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January 25, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Independent Pharmaceutica AB*

Serial No. 78160932

R. Peter Spies and Laurel V. Dineff of Dineff Trademark Law Limited for Independent Pharmaceutica AB.

John Dwyer, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before *Quinn, Hohein and Bottorff*, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Independent Pharmaceutica AB has filed an application to register the mark "NICCIN" for "vaccines; [and] anti-smoking pharmaceutical preparations in the form of tablets."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 78160932, filed on September 5, 2002, which is based on an allegation of a bona fide intention to use the mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "NICOCIN," which is registered for "pharmaceutical preparations, namely, medications for suppressing, reducing, or eliminating smoking and the urge to smoke,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.³ Here, inasmuch as applicant's "anti-smoking pharmaceutical preparations in the form of tablets" and registrant's "pharmaceutical preparations, namely, medications for suppressing, reducing, or eliminating smoking and the urge to smoke," encompass identical and otherwise very closely related

² Reg. No. 2,358,337, issued on June 13, 2000, which sets forth a date of first use anywhere and in commerce of January 1999.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

goods,⁴ the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective marks.

Turning, therefore, to such issue, applicant argues in its brief that "the respective marks are sufficiently dissimilar so as to not cause consumer confusion." Specifically, applicant maintains that the marks at issue appreciably differ in sound, appearance and connotation inasmuch as:

Appellant's mark, NICCIN, is pronounced NI-KIN, with the double C pronounced as a K. Registrant's mark NICOCIN is pronounced NI-KO-SIN, whereby the second C is pronounced as an S. Even if Appellant's mark were to be pronounced NIS-SIN, the marks are clearly pronounced differently. In addition, the combination of the two vowels "I" and "O" in Registrant's mark create a three syllable phonetically challenging word. Appellant's mark is pronounced in two syllabus [sic] and is straight forward to say out loud. Consequently, the pronunciation of the respective marks is clearly different and, therefore, clearly distinguishable.

The respective marks are also visually different. Registrant's mark involves a visually larger word interrupted in the middle by a visually obvious "O". Appellant's mark ... appears visually more homogeneous as is [sic] consist [sic] of only three different letters. In fact, Appellant's mark is a palindrome, which

⁴ Applicant, we note, does not contend otherwise. Although the Examining Attorney, without any supporting evidence, asserts in his brief that applicant's other goods, namely, "vaccines," are "substantially related to, and/or within the logical field of expansion of trade for the registrant" and that "vaccines and pharmaceuticals are thus medical goods of a kind that may emanate from a single source," it is well established that a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods listed in an application and any of those set forth in the cited registration. Thus, where a likelihood of confusion is so found, it is unnecessary to rule with respect to any of the other goods listed in the application. See, e.g., *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).

creates a significant visual difference to the cited mark.

The respective marks convey a different connotation. Registrant's mark closely imitates the word nicotine visually and phonetically, thereby creating a very distinct and different connotation as consumers will associate the term NICOCIN with NICOTINE. On the other hand, no such association can be drawn when encountering Appellant's mark, which plays with consumer's imagination as a palindrome, by the reverse replication of "NIC" thereby creating a very different connotation.

Applicant also contends that the respective marks do not engender either the same or similar overall commercial impression. In particular, in response to the evidence made of record by the Examining Attorney to show that the formatives "NIC" and "NICO" in the marks at issue are indicative of the word "nicotine," which the Examining Attorney insists is the substance responsible for many of the addictive effects of tobacco products, applicant refers in its brief to an attached list from "the acronym finder, which is located at www.acronymfinder.com, [showing that] NIC is being used as an acronym for numerous products, standards, organizations etc."⁵ Examples thereof, applicant observes, include "NIC ... being used as an acronym for 'network interface card', 'national identification code',

⁵ Such list, however, was submitted for the first time with applicant's brief as Exhibit 1 and thus is untimely under Trademark Rule 2.142(d) insofar as it includes information which is not set forth in the excerpt from the same website which the Examining Attorney made of record with his final refusal. Nevertheless, inasmuch as the Examining Attorney in his brief has not objected to the inclusion of the evidence contained in Exhibit 1 and has implicitly considered such in his brief, we have treated the evidence as being of record for whatever probative value it may have. See In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 n. 2 (TTAB 1990).

