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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Novartis Corporation  
v.  
David M. Brady.

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Opposition No. 91123924  
to application Serial No. 78018211

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Bruce P. Keller of Debevoise & Plimpton, LLP for Novartis Corporation.

David M. Brady, pro se.

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Before Bucher, Bottorff, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 25, 2000, David M. Brady (applicant) applied to register on the Principal Register the mark RITALOUT (typed drawing) for goods identified as a "nutritional supplement" in International Class 5.<sup>1</sup>

On July 10, 2001, Novartis Corporation (opposer) filed a notice of opposition to the registration of applicant's mark. Opposer alleges that applicant's mark is confusingly

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<sup>1</sup> Serial No. 78018211 contains an allegation of a bona fide intention to use the mark in commerce.

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similar to two registrations it owns, both in International Class 5, for the marks RITALIN<sup>2</sup> for a "pharmaceutical preparation having a stimulating effect" and RITALIN SR<sup>3</sup> for a "pharmaceutical preparation having a stimulating action" under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d). Opposer also alleges that applicant's mark dilutes the distinctiveness of its RITALIN mark.

Applicant denied the salient allegations of opposer's notice of opposition.

The Record

The record consists of the pleadings; the file of the involved application; the testimonial deposition of Steven H. Hartman, opposer's vice-president and counsel, with exhibits; the testimonial deposition of Ann Regina Cleary Moran, opposer's executive director of public relations, with exhibits; the testimonial deposition, with exhibits, of Ronald Califre, senior vice-president of opposer; the testimonial deposition, with exhibits, of Michelle Stolpman, senior product manager of opposer; the discovery deposition of applicant, with exhibits, submitted by opposer by notice of reliance; other notices of reliance of opposer submitting status and title copies of its registrations, news articles, books, FDA regulations, an article by applicant, and

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<sup>2</sup> Registration No. 517,928, issued November 22, 1949, third renewal.

<sup>3</sup> Registration No. 1,149,578, issued March 31 1981, renewed.

dictionary definitions; stipulations of the parties submitting applicant's product labels, a technical information sheet, an ingredient list, a list of RITALOUT references, and a list of publications by applicant; and a declaration of Michelle Stolpman submitted by stipulation.

Preliminary Matters

Because of opposer's proof of ownership and use of its registered marks, we find that opposer has established its standing to oppose. See, e.g., Lipton Industries, Inc. v. Ralston Purina Company, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, priority is not an issue here in view of opposer's ownership of two registrations for its RITALIN and RITALIN SR marks. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

We now address the issue of likelihood of confusion, which is the key issue in the case. When considering whether there is a likelihood of confusion, we rely on the factors set out by the Court of Appeals for the Federal Circuit and its predecessor, the Court of Custom and Patent Appeals, in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

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We begin by discussing the similarity of opposer's and applicant's marks. Applicant's mark is for the single word RITALOUT and opposer's marks are for the words RITALIN and RITALIN SR. All the marks are shown in typed form. The only difference between the words RITALIN and RITALOUT is the ending of the marks. Applicant's mark ends with the word "out," while opposer's mark ends with the word "in." Opposer's second registration adds the letters "SR," which stand for "sustained release." Hartman dep. at 7.<sup>4</sup> The abbreviation would have at least a suggestive significance in relation to opposer's goods. As such, it is unlikely to be viewed by health professionals and others as a significant feature of the mark. See In re Chatam International Incorporated, \_\_ USPQ2d \_\_\_\_, \_\_\_\_ (Fed. Cir. August 3, 2004), slip op. at 6 ("GOLD, in the context of tequila, describes either a characteristic of the good - its color - or a quality of the good commensurate with great value or merit ... In sum, the Board had good reason to

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<sup>4</sup> Opposer's witness explained:

A. The product sold under the Ritalin SR trademark is an advanced formulation of the product sold under the Ritalin trademark, and it allows for less frequent dosing.

