

This Opinion Is Not a
Precedent of the TTAB

Mailed: April 20, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Gilead Sciences, Inc.

v.

Gilead Capital LP
—

Opposition No. 91233311

Opposition No. 91233327
—

Lisa Greenwald-Swire and Michael A. Amon of Fish & Richardson P.C.
for Gilead Sciences, Inc.

Kanchana Wangkeo Leung for Gilead Capital LP.
—

Before Zervas, Bergsman and English, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Gilead Capital LP (Applicant) filed applications to register the marks GILEAD CAPITAL, in standard character form, and GILEAD CAPITAL LEADERSHIP INVESTING and design, reproduced below, both for the services set forth below:

Hedge fund investment services; Investment advisory services; Investment management; Financial services, namely, operation and management of hedge funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures,

derivatives, debt instruments and commodities, in International Class 36.¹



The description of the mark in the application reads as follows:

The mark consists of the words “Gilead Capital” in small caps font in the color green located above a black horizontal arrow and the words “Leadership Investing” in the color black. The arrow starts on the left side of the page, slightly before the beginning of the word “Gilead,” points to the right and extends slightly beyond the end of the word “Capital.” The words “Leadership Investing” appear below the arrow, in italicized font, and in smaller font size than the words “Gilead Capital.” The alignment of the phrase “Leadership Investing” is right justified with the word “Leadership” beginning below the letter “a” in “Gilead” and the word “Investing” ending below the “l” in “Capital.”

The color(s) green, and black is/are claimed as a feature of the mark.

Applicant disclaims the exclusive right to use the words “Capital” and “Investing.”

In the application for the mark GILEAD CAPITAL, Applicant disclaims the exclusive right to use the word “Capital.”

The operative pleading in these proceedings is Opposer’s Second Amended and Consolidated Notice of Opposition.² As grounds for opposition, Opposer alleges

¹ Applicant filed Serial No. 87048941 for the mark GILEAD CAPITAL LEADERSHIP INVESTING and design (Opposition No. 91233311) and Serial No. 87048887 for the mark GILEAD CAPITAL, in standard character form (Opposition No. 91233327) on May 24, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use of its marks anywhere and in commerce as of January 15, 2016.

² 28 TTABVue. Unless otherwise noted, citations are to the record in Opposition No. 91233311.

likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1051(d), and that Applicant's marks GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design falsely suggest a connection with Opposer under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

With respect to the likelihood of confusion claim, Opposer claims ownership of the four registrations listed below:³

- Registration No. 3604505 for the mark GILEAD, in standard character form, for “financial sponsorship of sports, educational and entertainment programs and events,” in International Class 36;⁴

- Registration No. 3665182 for the mark GILEAD, in standard character form, for “health insurance consultation to patients,” in International Class 36, and “providing health and medical information about medical disorders; counseling and charitable

³ Opposer attached to its Second Amended and Consolidated Notice of Opposition copies of the registrations printed from the USPTO Trademark Status and Document Retrieval system (TSDR) showing the current status and title to the registrations. 28 TTABVUE 24-41. Pursuant to Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), we receive Opposer's registrations in evidence and make them part of the record.

Opposer's allegation that it “has developed a variety of registered and unregistered GILEAD marks (collectively, the ‘GILEAD Marks’), including but not limited to” the four registrations specifically identified in Opposer's Second Amended and Consolidated Notice of Opposition does not put Applicant on notice that Opposer is relying on any registrations in addition to those specifically identified in Opposer's pleading. Opposer's Second Amended and Consolidated Notice of Opposition ¶4 (28 TTABVUE 14). Opposer also alleged that it “owns at least 186 other registrations for the mark GILEAD worldwide.” Opposer's Second Amended and Consolidated Notice of Opposition ¶5 (28 TTABVUE 15). It is incumbent upon Opposer to put Applicant on notice as to which of those 186 registrations form the basis of Opposer's likelihood of confusion claim. A plaintiff may not use an unpleaded registration as the basis for an opposition. *See FUJIFILM SonoSite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1235 (TTAB 2014).

⁴ Registered April 7, 2009; renewed.

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services for patients, namely, providing information and assistance with respect to obtaining prescription medications,” in International Class 44;⁵

- Registration No. 4279898 for the mark GILEAD, in standard character form, for “pharmaceutical preparations, namely, pharmaceuticals for the treatment of viral infections; pharmaceuticals for the treatment of cardiovascular disorders and conditions; pharmaceuticals for the treatment of respiratory disorders and conditions; pharmaceuticals for the treatment of fungal diseases and disorders; pharmaceuticals for the treatment of liver disease; pharmaceuticals for the treatment of HIV/AIDS and hepatitis,” in International Class 5;⁶ and

- Registration No. 3251595 for the mark GILEAD, in standard character form, for “pharmaceutical preparations, namely, antivirals, antifungals and preparations for the treatment of infectious conditions,” in International Class 5.⁷

Applicant, in its Answer, denies the salient allegations in Opposer’s Second Amended and Consolidated Notice of Opposition.

The Board consolidated proceedings in its May 10, 2017 order.⁸

⁵ Registered August 4, 2009; renewed.

⁶ Registered January 22, 2013; Sections 8 and 15 declarations accepted and acknowledged.

⁷ Registered June 12, 2007; renewed.

⁸ 6 TTABVUE.

I. Preliminary Issues

A. Numerous objections.

Both parties filed numerous objections to the other's evidence.⁹ Because an opposition proceeding is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that we cannot rely on the evidence in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections the parties have raised and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 1017), *appeal dismissed per stipulation*, No. 17-00345 (E.D. Va. August 24, 2017); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006). *See also Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) (where the objections refer to probative value rather than admissibility and the evidence that is subject to the objections is not outcome determinative, "we choose not to make specific rulings on each and every objection").

⁹ Opposer's Objections to Applicant's first and second notices of reliance (85 TTABVUE 58-59); "Applicant's Objections to Opposer's Purported Evidentiary Record" in Applicant's Brief, p.13 (86 TTABVUE 22).

B. Whether the parties tried Opposer's use of GILEAD as a trade name or trademark for financial or investment related services by express or implied consent.

In its August 7, 2019 order, the Board noted, "Opposer has not set forth a sufficient claim of likelihood of confusion based on rights accrued at common law in the mark GILEAD."¹⁰

Nevertheless, in its brief, Opposer argues that it renders financial and business advisory services that are substantially similar to Applicant's services even though those services were not included in the descriptions of goods and services in Opposer's pleaded registrations.

[Opposer] is well-known in the investment communities for its active investing in start-up companies and funding of medical research institutions. In 2018, [Opposer] invested directly in over 24 different companies.¹¹

[Opposer] invests in innovative technologies, provides capital to other companies, and enters into strategic financially-backed business collaborations with third parties in the healthcare space. [Opposer] structures and finances investments in a range of companies, including with co-investors. [Opposer] also provides funding to universities and research institutions, and awards grants to support scientific research. Through its active and wide-ranging investments, [Opposer] has become known to investors and the investment community for identifying, financing and investing in emerging companies and technologies related to new and innovative therapeutics.¹²

¹⁰ 41 TTABVUE 10. Because Opposer made its pleaded registrations of record and Applicant admitted Opposer's priority, the Board denied Opposer's motion to compel Applicant to provide information regarding Applicant's first use of its mark.

¹¹ Opposer's Brief, p. 4 (85 TTABVUE 6).

¹² *Id.* at p. 9 (85 TTABVUE 11).

[Opposer] owns longstanding common law trademark rights in GILEAD for a wide array of goods and services as a result of its broad commercial use of GILEAD. [Opposer's] common law trademark rights extend to [inter alia]:

- Capital and equity investment and financing services;
- Venture capital financing services;
- Business advisory and consulting services, including working with management teams to improve strategy and execution; [and]
- Acquisition consultation services.¹³

[Opposer] and [Applicant] render overlapping and closely related investment financing and business advisory services in that they both provide, *inter alia*, investment capital, investment management and advisory services, and related strategic advice to third parties.¹⁴

While this combination of providing investment capital and business advisory services is referred to by [Applicant] as “leadership investing,” it is no different than [Opposer's] “active investing” services, rendered long prior to [Applicant], by which [Opposer] couples its financial support with business advice and strategic guidance to companies to spur their success. [Opposer's] Chief Financial Officer testified that [Opposer's] equity investments are the same as those made by any other equity investor or investment management firm and that they provide an immediate and direct benefit for the companies in which [Opposer] invests by providing them

¹³ *Id.* at p. 10 (85 TTABVUE 12). *See also id.* at pp. 21-24 (85 TTABVUE 23-26).

¹⁴ *Id.* at p. 43 (85 TTABVUE 45). *See also id.* at pp. 4-5 (85 TTABVUE 6-7) (Applicant also invests in healthcare-related companies and Applicant's “investment activities are covered by the same media outlets that cover [Opposer's] investment activities.”).

with critical capital for management, operations, and product development.¹⁵

And while it is true that [Opposer's] mission is to bring forward medicines for life-threatening diseases, it is equally true that [Opposer] also renders financial and business advisory services.¹⁶

In opposition, Applicant contends that because Opposer bases its likelihood of confusion claim on Opposer's ownership of the four pleaded registrations discussed above,¹⁷ the issue before us is whether Applicant's marks for investment management services are likely to cause confusion with Opposer's registrations for the mark GILEAD covering pharmaceutical products, health insurance consultation, and event sponsorship.¹⁸ Thus, Applicant objects to part of Andrew Dickinson's testimony declaration regarding Opposer's purported investment services, in part, on the ground that Opposer "has not set forth a sufficient claim based on common law rights"¹⁹ and, therefore, the testimony is "not germane to the case and not admissible."²⁰

Fed.R.Civ.P. 15(b) provides, in pertinent part, that when the parties try by express or implied consent issues not raised by the pleadings, we shall treat those issues in all respects as if the parties raised them in the pleadings. It is clear from Applicant's

¹⁵ *Id.* at p. 44 (85 TTABVUE 46).

¹⁶ *Id.* at p. 45 (85 TTABVUE 47).

¹⁷ Applicant's Brief, p. 10 (86 TTABVUE 19).

¹⁸ *Id.* at p. 12 (86 TTABVUE 21).

¹⁹ *Id.* at p. 23 (86 TTABVUE 32). Andrew Dickinson is Opposer's Chief Financial Officer.

²⁰ *Id.* at p. 23-24 (86 TTABVUE 32-33).

description of the likelihood of confusion issue and objection to Andrew Dickinson's testimony that Applicant did not expressly consent to Opposer's assertion of common law rights.

As for whether there was implied consent, implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.03(b) (2020). "Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried." *Id. See also Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009).

To analyze the basis of Opposer's likelihood of confusion claim, we reproduce below the relevant allegations in Opposer's Second Amended and Consolidated Notice of Opposition:²¹

3. For over 30 years, [Opposer] has prominently used the term GILEAD as a trademark and trade name to identify itself and its products.

4. In that time, [Opposer] has developed a variety of registered and unregistered GILEAD marks (collectively, the "GILEAD Marks"), including but not limited to [Opposer's four pleaded registrations].

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23. As described above, Opposer is the owner of the registered and incontestable GILEAD Mark[s].

²¹ 28 TTABVUE 13-19.

28. Within the biotech and pharmaceutical industries, it is common for companies like [Opposer] to invest substantially and regularly in innovative companies and technologies in the healthcare industry. In fact, many pharmaceutical and biotech companies have investment arms of their businesses, including Novartis Venture Fund, Roche Venture Fund, Amgen Business Development, and Merck Research Ventures Fund. *See Exhibit 6* (an article from the *Gen* publication on Genetic Engineering and Biotechnology News, which lists 20 different corporate venture funds in the biotech and pharmaceutical space).

29. [Opposer] makes regular investments in smaller companies in the biotech, pharmaceutical, and healthcare services space.

30. As a result, it is likely that investment professionals and others are likely to encounter both parties' marks in circumstances likely to give rise to confusion or mistake.

As the Board noted above, Opposer did not plead common law use of the trade name or trademark GILEAD in connection with financial investment services as a basis for its likelihood of confusion claim. However, Opposer alleges that pharmaceutical companies invest "in innovative companies and technologies in the healthcare industry" and relevant consumers perceive that such investments by companies known for manufacturing and selling pharmaceuticals and Applicant's hedge funds services, investment advisory services, and investment management emanate from the same source.

