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

Proceeding no.	91264008
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IN UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GENZYME CORPORATION, Opposer, v. HILALI NORDEEN, Applicant.	Consolidated Opposition No.: 91264008

OPPOSER'S TRIAL BRIEF

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TREATISE

Opposer, Genzyme Corporation ("Opposer"), owner of the registered RENAGEL trademark, which it has long used on pharmaceuticals, submits this trial brief in support of its opposition against the trademark applications filed by Applicant, Hilali Noordeen ("Applicant"), for the confusingly similar marks REGENAL and REGENALL for pharmaceuticals in Application Serial Nos. 88361290 and 88361302 (the "Applications").

PRELIMINARY STATEMENT

Opposer and its predecessor-in-interest have used, for nearly three decades, the trademark RENAGEL (the "RENAGEL Mark") on and in connection with a prescription drug for the treatment of hyperophosphatemia, a kidney disorder. Applicant recently filed two applications for the trademarks REGENAL and REGENALL (together, "Applicant's Marks") for pharmaceutical treatments for damaged or injured tissue and nutritional supplements. Applicant's Marks are nearly identical and confusingly similar to Opposer's RENAGEL Mark, and the good's covered by Applicant's Marks are highly similar to those covered by the registration for the RENAGEL Mark. The high degree of similarity of the marks and goods strongly supports a finding of likely confusion. In addition, because the goods at issue are pharmaceuticals, the Board should refuse registration to protect the public from any possible confusion between medications, and from the dire effects such confusion could cause.

FACTUAL RECORD

The factual record in the opposition proceeding consists of:

1. Application Serial No. 88361290 for the mark REGENAL (the "REGENAL Application") in International Class 5 for use in connection with "Pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements."

2. Application Serial No. 88361302 for the mark REGENALL (the "REGENALL Application," and, with the REGENAL Application, the "Applications") in International Class 5 for use in connection with "Pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements; none of the aforementioned in relation to the treatment of skin or complexion or in relation to the treatment of livers."

3. Opposer's Notice of Reliance and exhibits attached thereto. (21 TTABVUE.)

4. Opposer's Trial Declaration of Onur Sebzeci, dated April 15, 2022, and exhibits attached thereto. (19-20 TTABVUE.)

5. Applicant's Notices of Reliance and exhibits attached thereto. (22-23 TTABVUE.)

6. Applicant's Trial Declaration of Dr. Hilali Noordeen, dated June 15, 2022. (24-25 TTABVUE.)

7. The other pleadings contained in the Board's file of this proceeding.

STATEMENT OF FACTS

A. Opposer's Business and its RENAGEL Mark

Opposer is a subsidiary of Sanofi, a leading pharmaceutical company that offers a range of pharmaceuticals, both over-the-counter and prescription. (19, 20 TTABVUE ¶¶ 1, 5). Sanofi is a global leader in healthcare, with 73 manufacturing sites in 32 countries, and is a provider of healthcare solutions in more than 170 countries around the world. (*Id.* ¶ 5). Opposer was founded in 1981 and acquired by Sanofi in 2011. It has a presence in approximately 65 countries and sells its products in 90 countries. (*Id.* ¶ 6).

Among Opposer's products is the pharmaceutical RENAGEL (sevelamer hydrochloride). (*Id.* ¶ 7). RENAGEL is a phosphate binding medication used to treat hyperphosphatemia in patients

with chronic kidney disease. Hyperphosphatemia is an electrolyte disorder, which results in elevated levels of phosphate in the patient's blood. When RENAGEL is taken with meals, it binds to dietary phosphate and prevents its absorption. RENAGEL is taken as a tablet, generally three times a day, with meals. The RENAGEL mark has been used continuously by Opposer and its predecessor-in-interest since October 18, 1995, in connection with this phosphate binding medication. (*Id.* ¶¶ 8-9).

B. Consumers and Trade Channels for Goods Offered Under the RENAGEL Mark

The RENAGEL product is sold throughout the United States. (*Id.* ¶ 12). It is sold by prescription through all channels that dispense prescription pharmaceuticals, including chain and independent pharmacies, hospitals, long-term care facilities, and others. (*Id.*). RENAGEL consumers are generally over the age of 40, with a little over half of them being men. (*Id.* ¶ 7).

