

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Novartis AG
v.
AbbVie Biotechnology Ltd.

Opposition No. 91238564

Maury M. Tepper, III of Tepper & Eyster, PLLC,
for Novartis AG.

Patrick J. Arnold Jr. and Katherine E. Ramlose of McAndrews, Held & Malloy, Ltd.,
for AbbVie Biotechnology Ltd.

Before Bergsman, Ritchie, and Hightower,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On February 1, 2017, AbbVie Biotechnology Ltd. (“Applicant”) applied to register SKYRIZI in standard character form for the goods identified below in International Class 5:¹

Pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological,

¹ Application Serial No. 87320935, filed February 1, 2017 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intent to use the mark in commerce.

gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders.

Novartis AG (“Opposer”) filed an opposition, alleging priority and likelihood of confusion with its prior registered mark IZIRIZE, also in standard character form, for the goods identified below in International Class 5:²

Pharmaceutical preparations for the prevention and treatment of diseases and disorders of the nervous system, the immune system, the cardiovascular system, the metabolic system, the endocrine system, the respiratory system, the musculo-skeletal system and the genitourinary system; pharmaceutical preparations for the prevention and treatment of inflammatory disorders; pharmaceutical preparations for use in dermatology, oncology, hematology and in tissue and organ transplantation, in ophthalmology and for gastroenterological disorders; pharmaceutical preparations for the prevention and treatment of ocular disorders and diseases; pharmaceutical preparations for the prevention and treatment of cancer and tumors; pharmaceutical preparations for the prevention and the treatment of allergies; pharmaceutical preparations for the prevention and treatment of diseases and disorders caused by bacteria, autoimmune diseases and disorders, kidney diseases and disorders, diabetes; antifungal, anti-infective, antiviral preparations and antibiotics.

Applicant denied the salient allegations of the Notice of Opposition, except that Applicant admitted that Opposer owns the pleaded registration, and that based on the registration date, Opposer has priority.³ As discussed below, the parties agreed to conduct this proceeding via Accelerated Case Resolution (“ACR”). In accordance with their approved stipulation, both parties filed briefs.

² Registration No. 4887432, registered on January 19, 2016. Opposer’s application for registration was an extension of protection of an international registration under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

³ 5 TTABVue 2 (paragraphs 3, 4).

I. The Record and ACR Stipulation

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. As noted, the parties agreed to conduct this proceeding via the streamlined process of ACR. The parties submitted to the Board on April 9, 2018 a Stipulated Motion to Approve Accelerated Case Resolution Status.⁴ The stipulation contains, along with a proposed briefing schedule, the following procedural provisions and agreed facts:

Paragraph 1: Witness testimony in the form of affidavits or deposition/trial testimony will not be required in this proceeding.

Paragraph 2: Expert disclosures will not be necessary in this proceeding.

Paragraph 3: Each party will submit a final brief, which will be considered the dispositive motions in this case and will be accepted as such in lieu of a full trial.

Paragraph 4: The Board may resolve any issues of material fact in deciding the Parties' dispositive motions.

Paragraph 5: The goods identified in Opposer's registration for IZIRIZE and the goods in Applicant's application for SKYRIZI are related and overlap in part.

⁴ 6 TTABVUE.

Paragraph 6: The trade channels for the goods in Opposer's registration for IZIRIZE and in Applicant's application for SKYRIZI will be substantially identical.

Paragraph 7: There is no consent agreement in existence between Novartis and AbbVie regarding the marks IZIRIZE and SKYRIZI.

Paragraph 8: Neither IZIRIZE nor SKYRIZI is currently in use in commerce.⁵

Paragraph 9: The Parties agree that the only issue in contention is whether registration of the SKYRIZI mark for use with the goods identified in the application should be refused on the ground that it creates a likelihood of confusion with Opposer's IZIRIZE mark, for the goods identified in Opposer's registration.

The stipulation was approved by the Board on April 11, 2018.⁶ Opposer included with its brief Exhibits A through D, which Applicant agreed are stipulated into the record.⁷ The Exhibits consist of a copy of Opposer's pleaded registration (Exhibit A); a copy of Applicant's application (Exhibit B) (which is already of record by operation of Trademark Rule 2.122(b)(1), as noted above); a copy of the stipulated motion (Exhibit C) (previously made of record at 6 TTABVUE and approved by the Board at 7 TTABVUE); and a declaration from Opposer's counsel, including a spreadsheet containing search results for a subset of "trademarks in International Class 5

⁵ As noted above, Opposer's registration for the mark IZIRIZE issued January 19, 2016 under Section 66(a) of the Trademark Act.