'National Intelligence Council', 'Network Information Center', and 'Nicaragua (ISO country code)[']'. Applicant urges, in view thereof, that "[a]lthough NIC may be recognized as an acronym for nicotine, the fact that NIC is also recognized for numerous other terms ... indicates that Appellant's mark may not be associated with nicotine unlike the [mark of the] cited registration" and that "[t]he mere fact that the letters NIC are placed at the beginning of both marks does not render the marks confusingly similar per se."

In addition, applicant asserts that a likelihood of confusion should not be found because registrant's mark is weak and, as such, should not be afforded a broad scope of protection. Specifically, applicant argues that since, as contended by the Examining Attorney, the formative "NIC is a common acronym for nicotine," registrant's "NICOCIN" mark "clearly suggests that it covers nicotine related goods and smoking related products" and therefore "must be considered highly suggestive" of registrant's goods. Similarly, applicant maintains that registrant's mark must be considered weak because, as shown by the copies which it made of record of certain third-party registrations, "the abbreviations NICO and NIC have been registered in many variations and currently co-exist on the Register" for goods "similar" to those of registrant. Examples of the marks which are the subjects of such registrations include "NIC-AVERT," "KICK NIC," "NICCHECK," "NICO-ECE," "NICO FIT," "NICO-PLEX," "NICO-FUME," "NICODERM" and "NICORETTE." According to applicant, "the widespread use of the abbreviation NIC and/or NICO by different

owners as part of their marks ... for smoking related goods has narrowed the scope of protection of these marks" such that "[a]ny one of the aforementioned marks, including the [mark of] the cited registration, containing the abbreviation NICO or NIC is limited to substantially that exact trademark only."

Lastly, applicant "stresses that consumers shopping for preparations that would enable them to quit smoking must be considered sophisticated purchasers." According to applicant, "[t]he products in question are usually sold at a substantial price and are, therefore, being sold in special store sections that are not accessible without customer assistance." In view thereof, applicant maintains that confusion is not likely because its goods and those of registrant "can be distinguished due to the fact that consumers shopping for drugs and/or preparations that will suppress their nicotine addiction will have formed an opinion as to which product they will purchase or will ask the person assisting in the sale of these products."

We concur with the Examining Attorney, however, that contemporaneous use of the marks "NICCIN" and "NICOCIN" in connection with the respective goods would be likely to cause confusion as to the source or sponsorship of such goods. As a starting point for our analysis, we note that, as pointed out by the Examining Attorney, it is a general proposition that when, as here, marks would appear in connection with the same or virtually identical goods, the degree of similarity between the marks necessary to support a conclusion of a likelihood of confusion declines. See, e.g., Century 21 Real Estate Corp. v. Century

Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Moreover, as the Examining Attorney also properly observes, tribunals have long recognized the need for a more "conservative approach to determining a likelihood of confusion between trademarks used on pharmaceutical preparations due to the harmful ... consequences of mistakenly taking the wrong medication." Thus, as set forth in 3 J. McCarthy, McCarthy on Trademarks & Unfair Competition (4th ed. 2004) at §23:32 (footnotes omitted):

The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations.

See also, *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19, 21 (CCPA 1972); and *American Home Products Corp. v. USV Pharmaceutical Corp.*, 190 USPQ 357, 360 (TTAB 1976).