C. Revenue and Advertising and Promotion for Goods Offered Under the RENAGEL Mark

Opposer's RENAGEL product has brought in more than [redacted] in sales between March 2015 and February 2021. (*Id.*, Ex. F). Opposer promotes its RENAGEL product along with its related RENVELA product through the website *renvela.com* and Sanofi's website, *Sanofi.com*. (*Id.* ¶ 15).

D. U.S. Trademark Registration for the RENAGEL Mark

Opposer owns U.S. Trademark Registration No. 1978935 for the RENAGEL Mark for "phosphate binders for the treatment of hyperphosphatemia" in International Class 5. (*Id.* ¶ 10, Ex. A). This registration is incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065. (*Id.*).

E. Applicant and His Application for REGENAL and REGENALL

Applicant is an individual residing in the United Kingdom who works as a consultant orthopaedic and spinal surgeon. (24 TTABVUE 187, ¶ 2). On March 28, 2019, Applicant filed an application to register the word mark REGENAL for "Pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements" as well as the word mark REGENALL for "Pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements; none of the aforementioned in relation to treatment of skin or complexion or in relation to the treatment of livers," both in International Class 5. Both Applications were filed under Section 44(a) of the Lanham Act, 15 U.S.C. § 1126(a).[1]

Applicant has stated that his goods, which have not yet been used in commerce, will be used in connection with prescription-based drugs that inhibit the formation of scar tissue and turn existing scar tissue into functional tissue. (24 TTABVUE 188, ¶¶ 6,7). Applicant has not explained how he plans to use his REGENALL mark in connection with inhibiting scar tissue, given that he excluded the use of the REGENALL mark on products "in relation to treatment of skin or complexion." Applicant claims that he chose the marks REGENAL and REGENALL because the "regen" component of the marks is meant to evoke the concept of regeneration. (*Id.* ¶ 5).

ARGUMENT

In this opposition, Opposer asserts a claim for likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). (*See* 1 TTABVUE 12.) To prevail on a claim for likelihood of confusion, an opposer must establish standing and then must "prove by a

[1] Pursuant to Trademark Rule of Practice 2.122(b), 37 C.F.R. § 2.122(b), the entire files of the opposed applications are considered part of the record without any action by the parties and reference can be made to any part of the file. *See also* TBMP § 704.03(a).

preponderance of the evidence both priority of use and likelihood of confusion." *Joe Van Gogh, Inc. v. Vincent Van Gogh Café, LLC*, Canc. No. 92063316, 2021 WL 462121, at *6 (T.T.A.B. Feb. 4, 2021) (citing *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1848, 222 F.3d 943, 951 (Fed. Cir. 2000)).

A. Opposer has Standing to Bring this Opposition

As a threshold matter, Opposer must prove that it is entitled to assert the statutory cause of action discussed herein.[2] See *PUMA SE v. Advance Inspiration, LLC*, Opp. No. 91249192, 2021 WL 822669, at *2 (T.T.A.B. Feb. 26, 2021) ("A plaintiff's entitlement to a statutory cause of action under Trademark Act Sections 13 and 14 is a threshold issue that a plaintiff must prove in every Board *inter partes* proceeding."); *A & M Wings, Inc. v. Thompson*, Canc. No. 92064044, 2019 WL 655036, at *1 (T.T.A.B. Feb. 14, 2019) ("Petitioner bears the burden of proving standing as an essential element of its case in chief."). For Opposer to establish its entitlement, it must prove (1) an interest falling within the zone of interests protected by the statute; and (2) a reasonable belief in damage that is caused by registration of Applicant's Marks. *See Corcamore, LLC v. SFM, LLC*, 2020 U.S.P.Q.2d 11277, 978 F.3d 1298, 1303-04 (Fed. Cir. 2020). "Proof of [entitlement to a statutory cause of action] in a Board opposition is a low threshold, intended only to ensure that the plaintiff has a real interest in the matter, and is not a mere intermeddler." *503 Sports LLC v. Nat'l Ass'n of Pro. Baseball Leagues, Inc.*, Opp. No. 91243580, 2021 WL 1904929, at *2 (T.T.A.B. May 6, 2021) (citations omitted) (modification in original).