Based on the following facts we find that the parties did not try Opposer's likelihood of confusion claim based on Opposer's purported trade name or common law trademark used in connection with financial or investment-related services by implied consent:

- (i) Opposer did not plead common law rights in the trade name or trademark GILEAD in connection with financial or investment-related services;
- (ii) the Board noted Opposer had not set forth a sufficient claim of likelihood of confusion based on rights accrued at common law in a pretrial order;
- (iii) Applicant, in its brief, identified the basis of Opposer's likelihood of confusion claim as whether Applicant's GILEAD marks for investment management services are likely to cause confusion with Opposer's registrations for the mark GILEAD covering pharmaceutical products, health insurance consultation, and event sponsorship; and
- (iv) Applicant objected to part of Andrew Dickinson's testimony declaration on the ground that Opposer "has not set forth a sufficient claim based on common law rights" and, therefore, the testimony is "not germane to the case and not admissible."

Opposer argues that Board proceedings are not limited to the goods or services in Opposer's pleaded registrations and that Opposer has rights beyond its registrations.²² Specifically, Opposer argues that it "may rely on rights arising from 'prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights,'" citing *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). While Opposer may rely on prior trademark or service

²² Opposer's Reply Brief, p. 4 (87 TTABVUE 6).

mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights, it must give Applicant notice on what it is relying to prove its proprietary rights. The purpose of notice pleading is to remove the requirement to use “magic words,” not to remove the requirement of notice. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Opposer must give Applicant fair notice of its claim and the basis on which it rests and, in this case, Opposer failed to give Applicant such notice.

Opposer contends that its trade name and common law rights have always been at issue in this proceeding.²³ We disagree. There is nothing in Opposer’s Second Amended and Consolidated Notice of Opposition summarized above putting Applicant on notice of Opposer’s trade name and common law rights. As noted above, the Board specifically noted in a pretrial order, “Opposer has not set forth a sufficient claim of likelihood of confusion based on rights accrued at common law in the mark GILEAD.”²⁴ Thus, the Board put Opposer on notice that it must amend its pleading to assert any common law rights it may have.

While we hold that the parties did not try by express or implied consent Opposer’s likelihood of confusion claim based on Opposer’s purported trade name or trademark use in connection with financial or investment-related services, Opposer is entitled to prove that relevant consumers perceive the manufacture and sale of pharmaceuticals as including Opposer’s financial or investment-related activities.

²³ *Id.* at p. 10 (87 TTABVUE 12).

²⁴ 41 TTABVUE 10.

This is the import of paragraph Nos. 28-30 in Opposer's Second Amended and Consolidated Notice of Opposition discussed above.²⁵

II. The Record.

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's application.

A. Opposer's Testimony and Evidence.

1. Testimony declaration of Andrew Dickinson, Opposer's Chief Financial Officer;²⁶
2. Testimony declaration of Amy Flood, Opposer's Senior Vice President of Public Affairs;²⁷
3. Testimony declaration of Melissa A. Pittaoulis, Ph.D., Associate Director at NERA Economic Consulting, Opposer's consumer survey expert;²⁸
4. Bruce E. Stangle, Ph.D., co-founder of Analysis Group, Inc., an economics consulting firm specializing in providing economic and financial advice;²⁹
5. Notice of reliance on Opposer's four pleaded registrations, and four other registrations owned by Opposer printed from the USPTO TSDR database showing the current status of and title to the registrations;³⁰

²⁵ 28 TTABVUE 19. These allegations are silent as to what trademarks the providers of such services use for such services and when any such use may have commenced.

²⁶ 60-61 TTABVUE.

²⁷ 63-64 TTABVUE. The Board posted the portions of the Amy Flood declaration Opposer designated confidential at 65 TTABVUE.

²⁸ 66 TTABVUE.

²⁹ 67 TTABVUE. The Board posted the portions of the Dr. Stangle declaration Opposer designated confidential at 68 TTABVUE.

³⁰ 69 TTABVUE.

6. Notice of reliance on copies of third-party registrations purportedly owned by pharmaceutical companies;³¹
7. Notice of reliance on unsolicited media articles referring to Opposer and Internet materials purportedly showing a mistaken association between Opposer and Applicant;³²
8. Notice of reliance on copies of administrative panel decisions of the World Intellectual Property Organization ordering the transfer of ownership of various GILEAD-formative domain names to Opposer;³³
9. Notice of reliance on excerpts from the discovery deposition of Jeffrey A. Strong, Applicant's Managing Partner;³⁴
10. Rebuttal testimony declaration of Melissa A. Pittaoulis;³⁵
11. Rebuttal notice of reliance on Applicant's response to Opposer's interrogatory No. 17;³⁶ and
12. Rebuttal notice of reliance on an Internet document from the U.S. Census Bureau in the U.S. Department of Commerce entitled "Dynamics of Economic Well-Being: Fluctuations in the U.S. Income Distribution: 2009-2012."³⁷

C. Applicant's Testimony and Evidence.

1. Testimony declaration of Jeffrey A. Strong, Applicant's Managing Partner;³⁸

³¹ 70 TTABVUE.

³² 71 TTABVUE.

³³ 72 TTABVUE.

³⁴ 73 TTABVUE. The Board posted the portions of the Jeffery Strong deposition Opposer designated confidential at 74 TTABVUE.

³⁵ 80 TTABVUE.

³⁶ 81 TTABVUE.

³⁷ 82 TTABVUE.

³⁸ 76 TTABVUE.

2. Notice of reliance on copies of official records (land records) referring to land in Gilead, Nebraska;³⁹
3. Notice of reliance on a request for the Board to take judicial notice of the existence and location of the village of Gilead in Thayer County, Nebraska;⁴⁰
4. Notice of reliance on Opposer's responses to Applicant's interrogatory Nos. 10, 12, 23, 30, 33 and 34;⁴¹ and
5. Notice of reliance on Opposer's admissions to Applicant's first set of requests for admission.⁴²

III. Entitlement to a Statutory Cause of Action.

Even though Applicant does not contest it, Opposer's entitlement to a statutory cause of action, formerly referred to as "standing" by the Federal Circuit and the Board,⁴³ is a threshold issue in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d

³⁹ 77 TTABVUE.

⁴⁰ 78 TTABVUE.

⁴¹ 79 TTABVUE 5-17.

⁴² 79 TTABVUE 19-60. A party may introduce only an admission to a request for admission through a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). A denial or statement that the responding party cannot respond to the request does not establish the truth or falsity of the assertion, but rather leaves the matter for proof at trial. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials to requests for admission inadmissible because "unlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial."). As such, we have considered only the admissions to the requests for admission.

⁴³ Our decisions have previously analyzed the requirements of Sections 1063 and 1064 under the rubric of "standing." We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting "standing" under §§ 1063 and 1064 remain applicable.

1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore*, 2020 USPQ2d 11277 at *4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

Because Opposer has properly introduced into evidence copies of its pleaded registrations showing the current status of and title to the registrations, Opposer has established its entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016) (standing established based on pleaded registration made of record).

IV. Priority

Because Opposer has properly made of record its pleaded registrations, priority is not an issue as to the mark and goods and services covered by the registrations. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

V. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)

(“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1406-07).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as

similarity of the marks and relatedness of the goods.”) (quoting *Herbko Int’l*, 64 USPQ2d at 1380)).

A. The strength of Opposer’s GILEAD mark.

Opposer contends that its GILEAD mark is famous.

GILEAD is a famous trademark, given that it has been used for over 30 years as the house mark for a global pharmaceutical company with over 10,000 employees, average annual revenues for the past eight years of over \$22 billion, and an average annual advertising spend for the past eight years of \$500 million.⁴⁴

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 Prods. 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 Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

⁴⁴ Opposer’s Brief, p. 38 (85 TTABVUE 40).

To determine a mark's place on that spectrum, we consider its inherent strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. North Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2021 update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”).

We turn first to the inherent or conceptual strength of GILEAD when used in connection with pharmaceutical products. “Gilead” is a mountain in northwest Jordan or a district in ancient Palestine, east of the Jordan River in present North Jordan.⁴⁵

⁴⁵ Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2021) (accessed April 1, 2021). *See also* MERRIAM-WEBSTER DICTIONARY (merrriam-webster.com) (accessed April 1, 2021); Gilead, ENCYCLOPAEDIA BRITANNICA (britannica.com) (accessed April 2, 2021)

Gilead (ji-LEED), fertile, mountainous region, NW Jordan, bordering on Syria in the N and on Israel and the West Bank in the W. The most developed and inhabited part of Jordan, consisting of the Balqa and Irbid districts. It was one of the most fertile regions of biblical Canaan and was much fought over.⁴⁶

Gilead is also a village in Thayer county Nebraska.⁴⁷

Opposer uses and registered a shield and leaf logo it refers to as the “Balm of Gilead.”⁴⁸

The leaf symbolizes the Balm of Gilead, a medicinal treatment that was mentioned in the Bible’s Old Testament and named for the region of Gilead, where the tree with leaves producing this balm was said to grow. The Balm of Gilead signifies a universal cure and is often accompanied by the image of a tree, shrub, or leaf.⁴⁹

The commercial impression engendered by the mark GILEAD in connection with pharmaceuticals is a reference to the biblical medicinal treatment inasmuch as there is no testimony or evidence that Gilead has any geographical significance for

(“Gilead, area of ancient Palestine east of the Jordan River, corresponding to modern northwestern Jordan.”).

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format, as well as encyclopedias. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (“dictionaries and encyclopedias may be consulted”); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

⁴⁶ “Gilead,” COLUMBIA GAZETTEER OF THE WORLD ONLINE (2021) (accessed April 14, 2021). The Board may take judicial notice of information in a gazetteer which is a standard reference work. See *In re Spirits of New Merced LLC*, 85 USPQ2d 1614, 1617 n. 3 (TTAB 2007); *In re Consolidated Specialty Rests., Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004).

⁴⁷ “Gilead,” COLUMBIA GAZETTEER OF THE WORLD ONLINE (accessed April 14, 2021).

⁴⁸ Registration No. 2661262 registered December 17, 2002; renewed. (69 TTABVUE 11); Flood Testimony Decl. ¶15 (63 TTABVUE 7);

⁴⁹ Flood Testimony Decl. ¶¶15-16 (63 TTABVUE 7).

pharmaceutical products. We find GILEAD is an arbitrary, or at worst suggestive, mark and inherently distinctive and, thus, presumed to designate origin. *See Chippendales*, 96 USPQ2d at 1685 (“[I]f the mark is inherently distinctive, it is presumed that consumers will view it as a source identifier.”); *Cicena Ltd. v. Columbia Tele. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1405 n.5 (Fed. Cir. 1990). *See also Maytag Co. v. Luskin’s, Inc.*, 228 USPQ 747, 750 (TTAB 1986) (“there is nothing in our trademark law which prescribes any different protection for suggestive, nondescriptive marks than that which is accorded arbitrary and fanciful marks”); *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985) (“the fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection”).

We find that Opposer’s GILEAD mark is an inherently strong mark.⁵⁰

We turn now to the commercial strength or fame of Opposer’s GILEAD mark. We may measure the commercial strength or fame of Opposer’s GILEAD mark indirectly by the volume of sales of and advertising expenditures for the goods and services

⁵⁰ Applicant, in its brief, referred to four third-party registrations incorporating the name “Gilead” contending they are admissible as “a matter of public record.” Applicant’s Brief, p. 38 (86 TTABVUE 47). However, the Board does not take judicial notice of third-party registrations. *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). Even if we considered the third-party registrations, they would not have any probative value because the description of goods and services in the third-party registrations are far removed from the goods and services at issue. *See Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus “on goods shown to be similar”); *TAO Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case.”).

identified by the mark at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales, or advertising figures for comparable types of goods or services. *Id.* at 1309.

Other contextual evidence probative of the renown of a mark may include:

- extent of catalog and direct mail advertising, email blasts, customer calls, and use of social media platforms, such as Twitter, Instagram, Pinterest, and Facebook, identifying the number of followers;
- the number of consumers that Opposer solicits through its advertising throughout the year;
- local, regional, and national radio and television advertising campaigns, free-standing print campaigns, and mentions in national publications;
- unsolicited media attention; and
- product placement in television and in movies.