We find, in light of the above, that when considered in their entirety, applicant's "NICCIN" mark is substantially identical to registrant's "NICOCIN" mark in both appearance and sound, since the former differs from the latter only in the absence of the letter "O." Even if consumers and/or medical professionals were to notice such a minor difference, it is still

the case that, structurally, the respective marks are essentially identical. As the Examining Attorney persuasively argues in his brief:

Both marks are palindromes, that is, they both read the same backward or forward. The act on the part of a potential purchaser of consciously recognizing that the registrant's mark is a palindrome adds a memorable creative aspect to the registrant's mark that further strengthens it as a mark. That is, the registrant's coined mark is made even stronger because it is an easily remembered palindrome. Potential purchasers of smoking cessation pharmaceutical preparations, upon encountering two nearly identical marks, both being palindromes, would be more likely to believe that both products originate from the same source, and that the one letter difference is intended to differentiate between [sic] aspects of the products, such as that one is the newer version or that the potency is different between the two.

Furthermore, as to applicant's contention that its mark differs substantially in pronunciation from registrant's mark, the Examining Attorney correctly notes that it is well settled that there is no correct pronunciation of a mark. See, e.g., *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); *Gio. Budon & C. S.p.A. v. Buitoni Foods Corp.*, 205 USPQ 477, 482 (TTAB 1979); *Yamaha International Corp. v. Stevenson*, 196 USPQ 701, 703 (TTAB 1977); and *Sterling Drug Inc. v. Sankyo Co., Ltd.*, 139 USPQ 395, 396 (TTAB 1963). Clearly, the respective marks are susceptible to being pronounced in substantially the same manner.

To the extent that the marks at issue, which appear to be fanciful or coined terms, can each be said to have a connotation or meaning, we find that both plainly suggest that the respective goods are for combating the nicotine addiction

associated with smoking. As the Examining Attorney notes in his brief, the evidence of record includes an excerpt from the "AcronymFinder" database showing that "'NIC' is an abbreviation for nicotine." In addition, the Examining Attorney has made of record excerpts of articles retrieved from the "NEXIS" database which "demonstrate that both 'NIC' and 'NICO' are sometimes used as abbreviations for 'nicotine' and/or as prefixes to refer to nicotine." A sample of the most pertinent excerpts is as follows (emphasis added):

"Smokers trying to quit will soon be able to try a **nicotine** lozenge to satisfy **nic** fits." -- Chicago Tribune, November 1, 2002;

"**NICO**-TEST: Cambridge biotech firm DynaGen Inc. said the FDA approved its **nicotine**-intake medical test yesterday The firm said its **NicCheck** I kits can be used by doctors to determine **nicotine** levels in the body." -- Boston Herald, January 15, 1997;

"Patches and **nicotine** gum help satisfy people suffering from '**nic** fits' who don't want to reach for cigarettes" -- Times Union (Albany, NY), November 1, 1996;

"Justin ... said he's been smoking for five years and is up to two packs a day. 'I '**nic**' all the time in school,' he said, meaning he suffers **nicotine** fits." -- Orlando Sentinel, October 7, 1994;

"John's bizarre picks: **Nico** Cola. 'It had **nicotine** in it. It was supposed to help you stop smoking.'" -- St. Petersburg Times (FL), August 31, 1994;

"Nick suffers numerous indignities, the worst of which is a botched hit by '**nico**-terrorists,' who kidnap and plaster him top to bottom with **nicotine** patches." -- Chicago Tribune, June 27, 1994;

"... why does my mother get distressed, or my dad get irritable, when the **nic** fit hits, and they cannot have their fix of **nicotine**?" -- Sun (Baltimore, MD), May 15, 1994;

"To anyone who has experienced the headaches, nausea and nasty mood swings of **nicotine** withdrawal, or had to tolerate someone in a '**nic** fit,' the device sounds like snake oil on a microchip." -- Houston Chronicle, August 2, 1992; and

"With such a rule, the system also would be less onerous to the **nicotine**-addicted poor than would quadrupled tobacco taxes. Ideally, a **nico**-dict won't have to cheat his children of necessities to finance his Marboros." -- Washington Post, January 1, 1986.