[2] "[E]ntitlement to bring a statutory cause of action" has previously been referred to as "standing." Despite the change in nomenclature, the Board's prior jurisprudence regarding standing remains "equally applicable." *Hayden v. Worksuites – IP Holdings, LLC*, Opp. No. 91249435, 2021 WL 877789, at *5 (T.T.A.B. Mar. 5, 2021).

As the owner of the RENAGEL Mark, Opposer has a "direct and personal stake" in the outcome of this opposition proceeding and in challenging any applications that seek to register trademarks that are confusingly similar to the RENAGEL Mark, such as Applicant's Marks. *See* TBMP § 309.03(b). Because Opposer introduced in evidence copies of its pleaded registration for the RENAGEL Mark showing the current status and title of the registration (*see* 55 TTABVUE 4-24), Opposer has established its entitlement to assert the statutory cause of action described herein under the Lanham Act. *See, e.g.*, *PUMA*, 2021 WL 822669, at *2 (finding that opposer's properly pleaded registrations establish entitlement to a statutory cause of action on grounds of likelihood of confusion); *Sharadha Terry Prods. Ltd. v. Hilasal USA, Inc.*, Opp. No. 91234957, 2021 WL 462045, at *1 (T.T.A.B. Jan. 15, 2021) (same).

B. Opposer Has Established Priority

To establish priority on a likelihood of confusion claim, an opposer must prove that it owns "a mark or trade name previously used in the United States . . . and not abandoned." 15 U.S.C. § 1052(d). "A party may establish its own prior proprietary rights in a mark through [1] ownership of a prior registration, [2] actual use or [3] through use analogous to trademark use which creates a public awareness of the designation as a trademark identifying the party as a source." *Moon v. Tillman*, Canc. No. 92054016, 2013 WL 5467037, at *4 (T.T.A.B. Sept. 18, 2013). Priority must be established with respect to "the filing date of [the applicant's] underlying application or [the applicant's] proven date of first use (whichever is earlier)." *Periera v. Thompson*, Canc. No. 92066525, 2021 WL 725614, at *5 (T.T.A.B. Jan. 28, 2021).

There is no dispute concerning Opposer's priority. Applicant's Applications both were filed under Section 44(a) of the Lanham Act, 15 U.S.C. § 1126(a). Both applications were first filed in the United Kingdom on March 27, 2019, and Applicant asserts the filing date of its foreign

applications as its priority date. (*See* 24 TTABVUE 198-190.) Here, Opposer has properly pleaded and entered in evidence its trademark registration for the RENAGEL Mark (*see* 19, 20 TTABVUE 7-12), which was registered many years prior to Applicant's priority date. Moreover, although Opposer need not also prove that it is the prior user of the RENAGEL Mark, it nonetheless has submitted ample evidence of its prior use. (*See* 19 TTABVUE 122; 19, 20 TTABVUE ¶ 19.)

Accordingly, Opposer has established priority.

C. Applicant's Marks are Likely to Cause Confusion with Opposer's Mark.

In determining likelihood of confusion, the Board considers the thirteen factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563, 567, 476 F.2d 1357, 1361 (C.C.P.A. 1973)[3]. Importantly, "[n]ot all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Mighty Leaf Tea*, 94 U.S.P.Q.2d 1257, 1259, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *see also Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901, 1903, 889 F.2d 1070, 1073 (Fed. Cir. 1989). There is no

[3] The DuPont factors are: "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing; (5) The fame of the prior mark (sales, advertising, length of use); (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark); (10) The market interface between applicant and the owner of a prior mark [such as a coexistence agreement]; (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; (12) The extent of potential confusion, i.e., whether *de minimis* or substantial; (13) Any other established fact probative of the effect of use." 177 U.S.P.Q. at 567, 476 F.2d at 1361.

mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *DuPont*, 177 U.S.P.Q. at 567, 476 F.2d at 1361.

