

THIS DISPOSITION  
IS NOT CITABLE AS  
PRECEDENT OF  
THE TTAB

Oral Hearing:  
April 20, 2004

Mailed: August 31, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Merck & Co., Inc.  
v.  
Nephro-Tech I, LLC

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Opposition No. 91125109  
to Application No. 76263120  
filed on May 29, 2001

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William R. Hansen and Bridget A. Short of Duane Morris LLP  
for Merck & Co., Inc.

Steven H. Mustoe and Justin D. Pulikkan of Seaman Stoll  
Mustoe & McCrummen for Nephro-Tech I, LLC.

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Before Hanak, Quinn and Walters, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Merck & Co., Inc. filed its opposition to the  
application of Nephro-Tech I, LLC to register the mark  
FORMAX for "pharmaceutical; namely dietary supplement for

phosphate binding and calcium supplementation," in International Class 5.<sup>1</sup>

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark FOSAMAX for "pharmaceutical preparations for the treatment and prevention of bone disease"<sup>2</sup> as to be likely to cause confusion, under Section 2(d) of the Trademark Act. Opposer also alleges that its mark is distinctive and famous, and asserts dilution as an additional ground of opposition.

Applicant, in its answer, denies the salient allegations of the claim.<sup>3</sup>

#### *The Record*

The record consists of the pleadings; the file of the involved application; a certified status and title copy of Registration No. 1,710,682; and the responses of applicant to opposer's interrogatories, all made of record by opposer's notice of reliance; and the testimony deposition by opposer of David Baker, opposer's senior director of

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<sup>1</sup> Application Serial No. 76263120, filed May 29, 2001, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

<sup>2</sup> Registration No. 1,710,682, issued August 25, 1992, in International Class 5. [Sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed.]

<sup>3</sup> Applicant included with its answer a counterclaim to cancel opposer's pleaded registration. The Board gave applicant a period of time in which to submit the required fee in connection therewith; however, applicant, instead, withdrew its counterclaim.

marketing for the osteoporosis therapeutic business group, with accompanying exhibits. Applicant filed no testimony or other evidence. Both parties filed briefs<sup>4</sup> on the case and an oral hearing was held at which counsel for both parties appeared.

*Factual Findings*

Opposer's FOSAMAX branded product is a prescription drug used to prevent and treat osteoporosis and to treat Paget's disease, both of which are bone diseases. (Baker Dep. p. 10) Osteoporosis is a bone thinning disease that is particularly common among post-menopausal women. (Baker Dep. p. 18.) Since the fall of 1995, opposer has promoted its FOSAMAX product through sales representative visits and direct mailings to physicians, patient education material for physicians to give to patients, samples of the product provided to physicians, advertising in medical journals, and direct-to-consumer advertising.<sup>5</sup> For example, opposer spends approximately one million dollars annually on journal advertising, eight million dollars annually on distributed samples, and in 2002, approximately 75 million dollars for its 2,000 sales representatives. The sales representatives

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<sup>4</sup> On January 17, 2004, the Board expressly accepted applicant's brief filed on December 21, 2003. Although, at the oral hearing, opposer continued its objection to the brief filed by applicant, we find no error with the Board order and no prejudice to opposer. Therefore, applicant's brief has been considered.

<sup>5</sup> Direct-to-consumer advertising is conducted by opposer principally via television, magazines and newspapers.

target approximately 70,000 U.S. physicians who prescribe osteoporosis medicine. (Baker Dep., pp. 41-42.)

Opposer's web site address for information about this product is [www.fosamax.com](http://www.fosamax.com). In 2002, this web site had 220,842 unique visitors,<sup>6</sup> and in the first five months of 2003, the web site had 118,544 unique visitors. (Baker Dep., p. 82.) Every month, to determine the effectiveness of its direct-to-consumer advertising, opposer conducts a market research study of randomly chosen women over the age of 50 to determine their awareness of opposer's FOSAMAX product. The study results show that overall FOSAMAX brand awareness grew from 31% of women polled in 2000 to 59% of women polled in 2002. (Baker Dep., pp. 84-85, and exh. 33.) However, the record contains no information regarding the methodology involved in these studies or the numbers of women polled.

There are four competing osteoporosis drugs and opposer's FOSAMAX is the market leader, with a 54% market share, whereas the next closest competing product has a 20% market share. (Baker Dep., p. 47.) FOSAMAX prescriptions dispensed increased from 800,000 in January 2000 to approximately 1.8 million in March 2003. (Baker Dep., p. 46.) Opposer's FOSAMAX sales totaled approximately \$1.3

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<sup>6</sup> A "unique" visitor represents one individual rather than the number of times that individual may have visited the site.

billion in 2001, \$1.5 billion in 2002, and \$585 million in the first quarter of 2003. (Baker Dep., p. 51.)

In 2002, opposer partnered with the maker of VIACTIV, a calcium and vitamin D supplement, to distribute kits that include samples of VIACTIV and educational information about bone density testing, osteoporosis and FOSAMAX. Mr. Baker stated that calcium and vitamin D supplements are recommended by physicians for the prevention of osteoporosis; that physicians recommend taking such supplements along with FOSAMAX or another osteoporosis drug in the treatment of osteoporosis; and that opposer provides calcium and vitamin D supplements to all patients involved in its clinical trials for osteoporosis drugs.