Q. And is that a function of the sustained release characteristic of the product?

A. Yes.

Hartman dep. at 7. See also Information For Parents and Patients About Ritalin® and Ritalin-SR® (Ritalin-SR (sustained release tablet)).

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discount ALE, JOSE, and GOLD as significant differences between the marks").

The "RITAL-" prefix, on the other hand, is apparently an arbitrary term. There is no evidence that the term has any meaning in the pharmaceutical industry.<sup>5</sup> There is also no evidence that the prefix is used in connection with any goods or services. Opposer's witness<sup>6</sup> identified a trademark search report for listings in Class 5 and described the results as showing that "apart from the mark we are opposing, RitalOut, there are no other marks that contain the prefix R-I-T-A-L either pending or registered or expired." Hartman dep. at 17-18. The witness also answered in the negative when he was asked if he was "aware of any third party for any goods or services that uses any mark in any way similar to your own trademark." Hartman dep. at 15. Applicant himself answered in the negative when he was asked: "Are you aware of any other product in the marketplace that begins with the letters R-I-T-A-L?" Brady disc. dep. at 94. Therefore, the prefix "Rital-" would be an arbitrary term. It would dominate both applicant's and opposer's marks even when it is combined with the common words "in" and "out."

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<sup>5</sup> "Q. Can any significance be attributed to the R-I-T-A-L prefix? Does it have any meaning? A. No." Hartman dep. at 23.

<sup>6</sup> Steven Hartman is opposer's vice president and counsel for trademarks and copyrights. Hartman dep. at 3.

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When we examine the similarities and dissimilarities of the marks in appearance, sound, and meaning, they are obviously not identical. There is a difference inasmuch as applicant's mark ends with the term "out" and opposer's mark ends with the term "in." Overall, they would still look similar and sound similar to the extent that both would be dominated by the "Rital-" prefix. When we consider the similarities in meaning, we again find that there is little to distinguish the marks. There is no evidence that the mark RITALIN has any meaning. Indeed, applicant acknowledges that fact.

Q. You are unaware of any other meaning associated with the word Ritalin other than to identify Novartis' drug?

A. The word Ritalin, yeah. I think that's the only meaning that I'm aware of, that it identifies their drug.

Brady disc. dep. at 94.

Regarding his trademark, applicant argues that "the original name selection for the Applicant's product was RIDDLE OUT (also trademarked by applicant). This name was selected in order to convey an image of removing the 'riddle' as to why so many American children are suffering from myriad of behavioral problems, including hyperactivity." Applicant's Brief at 2. See also Brady disc. dep. at 100-02. While it is possible that potential

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customers may engage in a process of translating "Ritalout" to mean "riddle out," it is not clear why they would then arrive at a conclusion that this term's meaning and commercial impression were so different from opposer's mark "Ritalin" that the marks would not be similar.

While it is improper to dissect a mark and marks must be viewed in their entirety, more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In this case, the only difference between opposer's first registration and applicant's mark is the fact that applicant's mark ends with the suffix "out," while opposer's mark ends with the opposite suffix "in." While this is a difference, we do not find that it is significant enough to avoid a finding that the marks are similar. In a similar case, the Court of Custom and Patent Appeals held that the marks MISTER STAIN and MR. CLEAN were similar despite their obvious differences. "While here we have both aural and optical dissimilarity between 'stain' and 'clean,' such factors are not necessarily controlling on the issue of likelihood of confusion in the market place. A designation may well be likely to cause purchaser confusion as to the origin of goods because it conveys, as used, the same idea, or stimulates the same mental reaction, or in the ultimate has

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the same meaning." Proctor & Gamble Co. v. Conway, 419 F.2d 1332, 164 USPQ 301, 304 (CCPA 1970). See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1283 (Fed. Cir. 1984) ("It is the similarity of commercial impression between SPICE VALLEY and SPICE ISLANDS that weights heavily against the applicant"); International House of Pancakes, Inc. v. Elca, Corp., 216 USPQ 521, 525 (TTAB 1982) (Likelihood of confusion between INTERNATIONAL HOUSE OF PANCAKES and COLONIAL HOUSE OF PANCAKES). Here, the difference between RITALIN and RITALOUT is not sufficient to make the marks dissimilar. The common prefix "Rital-" dominates the marks. We conclude that the similarities of the marks' sound, appearance, meaning, and commercial impression outweigh any potential differences.