In this proceeding, the relevant factors are the similarity of the parties' marks; the identity of the parties' goods; the strength of the RENAGEL Mark; lack of evidence of similar marks in use on similar goods; the overlap in trade channels and customers; and the condition of purchase and sophistication of customers. Importantly, "[i]n any likelihood of confusion analysis, *two key considerations are the similarities between the marks and the similarities of the goods*." *In re Am. Branding Agency, Corp*., Ser. No. 88683570, 2021 WL 5028102, at *2 (T.T.A.B. Sept. 29, 2021) (emphasis added) (citing *In re Chatam Int'l Inc.*, 71 U.S.P.Q.2d 1944, 1945, 380 F.3d 1340, 1342 (Fed. Cir. 2004)); *see also In re I.AM.Symbolic, LLC*, 123 U.S.P.Q.2d 1744, 1747, 866 F.3d 1315, 1322 (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*." (citations and internal quotation marks omitted) (emphasis added)). Here, both dispositive factors – namely, similarity of the parties' marks and similarity of the parties' goods – weigh strongly in favor of likelihood of confusion.

Further, "where the marks are used on pharmaceuticals and confusion as to source can lead to serious consequences, it is extremely important to avoid that which will cause confusion." *Alfacell Corp. v. Anticancer, Inc.*, 71 U.S.P.Q.2d 1301, 1306 (T.T.A.B. 2004). Thus, in the case at hand, where confusion between the products could lead to harmful results, the board applies a lower threshold in deciding whether there is a likelihood of confusion. *See, e.g.*, *Merck & Co. v. Abbott Lab'ys*, 210 U.S.P.Q. 605, 607 (T.T.A.B. 1981) ("And where, as here, marks are used in connection with pharmaceutical preparations and, in particular, prescription items, the degree to which a subsequently used mark may approach a previously used mark is narrowly drawn to

assure that a situation cannot arise that could, because of the identity of the marks, lead individuals to take one product in lieu of the desired or prescribed product, with harmful or dangerous results.").

Moreover, in analyzing the relevant factors, two broad principles apply. First, newcomers such as Applicant have a duty to avoid selecting a mark close to an established mark, to protect consumers from confusion and the senior user's goodwill and investment. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001, 1003, 281 F.3d 1261, 1265 (Fed. Cir. 2002) ("[T]he newcomer has the opportunity and obligation to avoid confusion with existing marks."). Second, all doubts must be resolved in favor of the prior user – in this case, Opposer. *See I.AM.Symbolic*, 123 U.S.P.Q.2d at 1747, 866 F.3d at 1322 ("In the likelihood of confusion analysis doubts are to be resolved against the newcomer and in favor of the prior user.") (citation and internal quotation marks omitted)).

Analyzing the relevant *DuPont* factors and applying these broad principles demonstrate that Applicant's Marks – when used in connection with the applied-for goods – so clearly resemble the RENAGEL Mark that there exists a likelihood of confusion, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

1. Applicant's Marks Are Highly Similar to Opposer's RENAGEL Mark

The first factor in the likelihood of confusion test is the similarity of the parties' marks. This factor focuses on the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *DuPont*, 177 U.S.P.Q. at 567, 476 F.2d at 1361. Similarity with respect to any one of these elements may be sufficient to find the marks confusingly similar. *See In re S.I. Consulting Ltd.*, Ser. No. 87821370, 2019 WL 5595076, at *3 (T.T.A.B. Oct. 16, 2019). "The proper test is not a side-by-side comparison of the marks, but

instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs., Inc. v. Triumph Learning, LLC*, 101 U.S.P.Q.2d 1713, 1721, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks omitted). In comparing marks, the focus must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See In re Mudskipper Media LLC*, Ser. No. 86570258, 2016 WL 3566146, at *3 (T.T.A.B. May 27, 2016).

Applicant's Marks, REGENAL and REGENALL, are highly similar to Opposer's RENAGEL Mark in appearance (spelling), sound (pronunciation), and overall commercial impression. Applicant's REGENAL Mark contains the exact same letters as Opposer's RENAGEL Mark, and both marks contain three syllables. RENAGEL and REGENAL also both start with "re" prefix, and end with the letter "l." Moreover, both marks end with similar suffixes, "al" and "el," which have similar spelling and pronunciation. The only difference between the two marks is the transposition of the "na" and "ge" in the middle of the mark. In short, the marks are as close as they could be without being identical. Indeed, in writing this brief, Opposer's counsel, although familiar with the marks, repeatedly mixed up the marks, and we expect that the Board will have the same difficulty.