Omaha Steaks, 128 USPQ2d at 1694.

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, Opposer has the duty to prove the fame of its

mark clearly. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Opposer introduced the evidence listed below to prove that its GILEAD mark is famous:

- “Gilead is and has been a leader in the development of medicines for the treatment and prevention of HIV-1 infection, beginning with the 2001 United States Food and Drug Administration approval of **Viread**® (tenofovir disoproxil fumarate) for the treatment of HIV-1 infection in connection with other antiretroviral agents, followed by the 2006 approval of **Atripla**® (efavirenz/emtricitabine/tenofovir disoproxil fumarate), the first single-tablet regimen treatment for HIV-1 infection, and the 2012 approval of **Truvada**® (emtricitabine/tenofovir disoproxil fumarate) for the prevention of HIV-1 infection.”⁵¹

- In 2014, Opposer “released **Harvoni**® (ledipasvir/sofosbuvir), a single-tablet regimen that cures certain genotypes of Hepatitis C.”⁵²

- Currently, Opposer “is ... in the spotlight for its research and testing of its investigational compound *remdesivir* as a potential treatment for COVID-19.”⁵³

⁵¹ Dickinson Decl. ¶17 (60 TTABVUE 8). *See also* Flood Decl. ¶22 (63 TTABVUE 8).

⁵² Dickinson Decl. ¶17 (60 TTABVUE 8). *See also* Flood Decl. ¶25 (63 TTABVUE 8).

⁵³ Dickinson Decl. ¶17 (60 TTABVUE 8). *See also* Flood Decl. ¶30 (63 TTABVUE 11).

“Due to the coronavirus pandemic and [Opposer’s] investigational drug *remdesivir* to treat Covid-19, visits to [Opposer’s] website at <gilead.com> skyrocketed to over 4 million visits between March 1, 2020 and May 31, 2020.” Flood Decl. ¶9 (63 TTABVUE 4).

• Opposer’s *Truvada*® and *Descovy*® both for PrEP “are currently the only products approved by the FDA for the prevention of HIV infection.”⁵⁴

• “The U.S. market for HIV treatment has been consolidating around [Opposer’s] *Biktarvy*®, which has been and is the number one prescribed HIV regimen in the U.S.”⁵⁵

• “[Opposer’s] share of the HIV treatment market in the U.S. has been approximately at 80% over the last three years [2017-2019].”⁵⁶

• Due to the success of the above-noted drugs, Opposer’s revenues have grown from 2012 through 2019 as reflected in the table below:⁵⁷

Year	Worldwide Product Sales Revenue ²	U.S. Product Sales Revenue ³
2012	\$9,398,000,000	\$5,500,000,000
2013	\$10,804,000,000	\$6,600,000,000
2014	\$24,474,000,000	\$18,100,000,000
2015	\$32,151,000,000	\$21,200,000,000
2016	\$29,953,000,000	\$19,354,000,000
2017	\$25,662,000,000	\$18,109,000,000
2018	\$21,667,000,000	\$16,197,000,000
2019	\$22,119,000,000	\$16,565,000,000

• “When [Opposer’s] medications are dispensed, they come in a bottle or carton that prominently display[s] the GILEAD trademark, and in some cases, the GILEAD trademark also appears on the pills themselves.”⁵⁸

⁵⁴ Dickinson Decl. ¶19 (60 TTABVUE 9).

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at ¶18 (60 TTABVUE 9).

⁵⁸ Flood Decl. ¶27 (63 TTABVUE 9).

- “[Opposer’s] medical breakthroughs are also covered by the media.”⁵⁹
- “[Opposer] owns corporate social media accounts on LinkedIn, Twitter, and Facebook under the GILEAD name, among others. [Opposer’s] LinkedIn page has over 310,000 followers and its Twitter newsfeed has over 60,000 followers.”⁶⁰
- Opposer’s social media accounts, press releases, corporate advertising, corporate reports and annual reports “have reached hundreds of millions of people.”⁶¹
- “In 2015, [Opposer] received a Scrip Award for ‘Pharmaceutical Company of the Year.’ The company was also recognized as one of the most innovative companies by *Fast Company* and as one of the smartest companies by *MIT Technology Review* in 2015.”⁶²
- “In 2016, *Business Insider* named [Opposer] as one of the best companies to work for to have an impact on the world, and *Fortune* magazine listed [Opposer] as one of the world’s most admired companies. That same year, [Opposer’s] scientists also won the Lasker-DeBakey Clinical Medical Research Award for their transformative research for hepatitis C treatment. The Lasker Award is one of the highest honors awarded for medical research. And *Barron’s*, which offers financial and investment news, ranked Gilead as #2 out of the 500 largest public companies. Also in 2016, [Opposer] received the Scrip Award for the ‘Licensing Deal of the Year’ for its

⁵⁹ Flood Decl. ¶29 and Exhibit 26 (63 TTABVUE 10 and 186-196). *See also* Opposer’s notice of reliance on unsolicited media articles referring to Opposer (71 TTABVUE 7-251).

⁶⁰ Flood Decl. ¶10 (63 TTABVUE 4).

⁶¹ *Id.* at ¶11 (63 TTABVUE 4-5).

⁶² *Id.* at ¶33 (63 TTABVUE 13).

collaboration with Galapagos. [Opposer] was ranked as #17 of *Fortune's* Fastest-Growing Companies, #2 in Pharmaceutical Executive's Annual Industry Audit, and #3 among global large-cap companies in The Boston Consulting Group's 'The World's Top Value Creators.'⁶³

- "In 2018, [Opposer] and its subsidiary Kite Pharma, Inc. were awarded the Prix Galien Award for 'Best Biotechnology Product' by The Galien Foundation for ***Yescarta***, a cell therapy treatment in which T-cells are removed from a patient with lymphoma and genetically engineered to produce a specific T-cell receptor."⁶⁴

- In 2020, "[Opposer] received the inaugural 'Emerging Collaborator Award' from the Crohn's & Colitis Foundation for its work in partnership with the inflammatory bowel disease community."⁶⁵

- "In 2015 and 2016, [Opposer] was recognized as the top corporate funder by the 'Fundors Concerned About AIDS' organization and was named #1 for charitable giving and #2 in total giving by The Chronicle of Philanthropy."⁶⁶

- "In 2013, the USPTO awarded Gilead its inaugural 'Patents for Humanity' award for the medical category. The USPTO's Patents for Humanity program recognizes patent owners and licensees who address global challenges in health and standards of living. [Opposer] was awarded this honor for making its HIV drugs available to the world's poor by utilizing a network of generic pharmaceutical

⁶³ *Id.* at ¶34 (63 TTABVUE 13-14).

⁶⁴ *Id.* at ¶35 (63 TTABVUE 14).

⁶⁵ *Id.* at ¶36 (63 TTABVUE 14).

⁶⁶ *Id.* at ¶42 (63 TTABVUE 16).

manufacturers in Asia and Africa. In 2016, *Fortune* magazine identified [Opposer] on its ‘Change the World’ list, which names companies with a positive social impact.”⁶⁷

- “[Opposer] advertises in a variety of ways including by disseminating educational ‘disease state’ social media ads that receive millions of impressions (views) and through national advertising campaigns for its branded medicines. All advertising content displays the GILEAD trademark.”⁶⁸

- Opposer spent nearly \$3.2 billion on promotion and advertising in the United States from 2012 through 2019.⁶⁹

Opposer’s testimony and evidence regarding its substantial revenue, extensive advertising and promotional activities, philanthropy, innovative research and development, and media attention prove that GILEAD is a commercially strong mark or famous mark when used in connection with pharmaceutical products.

Applicant, in its brief, does not contest that GILEAD is a commercially strong or famous mark when used in connection with the goods and services identified in Opposer’s pleaded registrations; rather Applicant contends Opposer has not proven that GILEAD is a commercially strong or famous mark when used in connection with investment and financially related services.

Although Opposer has submitted testimony and exhibits regarding its sales and marketing expenditures, it has failed to support its position that its reputation, if any, for pharmaceutical products and health consultation services would have reach beyond its registered goods and services.

⁶⁷ *Id.* at ¶53 (63 TTABVUE 19).

⁶⁸ *Id.* at ¶58 (63 TTABVUE 21).

⁶⁹ *Id.* at ¶64 (63 TTABVUE 23-24).

Consequently, Opposer's evidence falls short of establishing the fame of its mark. Furthermore, while Opposer may have been the subject of articles and received some awards, Opposer has not presented any direct evidence (*e.g.*, customer testimony) of fame or brand recognition of its GILEAD Mark in the markets relevant to this analysis.⁷⁰

Applicant's argument misses the point of why Opposer is trying to prove that its mark is commercially strong or famous. A plaintiff introduces evidence to show that its mark is commercially strong to establish the extent of its trademark rights. The stronger the mark, the more extensive the trademark rights. As noted above, we accord a commercially strong mark a commensurately broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *See Bose Corp.*, 63 USPQ2d at 1305; *Recot*, 54 USPQ2d at 1897; *Kenner Parker Toys*, 22 USPQ2d at 1456.

As noted above, we found that Opposer's GILEAD mark is a commercially strong or famous mark when used in connection with pharmaceutical products. "As a mark's fame increases, the [Trademark] Act's tolerance for similarities in competing marks falls." *Kenner Parker Toys*, 22 USPQ2d at 1456. Nevertheless, the commercial strength or fame of a mark is not an automatic entitlement to appropriate a mark for all products and services. *See Recot*, 54 USPQ2d at 1894 ("[F]ame alone cannot overwhelm the other *DuPont* factors as a matter of law."); *Burns Philp Food Inc. v. Modern Prods Inc.*, 24 USPQ2d 1157, 1160 (TTAB 1992), *aff'd*, 28 USPQ2d 1687 (Fed. Cir. 1993) (while the fame of a mark is entitled to substantial weight in the likelihood

⁷⁰ Applicant's Brief, p. 37 (86 TTABVUE 46).

of confusion analysis, there may be countervailing factors). Thus, we must keep in mind the commercial strength or fame of Opposer's GILEAD mark when we analyze the other *DuPont* likelihood of confusion factors.

Because Opposer's GILEAD mark when used in connection with pharmaceuticals is an inherently and commercially strong or famous mark, we find that is a very strong mark on the spectrum from very strong to very weak and famous, and, therefore, it is entitled to a broad scope of protection.

B. The similarity or dissimilarity of the marks.

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

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." *Cai v. Diamond Hong*,

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Inc., 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1721.

Applicant is seeking to register the marks GILEAD CAPITAL, in standard character form, and GILEAD CAPITAL LEADERSHIP INVESTING and design, reproduced below:



The mark in Opposer’s pleaded registrations is GILEAD, in standard character form.

The marks are similar because they share the name “Gilead.” As discussed in the previous section of this decision, “Gilead” is arbitrary term, or at worst suggestive, when used in connection with pharmaceuticals and it is commercially very strong and famous.

The term “Gilead” is the dominant element of Applicant’s marks. There is nothing improper in stating that, for rational reasons, we have given more or less weight to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With respect to Applicant’s mark GILEAD CAPITAL, in standard character form, the term “Gilead” is the dominant element of the mark because the word “Capital” is descriptive when used in connection with Applicant’s investment and financial services and Applicant has disclaimed the exclusive right to use it. Disclaimed,

descriptive matter may have less significance in likelihood of confusion determinations. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 41 USPQ2d at 1533-34); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“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.’”) (quoting *Nat’l Data Corp.*, 224 USPQ at 752); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Further reinforcing the significance of the name “Gilead” in Applicant’s mark is its position as the first word in the mark. The lead word in a mark generally has a position of prominence because it is likely that consumers will notice and remember it to play a dominant role in the mark. *See Detroit Ath. Co.*, 128 USPQ2d at 1049 (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

With respect to Applicant’s mark GILEAD CAPITAL LEADERSHIP INVESTING and design, GILEAD is also the dominant feature of Applicant’s mark. First,

Applicant displays the term GILEAD CAPITAL as the largest and most prominent part of the mark.