However, similarity of the marks is only one factor we consider in our likelihood of confusion analysis. The next factor, which is often a critical factor, is the similarity or dissimilarity of the goods. In this case, applicant's goods are nutritional supplements while opposer's goods are pharmaceutical preparations having a stimulating effect or action. We must compare the goods as described in the application and the registrations to determine if there is a likelihood of confusion. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed.

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Cir. 1987). We start by noting that nutritional supplements and pharmaceutical preparations are not identical products but that does not end our consideration. Opposer's witness testified that:

Novartis itself makes both prescription pharmaceuticals and nutritional supplements. And we in fact make those products for the same - to treat the same symptoms and disease states.

We make, for example, nutritional supplements to treat diabetes, nutritional supplements, under the brand name Resource; and we also offer a prescription pharmaceutical called Starlix for diabetes.

Hartman dep. at 25.

The fact that opposer is also the source of both nutritional supplements and pharmaceutical preparations is evidence that these products are related. Accord Eli Lilly, 56 USPQ2d at 1947 ("[D]ietary supplements are an area of natural expansion for pharmaceutical companies").

Opposer's goods are specifically identified as pharmaceutical preparations having a stimulating effect or action. Mr. Harman explained that:

The drug [Ritalin] actually is a stimulant to the central nervous system, and for reasons that doctors and clinicians are not entirely sure why, the net effect of stimulating certain parts of the central nervous system on people whose systems are already overly active has the countervailing effect. It actually calms them down.

Hartman dep. at 13.

"Ritalin is indicated for the treatment of ADHD [attention deficit hyperactivity disorder]. ... It was the

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first medication that was approved by the FDA for the treatment of ADHD." Moran dep. at 5. Applicant agrees that "the principal prescribed purpose of Ritalin is to help overactive children." Brady disc. dep. at 127. Applicant's nutritional supplements are similarly directed towards helping hyperactive children. A sample label for RITALOUT, after identifying the product as a nutrition shake, goes on to indicate that it is a "Daily nutritional support for over-active children." Brady disc. dep. Ex. 4. Applicant admits that this is the only claim that is made on the label. Brady disc. dep. at 124. Part of applicant's marketing plan includes marketing "Ritalout as a daily nutritional support for overactive children." Brady disc. dep. at 123. Applicant subsequently argues that its nutritional supplement "is a broad-spectrum general nutritional repletion product designed for healthy children, as well as those who may be experiencing behavioral difficulties not necessary diagnosed as ADD/ADHD." Applicant's Brief at 3. However, applicant's evidence of his intended use for his supplement clearly shows that, regardless of any other potential uses or targeted customers, his supplement will address the problem of over-activity in children.<sup>7</sup>

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<sup>7</sup> See RitalOut "A Comprehensive Program for Over-Active Children" information sheet ("When considering alternative treatments for your over-active child, it is wise to discuss the options with

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Thus, we are not dealing with a hypothetical overlap of pharmaceutical products and nutritional supplements. The evidence shows that, among other possible uses, applicant's and opposer's products are both marketed to help overactive children. Applicant's supplements that address the problem of overactive children and opposer's pharmaceutical preparations that include the treatment of overactivity in children are related.

Applicant argues that there "is simply no possibility that consumers will confuse these two products which represent products in two entirely different classes of services and require extremely different method of procurement." Applicant's Brief at 3. However, the test for likelihood of confusion is not simply whether consumers would likely mistake one product for another. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at

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your doctor or health practitioner. The makers of the RitalOut program are pleased to offer you a nutritional approach to the management of your over-active child"); Brady disc. dep. at 121 ("We intend to market to all children, particularly those with overactivity"); Response to Notice of Opposition at 1 ("Applicant desires to market a nutritional supplement product, not a drug, which is an alternative to Ritalin").