These same similarities also apply to Applicant's REGENALL Mark, which differs from Applicant's REGENAL Mark only in the second letter "l" added at the end of the mark. Thus, Applicant's Marks are confusingly similar to Opposer's Mark both visually and phonetically. *See Carlisle Chem. Works, Inc. v. Hardman & Holden, Ltd.*, 168 U.S.P.Q. 110, 112, 434 F.2d 1403, 1405-06 (C.C.P.A. 1970) (reversing dismissal of oppositions to registration of COZIRC

based on use of ZIRCO for related goods, finding that the marks "are substantially similar, the difference being in a reversal of syllables which are essentially the same").

As for their meaning or commercial impression, both marks appear to be (and are) coined terms that have no readily understood meaning that would distinguish them. *Hoffmann-La Roche Inc. v. Knoll Pharm. Co*., 167 U.S.P.Q. 183, 185 (T.T.A.B. 1970) (finding TARUXAN and TARACTAN were similar because "they are both coined terms which comprise the same number of syllables, begin with the same letters 'TAR', and end with 'AN'" and that "[i]n addition, they not only look alike, but bear a strong resemblance in sound").

Although Applicant claims that the "regen" component of his marks is meant to evoke the concept of "regeneration" (24 TTABVUE 188, ¶ 5), such a connotation, whether or not it exists, cannot overcome the overwhelming visual and phonetic similarity of the marks. *See, e.g.*, *Pfizer Inc. v. Soft Gel Techs., Inc.*, Opp. No. 91117607, 2003 WL 203128, at *5 (T.T.A.B. Jan. 29, 2003) (finding that any difference in connotation between GLUCOSOL and GLUCOTROL could not overcome strong visual and phonetic similarities); *Clairol, Inc. v. Roux Lab'ys, Inc.*, 169 U.S.P.Q. 589, 590, 442 F.2d 980, 982 (C.C.P.A. 1971) (finding that even though the words "Puff" and "Plus" may have different meanings by themselves, when the marks are viewed in their entireties, a likelihood of confusion exists).

The results of the U.S. Food and Drug Administration Phonetic and Orthographic Computer Analysis Program (the "POCA Program") provides further evidence of the strong similarity between Applicant's Marks and Opposer's RENAGEL Mark. The POCA Program is a software tool used by the U.S. Food and Drug Administration ("FDA") which employs an advanced algorithm to determine the orthographic and phonetic similarity between two drug names. (21 TTABVUE 5). Using the POCA Program to analyze the REGENAL and REGENALL marks

resulted in an 80% and 78% match to the RENAGEL Mark, respectively. (21 TTABVUE 7, 10). The FDA considers anything above a 70% match to be in the highest matching category. *Id.*

2. The Parties' Goods Are Closely Related

In considering the similarity or relatedness of the parties' goods offered under their respective marks, two fundamental principles apply.

First, it is well-established that the parties' goods do not have to be identical—or even competitive—for there to be a likelihood of confusion. *Hewlett-Packard*, 62 U.S.P.Q.2d at 1004, 281 F.3d at 1267. Rather, the inquiry is whether the parties' goods are sufficiently "related" that consumers are likely to believe that they come from the same source. *Id.*

Second, when analyzing the relatedness of the goods, the Board must look at the goods as they are identified in the Applicant's application. *See Octocom Sys., Inc. v. Hous. Computer Servs., Inc.*, 16 U.S.P.Q.2d 1783, 1787, 918 F.2d 937, 942 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade, or the class of purchasers to which sales of the goods are directed.").