Second, in the case of marks consisting of words and a design, we normally accord words greater weight because the words are likely to make an impression upon purchasers, and consumers will remember the words and use the words to request the services. *See Viterra*, 101 USPQ2d at 1908 and 1911 (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)); *Herbko Int'l*, 64 USPQ2d at 1380 (“Because the impact of the design in the overall commercial impression is minor when compared with the words, a consumer viewing Herbko’s mark would attach greater significance to the words CROSSWORD COMPANION than to the crossword puzzle design.”).

Third, the reasons that the name “Gilead” is the dominant part of Applicant’s mark GILEAD CAPITAL also explain why the name “Gilead” is the dominant part of Applicant’s mark GILEAD CAPITAL LEADERSHIP INVESTING and design.

Another reason supporting the similarity of the marks is that Applicant’s marks incorporate Opposer’s entire mark. While there is no express rule that we must find marks similar where Applicant’s marks incorporate the entirety of Opposer’s mark, the fact that Applicant’s marks subsume Opposer’s mark increases the similarity between them. *See, e.g., China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) (applicant’s mark CHI PLUS is similar to opposer’s mark CHI both for electric massagers); *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556,

188 USPQ 105 (CCPA 1975) (applicant's mark BENGAL LANCER for club soda, quinine water and ginger ale is likely to cause confusion with BENGAL for gin); *Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (respondent's mark ABS-CBN is similar to petitioner's mark CBN both for television broadcasting services).

Finally, Applicant sometimes refers to GILEAD CAPITAL as GILEAD.⁷¹

Q. And you have referred to your company as Gilead in your annual letter to your partners, correct?

—

A. In shorthand after making it ... clear that it's Gilead Capital.

Q. Exactly. In shorthand, you refer to your company as Gilead in those three documents [pitch deck, annual letter, and when talking to a potential investor], right?

—

A. Correct.⁷²

Inasmuch as Applicant refers to itself as GILEAD, the relevant public may also refer to GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design as "Gilead."

[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomin' for Bloomingdale's.

⁷¹ Strong Discovery Dep., pp. 126-27 and 252 (73 TTABVUE 99-100 and 187).

⁷² *Id.* at p. 252 (73 TTABVUE 187).

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992). See also *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant’, it does indicate that people have called it by that name, omitting the word ‘Hamburgers’. Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant’, there likely would be confusion about which ‘Giant’ they were talking about.”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 (TTAB 2015) (“While Opposer’s beer was originally sold under the BUDWEISER brand, customers soon began to abbreviate the mark, calling for BUDWEISER beer just by the name ‘BUD.’”); *Big M Inc. v. U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the ‘T.H.’ in referring to registrant’s stores [T.H. MANDY].”).

Applicant contends that the addition of the word “Capital” to its marks creates a distinct commercial impression from Opposer’s mark.⁷³

Here, Applicant’s Marks consist of the term GILEAD combined with the additional terms CAPITAL and INVESTING, which are typically used in connection with investment management services, as well as LEADERSHIP INVESTING, which is Applicant’s registered mark for certain investment management and hedge fund services. These additional terms distinguish Applicant’s Marks from Opposer’s Mark[] in appearance and sound, and clearly connote and reinforce the commercial impression that Gilead Capital is engaged in

⁷³ Applicant’s Brief, pp. 16-17 (86 TTABVUE 25-26).

hedge fund services. That these additional terms are legally disclaimed does not negate their consideration as part of such marks.⁷⁴

Applicant's contention does not persuade us that GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design have a different meaning and engender a different commercial impression than Opposer's GILEAD mark. Applicant does not take into account the inherent and commercial strength of Opposer's mark, nor does it take into account the prominence the name "Gilead" plays in the marks, including the fact that Applicant and its clients sometimes refer to GILEAD CAPITAL as "Gilead."

We find that Applicant's marks GILEAD CAPITAL, in standard character form, and GILEAD CAPITAL LEADERSHIP INVESTING and design, are similar in their entirety to Opposer's mark GILEAD. This finding of fact is supported by our analysis of the purported instances of confusion discussed below.

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

Applicant seeks to register its marks for the services set forth below:

Hedge fund investment services; Investment advisory services; Investment management; Financial services, namely, operation and management of hedge funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures, derivatives, debt instruments and commodities.

Although Opposer's registrations include services in International Classes 36 and 44, we focus our analysis on Opposer's pharmaceutical products because it is

⁷⁴ *Id.*

Opposer's core business, the basis of Opposer's argument that the goods and services are related, and the goods for which Opposer's GILEAD mark is famous or commercially strong. Thus, Opposer's description of goods at issue are set forth below:

- "pharmaceutical preparations, namely, pharmaceuticals for the treatment of viral infections; pharmaceuticals for the treatment of cardiovascular disorders and conditions; pharmaceuticals for the treatment of respiratory disorders and conditions; pharmaceuticals for the treatment of fungal diseases and disorders; pharmaceuticals for the treatment of liver disease; pharmaceuticals for the treatment of HIV/AIDS and hepatitis"; and

- "pharmaceutical preparations, namely, antivirals, antifungals and preparations for the treatment of infectious conditions."

Applicant argues that there is no likelihood of confusion because (i) Applicant's services are different from Opposer's goods and, therefore, not related, (ii) the parties offer their goods and services in different channels of trade to different classes of consumers, and (iii) Applicant's consumers exercise a high degree of consumer care. For example,

- Opposer's "[p]harmaceutcal preparations, event and program sponsorship, and health insurance consultation are each dissimilar to investment management and hedge fund services."⁷⁵

- "[Applicant] provides hedge fund investment services, investment management, and securities trading services in the shares of publicly-traded companies in North

⁷⁵ Applicant's Brief, p. 19 (86 TTABVUE 28).

America, Europe, and Australia. Applicant's Services do not include investing in privately-held companies or providing venture or seed capital to start-up businesses.”;⁷⁶

- Applicant requires institutions to maintain a minimum account of \$500,000 and individuals to maintain an account of \$250,000;⁷⁷

- “Applicant's consumers are ‘accredited investors,’ ‘qualified clients,’ and ‘qualified purchasers.’ These types of potential investors include institutional investors, such as foundations, endowments, charitable organizations, pension and employee benefit plans, insurance companies, sovereign wealth funds, funds of funds, and family offices, as well as certain high net-worth individuals.”;⁷⁸ and

- Applicant's clients and prospective clients “are highly-sophisticated and conduct extensive diligence before hiring a manager to invest millions of dollars on their behalf” and, therefore, “exercise care in the selection of their asset managers,” including whether Applicant's investment management strategy “aligns with the clients' objectives.”⁷⁹

Applicant's arguments ignore the breadth of Applicant's “investment advisory services” and “investment management” services. Applicant has identified “investment advisory services” and “investment management” as separate activities in Applicant's description of services having separated them from the other listed

⁷⁶ *Id.* at p. 21 (86 TTABVUE 30).

⁷⁷ *Id.* at p. 35 (86 TTABVUE 44).

⁷⁸ *Id.* at p. 29 (86 TTABVUE 38).

⁷⁹ *Id.* at pp. 34-35

activities with semicolons. *See In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1166 (TTAB 2013) (finding that, because a semicolon separated the two relevant clauses in registrant's identification, its "restaurant and bar services" is a discrete category of services that stands alone and independently as a basis for likelihood-of-confusion analysis, and is not connected to nor dependent on the services set out on the other side of the semicolon). *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01(a) (2018) ("Semicolons should generally be used to separate distinct categories of goods or services within a single class.").

For example, "cleaners, namely, glass cleaners, oven cleaners, and carpet cleaners; deodorants for pets" is an acceptable identification in Class 3. In this example, the word "cleaners" names the category covering "glass cleaners, oven cleaners, and carpet cleaners." The semicolon prior to "deodorants for pets" indicates that the deodorants are a separate category of goods from the cleaners.

Id.

Because Applicant's "investment advisory services" and "investment management" are unrestricted and include no limitations, we presume that Applicant's "investment advisory services" and "investment management," encompass all activities included in the identified services. *See, e.g., Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *In re FCA US LLC*, 126 USPQ2d 1214, 1217 (TTAB 2018) (where a description of goods includes no restrictions or limitations, the Board must read the application to cover all goods of the type identified); *Sw. Mgmt., Inc. v. Ocinoled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (where the services in an application or

registration are broadly described, they are deemed to encompass all the activities of the nature and type described therein), *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, * 4 (TTAB 2019) and *cited in In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *11-12 (TTAB 2020).

We do not read limitations into the identification of services. *i.am.symbolic*, 123 USPQ2d at 1748; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco’s mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”).

Additionally, we may not rely on extrinsic evidence beyond the description of goods and services in Applicant’s applications and Opposer’s pleaded registrations to distinguish Applicant’s services from Opposer’s goods and services, channels of trade and classes of consumers. *See e.g., In re Dixie Rests. Inc.*, 41 USPQ2d at 1534; *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (quoting *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983)); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). “The description of the goods in the application for

registration is critical because any registration that issues will carry that description.” *CBS*, 218 USPQ at 199.

We presume, therefore, that Applicant’s “investment advisory services” and “investment management” include all types of investment advisory, management services, and all types of investors regardless of their income, wealth, or sophistication. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”).

Nevertheless, Applicant’s “investment advisory services” and “investment management” services are specifically different from Opposer’s pharmaceuticals, sponsorship services, health insurance consultation, providing health and medical information about medical disorders, and providing information and assistance with respect to obtaining prescription medications. However, “[i]n comparing the . . . goods [and services], [t]he issue to be determined . . . is not whether the goods [and services]. . . are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Anheuser-Busch*, 115 USPQ2d at 1825 (quoting *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989)).

In determining whether the goods and service are related, it is not necessary that the goods and services of the parties be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes if Opposer establishes that the goods and services are related in some manner or that conditions

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and activities surrounding marketing of the goods and services are such that they would or could be encountered by same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *Coach Servs.*, 101 USPQ2d at 1722.

Where the marks are as similar as the marks before us, it is only necessary that there be a viable relationship between the goods and services to support a finding of likelihood of confusion. *See i.am.symbolic*, 116 USPQ2d at 1411; *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia Int'l Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

In this regard, Opposer contends that its investment activities are a key aspect of its pharmaceutical business and provides the viable relationship among the goods and services at issue. *See* Opposer's Second Amended and Consolidated Notice of Opposition ¶¶28-30 (because it is common for pharmaceutical companies to invest in innovative companies and technology in the healthcare industry, investment professionals and others will encounter both parties' marks in circumstances likely to give rise to confusion or mistake).

To support these allegations, Andrew Dickinson, Opposer's Chief Financial Officer, testified that Opposer and other healthcare and pharmaceutical companies "fund, invest in, advise, support, and partner and collaborate with other innovative

companies, both public and private, as well as research and educational institutions.”⁸⁰

In 2018 alone, [Opposer] invested directly in over two dozen companies, by partnerships, mergers, acquisitions, venture capital financing, and other types of equity investment transactions. [Opposer] has been actively investing in companies for more than fifteen years.⁸¹

Opposer has been investing in other companies since 2004.⁸²

Some pharmaceutical companies fund and invest in other companies by forming a separate venture arm, subsidiary or affiliate company.

These arms, subsidiaries, and/or affiliates typically use the trade name of their pharmaceutical parent. For example, Amgen has its Amgen Ventures, Roche has its Roche

⁸⁰ Dickinson Testimony Decl. ¶¶4-5 (60 TTABVUE 3).

Applicant objects to the Dickinson Testimony Declaration discussing “Opposer’s purported ‘Funding and Equity Investment Services’ and ‘Presence in the Investor Community.’” Applicant’s Brief, p. 13 (86 TTABVUE 22). Applicant contends that Andrew Dickinson’s testimony regarding the investment activities of third parties is hearsay and irrelevant. Applicant’s Brief, pp. 19-20 and 23-27 (86 TTABVUE 28-29 and 32-36).

Mr. Dickinson’s testimony regarding general investment activities of pharmaceutical companies is not hearsay because he bases his testimony on personal knowledge, experience and observations. For example, Mr. Dickinson testified that in his over 20 years working for pharmaceutical companies, “I know that most of our peer pharmaceutical companies are, and have long been, offering these same type of services and they – and we – are rendering the same services that any investment management firm and does provide,” and that “I also know that many pharmaceutical companies fund and invest in other companies by forming a separate venture arm, subsidiary or affiliate company that focuses only on investment services.” Dickinson Testimony Decl. ¶¶5-6 (60 TTABVUE 3).