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the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). Here, potential customers familiar with opposer's prescription drug RITALIN for the treatment of overactive children are likely to assume that there is some association with a nutritional supplement that would be sold under the trademark RITALOUT that also addresses the same problem.

Furthermore, the prospective purchasers of these supplements and pharmaceuticals would at least overlap. Certainly, medical and health professionals who are involved with treating hyperactive children, those with ADHD/ADD, would likely be interested in any treatment regimen that would provide relief to children diagnosed with this illness. Therefore, they are likely to be interested in both prescription and non-prescription treatments that may help. Parents with a child who has been prescribed a drug such as RITALIN may also be interested in a nutritional supplement to provide additional relief or a supplement that could replace or diminish the need to use a prescription medication.

Regarding channels of trade, applicant has indicated that his product will be available in "the retail marketplace, such as vitamin stores, nutritional stores,

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potentially in pharmacy supermarkets." Brady disc. dep. at 167. In addition, applicant's identification of goods for nutritional supplements contains no limitations so we assume that the channels include all normal channels of trade. In re Sawyer of Napa Inc., 222 USPQ 923, 924 (TTAB 1983). Morton-Norwich Products, Inc. v. N. Siperstein, Inc., 222 USPQ 735, 736 (TTAB 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers").

Therefore, applicant's and opposer's products are likely to be encountered in pharmacies, albeit applicant's nutritional supplements are non-prescription products while opposer's products would be dispensed by prescription. Potential purchasers as well as the channels of trade would be similar.

Another factor that we consider is the question of fame or public recognition and renown. The Federal Circuit "has acknowledged that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting, Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir.

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1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for "natural agricultural products, namely, edible dog treats" confusingly similar to FRITO-LAY for snack foods).

Here, opposer has submitted significant evidence that shows that its RITALIN marks have achieved wide public recognition and renown. Applicant himself acknowledged that "both Prozac and Ritalin are well-known drugs." Brady disc. dep. at 172. RITALIN has appeared as a cover story on several magazines. See Time, November 30, 1998 ("The Latest on RITALIN - Scientists last week said it works. But how do you know if it's right for your kids?"); Newsweek, March 18, 1996 ("Ritalin - Are We Overmedicating Our Kids?"); New Yorker, September 9, 1996 ("Readin Ritin Ritalin"). RITALIN has also been featured in numerous articles in newspapers and magazines.<sup>8</sup> See USA Today, March 14, 1995 ("'90s teens find a new high by abusing Ritalin"); Forbes, August 12, 1996 ("U.S. relaxes with Ritalin"); Washington Post, June 2, 1998 (Hyperactivity Drugs Given to Very Young - Ritalin, Prozac and Other Medications Prescribed to Children as Young as 1 Year Old"); U.S. News & World Report, November 23, 1998 ("Doing Ritalin Right"); Newsweek, April 24, 2000 ("Does My

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<sup>8</sup> Opposer's witness testified that in 2000 there were "nearly 3,000 articles about Ritalin." Stolpman dep. at 25.

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Child Need Ritalin"); *Rosie*, August 2001 ("Getting better on Ritalin"); *New York Post*, August 7, 2002 ("ZOMBIE - Boy, 12, sues school over drug horror" with picture of a prescription bottle for RITALIN). Several books have been written on the subject of RITALIN. See Breggin, *Talking Back to RITALIN*; Diller, *Running on Ritalin - A Physician Reflects on Children, Society, and Performance in a Pill*"; Ferreiro, *Ritalin*; Mercogliano, *Teaching the Restless: One School's Remarkable no-Ritalin Approach to Helping Children Learn and Succeed*.