Here, the goods identified in the Applications are extremely similar to the goods identified in Opposer's RENAGEL Registration. Both Applications cover "Pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements," in International Class 5, with this added limitation in the REGENALL Application: "none of the aforementioned in relation to the treatment of skin or complexion or in relation to the treatment of livers." As explained above, Opposer's RENAGEL product treats hyperphosphatemia in patients with chronic kidney disease. Applicant's broadly worded Applications include no limitations

excluding the treatment of kidneys, and thus the "damaged or injured tissue" could include kidney tissue. Similarly, the nutritional supplements in the Applications must be presumed to include supplements that could be marketed to prevent or treat kidney disease or maintain healthy kidneys. *See, e.g.*, *Pfizer*, 2003 WL 203128, at *6 (finding that goods were related when applicant's goods covered "dietary and nutritional supplements" and opposer's covered "antidiabetic preparations" because "dietary and nutritional supplements" should be read to include all sorts of dietary and nutritional supplements, "including those which may be specifically formulated for diabetics").

It is anticipated that, nonetheless, Applicant will argue that the parties' goods are not related because Applicant's products purportedly are not used to control serum phosphorous in patients and will not treat chronic kidney disease (24 TTABVUE 189, ¶¶ 16-17). However, the applications contain no such restrictions or limitations. If Applicant made such an argument, he would be trying (improperly) to restrict the scope of the goods covered by his Applications through extrinsic evidence. This is contrary to controlling law, which holds that the likelihood of confusion analysis must be based on the goods or services as identified in the application, "rather than what the extrinsic evidence shows those goods to be." *In re Bercut-Vandervoort & Co*., 229 U.S.P.Q. 763, 765 (T.T.A.B. 1986). Accordingly, such arguments "must be disregarded since there is no restriction in the application . . . limiting the [services] to particular channels of trade or classes of customers." *Id.*; *In re Am. Cmty. Mut. Ins. Co*., Ser. No. 78827035, 2008 WL 4354144, at *5 (T.T.A.B. Sept. 17, 2008) (rejecting applicant's attempt to limit its applied-for services from "insurance brokerage services" to "workers compensation insurance" by extrinsic evidence.

3. Opposer's RENAGEL Mark Is a Strong Trademark

The fifth DuPont factors concern the strength of the prior user's mark. *DuPont*, 177 U.S.P.Q. at 567, 476 F.2d at 1361. In determining the strength of a mark, the Board considers "both inherent strength, based on the nature of the mark itself, and commercial strength." *Oldenburg Grp. Inc. v. Vita Living ApS*, Canc. No. 91222815, 2017 WL 2572835, at *4 (T.T.A.B. May 17, 2017); *see also In re Chippendales USA, Inc.*, 96 U.S.P.Q.2d 1681, 1686, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).").

i. The RENAGEL Mark Is Inherently Strong

The inherent strength of a mark derives from its place on the spectrum of generic, descriptive, suggestive, arbitrary, and fanciful marks. *See In re MBNA Am. Bank, N.A.*, 67 U.S.P.Q.2d 1778, 1780, 340 F.3d 1328, 1332 (Fed. Cir. 2003). Suggestive, arbitrary, and fanciful marks are considered inherently distinctive, whereas generic and descriptive marks are not. *See Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 71 U.S.P.Q.2d 1173, 1178, 372 F.3d 1330, 1336-37 (Fed. Cir. 2004). No serious argument can be made that Opposer's RENAGEL mark is descriptive. Moreover, Opposer's registration for the RENAGEL Mark is incontestable (19, 20 TTABVUE 6), and therefore the mark is not subject to challenge as merely descriptive. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 196, 224 U.S.P.Q. 327, 330 (1985) ("The language of the Lanham Act . . . refutes any conclusion that an incontestable mark may be challenged as merely descriptive."). Nor is RENAGEL a generic term for any product or service. Therefore, the RENAGEL mark is inherently distinctive as a matter of law.

The RENAGEL mark also is inherently distinctive as a matter of fact. The RENAGEL mark does not describe or suggest any characteristics or qualities of the recited goods in the

RENAGEL registration, namely "phosphate binders for treatment of hyperphosphataemia." Therefore, it cannot be disputed that RENAGEL is a coined or fanciful mark. *E.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (hereinafter "*McCarthy*") § 11:8 (5th ed. 2022); *MBNA Am. Bank*, 67 U.S.P.Q.2d at 1780, 340 F.3d at 1332. Coined marks are given an "expansive scope" of protection. 2 *McCarthy* § 11:6; *Tisch Hotels, Inc. v. Americana Inn, Inc.*, 146 U.S.P.Q. 566, 568, 350 F.2d 609, 611 (7th Cir. 1965).

