * * *
>
> A. Because the laws says that you have to put the generic chemical name of the drug contained in the tablets on the label in big letters - - big-size letters, so people can see and they are not confused.
>
> Anything else would be misbranding.
>
> Q. Why doesn't the name and logo for [Applicant] appear on the front of the bottle?
>
> A. Because the way the label is affixed, we are at the bottom, because we are the manufacturers.
>
> And so, when the label turns around, it goes in the back of the bottle.[150]
>
> * * *
>
> Q. Are pharmaceutical companies, such as [Applicant], required by law to indicate on the bottle what the manufacturer is of the drugs?
>
> A. Yes.
>
> * * *
>
> So if there is any problem with this product in the future, they can reference directly and come to us.[151]

The testimony of Opposer's witnesses corroborates the testimony of Spiro Spireas regarding labeling. Dr. Fornasini testified that pharmaceutical products are

[149] 75 TTABVUE 51 – 52. See the CARNITOR package in the fame analysis *supra.*

[150] 75 TTABVUE 63.

[151] 75 TTABVUE 63 – 64.

marketed and sold under their brand names, not their manufacturer's name,[152] and that the brand names such as ADAGEN or MATULANE prominently appear on packaging.[153]

Nichol Muzrim testified that each of Opposer's products include the product name and the house mark.

> Q. How did [Opposer] identify those products with the company Sigma-Tau Pharmaceuticals?
>
> A. Each commercial product had, whether it was in print campaigns, digital campaigns, or the actual product packaging, had the product name, its generic name, as well as the Sigma-Tau Pharmaceuticals logo and name.[154]

With respect to the standard of care or quantum of evidence required in pharmaceutical cases, the purpose is to avoid mistaking one drug for another because of the name.

> And where, as here, the marks are used in connection with pharmaceutical preparations and, in particular, prescription items, the degree to which a subsequently used mark may approach a previously used mark is narrowly drawn to assure that a situation cannot arise that could, because of the identity of the marks, lead individuals to take one product in lieu of the desired or prescribed product, with harmful or dangerous results.

Merck & Co. v. Abbot Laboratories, 210 USPQ 605 (TTAB 1981).

[152] 63 TTABVUE 125 – 126, 164.

[153] 63 TTABVUE 132.

[154] 64 TTABVUE 16.

The cases in which the Board and our reviewing courts have applied a higher standard of care involve product marks and not manufacturer's house marks. For example,

1. *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972).

American Home Products Corporation filed an application to register MYOCHOLINE for a medicinal preparation for treatment of dysphagia, abdominal distention, gastric retention, and urinary retention which was opposed by Glenwood Laboratories, Inc. based on its mark MYSOLINE for an anti-convulsant drug.

2. *Clifton v. Plough, Inc.*, 341 F.2d 934, 144 USPQ 599 (CCPA 1965).

C.L. Clifton, Sr. filed an application to register NUMOL for a pharmaceutical product for the relief of coughs, colds and bronchial irritation which was opposed by Plough, Inc. based on its mark NUJOL for mineral oil for chemical, medicinal and pharmaceutical uses.

3. *Alfacell Corp. v. Anticancer Inc.,* 71 USPQ2d 1301 (TTAB 2004).

Anticancer, Inc. registered the mark ONCASE for therapeutic compositions containing reagents for in vivo anticancer use which Alfacell Corporation petitioned to cancel based on its mark ONCONASE for pharmaceuticals, namely, cancer-treating drugs.

4. *Merck & Co. v. Abbot Laboratories*, 210 USPQ 605.

Abbot Laboratories filed an application for A-HYRODCORT for an anti-inflammatory product which was opposed by Merck & Co. based on its mark

HYDROCORTONE for a hormonal substance used in the treatment of collagen, allergic and other diseases.

5. *Schering Corp. v. Alza Corp.,* 207 USPQ 504 (TTAB 1980).

Alza Corporation filed an application for CHRONOMER for medical grade polymeric membrane being a biodegradable disposing medium and sold as an inactive drug which was opposed by Schering Corporation based on its marks CHRONOTAB and CHRONOSULE for timed release pharmaceutical preparations.

Accordingly, based on the facts and circumstances presented on this record, any confusion that might arise from the use of the marks at issue in these cases will not result in patients taking the wrong drugs. That being said, the Board takes great care to review all of the evidence made of record and to consider all of the arguments made by the parties to reach the correct decision.

I. Balancing the factors.

Despite finding the goods are in part identical and the presumption that they move in the same channels of trade and are sold to the same classes of consumers, because we find that the marks are not similar, there are multiple users of the term "Sigma" in the relevant industry, and there have been no reported instances of confusion even after a reasonable opportunity for confusion to have occurred, we find that Applicant's marks for the goods and services set forth therein are not likely to cause confusion with the marks in Opposer's pleaded registrations.

VI. False Suggestion of a Connection

To prevail on its Section 2(a) claim for false suggestion of a connection, Opposer must prove: (1) Applicant's marks are the same as or a close approximation of Opposer's previously used name or identity; (2) Applicant's mark would be recognized as such by purchasers, in that the marks points uniquely and unmistakably to Applicant; (3) Opposer is not connected with the goods and services that are sold or will be sold by Applicant under its mark; and (4) that Opposer's name or identity is of sufficient fame or reputation that when Applicant's marks are used in connection with Applicants' goods and services, a connection with Opposer would be presumed. *See Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). *See also Bd. of Trs. of Univ. of Ala. v. Pitts,* 107 USPQ2d 2001, 2025 (TTAB 2013); *Boston Red Sox*, 88 USPQ2d 1581, 1593 (TTAB 2008); *Hornby v. TJX Companies Inc.,* 87 USPQ2d 1411, 1424 (TTAB 2008); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956 (TTAB 2007).

Opposer's name is Sigma-Tau Industrie Farmaceutiche Riunite S.p.A. It does business in the United States through its subsidiary Sigma-Tau Pharmaceuticals, Inc. which uses the marks in Opposer's pleaded registrations.[155] Thus, Opposer's identity in the United States is Sigma-Tau Pharmaceuticals, Inc.

The similarity required for a "close approximation" is akin to that required for a likelihood of confusion under Section 2(d) and is more than merely "intended to refer" or "intended to evoke." The accused marks must do more than simply "bring

[155] 63 TTABVUE 18 and 25.

to mind" Opposer's identity. *Bd. of Trs. of Univ. of Ala. v. Pitts,* 107 USPQ2d at 2027. For the same reasons we found that Applicant's marks are not similar to Opposer's marks for purposes of the likelihood of confusion analysis, we find here that Applicant's marks are not a close approximation of Opposer's identity and, therefore, it cannot be "unmistakably associated" with Opposer's identity, nor do they point uniquely to Opposer.

There is no real dispute in these cases as to the fact that Applicant is not connected with the activities performed by Opposer under the marks.

For the reasons we found that Opposer's marks are not famous and, in fact, are not well-known in the pharmaceutical industry, we find that Opposer's marks are not of sufficient fame or reputation that when Applicant's marks are used in connection with Applicant's goods and services a connection with Opposer will be presumed.

After considering all of the evidence of record in connection with the Section 2(a) false suggestion of a connection factors, we find that Applicant's marks do not falsely suggest a connection with Opposer.

Decision: The oppositions are dismissed on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act and on the ground that Applicant's marks falsely suggest a connection with Opposer under Section 2(a) of the Trademark Act.