RITALIN has also been discussed or featured on several television shows. See, e.g., *South Park* "Timmy 2000," April 19, 2000;<sup>9</sup> *ABC Chronicle* "New Drugs," September 19, 2002; *CNN American Morning* "ADHD," September 26, 2002; *Fox News Hannity & Colmes* "Ritalin," September 26, 2002; *Discovery Health* "ADHD - Following 3 Families," October 23, 2002; *NBC Today Show* "Understanding Ritalin," February 28 - March 2, 2001; and *NBC Dateline* "Ritalin - Rx for Disaster," January 16, 2001. Indeed, applicant admits that "[t]here's not a whole long length of time you can watch television and not see something about Ritalin." Brady disc. dep. at 26.<sup>10</sup>

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<sup>9</sup> Interestingly, in the *South Park* episode involving a story about the overuse of RITALIN, the "antidote" used to reverse the effects of RITALIN is referred to as RITALOUT.

<sup>10</sup> Applicant goes on to indicate that this television exposure is about "the potential abuse of [Ritalin] and the overprescribing of it and the overreliance on it for behavioral problems as a Band-Aid solution to a very complex problem." Brady disc. dep. at 26.

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Opposer has also submitted entries from various dictionaries showing that RITALIN is defined as a trademark for the drug known by its chemical name of methylphenidate. See *The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed.); *Random House Webster's Unabridged Dictionary* (2d ed.); and *Merriam-Webster's Collegiate Dictionary* (10<sup>th</sup> ed.).

In addition, Opposer introduced evidence of sales figures for its RITALIN and RITALIN SR drugs. In 1958, sales totaled \$3 million dollars. Stolpman dep. at 25. By 1993, sales totaled \$77.3 million. Between 1994 and 2001, sales figures were \$100.7 million; \$128 million; \$139 million; \$142 million; \$146.7 million; \$136.5 million; \$108.6 million; and \$68.8 million. Stolpman dep. at 26-27, Ex. 80. The witness also testified that "even until the mid nineties, over half of the prescriptions [of the ADHD market prescriptions] were for Ritalin or Ritalin SR products." Stolpman dep. at 28.<sup>11</sup>

The above evidence indicates that opposer's mark RITALIN has been the subject of books, newspaper and magazine articles, and television shows. It has generated hundreds of millions of dollars in sales and it is listed in numerous dictionaries as a trademark for the drug methylphenidate. In light of our precedent on well-known

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marks, this evidence and case law convinces us that the mark RITALIN has acquired a significant degree of public recognition and renown. Therefore, this factor weighs heavily in opposer's favor.

Applicant responds to this evidence by arguing that "the Ritalin Drug is highly controversial because of professional and public concerns of abuse and over prescribing to the point that there have been countless public news reports as well as congressional hearings on the topic. For these reasons, and others, it is the Applicant's strong desire not to be associated with the Opposer, or RITALIN, but to be clearly differentiated from Opposer and its product." Applicant's Brief at 3-4. While this may have been applicant's desire, almost any other trademark would have done a better job of not associating applicant "with the Opposer, or RITALIN." Instead, applicant chose the arbitrary prefix of opposer's well-known mark and simply changed the suffix almost guaranteeing an association between its supplement and the prescription drug.

Applicant has chosen a trademark that is close to opposer's and he intends to use the mark on a product that

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<sup>11</sup> Currently Ritalin products account for less than 5% of the ADHD marketplace medications. Stolpman dep. at 28-29.

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will be used to treat the same problem that opposer's drug treats.<sup>12</sup> The Federal Circuit and its predecessor have held that "there is no excuse for even approaching the well-known trademark of a competitor and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc., 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) (internal punctuation marks omitted).

We conclude that applicant's mark RITALOUT when used on nutritional supplements, particularly those used to treat overactive children, will likely cause confusion in view of opposer's registered marks RITALIN and RITALIN SR for the identified pharmaceutical preparations.<sup>13</sup>

Decision: The opposition is sustained and registration to applicant of his mark is refused.

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<sup>12</sup> Applicant admits that opposer is a direct competitor of his in the nutritional supplement business. Brady disc. dep. at 63.

<sup>13</sup> In view of our disposition of the case on the likelihood of confusion ground, we do not reach the dilution issue.