ii. The RENAGEL Mark Is Commercially Strong

With respect to marketplace strength, the RENAGEL Mark is also strong. A mark's commercial strength may be measured "indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Prods. Inc.*, 63 U.S.P.Q.2d 1303, 1305, 293 F.3d 1367, 1371 (Fed. Cir. 2002). Importantly, "[i]n the context of a likelihood of confusion analysis, the commercial strength of a mark is not a binary factor. Rather, it 'varies along a spectrum from very strong to very weak.'" *J.C. Newman Cigar Co. v. Fairmont Holdings, Inc.*, Opp. No. 91239345, 2020 WL 3027609, at *5 (T.T.A.B. May 12, 2020) (quoting *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 122 U.S.P.Q.2d 1733, 1734, 857 F.3d 1323, 1325 (Fed. Cir. 2017)). Here, Opposer and its predecessor-in-interest has continuously used the RENAGEL Mark for almost three decades. (19, 20 TTABVUE ¶ 9.) In recent years, Opposer has generated approximately [redacted] in sales between March 2015 and February 2022 throughout the entirety of the United States. (19 TTABVUE 122). Opposer also markets its RENAGEL product through the website *renvela.com* and through the *Sanofi.com* website. (19 TTABVUE ¶ 15).

Thus, the RENAGEL Mark is both conceptually and commercially strong and entitled to a broad scope of protection. The fifth *DuPont* factors weigh in favor of Opposer.

4. Applicant Has Not Shown Evidence of Similar Marks in Use on Similar Goods

Applicant has entered in evidence several third-party registrations in an attempt to show that the RENAGEL Mark is weak. However, as to strength of a mark, "registration evidence may not be given *any* weight." *Olde Thyme Foods, Inc. v. Roundy's, Inc.*, 22 U.S.P.Q.2d 1542, 1545, 961 F.2d 200, 204 (Fed. Cir. 1992) (emphasis in original). Applicant does not offer any evidence to show that these marks are actually in use or that the public is familiar with them. *Id.*; *see also Pfizer*, 2003 WL 203128, at *9. Therefore, these registrations have no probative value and can be ignored.

5. Channels of Trade and Class of Consumers Are the Same

When considering channels of trade in the context of likelihood of confusion, the Board should look to the applications and the registration in the record before it. "When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade." *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1357, 227 F.3d 1352, 1361 (Fed. Cir. 2000); *see also In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 (T.T.A.B. 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."). Moreover, when the registration and applications concern closely related goods, there is a presumption that the channels of trade and classes or purchasers will be the same. *See In re Jenisys Engineered Prods., Inc.*, Ser. No. 78656734, 2008 WL 853819, at *2 (T.T.A.B. Jan. 18, 2008).

Here, neither Opposer's registration nor the Applications include any limitations on channels of trade. Accordingly, the Board must presume that Applicant's goods will move through the

normal channels of trade and to all classes of consumers, which inevitably overlap with the similarly unrestricted trade channels and consumers for Opposer's goods.

Thus, this factor weighs in Opposer's favor.

6. The Conditions of Purchase and Consumer Sophistication Favor Opposer.

The *DuPont* factor relating to the conditions of purchase and "consumer sophistication" is concerned with Applicant's consumers and the degree of care they exercise in making purchasing decisions. *DuPont*, 177 U.S.P.Q. at 567, 476 F.2d at 1361. It is well-settled that "[p]urchaser sophistication may tend to minimize likelihood of confusion . . . [whereas] impulse purchases of inexpensive items may tend to have the opposite effect." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 U.S.P.Q.2d 1689, 1695, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

Applicant has asserted that his intended customers are highly sophisticated medical prescribers. (24 TTABVUE 190, ¶¶ 7-8, 19). However, the Board has held that the fact that physicians and pharmacists are sophisticated as to the field of medicine and prescription drugs does not mean they are sophisticated consumers when it comes to trademarks. *See Schering Corp. v. Alza Corp.*, 207 U.S.P.Q. 504, 509 (T.T.A.B. 1980) ("Furthermore, the fact that the purchasers of both applicant's and opposer's products are discriminating in their selection and make their purchases only after careful consideration, and know from whom they buy, does not mean they are equally as knowledgeable as to trademarks and immune from mistaking one trademark for another…"). In short, even doctors can be confused by extremely confusing marks like RENAGEL and REGENAL.