⁶ 7 TTABVUE.

⁷ 9 TTABVUE 6.

containing the letter string ‘RIZ’ in connection with goods containing the word ‘pharmaceutical.’”⁸

Applicant did not introduce any additional testimony or evidence.

II. Standing and Priority

To have standing, a plaintiff must have a real interest, *i.e.*, a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999). Applicant has admitted that Opposer’s mark is registered, and that this establishes Opposer’s priority.⁹ We therefore find that Opposer has established its standing and priority in this proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King’s Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

III. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the relevant, probative evidence in the record related to a likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d

⁸ 8 TTABVUE 26.

⁹ 5 TTABVUE 2.

1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard 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.”). We discuss the *du Pont* factors for which there is relevant argument and evidence.

A. Goods, Channels of Trade, and Classes of Consumers

As noted above, the parties agreed by stipulation that the goods “are related and overlap in part.”¹⁰ They further agreed that “[t]he trade channels for the goods in Opposer’s registration for IZIRIZE and in Applicant’s application for SKYRIZI will be substantially identical.”¹¹ Therefore, the second and third *du Pont* factors weigh heavily in favor of finding a likelihood of confusion.

B. The Strength of Opposer’s Mark

Applicant contends that the letter sequence and sound “RIZ,” which is shared by Applicant’s and Opposer’s mark, is entitled to a narrow scope of protection because the term is common in the pharmaceutical industry, and is therefore weak. In this regard, Applicant refers to third-party registrations listed in the spreadsheet that

¹⁰ 6 TTABVUE 3 (paragraph 5).

¹¹ 6 TTABVUE 3 (paragraph 6).

was introduced by Opposer as Exhibit D to Opposer's brief.¹²

The "existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nonetheless, in determining the degree of weakness, if any, in the shared letter sequence "RIZ," the Court of Appeals for the Federal Circuit instructs that "extensive evidence of third-party use and registrations is 'powerful on its face,' even where the specific extent and impact of the usage has not been established." *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Regarding the probative value of third-party registrations for similar marks on similar goods, we also note that third-party registrations may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to both parties' marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is inherently relatively weak. *Jack Wolfskin*, 116 USPQ2d at 1136; *see also In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) ("[T]hird-party registrations are relevant evidence of the inherent or conceptual strength of a mark

¹² Both Opposer and Applicant refer to the third-party registrations as being probative of the sixth *du Pont* factor. However, that factor considers "[t]he number and nature of similar marks in use on similar goods." There is no evidence in this case of any third-party *use*, which would be probative of commercial strength. Rather, as discussed herein, the spreadsheet referencing the third-party registrations is probative of conceptual strength.

or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.”).

As noted above, the spreadsheet referencing the third-party registrations was introduced by Opposer as Exhibit D to its brief. The accompanying declaration from Opposer’s counsel, Kathryn M. Eyster, states that she conducted a “search for trademarks in International Class 5 containing the letter string ‘RIZ’ in connection with goods containing the word ‘pharmaceutical.’”¹³ Ms. Eyster further states that she “filtered out” certain marks that she did not consider to be relevant, and that the remaining 43 marks are set forth on “the attached spreadsheet.”¹⁴ Applicant did not object to the submission of Opposer’s Exhibit D, and referred to it as being of record.

Since Opposer submitted only a spreadsheet, and not copies of registrations, we can only consider it for such probative value as it may have, given the constraints of the information presented. *See, e.g., In re 1st USA Realty Professionals, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) (lacking objection, list is accepted to extent probative); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994) (copy of search report not admissible). We note that of the marks presented in the exhibit, several have the letter sequence “RIZ” in registrations for pharmaceutical products.¹⁵ These marks include: ACARIZAX (owned by ALK-Abello); BACTRIZOLE (owned by Ovidio J. Vides S.A.); BRIZO (owned by SE-Cure Pharma); HORIZANT (owned by Xenoport, Inc.); OBRIZANDA (owned by Glaxo Group Limited); ORIZON (owned by

¹³ 8 TTABVUE 26.