In a letter from applicant to opposer, dated January 21, 2003, (Baker Dep., Exh. 25) applicant asked opposer if it would be interested in partnering or acquiring applicant's calcium supplement technology. Opposer responded that it was not interested.

Applicant described its proposed FORMAX branded product as "a calcium supplement containing calcium formate" and stated that it selected its mark "by combining the words **formate** (calcium formate) and **max**imum, ... [which] enables the marketing by-line 'for maximum calcium absorption, FORMAX.'" (Applicant's answers to opposer's first set of interrogatories, No. 4.) Applicant acknowledged that it was

aware of opposer's mark used in connection with its identified goods at the time it selected the FORMAX mark. Applicant has neither used the FORMAX mark on the identified goods nor promoted or advertised the mark. However, applicant stated that it intends to sell its product directly to consumers through health food stores and other retail outlets for such products.

*Analysis*

*Likelihood of Confusion*

Inasmuch as a certified copy of opposer's registration is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*,

544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Opposer contends that FOSAMAX is a famous mark entitled to a broad scope of protection; that FOSAMAX and FORMAX are similar in appearance, sound, connotation and commercial impression; that the parties' goods are related and move through overlapping channels of trade, noting that, while opposer's product is available by prescription only, both products will be available at pharmacies; and that consumers are likely to mistakenly believe that applicant's calcium supplement comes from the same source as opposer's prescription osteoporosis medication.

Applicant contends that the marks are different in appearance, sound, connotation and commercial impression, noting that the marks share only the suffix MAX; that the goods are unrelated, noting that the chemical composition of the products is different and the products are intended for different purposes; that the goods are not competitive, noting that its product is an over-the-counter dietary supplement and opposer's product is a prescription drug; that, except for pharmacies, the products will not be sold in the same store; that opposer's product is prescribed only by doctors and dispensed only by pharmacists and, thus, is purchased with care; and that the fame of opposer's mark is

limited to a prescription drug for the treatment and prevention of osteoporosis.<sup>7</sup>

The first *du Pont* factor we consider is the fame of opposer's mark. Opposer submitted sufficient evidence of the extent of its advertising, sales and consumer awareness to warrant the conclusion that FOSAMAX is a famous mark for pharmaceutical preparations for the treatment and prevention of bone disease. As our primary reviewing Court has made clear, fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. "Famous or strong marks enjoy a wide latitude of legal protection" and a famous mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). In this regard, the Court has noted 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 when the established mark is one which is famous." *Kenner Parker Toys*, 22 USPQ2d at 1456; and *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 2 USPQ2d 1901, 1904 (Fed. Cir. 1989). This is so

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<sup>7</sup> In its reply brief, opposer objected to statements of fact in applicant's brief that are outside the record. These statements of alleged fact have not been considered.

because "a well-known mark enjoys an appropriately wider latitude of legal protection, for similar marks tend to be more readily confused with a mark that is already known to the public." *Opryland USA, Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992). See also *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)(involving the marks SPICE ISLANDS and SPICE VALLEY).

Turning to consider the goods of the parties, we observe that both the goods identified in the application and the goods identified in the pleaded registration are "pills"; that both products are used by the consumer in connection with bone health and, while opposer's FOSAMAX is used for the treatment of osteoporosis, it is also used for the prevention of osteoporosis, as is applicant's calcium supplement. Further, the record establishes that calcium supplements and opposer's medication are regularly used together and that opposer has advertised its product together with a calcium supplement. Indeed, this complementary relationship is shown by applicant's attempt to partner its product with opposer's product. Thus, in use and purpose, applicant's identified calcium supplement is closely related to the osteoporosis medication identified in opposer's registration. This relationship is not mitigated by the fact that one product is an over-the-counter

supplement and the other is a prescription medication.

Thus, regardless of the fame of opposer's mark, we conclude that the goods of the parties are closely related.

Further, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of the applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, as applicant has acknowledged, the channels of trade are overlapping and the class of purchasers of the parties' goods, i.e., consumers, are the same.

Turning to the marks, we note that while we must base our determination on a comparison of the marks in their entirety, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

As applicant concedes, both marks consist of the suffix "MAX." While applicant indicated what it intends the connotation of the MAX portion of its mark to be, there is no evidence that consumers would so understand the suffix or that it would be perceived as having a different connotation from the identical suffix in opposer's mark. Additionally, both marks begin with the letters "FO." In view of the related nature of the goods and the established fame of opposer's mark, which entitles it to a broad scope of protection, we find that the marks FOSAMAX and FORMAX are substantially similar.

In conclusion, in view of the substantial similarity in the commercial impressions of applicant's mark, FORMAX, and opposer's mark, FOSAMAX, their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

*Dilution*

Because we have found that opposer has priority and that a likelihood of confusion exists, we need not, and do not, reach opposer's claim of dilution under Section 43(a) of the Trademark Act.

*Decision:* The opposition is sustained.