

Mailed:
October 24, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wyeth
v.
David M. Graham

Opposition No. 91124967
to application Serial No. 761479801

Marie V. Discoll of Fross Zelnick Lehrman & Zissu, P.C.,
and Bret I. Parker of Wyeth, for Wyeth

David M. Graham, *pro se*

CORRECTION

By the Board:

A copy of the attached decision was entered in the Board's electronic records with a mailing date of October 13, 2005, but the decision was inadvertently not mailed on that date. As indicated on the attached copy, the decision is being mailed on October 24, 2005. The period for requesting reconsideration or filing an appeal will run from October 24, 2005.

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
October 13, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wyeth¹

v.

David M. Graham

Opposition No. 91124967
against Serial No. 76147801

Marie V. Driscoll of Fross Zelnick Lehrman & Zissu, P.C.,
and Bret I. Parker of Wyeth, for Wyeth.

David M. Graham, *pro se*.

Before Walters, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

David M. Graham seeks registration on the Principal
Register of the mark **AdvaLife** for goods identified in

¹ The opposition was originally filed by American Home Products Corporation. However, on March 11, 2002, American Home Products Corporation changed its corporate name to Wyeth.

the application as "vitamins, minerals and nutritional dietary supplements," in International Class 5.²

Registration has been opposed by Wyeth (formerly American Home Products Corporation). As its ground for opposition, opposer asserts that applicant's mark when used in connection with applicant's goods so resembles opposer's previously used and registered mark, **ADVIL**, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act.

Applicant, in its answer, has denied the salient allegations in the opposition.

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer has also made of record its pleaded registrations by submitting certified status and title copies of the following registrations:

REGISTRATION NO. 1298347 **ADVIL** (STANDARD CHARACTER DRAWING)
for "an Analgesic Preparation" in International Class 5;³

² Application Serial No. 76147801 was filed on October 16, 2000 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

³ Registration No. 1298347 issued on October 2, 1984, claiming first use anywhere and first use in commerce at least as early as July 14, 1983; renewed.

REGISTRATION NO. 1635943 **ADVIL** (STANDARD CHARACTER DRAWING)
for "anti-pyretic and anti-inflammatory preparations and
preparations for the treatment of juvenile arthritis,
rheumatoid arthritis and osteoarthritis" in International
Class 5;⁴ and

REGISTRATION NO. 1942746 **ADVIL** (STANDARD CHARACTER DRAWING)
for "cold and sinus relief medicines" in International Class 5.⁵

Opposer, as part of its case-in-chief, has also made of record, pursuant to a notice of reliance, the testimonial deposition of Kevin Homler, Group Product Director in charge of marketing products under the ADVIL brand, and exhibits thereto. Applicant submitted no evidence in this proceeding and did not file a brief.

As noted above, opposer has shown that its pleaded registrations are valid, subsisting and owned by opposer. Thus, this proof removes the issue of priority from this case. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, as to the claim of priority of use and likelihood of confusion, the focus of our determination is on the issue of whether applicant's mark, when used in connection with the goods set forth in his application, so

⁴ Registration No. 1635943 issued on February 26, 1991, claiming use anywhere and use in commerce at least as early as July 14, 1983; renewed.

⁵ Registration No. 1942746 issued on December 19, 1995, claiming first use anywhere and first use in commerce at least as early as November 1991; renewed.

resembles opposer's ADVIL mark as to be likely to cause confusion, to cause mistake or to deceive as to source or sponsorship.

The record demonstrates that opposer is a leading company in the development and marketing of pharmaceutical products, including analgesics and multi-vitamin, mineral, and nutritional preparations. Opposer's ADVIL brand of products has been in use for over twenty years. This line of products began with an analgesic, but has steadily grown over the years to meet new consumer health care needs (e.g., ORIGINAL ADVIL, ADVIL COLD AND SINUS, ADVIL MIGRAINE, ADVIL FLU AND BODYACHE, ADVIL ALLERGY SINUS, ADVIL MULTI-SYMPATOM COLD, and three formulations of CHILDREN'S ADVIL). These products are intended for a variety of uses, including relief of pain, cold and sinus pain, migraine pain, flu symptoms, allergy and pain relief, sneezing and runny nose.

