

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Biogen, Inc. and Biogen Idec Ma, Inc.,
joined as a plaintiff¹

v.

Altana Pharma AG (f/k/a Bykg Gulden
Lomberg Chemische GmbH)

Opposition No. 91125855 to application Serial No. 76105433
filed on August 7, 2000

Mailed: November 14, 2005

Roberta Jacobs-Meadway, Jay K. Meadway and Patricia G.
Cramer of Ballard Spahr Andrews & Ingersoll, LLP, for Biogen
Idec Ma, Inc.

Mark Peroff and Darren W. Saunders of Kirkpatrick & Lockhart
LLP for Altana Pharma AG.

¹ On January 6, 2005, the Assignment Division of the United States Patent and Trademark Office recorded an assignment of Registration No. 2470036, which is asserted in the notice of opposition, from Biogen, Inc. to Biogen Idec Ma, Inc. See Reel No. 3003, Frame No. 0366. In view thereof, Biogen Idec Ma, Inc. is joined as a party plaintiff in this proceeding. See TBMP § 512.01 (2d ed. rev. 2004).

The parties refer to Biogen Idec Ma, Inc. as "f/k/a Biogen, Inc." in their briefs. However, the Board has not received documents of a change of name from Biogen, Inc., and the Assignment Division has recorded the transfer of Registration No. 2470036 as an "assignment." In view thereof, we consider the transfer to have been an assignment and refer to plaintiff in this proceeding as "opposer" rather than "opposers."

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Before Walters, Drost and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Altana Pharma AG, seeks registration on the Principal Register of the mark AMAVIO² (in standard character form) for the following goods, as amended:

"pharmaceutical preparations for the treatment of gastrointestinal and respiratory diseases" in International Class 5.

Opposer Biogen, Inc. filed a timely notice of opposition to registration of applicant's mark. In the notice of opposition, opposer pleaded ownership of Registration No. 2470063 for the mark AMEVIVE for "pharmaceutical preparations for use in the treatment of dermatological disorders; pharmaceutical preparations for use in the treatment of autoimmune disorders; pharmaceutical preparations for use in the treatment of inflammatory disorders; [and] pharmaceutical preparations for use in the treatment [of] psoriasis," in International Class 5;³ and alleged that applicant's mark, as applied to the goods identified in the application, so resembles opposer's previously-used and registered mark AMEVIVE as to be likely

² Application Serial No. 76105433, filed August 7, 2000, is based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b).

³ Registration No. 2470063 issued July 17, 2001.

to cause confusion, to cause mistake, or to deceive.

Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant answered the notice of opposition by denying the salient allegations thereof.

The Record

The record consists of the pleadings; the file of the involved application; the trial testimony, with related exhibits, taken by opposer, of Douglas Abel, Vice President, Dermatology Business Unit of Biogen Idec Ma, Inc. and Gunther Winkler, Ph.D., Vice President, Strategic Initiatives, of Biogen Idec Ma, Inc.; and the trial testimony, with related exhibits, taken by applicant of Dr. Wolfgang Feiler, Director of Trademarks of Altana Pharma G.⁴

⁴ On November 24, 2003, opposer filed a motion to strike two exhibits to the testimony deposition of Dr. Feiler, which were produced just prior to Dr. Feiler's deposition, and Dr. Feiler's testimony regarding such documents. Specifically, opposer requests that we strike (i) the packaging for the "AMAVIO Inhaler" pharmaceutical preparation, and (ii) a forty-page report that a marketing research company prepared for applicant on the use of AMAVIO and other potential marks for two different compounds being developed by applicant for future pharmaceuticals: roflumilast and ciclesonide. According to opposer, opposer had requested the packaging and report in its discovery requests during the discovery period, but opposer failed to produce the packaging and report.

Opposer's motion to strike is denied. Opposer has not established that it has been prejudiced by the late production of the exhibits; applicant has explained that its failure to produce the full report was "inadvertent"; opposer has not shown how applicant's failure to produce the full report and packaging has interfered or prejudiced its ability to present its case at trial or on its briefing; and opposer did not present any evidence during its case in chief regarding a summary of the report regarding roflumilast, which applicant had produced to opposer during the discovery period.

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Also, pursuant to opposer's notices of reliance, opposer has introduced the following into evidence: a status and title copy of opposer's Registration No. 2470063 showing opposer as the owner of record for Registration No. 2470063 and that the registration is subsisting; copies of various printed publications and public records; a dictionary definition of "amavios"; third-party trademark registrations; and applicant's responses to opposer's first set of interrogatories.

Both parties filed briefs. An oral hearing was not requested by either party.

Factual Findings

Opposer is a global biopharmaceutical company that develops, manufactures, and markets human therapeutic products. Included among such products is a lymphocyte activating protein having the generic name Alefacept and branded AMEVIVE. (Winkler Dep. at 10 - 11.) AMEVIVE has been approved for the treatment of adult patients with moderate to severe chronic plaque psoriasis, which is an immune-mediated inflammatory disease or disorder. (Abel Dep. at p. 42 - 43.) AMEVIVE currently does not have any applications for asthma. (Winkler Dep. at p. 67.) The mark AMEVIVE was selected in part because it fit into opposer's portfolio of drugs beginning with the letter "A" that sound soothing to people with lifelong autoimmune diseases.