Further, Applicant's Registrations do not restrict its goods to prescription-based goods. The identifications of goods in the Applications are broad enough to include both prescription and over-the-counter drugs. *See, e.g.*, *Pennwalt Corp. v. Ctr. Lab'ys, Inc.*, 187 U.S.P.Q. 599, 601,

524 F.2d 235, 236 (C.C.P.A. 1975) (noting that the goods described as "medication for relief of sinus passage congestion, allergies and hay fever" encompasses not only prescription medications, but also over-the-counter items); *Pfizer*, 2003 WL 203128, at *6 (reading "antidiabetic preparations" to include prescription and non-prescription drugs, and reading "nutritional and dietary supplements" to include non-prescription items). Applicant has submitted no evidence that consumers of these non-prescription items are sophisticated purchasers. In fact, courts looking at the issue have found no evidence that purchasers of nutritional supplements are sophisticated. *See Eli Lilly & Co. v. Nat. Answers, Inc.*, 56 U.S.P.Q.2d 1942, 1947, 223 F.3d 456, 464 (7th Cir. 2000) (finding that "there is just no evidence that consumers as a whole are extraordinarily careful when it comes to dietary supplements").

Finally, Applicant's argument about the sophistication of consumers ignores how consumers use medications, including prescription medications. Consider a husband and wife, who share a medicine cabinet. One could be prescribed RENAGEL, while the other could be prescribed REGENAL. It is easy imagine one spouse mistakenly taking the other's medication, with possibly disastrous consequences. This is especially likely if they are older people, whose eyesight or concentration is failing. Consider also, a single individual, who is first prescribed REGENAL, and then later prescribed RENAGEL. If he keeps both in the same medicine cabinet, he could easily mix them up, again with disastrous consequences, especially if his eyesight or concentration is not what they once were. *See, e.g.*, *In re Star Pharms., Inc.*, 221 U.S.P.Q. 84, 85-86 (T.T.A.B. 1984) (noting that even if products were prescription only, they "the products of both parties are intended for oral ingestion and may be taken at home without medical supervision. It is clear that in evaluating a likelihood of mistake under Section 2(d) of the Act, what may happen subsequent to the sale of the products is also relevant").

Accordingly, this factor favors Opposer.

7. The Remaining DuPont Factors Are Not Relevant Here

The remaining *DuPont* factors not discussed above are not relevant in this proceeding. Because Applicant has not used his marks in commerce, there is no actual confusion, nor is there evidence of concurrent use without actual confusion. Likewise, there is no evidence of the variety of goods on which a mark is or is not used, of a market interface between applicant and opposer, and of applicant's rights (or lack thereof) to exclude others from use of its mark.

Only the final *DuPont* factor is worth mentioning - the extent of potential confusion. Based on the foregoing analysis of the relevant *DuPont* factors, there is a substantial risk of potential confusion, and such a risk poses a harm to the public.

* * *

Considering all of the evidence on the relevant factors and giving each such factor its appropriate weight in the circumstances of this proceeding, the vast majority of the *DuPont* factors favor Opposer. The remaining factors are either neutral or not relevant to the analysis, and none of the factors favor Applicant. Accordingly, Opposer has shown that Applicant's Marks as applied for in his Applications are likely to cause confusion, mistake, or to deceive consumers, in violation of Section 2(d) of the Lanham Act.

CONCLUSION

In light of the arguments and evidence set forth herein, Opposer has established that it is the prior user of the registered RENAGEL Mark and that the *DuPont* factors compel a finding that the highly similar REGENAL and REGENALL Marks – if used in connection with the identical or highly similar goods identified in Applications – are likely to cause confusion, to cause mistake, or to deceive consumers with respect to the RENAGEL Mark. As a result, Opposer

respectfully requests that the Board sustain this opposition and refuse registration to Applicant's Marks.

Dated: New York, NY
October 12, 2022

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this document is being served by email on Applicant's counsel this 12th day of October 2022 at efiling@knobbe.com.

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