His testimony on the subject is relevant because it relates directly to whether the relevant public perceives a relationship between pharmaceutical companies and their investment arms and investment firms in general and specifically to Opposer’s investment activities as part of its pharmaceutical manufacturing and sales and Applicant’s hedge fund services, investment advisory services, and investment management.

Applicant’s objections to Andrew Dickinson’s testimony are overruled.

⁸¹ *Id.* at ¶4 (60 TTABVUE 3).

⁸² *Id.* at ¶20 (60 TTABVUE 10).

Venture Fund, Novartis has its Novartis Venture Fund, and Pfizer has Pfizer Ventures.⁸³

Opposer's investment activities include the following:

1. Direct equity investments in public and private companies;⁸⁴
2. Investing in independent companies with which Opposer also collaborates by providing strategic guidance such as,
 - a. providing them with resources to operate, research, develop, and conduct clinical trials for investigational medicines and treatments;
 - b. advising and training their employees on research and development, clinical trials, regulatory approval, and positioning products in markets;
 - c. helping them acquire or research new technologies;
 - d. working with their management teams to improve strategy and execution;
 - e. handling their operations such as order fulfillment, manufacturing, distribution, inventory management, warehousing, and sales, all of which are highly regulated services that may be difficult for a small company to handle efficiently and be compliant with applicable regulations; and
 - f. handling marketing and other promotional support services.⁸⁵

⁸³ *Id.* at ¶6 (60 TTABVUE 3).

⁸⁴ *Id.* at ¶¶21-22 (60 TTABVUE 10).

⁸⁵ *Id.* at ¶23 (60 TTABVUE 10-11).

3. Providing capital financing to support research, development, operations, and management of universities and research institutions.⁸⁶

By virtue of its status as a major pharmaceutical company and its investment activities, Opposer “regularly meets with other investors, including large institutional investors such as retirement funds, mutual funds, and hedge funds, as well as with companies in which [Opposer is] considering investing.”⁸⁷ For example, Opposer regularly attends and presents at financial conferences related to healthcare companies, including the annual JP Morgan Chase Healthcare Conference. The JP Morgan Chase Healthcare Conference is a large investment symposium attended by emerging companies, technology developers, industry leaders in healthcare, and members of the investment community (e.g., investors, analysts, and media).⁸⁸ Opposer also attends and presents at the Jefferies Healthcare Conferences sponsored by the Jefferies Financial Group, as well as conferences sponsored by Piper Jaffray, Goldman Sachs, Bank of America Merrill Lynch, Barclays, Morgan Stanley, Wells Fargo and Citi.⁸⁹ At these conferences, Opposer meets with representatives from potential investment targets and investing partners.⁹⁰

The testimony of Bruce E. Stangle, Ph.D., co-founder of Analysis Group, Inc., an international economic consulting firm, corroborates Andrew Dickinson’s testimony

⁸⁶ *Id.* at ¶26 (60 TTABVUE 12).

⁸⁷ *Id.* at ¶31 (60 TTABVUE 14).

⁸⁸ *Id.* at ¶¶33-34 and 38-39 (60 TTABVUE 14-15 and 18).

⁸⁹ *Id.* at ¶38 (60 TTABVUE 18).

⁹⁰ *Id.* at ¶37 (60 TTABVUE 17-18).

regarding the investment activities of third-party pharmaceutical companies.⁹¹ Dr.

Stangle provides the following testimony:

- Large healthcare-related companies, like Merck, Novartis, Johnson & Johnson (“J&J”), and Opposer are active investors. These companies invest in start-ups and emerging healthcare-related companies that show promising research and development results, or that own innovative technology. Typical investments include

⁹¹ Stangle Testimony Decl. (67 TTABVUE). Dr. Stangle has been a practicing economist for over 40 years specializing in economic and financial advice. He advises companies in the healthcare, medical device, biotech and pharmaceutical industries on a variety of economic and financial issues, including equity investments and acquisitions. Stangle Testimony Decl. ¶¶ 2-4 (67 TTABVUE 3-4). In addition, Dr. Stangle is an active “angel investor” in more than 50 companies providing seed money for start-ups and emerging companies, including companies in the healthcare, medical device, biotech and pharmaceutical industries. *Id.* at ¶¶5-7 (67 TTABVUE 4-5).

Applicant objects to the testimony of Dr. Stangle in its entirety. Applicant’s Brief, p. 13 (86 TTABVUE 22). According to Applicant, Dr. Stangle’s opinions are inadmissible under Fed. R. Evid. 401, 402 and 702 because (i) they are irrelevant, (ii) Dr. Stangle does not apply recognized methodology or principles for showing likelihood of confusion or a false association of a connection, (iii) they are hearsay, and (iii) Dr. Stangle is not qualified to testify as an expert in a trademark case. We rely on Dr. Stangle’s testimony to the limited extent he refers to the investment activities of third-party pharmaceutical companies. We do not consider his opinion as to whether the goods and services are related or whether there is a likelihood of confusion. The Board is responsible for making those determinations and we will not substitute the opinion of a witness even that of an expert witness for our own evaluation of the facts. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010).

Dr. Stangle’s testimony is relevant because it relates directly to whether the relevant public perceives a relationship between Opposer’s investment activities as part of its pharmaceutical manufacturing and sales and Applicant’s hedge fund services, investment advisory services, and investment management.

Dr. Stangle’s testimony is not hearsay because he bases his testimony on personal knowledge, experience and observations.

Dr. Stangle is qualified to testify regarding the investment practices of companies in the healthcare-related industry including how large-cap companies in this industry set up financial investment arms that use the unique part of the parent’s name. Thus, Dr. Stangle qualifies as an expert in the investment practices of companies in the healthcare related industries.

Applicant’s objections to Dr. Stangle’s testimony in its entirety is overruled.

taking an equity stake in the smaller company and an active role to support and benefit that company by, for example, providing resources to support the research and development activities of the smaller company and assisting with clinical trials or regulatory affairs;⁹²

- Many of the above-noted pharmaceutical firms have investment divisions “whose primary objective is to invest in healthcare-related companies and ventures.” Many of these divisions bear the name of their parent (e.g., Novartis invests through Novartis Venture Fund and J&J invests through Johnson & Johnson Innovations);⁹³

- The table reproduced below “shows the top 20 pharmaceutical and biotechnology firms by market capitalization” and their investment divisions. “A dash in the ‘Investment Arm’ column indicates only that the company does not have an investment arm organized formally as a separate entity.”⁹⁴

⁹² Stangle Testimony Decl. ¶10 (67 TTABVUE 6).

⁹³ *Id.* at ¶12 (67 TTABVUE 6-7).

⁹⁴ *Id.* at ¶11 (67 TTABVUE 6).

No.	Company	Market Cap (billion USD)	Investment Arm	Description
1	Johnson & Johnson	340.4	Johnson and Johnson Innovation	active investment arm
2	Roche Holding AG	235.5	Roche Venture Fund	active investment arm
3	Merck & Co., Inc.	220.6	MRL Ventures Fund	active investment arm
4	Novartis Inc.	205.5	Novartis Venture Fund	active investment arm
5	Pfizer Inc.	201.1	Pfizer Ventures	active investment arm
6	Novo Nordisk A/S	125.2	Novo Ventures/Novo Seeds	two active investment arms
7	Amgen, Inc.	124.4	Amgen Ventures	active investment arm
8	AstraZeneca PLC	116.5	MedImmune Ventures	active investment arm
9	Sanofi S.A.	112.9	Sanofi Ventures	active investment arm
10	Eli Lilly & Co.	110.7	Lilly Ventures/Lilly Asia Ventures	two spun off investment arms
11	GlaxoSmithKline plc	105.1	SR One	active investment arm
12	AbbVie, Inc.	99.1	AbbVie Ventures	active investment arm
13	Gilead Sciences, Inc.	81.4	_____	N/A
14	Bristol-Myers Squibb Company	79.2	_____	N/A
15	CSL Limited*	71.9	_____	N/A
16	Celgene Corporation	69.0	_____	N/A
17	Takeda Pharmaceutical Company Limited	55.2	Takeda Ventures	active investment arm
18	Merck KGaA*	47.4	M Ventures	active investment arm
19	Illumina, Inc.	46.2	Illumina Ventures	active investment arm
20	Vertex Pharmaceuticals Incorporated	45.8	_____	N/A

• Opposer ‘is well known among investors and others in the investment community for making investments.’⁹⁵

Finally, Opposer introduced copies of use-based, third-party registrations covering the goods and services in Applicant’s description of services and Opposer’s description of goods and services. Third-party registrations based on use in commerce that individually cover a number of different goods and services may have probative value to the extent that they serve to suggest that the listed goods and services are of a type

⁹⁵ *Id.* at ¶22 (67 TTABVUE 10).

that may emanate from the same source. *Country Oven*, 2019 USPQ2d 443903, *8; *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988). We list below the relevant registrations, with relevant portions of the identifications of goods and services.⁹⁶

Mark	Reg. No.	Goods and Services
AMGEN (owned by Amgen Inc.)	3226919	A full line of pharmaceuticals
AMGEN VENTURES (owned by Amgen Inc.)	3942123	Venture capital services, namely, providing financing to start-up companies; venture capital advisory services
JOHNSON & JOHNSON (owned by Johnson & Johnson)	1477368	Sports adhesive tape and blister dressings
JOHNSON & JOHNSON INNOVATION (owned by Johnson & Johnson)	5617947	Providing financing to entrepreneurs, start-ups and existing businesses
LILLY (owned by Eli Lilly and Company)	1318867	A full line of pharmaceuticals
LILLY VENTURES (owned by Eli Lilly and Company)	5826948	Venture capital financing; venture capital services, namely, providing financing to seed and early stage companies; venture capital advisory, financing, funding and fund management services

Opposer has established a tenuous nexus between manufacturing and selling pharmaceuticals and investment advisory services and investment management by showing that it is common for large pharmaceutical companies to invest in innovative

⁹⁶ 70 TTABVUE. We did not include the registrations owned by Merck Sharp & Dohme (Registration No. 2169031 for the mark MERCK and Registration No. 5499038 for the mark MRL VENTURES FUND) and Novartis AG (Registration No. 4986124 for the mark NOVARTIS and Registration No. 4857256 for the mark NVF) because they are for different marks.

companies and technologies in the healthcare industry if for no other reason to expand their own research and development capabilities for pharmaceuticals.

As noted above, Opposer is an active participant in the investment advisory and investment management fields, as are other pharmaceutical companies, by attending and presenting at numerous healthcare investment conferences attended by representatives of emerging companies, technology developers, healthcare leaders, and members of the investment community.

Thus, even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.

Recot, 54 USPQ2d at 1898 (finding the Board erred when it refused to consider the lay evidence that several large companies produce and sell both pet and human food in deciding whether a consumer would reasonably believe that FIDO LAY dog treats originated from the same source as FRITO-LAY human snacks). *See also In re Malletier*, 777 Fed. Appx. 984, 2019 USPQ2d 249385, *4 (Fed. Cir. 2019) (“Goods need not be identical or similar in kind to be related. Instead, what matters is whether ‘the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] emanate from the same source.’”) (quoting *Coach Servs.*, 101 USPQ2d at 1722). Likewise, in the cases before us, the evidence shows that several large companies manufacture and sell pharmaceuticals as well as invest in start-up and emerging healthcare companies. *See Faberge, Inc. v. Haw Par Bros., Int’l Ltd.*, 216 USPQ 861, 863 (TTAB 1983) (finding that specifically different goods

are commercially related based on testimony that companies manufacture and sell drugs, as well as products in the cosmetic, toiletry and fragrance field).

We find that Applicant's "investment advisory services" and "investment management" and Opposer's pharmaceuticals are related.

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

We turn now to the channels of trade and classes of consumers.⁹⁷ Opposer describes its channels of trade for its pharmaceuticals as follows:

Most of [Opposer's] pharmaceutical products are distributed in the United States exclusively through wholesale channels.⁹⁸ A few products [e.g., Letairis® (ambrisentan) and Cayston® (aztreonam for inhalation solution)] are distributed exclusively by specialty pharmacies that dispense medications for complex or chronic conditions that require significant patient education.