Furthermore, the Examining Attorney points out in his brief that "[n]icotine is recognized as being 'responsible for many of the effects of tobacco' and is 'powerfully addictive,'" citing the following relevant excerpt which he made of record from Stedman's Online Medical Dictionary (2003):

Nicotine in inhaled tobacco smoke or in smokeless tobacco applied to buccal or nasal mucosa enters the circulation within seconds, causing an increase in heart rate, ventricular stroke volume, and myocardial oxygen consumption, as well as euphoria, heightened alertness, and a sense of relaxation. Nicotine use is powerfully addictive, readily leading to habituation, tolerance, and dependency. Withdrawal from nicotine causes restlessness, irritability, anxiety, difficulty concentrating, and craving for nicotine. Addiction to nicotine is the reason for most tobacco use and thus directly responsible for the resulting morbidity and mortality.

Based upon the foregoing, we concur with the Examining Attorney that not only is it the case that "[p]otential purchasers of applicant's and registrant's smoking cessation products could

reasonably perceive the letters 'NIC-' and 'NICO-' in the respective marks as referring to nicotine," but "the overall commercial impression created by [each of] the two marks is the same," given that in terms of connotation, "the beginning of each mark could reasonably be perceived as referring to 'nicotine,' and the end of each mark is the same."

While applicant, as indicated previously, makes much of the fact that it has made of record information concerning a number of third-party registrations for marks which begin with the letters "NIC" or "NICO" for various nicotine related products, such evidence does not constitute proof of actual use of the marks which are the subjects thereof in the marketplace and, consequently, that the purchasing public has become conditioned to encountering anti-smoking products, including pharmaceutical preparations or medications, under such marks and is able to distinguish the source thereof based upon differences in the elements of the marks. See, e.g., *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *In re Hub Distributing, Inc.*, 218 USPQ 284, 285-86 (TTAB 1983). Thus, with respect to anti-smoking or smoking cessation products, the asserted weakness of marks which begin with letters indicative of the word "nicotine" is of no aid to applicant, especially in view of the substantial identity in sound and appearance and virtual identity in connotation and commercial impression which is present between applicant's "NICCIN" mark and the cited registrant's "NICOCIN" mark.

Finally, as to applicant's contentions that consumers of pharmaceutical preparations to enable them to quit smoking must be considered sophisticated purchasers and that such goods are usually sold at both a substantial price and through special store sections which require customer assistance, the Examining Attorney correctly notes in his brief that "applicant has entered no evidence into the record as to the cost of the goods." Nonetheless, as the Examining Attorney also properly notes, even assuming that applicant's and registrant's pharmaceutical preparations are not inexpensive and would be prescribed and/or purchased with care and deliberation, it is well settled that the fact that consumers and/or their pharmacists and physicians may exercise discrimination in choosing such products "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); and *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB 1980) [the fact that physicians and pharmacists "are discriminating in their selection and make their purchases only after careful consideration, and know from whom they buy, does not mean that they are equally knowledgeable as to trademarks and immune from mistaking one trademark for another"].

We accordingly conclude that consumers, as well as pharmacists and physicians, who are familiar or acquainted with registrant's "NICOCIN" mark for "pharmaceutical preparations,

namely, medications for suppressing, reducing, or eliminating smoking and the urge to smoke," would be likely to believe, upon encountering applicant's substantially identical "NICCIN" mark for "anti-smoking pharmaceutical preparations in the form of tablets," that such legally identical and otherwise very closely related goods emanate from, or are sponsored by or associated with, the same source. See, e.g., *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992) [confusion is likely, even for drugs prescribed by doctors and dispensed by pharmacists, "where ... similar goods are marketed under marks which look alike and sound alike"]. For instance, such persons could readily believe, with potentially dangerous results, that applicant's "NICCIN" anti-smoking tablets constitute another product line or formulation of registrant's "NICOCIN" medications for suppressing, reducing, or eliminating smoking and the urge to smoke, or vice versa.

Decision: The refusal under Section 2(d) is affirmed.