¹⁴ *Id.*

¹⁵ Furthermore, several were registered after Opposer’s registration date.

Voco GmbH); PRIZEMBA (owned by Astrazeneca AB); RIZAPORT (owned by Intelgenx Corp.); RIZIMO (owned by Shionogi & Co., Ltd.); RIZLATET (owned by Akarx, Inc.); RIZOPRAD (owned by Novo Nordisk A/S); RIZUPA (owned by Gilead Sciences); TRIZELL (owned by Trizell Limited); TRIZIVIR (owned by ViiV Healthcare Co.); VARIZIG (owned by Venus Biotherapeutics Sub LLC); VORIZE (owned by ViiV Healthcare); WELTRIZ (owned by Glaxo Group); and the following two marks owned by Opposer: VISPRIZA and RIZARG.

Considering the evidence presented, we find that the letter sequence “RIZ” is a weak source indicator for pharmaceutical products. *See Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674. This weighs against finding a likelihood of confusion.

C. Comparison of the Marks

We thus consider the similarity or dissimilarity of the parties’ marks in their entireties as to appearance, sound, connotation and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014); *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567; *Palm Bay Imps.*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d unpublished*, No. 92-

1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average consumer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average consumer is a physician, pharmacist, or a patient seeking a pharmaceutical to help relieve a specific medical condition.

We find that the marks look different. Applicant's mark starts with the term "SKY" followed by the term or letter string "RIZI." Opposer's mark starts with the letter string IZ or IZI followed by the letter string "RIZE." The lead element of a mark may be perceived as having a position of prominence, and we find that to be the case here. *See 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); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

There is no indication of the meaning of either mark, and Opposer refers to both as being "fanciful."¹⁶ Regarding the pronunciation, our case law dictates that there is no correct pronunciation of a trademark. *StonCor Grp., Inc. v. Specialty Coatings*,

¹⁶ 8 TTABVUE 10.

Inc., 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014) (“There is no correct pronunciation of a trademark that is not a recognized word.”) (citing *In re Belgrade Shoe Co.*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969)); *In re Allegiance Staffing*, 115 USPQ2d 1319, 1325 (TTAB 2015) (no correct pronunciation of mark that is coined term). Nevertheless, the parties agree that there are several possible pronunciations of each mark, although differing as to what those pronunciations are likely to be.¹⁷ Based on typical conventions of pronunciation in English, we find that Applicant’s mark is likely to be pronounced SKĪ RĪZ E or SKĪ RIZ E and Opposer’s mark is likely to be pronounced as EASY RISE or IZZY RISE.

Since the only common element of the marks is the “weak” letter string “RIZ,” we find that the marks are more dissimilar than similar and that the first *du Pont* factor also favors finding no likelihood of confusion.

D. Conditions of Sale

Both Opposer and Applicant have asked us to consider the conditions of sale at issue with their pharmaceutical products. Applicant argues that the likely consumers of the products are prescribing medical professionals and pharmacists, who are sophisticated and are likely to exercise increased care in their purchasing decisions. As argued by Opposer however, we must make our determination based on the least sophisticated consumer, which in this case may include members of the general public who have a medical need for a pharmaceutical product, but who have neither medical nor legal expertise. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163 (affirming that TTAB properly considered all potential investors for recited services, including

¹⁷ 8 TTABVUE 11; 9 TTABVUE 10.

not only sophisticated investors, but also “the least sophisticated potential purchasers”). In particular, as our precedent dictates, where competing medical products are at issue, “there is no reason to believe that medical expertise as to pharmaceuticals will ensure that there will be no likelihood of confusion as to source or affiliation.” *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004) (Further stating, “Courts have noted that drugs are increasingly marketed directly to potential patients through, for example, ‘ask-your-doctor-about-Brand-X’ style advertising [citations omitted].”).

We find this factor to be neutral.

E. Summary

Considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find, consistent with the stipulation of the parties, that the goods are related and overlapping in part and that the channels of trade are substantially identical. Nevertheless, we find that the common element of the mark is weak, and the marks are not similar in appearance, sound or commercial impression. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.”). There is no likelihood of confusion.

Decision: The opposition is dismissed.