According to the testimony of Mr. Homler, ADVIL products are sold in virtually every consumer outlet in which over-the-counter analgesics are sold including pharmacies, chain drug stores, food stores and convenience stores. They are also available in foil envelopes in smaller retail outlets and dispensing machines.

ADVIL products are available in tablet form and as caplets, gel-coated caplets and liquid-filled capsules. They are also available in a variety of sizes and prices. The ADVIL brand is stamped on every tablet, caplet and capsule and is thus seen every time a consumer takes one. On typical packaging, the ADVIL mark is shown prominently in bright yellow lettering at least three times.

The volume of annual sales of ADVIL products has been consistent over the past ten years - totaled in excess of *one billion dollars* over the past three years alone. In fact, the ADVIL product line is among the top ten non-prescription medications in the United States.

Opposer's promotional efforts include print advertisements (e.g., in glossy magazines and free standing inserts in Sunday newspapers), ads on radio, television and on the Internet, as well as through mass mailings, point of sale displays and a variety of other promotional activities. Promotions to health care professionals include ads in professional journals, a presence at trade shows, and visits by pharmaceutical sales representatives. Opposer uses several of its websites to provide information about the ADVIL products to consumers as well as health care professionals. Over the

past three years alone, opposer has expended more than *three-hundred million dollars* on its advertising and promotional program on behalf of the ADVIL brand.

As to the success of this promotional activity, consistent with prior consumer surveys, a recent consumer recognition marketing study (2003) showed consumer awareness of the ADVIL brand at 97%.

Applicant seeks to register **AdvaLife** for use on vitamins, minerals and nutritional dietary supplements.

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

Turning first to the goods, the products herein are both over-the-counter health aids. Because there are no limitations as to the channels of trade in applicant's application or in opposer's registrations, we must assume that the parties' goods would be sold in the same channels of trade and to the same classes of consumers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) [the question of likelihood of confusion must be determined

based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration]; see also, Sterling Drug Inc. v. Merritt Corp., 119 USPQ 444, 445 (TTAB 1958); and Pennwalt Corp. v. Center Lab., Inc., 187 USPQ 599, 601 (TTAB 1975). The record demonstrates that products such as vitamins, minerals and nutritional dietary supplements (products that opposer also sells under different marks) will be sold in many of the same outlets as are analgesics.

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, the evidence shows that small packages of analgesics, like small bottles of vitamins, are relatively inexpensive, and are sold to members of the general public rather than to sophisticated purchasers. As a result, the purchase of small quantities of over-the-counter health aids would not be the subject of a great deal of thought or analysis.

We turn next to the du Pont factor focusing on the fame of the prior mark. As a result of opposer's impressive volume of sales and extensive promotional activities, and in light of recent survey results demonstrating widespread public recognition of the mark,

we find opposer's ADVIL mark is indeed a famous mark. Fame, of course, plays a dominant role in cases featuring a well-known or strong mark, as such marks enjoy a wide latitude of legal protection. As the Court said in Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark." Furthermore, as argued by opposer, ADVIL is a totally arbitrary term for ibuprofen, and the record does not reveal any similar marks in use on related goods.

With these points in mind, we turn to a consideration of the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression.

We find that ADVIL and **AdvaLife** are similar as to appearance and sound. The prefix portion of applicant's mark is substantially the same as opposer's arbitrary mark. This first part of a mark is most likely to be impressed upon the mind of a purchaser and remembered. The upper-case letter "L" in applicant's special form drawing only accentuates the similarity in appearance

between the first five letters of each mark (e.g., "advil" and "adval").

Irrespective of the type of goods involved, it is well settled that similarity in sound alone may be sufficient to support a finding of likelihood of confusion. See *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968). This would be even more compelling given the public interest in avoiding confusion between different health care products.

As to connotation and commercial impression, ADVIL is a coined term for analgesics. When used in connection with vitamins and mineral supplements, applicant's "Life" suffix is not particularly distinctive. The likelihood of confusion is greater given that the number of products in the ADVIL line has increased regularly over the years. With each addition, opposer slightly varied the product mark by combining ADVIL with another word or words describing the intended use. Hence, consumers might well believe, mistakenly, that **AdvaLife** vitamins, minerals and dietary supplements are simply the latest addition to opposer's product line.

On this record, after weighing all the du Pont factors, we find that the mark **AdvaLife** is likely to cause

confusion with **ADVIL** when applied to over-the-counter health aids.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.