[Opposer's] investigational new pharmaceuticals are distributed to patients in the United States who have enrolled in Gilead-sponsored clinical trials.

[Opposer's] cell therapy treatment services are distributed through treatment centers that collect a patient's T-cells, which are sent to a manufacturing center in El Segundo, California before being sent back to the treatment center for use with the patient.

⁹⁷ Because Opposer did not plead its claim of likelihood of confusion based on its use of GILEAD as a trade name or trademark in connection with financial or investment-related services and because the parties did not try that claim by express or implied consent, we do not consider the channels of trade or classes of consumers to whom Opposer markets those activities.

⁹⁸ See also Opposer's response to Applicant's request for admission No. 27 (79 TTABVUE 34) (Opposer sells and distributes most of its products in the U.S. exclusively through the wholesale channel) and No. 28 (79 TTABVUE 34-35) (Opposer's product sales to wholesalers McKesson Corporation, AmerisourceBergen Corporation, and Cardinal Health, Inc. combined form approximately 89% of Opposer's product sales in the U.S.).

[Opposer's] informational, awareness, grant-related, sponsorship and other services are provided online and in person.

[Opposer's] investment-related services are provided on an opportunity-by-opportunity basis.⁹⁹

Opposer advertises its mark as follows:

[Opposer] advertises in print media, including as newspapers and magazines of general circulation (such as *People* magazine) and print media focused on health care issues or directed toward health care professionals, on television, and on the internet. In addition, [Opposer] has sponsored numerous events and activities and hosted booths at events and activities, including events of general interest and events more particularly directed to health care professionals and people interested in therapeutic areas where [Opposer] has developed or is researching treatments. Lastly, [Opposer] promotes its products through direct field contact with physicians, hospitals, clinics and other healthcare providers.¹⁰⁰

Accordingly, Opposer's pharmaceuticals are offered through wholesale channels, specialty pharmacies, patients in clinical trials, and treatment centers specializing in cell therapy. The classes of customers include physicians, hospitals, clinics and other healthcare providers. Opposer's advertising also reaches ordinary consumers presumably so they can ask their doctor if a specific pharmaceutical treatment may be appropriate for them.

As noted above, we presume that Applicant's unrestricted "investment advisory services" and "investment management" include all types of investment advisory,

⁹⁹ Opposer's response to Applicant's interrogatory No. 12 (79 TTABUE 7-8).

¹⁰⁰ Opposer's response to Applicant's interrogatory No. 10 (79 TTABUE 6-7).

management services, and all types of investors regardless of their income, wealth, or sophistication.

Opposer did not introduce any testimony or evidence showing a nexus or connection between the parties' channels of trade and classes of consumers such that we might find that Opposer's pharmaceuticals and Applicant's "investment advisory services" and "investment management" will be encountered by the same consumers in the same marketing milieu. This absence of convergent marketing channels, competition, and classes of consumers decreases the likelihood of confusion. Thus, Opposer failed to meet its burden of proving that the parties market their goods and services in the same channels of trade to the same classes of consumers.

E. Conditions under which the parties make sales.

We now turn to the conditions under which the parties make sales (i.e., the degree of consumer purchasing care). While Applicant's hedge fund clients may be sophisticated consumers, there is no testimony or evidence regarding the purchasing process and the degree of consumer purchasing care for Applicant's unrestricted "investment advisory services" or "investment management" which the description of services dictates may be rendered to less affluent clients. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the "least sophisticated consumer in the class"). Neither is there any testimony or evidence regarding the purchasing process and degree of consumer purchasing care for Opposer's pharmaceuticals.

Nonetheless, we may assume that entities that purchase pharmaceuticals exercise a high degree of purchasing care by virtue of the nature, complexity and purpose of the pharmaceutical products. However, we do not know whether those purchasers focus on Opposer's product names (e.g., Viread®, Atripla®, Truvada®, etc.) or Opposer's GILEAD mark. For example, when Opposer's advertising reaches ordinary consumers presumably so they can ask their doctor if a specific pharmaceutical treatment may be appropriate for them, there is no testimony or evidence regarding whether the ordinary consumer inquires about a specific drug or a specific drug manufactured by a specific company (e.g., Viread or Viread by Gilead).

Opposer failed to meet its burden of proving that the factor regarding the conditions under which the parties make sales weighs in favor of finding a likelihood of confusion and, thus, we find that this *DuPont* factor is neutral.

F. Instances of confusion.

1. Purported instances of confusion.

Opposer introduced testimony and evidence regarding four purported instances of confusion:

- The CentralCharts website (centralcharts.com) entries for Opposer, Gilead Sciences, reported that "Gilead Capital [Applicant] Expresses Grave Concerns with Monotype Proxy Statement and Highlights Board's Failure to Protect Shareholders'

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Interests” (August 28, 2019)¹⁰¹ and “Gilead Capital Sends Open Letter to Board of Monotype Imaging Holdings Opposing Sale To HGGC.” (August 20, 2019).¹⁰²

- The Reuters website

(global.factiva.com/hp/printsaves.aspx?pp=Pring&hc=Publication) corrected a posting where it incorrectly “coded” Applicant for Opposer.

Dec 19 [2016] (Reuters) – Alerts on Landauer Inc. commenting on Gilead Capital LP’s [Applicant] nomination of directors was wrongly coded to Gilead Sciences Inc. [Opposer], an unrelated company. For the correct alerts, click.¹⁰³

- In a March 14, 2017 email exchange between Applicant and Manako Ihaya, a certified Japanese translator in Foothill Ranch, California, preparing for a telephone conference, Ms. Ihaya wrote, “Just curious, I’ve worked with Gilead Sciences [Opposer] before, so I had assumed that you were associated.”¹⁰⁴

- A representative of an institutional investor approached Jeffrey Strong, Applicant’s Managing Partner, at the Santangel’s Investment Conference and inquired whether Applicant has any association with Opposer.¹⁰⁵ The representative

¹⁰¹ 71 TTABVUE 256. “CentralCharts is a social network and an information portal on the financial markets for traders and investors.” 71 TTABVUE 264.

¹⁰² 71 TTABVUE 257.

¹⁰³ 71 TTABVUE 265.

¹⁰⁴ Strong Discovery Dep., pp. 143-144 (73 TTABVUE 110-111); Stangle Testimony Decl. ¶32 and Exhibit OTX67 (67 TTABVUE 14 and 68 TTABVUE 11). Opposer designated Exhibit OTX 67 confidential.

¹⁰⁵ Strong Discovery Dep., pp. 136-142 (73 TTABVUE 103-109).

of the institutional investor did not explain why he thought there might be an association.¹⁰⁶

These purported instances of confusion are not particularly probative because they are too lacking in detail to demonstrate actual confusion. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 614 F.2d 757, 204 USPQ 697, 701 (CCPA 1980) (“Actual confusion is entitled to great weight but only if properly proven. ... Such is not the case here.”); *Mini Melts*, 118 USPQ at 1475 (“Without direct testimony from these individuals, there is insufficient information to ascertain what they were thinking, or what caused the purported confusion.”); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992) (inquiries as to corporate affiliations is not evidence of confusion because, without more, they “indicate that these persons were aware that [the companies at issue] were two different entities”); *Kraft, Inc. v. Balin*, 209 USPQ 877, 882 (TTAB 1981) (it is necessary to fully probe the circumstances surrounding a purported instance of confusion to learn whether it sheds any light on what may normally be expected to occur in the marketplace). *Compare Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 186 USPQ 73, 74 (5th Cir. 1975) (actual confusion evidenced by testimony of four individuals). In these cases, Opposer did not call any of the individuals who were purportedly confused as witnesses to explain why they thought Opposer and Applicant were associated. In addition, inquiries as to whether Applicant and Opposer are associated do not necessarily prove that the inquirers were confused. *See Mini Melts*, 118 USPQ at 1475.

¹⁰⁶ *Id.* at p. 141 (73 TTABVUE 108).

While the testimony and evidence falls short of proving actual confusion, it does reinforce our finding that the marks are similar because the similarity of the marks form the basis of the inquiries or errors.

2. Opposer's confusion consumer survey.

Opposer introduced a likelihood of confusion survey to determine whether relevant consumers who encounter the GILEAD CAPITAL marks are likely to believe the marks identify Opposer or a company affiliated or otherwise connected to Opposer.¹⁰⁷ We may regard a properly conducted survey as evidence akin to actual confusion. *See Blue Cross and Blue Shield Ass'n v. Harvard Comty. Health Plan Inc.*, 17 USPQ2d 1075, 1078 n.7 (TTAB 1990) (citing 2 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION, Section 32:54 at page 783 (2d ed. 1984) ("Survey results are generally classified as evidence of actual confusion ...").

Professor McCarthy more recently opined that survey evidence is not direct evidence of actual confusion but circumstantial evidence from which we may infer likelihood of confusion.

As discussed previously, survey evidence is circumstantial, not direct, evidence of the likelihood of confusion. Surveys do not measure the degree of actual confusion by real consumers making mistaken purchases. Rather, surveys create an experimental environment from which we can get useful data from which to make informed inferences about the likelihood that actual confusion will take place. Direct evidence of actual confusion can come only from such sources as misdirected phone calls or letters or even from that rarest of evidence, the testimony of someone willing to testify that they were once a confused customer.

¹⁰⁷ Pittaoulis Testimony Decl. ¶6 (66 TTABVUE 3).

6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:184 (5th ed. 2021). Thus, a properly conducted survey is circumstantial evidence from which we may infer a likelihood of confusion. *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1247 (TTAB 2015) (“Survey results may act as circumstantial evidence of likelihood of confusion, if the survey is designed and conducted using generally-accepted principles and methodology.”).

Opposer introduced testimony about and evidence of a survey conducted by NERA Economic Consulting, under the direction of Dr. Pittaoulis.¹⁰⁸ According to her testimony, Dr. Pittaoulis oversaw an online survey “using a variant of the ‘Squirt’ methodology,”¹⁰⁹ conducted “in accordance with accepted survey research principles such as those listed in the Federal Judicial Center’s *Manual for Complex Litigation* and described in the *Reference Manual on Scientific Evidence*,” “including practices such as defining the relevant population, selecting a representative sample, employing a control group, asking non-leading questions, and analyzing the data properly.”¹¹⁰

Dr. Pittaoulis “conducted the survey using Dynata, a leading market research firm that specializes in sampling and survey data collection.”¹¹¹ She designed and conducted a double-blind survey. The survey respondents did not know the purpose of the survey, the context in which she would use the survey data, or the company

¹⁰⁸ Pittaoulis Testimony Decl. (66 TTABVUE).

¹⁰⁹ *Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 207 USPQ 897, 899 n.4 (8th Cir. 1980).

¹¹⁰ Pittaoulis Testimony Decl. ¶¶8 and 15 (66 TTABVUE 4 and 6-7).

¹¹¹ *Id.* at ¶16 (66 TTABVUE 7).

who had engaged NERA to collect the data. Although the project managers at Dynata knew that she would use the survey data in a legal proceeding, they did not know the issue in dispute or the parties involved.¹¹²

Applicant's clients and prospective clients form the basis or the universe of survey respondents, including potential customers for hedge fund services, investment advisory services, investment management.¹¹³

To qualify for the survey, respondents had to indicate that in the last 12 months or in the next 12 months they either engaged or intend to engage in investing in a hedge fund, participating in a commodity pool, enter into a commodities or futures contract, purchase or trade securities, such as stocks, bonds, or options, or use the services of an investment management or investment advisory company. In addition, respondents were required to have annual household incomes of at least \$300,000.¹¹⁴

"A total of 627 respondents completed the survey."¹¹⁵ Dynata randomly assigned the respondents to a test group or one of two control groups.¹¹⁶ "Each of the three groups had 209 respondents."¹¹⁷ Dynata showed the test group the mark GILEAD CAPITAL and the list of activities comprising Applicant's description of services.¹¹⁸ Dynata then showed the test group respondents the names GILEAD SCIENCES,

¹¹² *Id.* at ¶18 (66 TTABVUE 7).

¹¹³ *Id.* at ¶20 (66 TTABVUE 7-8).

¹¹⁴ *Id.* at ¶¶21-22 (66 TTABVUE 8).

¹¹⁵ *Id.* at ¶9 (66 TTABVUE 4). *See also id.* at ¶65 (66 TTABVUE 20).

¹¹⁶ *Id.* at ¶¶9 and 25 (66 TTABVUE 4 and 9).

¹¹⁷ *Id.* at ¶9 (66 TTABVUE 4). *See also id.* at ¶65 (66 TTABVUE 20).

¹¹⁸ *Id.* at ¶27 (66 TTABVUE 10).

BOSTON SCIENTIFIC, GENESIS HEALTHCARE, and QUEST DIAGNOSTICS one at a time in a randomized order with a description of services associated with each name as shown below:¹¹⁹

TRADEMARK	DESCRIPTION OF GOODS OR SERVICES
<p style="text-align: center;">GILEAD SCIENCES</p>	<ul style="list-style-type: none"> • Pharmaceutical preparations, namely pharmaceuticals for the treatment of viral infections, cardiovascular disorders and conditions, respiratory disorders and conditions, fungal diseases and disorders, liver disease, HIV/AIDS and hepatitis • Pharmaceutical preparations, namely, antivirals, antifungals and preparations for the treatment of infectious conditions • Financial sponsorship of sports, educational and entertainment programs and events • Pharmaceutical preparations for the treatment of viral diseases, such as AIDS, Herpes, and Human Papilloma virus, and cancers, for professional medical use.
<p style="text-align: center;">BOSTON SCIENTIFIC</p>	<ul style="list-style-type: none"> • Name for full line of medical and surgical instruments and apparatus, and parts therefore
<p style="text-align: center;">GENESIS HEALTHCARE</p>	<ul style="list-style-type: none"> • Management of geriatric care facilities, primary care clinics, rehabilitation agencies, home healthcare agencies and retirement communities; • Business management and consultation • Healthcare services, namely, providing geriatric care facilities, primary care medical clinics, rehabilitation agencies, home health care services and retirement communities
<p style="text-align: center;">QUEST DIAGNOSTICS</p>	<ul style="list-style-type: none"> • Clinical testing information services for the diagnosis, monitoring and treatment of disease

¹¹⁹ *Id.* at ¶¶32-32 (66 TTABVUE 10-11).

After the test group respondents viewed a name, Dynata asked each respondent “Do you think this company is the same company or a different company than the one whose name and description you were shown first, or do you not know?”¹²⁰

For test group respondents who said the same company, Dynata asked them “What makes you think that this company is the same company as the company whose name and description you were first shown?”¹²¹

For test group respondents who said a different company or don’t know, Dynata asked those respondents “Do you think this company is associated or connected with the company whose name and description you saw first, or is not associated or connected with the company whose name and description you were shown first, or do you not know?”¹²²

For those respondents who selected associated or connected, Dynata asked them “What makes you think that this company is connected or affiliated with the company whose name and description you saw first?”¹²³

“Respondents completed this same series of questions for each of the four names (i.e., GILEAD SCIENCES, BOSTON SCIENTIFIC, GENESIS HEALTHCARE, and QUEST DIAGNOSTICS).”¹²⁴

¹²⁰ *Id.* at ¶34 (66 TTABVUE 11-12).

¹²¹ *Id.* at ¶37 (66 TTABVUE 13).

¹²² *Id.* at ¶39 (66 TTABVUE 13).

¹²³ *Id.* at ¶41 (66 TTABVUE 14).

¹²⁴ *Id.* at ¶42 (66 TTABVUE 14).

Dynata asked the respondents in Control Group 1 and Control Group 2 the same series of questions. However, instead of GILEAD CAPITAL, Dynata showed Control Group 1 GILEAN CAPITAL and Control Group 2 BOSTON CAPITAL as the first mark.¹²⁵

According to the survey results as interpreted by Dr. Pittaoulis,

36.8% of the Test Group respondents believed that GILEAD SCIENCES was *either* the same company *or* an affiliate of GILEAD CAPITAL, while only 21.5% of Control Group #1 respondents believed that GILEAD SCIENCES was *either* the same company *as or* an affiliate of GILEAN CAPITAL. This leaves a net confusion rate of 15.3 percent.¹²⁶

As a point of reference, Dr. Pittaoulis found,

[T]he share of Control Group # 2 respondents who experienced some form of either source confusion or

¹²⁵ *Id.* at ¶¶44-57 (66 TTABVUE 14-18).

¹²⁶ *Id.* at ¶86 (66 TTABVUE 30). *See also id.* at ¶66 (66 TTABVUE 20).

Dr. Pittaoulis concluded 20.6% of the Test Group believed GILEAD CAPITAL was the same company as GILEAD SCIENCES, 13.9% of Control Group 1 believed GILEAN CAPITAL was the same company as GILEAD SCIENCES, yielding a net source confusion rate of 6.7%. *Id.* at ¶¶10(a) and 68-69 (66 TTABVUE 4-5 and 21).

She concluded 32.5% of the Test Group believed GILEAD CAPITAL was associated or connected to GILEAD SCIENCES, 17.7% of Control Group 1 believed GILEAN CAPITAL was associated with or connected to GILEAD SCIENCES, yielding a net source confusion rate of 14.8%. *Id.* at ¶¶10(b) and 78-79 (66 TTABVUE 5 and 26-27).

Finally, she concluded 36.8% of the Test Group believed that GILEAD CAPITAL was either the same company as or an affiliate of GILEAD SCIENCES, 21.5% of Control Group 1 believed that GILEAN CAPITAL was either the same company as or an affiliate of GILEAD SCIENCES, yielding a net overall confusion rate of 15.3%. *Id.* at ¶¶10(c) and 85-86 (66 TTABVUE 5 and 29-30).

Presumably, the 36.8% of the Test Group who believed GILEAD CAPITAL was either the same company as or an affiliate of GILEAD SCIENCES is a combination of the 20.6% of the Test Group who believed GILEAD CAPITAL was the same company as GILEAD SCIENCES and the 32.5% of the Test Group who thought GILEAD CAPITAL was an affiliate of or connected to GILEAD SCIENCES.

affiliate confusion between BOSTON SCIENTIFIC and BOSTON CAPITAL was 10.5 percent.¹²⁷

The 15.5% confusion rate is within the range of percentages the Board and courts have found probative. *See Miles Labs., Inc. v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1462 (TTAB 1986) (18% corroborates finding of likely confusion) (citing *James Burrough, Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555, 565 (7th Cir. 1976) (15%); *Lon Tai Shing Co. v. Kock + Lowy*, 19 USPQ2d 1081, 1097 (S.D.N.Y. 1991) (survey result of 18% confusion is "within the range of cognizable confusion recognized in this Circuit"); *Jockey Int'l, Inc. v. Burkard*, 185 USPQ 201 (S.D. Cal. 1975) (11.4%); *McDonough Power Equip., Inc. v. Weed Eater, Inc.*, 208 USPQ 676, 683 (TTAB 1981) (11%)).

Nevertheless, we must consider the survey results in light of an evaluation of the survey, including the fact that the stimulus cards lack marketplace reality. *Miles Labs.*, 1 USPQ2d at 1457 and 1462.¹²⁸ For example, when Dynata showed the survey respondents a stimulus card with the name "Gilead Capital" and list of services and "Gilead Sciences" with a list of products and services rather than how they might appear in actual use (e.g., on pharmaceutical bottle or a prospectus for an investment).

¹²⁷ *Id.* at ¶88 (66 TTABVUE 31).

¹²⁸ Professor McCarthy notes "survey numbers that go below 20% need to be carefully viewed against the background of other evidence weighing for and against a conclusion of likely confusion." 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:188

In addition, Dr. Pittaoulis did not testify about the sampling error derived from a sample size of 209. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1831 n.23 (TTAB 2015) (“[A] confidence interval may be useful in considering survey results (at least when a random sample is chosen), particularly when the sample size is somewhat small.”) (citing *Daubert v. Merrill Dow Pharm., Inc.*, 509 U.S. 579, 594 (1993) (“[I]n the case of a particular scientific technique, the court should ordinarily consider the known or potential rate of error.”) and *Avon Prods., Inc. v. S.C. Johnson & Son, Inc.*, 32 USPQ2d 1001, 1006 (S.D.N.Y. 1994) (not reported in F. Supp.) (“[O]ne must employ statistical confidence tests when making a claim regarding the projectability of a sample or survey result in order to infuse that result with any meaning.”)). For example, if the sampling error derived from a sample size of 209 is over 5% then as much as 20.5% of the population may be confused or as little as 10.5% of the population may be confused.

Applicant objects to the testimony of Dr. Pittaoulis and the likelihood of confusion consumer survey she introduced.

Dr. Pittaoulis’ opinions are inadmissible under Federal Rules of Evidence 401, 403, and 702 because (i) her opinions do not address the legal issues in the case; (ii) are not the product of reliable principles and methods because she used the wrong survey design; and (iii) are based on insufficient facts or data because she failed to survey the relevant population.¹²⁹

First, Applicant contends that Dr. Pittaoulis did not test the marks at issue in these proceedings because she used GILEAD SCIENCES instead of GILEAD, the

¹²⁹ Applicant’s Brief, p. 40 (86 TTABVUE 49).

mark in Opposer's pleaded registrations, and she did not include Applicant's mark GILEAD CAPITAL LEADERSHIP IN INVESTING and design. Opposer's use of GILEAD SCIENCES rather than GILEAD is a harmless error. Opposer's GILEAD mark is closer to Applicant's GILEAD CAPITAL mark than GILEAD SCIENCES because the word "Sciences" is an additional difference in the marks. The survey respondents are more likely to distinguish GILEAD SCIENCES from GILEAD CAPITAL than distinguish GILEAD from GILEAD CAPITAL. Thus, the use of GILEAD SCIENCES in lieu of GILEAD benefits Applicant.

As noted above, we found GILEAD and GILEAD CAPITAL to be the dominant parts of Applicant's mark GILEAD CAPITAL LEADERSHIP INVESTING and design. Nevertheless, GILEAD CAPITAL LEADERSHIP INVESTING and design is different from GILEAD CAPITAL. There are more points of difference between GILEAD CAPITAL LEADERSHIP INVESTING and design and GILEAD SCIENCES than between GILEAD CAPITAL and GILEAD SCIENCES. We would be speculating if we drew any inferences from the survey results using GILEAD CAPITAL instead of GILEAD CAPITAL LEADERSHIP INVESTING and design. Accordingly, we will not further consider the survey in our likelihood of confusion analysis in connection with the GILEAD CAPITAL LEADERSHIP INVESTING and design mark.

Second, Applicant contends that Opposer should have used the *Eveready* methodology¹³⁰ instead of the *Squirt* survey design.¹³¹ The *Eveready* methodology “more accurately approximates market conditions by ensuring that respondents are not made artificially aware of the other party’s trademark.”¹³² The *Squirt* survey design is appropriate in the following circumstances:

(i) accessibility of the senior mark in memory is low to non-existent; and (ii) the brands exist together in the market or one mark is typically encountered soon after the other. “The second criterion is necessary because, if the products are not competing or complementary goods/services with identical or substantially overlapping consumers, then respondents who report a ‘connection’ due to the ‘similarity of names’ are ‘demonstrating merely that they had read the names . . . in artificially close proximity.’” *Hypnotic Hats, Ltd. v. Wintermantel Enters., LLC*, 335 F. Supp. 3d 566, 596-97 (S.D.N.Y.).¹³³

According to Applicant, because Opposer claims its GILEAD mark is famous and because there is no evidence that the parties offer their goods and services in the same channels of trade to the same classes of consumers, the Board should reject Opposer’s use of the *Squirt* survey format.¹³⁴

¹³⁰ *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623, 640-41 (7th Cir. 1976) (unaided survey questions where survey respondents were shown accused mark and were asked who made the product and what other products that company put out, all without showing or asking consumers about plaintiff’s mark).

¹³¹ *Squirtco v. Seven-Up Co.*, 207 USPQ at 899 n.4 (aided survey questions where survey respondents were shown the parties’ marks together and asked whether they thought the two products were put out by the same companies or different companies and what made the respondents think that the products were put out by the same or different companies).

¹³² Applicant’s Brief, p. 42 (86 TTABVUE 51) (citing *Kargo Global, Inc. v. Advance Magazine Publishers, Inc.*, No. 06 CIV 550 JFK, 2007 WL 2258688, at *8 (S.D.N.Y. Aug. 6, 2007)).

¹³³ Applicant’s Brief, p. 42 (86 TTABVUE 51).

¹³⁴ Applicant’s Brief, p. 42 (86 TTABVUE 51).

Applicant's objection goes to the probative value we should give Opposer's survey rather than to admissibility. As we noted above, we evaluate the survey methodology and its results, including the fact that the stimulus cards lack marketplace reality, and the other evidence weighing for and against finding a likelihood of confusion. In this regard, Professor McCarthy advises, "[t]he 'Eveready' format is especially useful when the senior mark is readily recognized by buyers in the relevant universe."

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§ 32:174. In addition,

The "Squirt" survey method will often produce different results from the "Eveready" format for the same contesting marks. For a senior user's mark that is not readily identified by survey respondents, a Squirt survey is more likely to produce a higher level of perception that the marks identify the same or related sources.

Id. at § 32:174.50. *See also Nat'l Distillers Prods. Co., LLC v. Refreshment Brands, Inc.*, 198 F.Supp.2d 474, 482-484 (S.D.N.Y. 2002) (an Eveready-type survey showed a zero level of confusion while a Squirt-type survey showed a 38% level of confusion of affiliation.).

On the one hand, Opposer alleges that its mark is famous but, on the other hand, Opposer introduces a likelihood of consumer survey better suited where its mark is not readily recognizable by the relevant public. In addition, because Dynata shows the survey respondents both marks, the *Squirt*-style survey presents a side-by-side comparison of the marks when there is no testimony or evidence that Applicant's "investment advisory services" and "investment management" and Opposer's pharmaceutical products are offered for sale on a side-by-side basis.

Finally, Applicant objects to Opposer's likelihood of confusion survey because the universe of respondents is not accurate.

Applicant's potential clients are persons who are "accredited investors," "qualified clients," and/or "qualified purchasers," and thus the pool of consumers for Applicant's Services includes institutional investors and certain high-net-worth individuals. ... Furthermore, respondents were not asked about their incomes, either alone or combined with their spouses, for *each of the two most recent years* and whether they had a reasonable expectation of reaching the same income level in the current year so as to qualify as "accredited investors." They were not asked whether they owned more than \$5,000,000 in investments for "qualified purchaser" status, nor were they asked if they would have at least \$1,000,000 under the management of an investment advisor so as to be "qualified clients." ...

Even if Dr. Pittaoulis had properly screened for natural persons who were potential consumers of Applicant's Services, her survey should still be rejected as being unrepresentative because it excludes institutional investors entirely.¹³⁵

As discussed in the analysis of the similarity or dissimilarity and nature of the goods and services, we presume Applicant's "investment advisory services" and "investment management" include all types of investment advisory, management services, and all types of investors regardless of their income, wealth, or sophistication. Thus, the universe of survey respondents is under inclusive.

We sustain Applicant's objections to Opposer's likelihood of confusion survey to the limited extent that we will not consider it in connection with Opposer's claim

¹³⁵ Applicant's Brief, pp. 43-44 (86 TTABVue 52-53).

against Applicant's mark GILEAD CAPITAL LEADERSHIP INVESTING and design. Otherwise, we overrule Applicant's objections.

However, we will not infer there is a likelihood of confusion from Opposer's survey because (i) it does not sufficiently replicate the marketplace, (ii) it presents a side-by-side comparison of the marks when Applicant's services and Opposer's goods and services are not offered for sale on a side-by-side basis, (iii) the survey style is more conducive where Opposer's mark is not famous or commercially strong as we have found it to be here, and (iv) because Opposer did not introduce the sampling error derived from a survey of 209 respondents.

G. Conclusion

Even though Opposer's GILEAD mark is commercially strong, the parties' marks are similar and the parties' goods and services are tenuously related, because Opposer failed to prove the parties' goods and services are offered in the same channels of trade to the same classes of consumers, there is no testimony or evidence that the same consumers will encounter the parties marks and goods and services in the same marketing milieu. In other words, the same consumers will not be exposed to the parties' marks under circumstances likely to give rise to the mistaken belief that the goods and services emanate from the same source. *See In re HerbalScience Grp.*, 96 USPQ2d 1321, 1324 (TTAB 2010) ("Because of the differences in the channels of trade and customers for applicant's and the registrant's goods, there is virtually no opportunity for confusion to arise."). *See also Sheller-Globe Corp. v. Scott Paper Co.*, 204 USPQ 329, 336 (TTAB 1979) (no likelihood of confusion despite applicant's

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extensive commercial use of its mark because, inter alia, differences in trade channels, purchasers, uses of the goods, and advertising media). Therefore, we find that Applicant's marks GILEAD CAPITAL, in standard character form, and GILEAD CAPITAL LEADERSHIP INVESTING and design, both for, "hedge fund investment services; investment advisory services; investment management; financial services, namely, operation and management of hedge funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures, derivatives, debt instruments and commodities" is not likely to cause confusion with Opposer's mark GILEAD, in standard character form for pharmaceutical products.

We dismiss Opposer's Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), likelihood of confusion claims as to both marks in both oppositions.

VI. False suggestion of a connection

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), in relevant part, prohibits registration of matter which may...falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols..." As applied to these cases, Opposer must show:

(1) Applicant's marks GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design are the same as, or a close approximation of, the name or identity previously used by another person or institution, in this case Opposer, Gilead Sciences, Inc.;

(2) Relevant consumers will recognize Applicant's marks as such, in that they point uniquely and unmistakably to Opposer;

(3) Opposer is not connected with the services offered by Applicant under the marks; and

(4) The fame or reputation of Opposer is such that, when Applicant uses its marks in connection with Applicant's services, consumers will presume there is a connection with Opposer.

See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 703 F.2d 1372, 217 USPQ 505, 508-510 (Fed. Cir. 1983) (providing the foundational principles for the current four-part test used to determine the existence of a false suggestion of connection). *See also Bd. of Trs. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013); *Petról eos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club Ltd. P'ship v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008)

In determining whether Applicant's marks falsely suggest a connection with Opposer, it is important to keep in mind that the rationale behind the Section 2(a) prohibition differs significantly from the Section 2(d) ground of likelihood of confusion. As Professor McCarthy points out "[t]he issue in a § 2(a) case is not whether consumers would believe that the defendant's goods emanate from the plaintiff [but] whether consumers would falsely assume the goods had some connection with plaintiff." 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:76. While Congress designed likelihood of confusion to protect the public from confusion as to the source of goods or services, the Federal Circuit has noted that the Section 2(a) false suggestion of a connection ground protects different interests:

[T]he rights protected under the § 2(a) false suggestion provision are not designed primarily to protect the public, but to protect persons and institutions from exploitation of their persona.

Bridgestone/Firestone Research Inc. v. Auto. Club de l'Ouest de la France, 245 F.3d 1359, 58 USPQ2d 1460, 1463-64 (Fed. Cir. 2001) (citing to *Univ. of Notre Dame*, 271 USPQ at 508-509 (“[I]t appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy,” even in the absence of likelihood of confusion); *See also In re MC MC S.r.l.*, 88 USPQ2d 1378, 1380 (TTAB 2008).

We turn to the first element. “[T]he similarity required for a ‘close approximation’ is akin to that required for a likelihood of confusion under § 2(d) and is more than merely ‘intended to refer’ or ‘intended to evoke.’” *Bos. Athletic Ass’n v. Velocity, LLC*, 117 USPQ2d 1492, 1497 (TTAB 2015) (citation omitted). For the reasons we articulated for finding Applicant’s marks similar to Opposer’s mark, we find that GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design are close approximations of Opposer’s identity, Gilead Sciences, Inc., particularly because Applicant refers to itself as Gilead, the same as the mark in Opposer’s pleaded registrations (i.e., GILEAD identifies the source of Opposer’s pharmaceuticals).

We now turn to the second element of the false suggestion claim: whether the relevant public will recognize GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING as pointing uniquely and unmistakably to Opposer.

Thus, to show an invasion of one’s “persona,” it is not sufficient to show merely prior identification with the name adopted by another. Nor is it sufficient, as urged by the

University, that the fame of the name of an institution provides the basis for protection in itself. The mark NOTRE DAME, as used by Gourmet, must point uniquely to the University.

Univ. of Notre Dame du Lac, 217 USPQ at 509. *See also Hornby v. Tjx Cos., Inc.*, 87 USPQ2d 1411, 1424 and 1427 (TTAB 2008) (“the name claimed to be appropriated by the defendant must point uniquely to the plaintiff.”). That is, to falsely suggest a connection with Opposer, Applicant’s use of GILEAD CAPITAL in connection with “hedge fund services,” “investment advisory services,” or “investment management” must point uniquely to Opposer.

Applicant’s marks GILEAD CAPITAL and GILEAD CAPITAL LEADERSHIP INVESTING and design do not satisfy this demanding standard. The only commonality between Applicant’s marks and Opposer’s identity is the name “Gilead.” As noted above, “Gilead” refers to a mountain in northwest Jordan or a district in ancient Palestine, east of the Jordan River in present North Jordan.¹³⁶ Opposer uses and registered a shield and leaf logo it refers to as the “Balm of Gilead.”

The leaf symbolizes the Balm of Gilead, a medicinal treatment that was mentioned in the Bible’s Old Testament and named for the region of Gilead, where trees with leaves producing this balm was said to grow. The Balm of Gilead signifies a universal cure and is often accompanied by the image of a tree, shrub, or leaf.¹³⁷

¹³⁶ Dictionary.com based on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2021) (accessed April 1, 2021). *See also* MERRIAM-WEBSTER DICTIONARY (merrriam-webster.com) (accessed April 1, 2021); Gilead, ENCYCLOPAEDIA BRITANNICA (britannica.com) (accessed April 2, 2021) (“Gilead, area of ancient Palestine east of the Jordan River, corresponding to modern northwestern Jordan.”).

¹³⁷ Flood Testimony Decl. ¶¶15-16 (63 TTABVUE 7).

In addition, “Gilead” is a farm community or village in Nebraska that serves as the source for Applicant’s name.¹³⁸

The name “Gilead” is not uniquely associated with Opposer because the name also identifies a region in Jordan, formerly, Palestine, a medicinal treatment originating from Gilead, and a village in Nebraska. *See Univ. of Notre Dame du Lac*, 217 USPQ at 509 (“Notre Dame” is not a name solely associated with the University because “[i]t serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus, it cannot be said that the only ‘person’ which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.”).

We now turn to the fourth element in the false suggestion of a connection claim: whether the fame or reputation of Opposer is such that, when Applicant uses its marks are in connection with Applicant’s services, consumers will presume there is a connection with Opposer. As discussed above, GILEAD is a commercially strong mark and Opposer is and has been a leader in the development of medicines for the treatment and prevention of HIV-1 infection, as well as for the treatment of Covid-19. Nevertheless, Opposer’s likelihood of confusion survey found that only 6.7% of the respondents thought GILEAD CAPITAL is the same company as GILEAD SCIENCES.

As my analysis shows, 20.6 percent of Test Group respondents experienced source confusion and 13.9 percent

¹³⁸ Strong Testimony Decl. ¶¶40-43 (63 TTABVUE 12-13).

of Control Group #1 respondents experienced source confusion, leaving a net confusion rate of 6.7 percent.¹³⁹

Such a de minimis percentage of respondents believing GILEAD CAPITAL is the same company as GILEAD SCIENCES is not compelling evidence that the relevant public will presume there is a connection between GILEAD CAPITAL and Opposer.

Inasmuch Applicant's marks do not point uniquely and unmistakably to Opposer and Opposer has failed to establish that the relevant public will not presume there is a connection between GILEAD CAPITAL and Opposer, the Section 2(a) false suggestion of a connection claim fails and we dismiss the oppositions on that ground.

Decision: The oppositions are dismissed on the Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), claims of likelihood of confusion as to both applications.

The false suggestion of a connection claims under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), are dismissed as to both applications.

¹³⁹ Pittaoulis Testimony Decl. ¶69 (66 TTABVUE 21).