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(Winkler Dep. at 12.) AMEVIVE is only administered pursuant to a prescription from a physician. (Abel Dep. at p. 61.)

Opposer maintains a website whose Internet address is www.Amevive.com. (Abel Dep. at p. 13.) The website is directed to three audiences; individuals with psoriasis, physicians and the press. (Abel Dep. at p. 14.) Opposer also has a "patient support kit," comprising a video and a booklet, and targeted at the patient to answer any questions the patient may have in considering psoriasis therapies. (Abel Dep. at p. 15.) Additionally, opposer maintains a toll free telephone service which allows the patient to get answers to questions regarding AMEVIVE directly from opposer, advertises AMEVIVE in publications such as the patient journal published by the National Psoriasis Foundation and advertises to patients by means of direct mail. (Abel Dep. at p. 17.) Further, opposer distributes brochures for display in physicians' offices for the purpose of generating a discussion about AMEVIVE between the patient and the physician, has advertised AMEVIVE by means of a "supplement" distributed in *Readers Digest*, and makes direct mailings to potential patients who have solicited information about AMEVIVE and to all dermatologists in the United States. (Abel Dep. at pp. 19 - 21, 24.)

Clinical trials for AMEVIVE have been conducted to examine the efficacy of the drug in three autoimmune

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diseases, i.e., scleroderma of the lung, rheumatoid arthritis and psoriatic arthritis. (Winkler Dep. at pp. 16 and 54 - 55. Abel Dep. at p. 43.) Scleroderma of the lung is a respiratory condition. (Abel Dep. at p. 81).

Additionally, opposer has written protocols for clinical studies for Crohn's disease⁵ and opposer has made plans for clinical studies for ulcerative colitis. (Wrinkler Dep. at p. 57. Abel Dep. at p. 44.) Also, opposer is developing a protocol for alopecia areata and has attempted protocols for multiple sclerosis, atopic dermatitis and an oncological indication, i.e., cutaneous T cell lymphoma. (Winkler Dep. at p. 17. Abel Dep. at p. 46.)

AMEVIVE is not distributed directly to general pharmacists. Rather, AMEVIVE is distributed by opposer to a wholesale distributor and to one specialty pharmacist which helps health plans manage and monitor the distribution of pharmaceutical agents. (Abel Dep. at p. 67 - 68.) From the wholesale distributor and specialty pharmacist, AMEVIVE is

⁵ Crohn's disease is defined in *Collins English Dictionary*, HarperCollins Publishers (2000) as "[i]nflammation, thickening, and ulceration of any of various parts of the intestine, especially the ileum." Also, *The American Heritage Dictionary of the English Language* defines "inflammatory bowel disease" as a "chronic disorder of the gastrointestinal tract, especially Crohn's disease or an ulcerative form of colitis, characterized by inflammation of the intestine and resulting in abdominal cramping and persistent diarrhea." (The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).) Thus, Crohn's disease and ulcerative colitis are both gastrointestinal diseases.

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forwarded to the physician, hospital pharmacy or other pharmacy. (Abel Dep. at p. 70.) Also, AMEVIVE is advertised in dermatology medical journals and has been the subject of a *Readers Digest* supplement. (Abel Dep. at p. 81.)

The AMEVIVE label states that the patient's T cell blood count should be checked after AMEVIVE is administered to the patient. Presently, AMEVIVE is injected into the patient's body and must be administered by a healthcare professional. (Abel Dep. at pp. 68 and 74). However, proteins (such as AMEVIVE) are not only injected into the body, but may be formulated as pills and absorbed throughout the stomach or other parts of the intestines. Dr. Winkler predicted that at some point, AMEVIVE could be administered orally or through skin patches. (Winkler Dep. at p. 61). Dr. Winkler also indicated that opposer envisions seeking regulatory approval to "do away" with blood testing every time AMEVIVE is administered, so as to make it easier for the patient to administer AMEVIVE by himself or herself at home. (Winkler Dep. at p. 63.) Mr. Abel testified that he did not know of anything that would preclude AMEVIVE from being self-injected by a patient at home, in the future. (Abel Dep. at pp. 105, 112.)

The cost to wholesalers for AMEVIVE ranges from \$7,000 to \$10,000 for one course of treatment, i.e., twelve doses.

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The retail price for one course of treatment is \$8,400 to \$11,900. (Abel Dep. at p. 84.)

Applicant is a German pharmaceutical company which sells its products in ninety countries throughout the world. Its core business is in the areas of gastrointestinal and respiratory diseases. (Feiler Dep. at pp. 3 - 4.) It manufactures a ciclesonide, i.e., a glucocorticosteriod, for the treatment of asthma, and the brand name of the ciclesonide is AMAVIO. (Feiler Dep. at pp. 5-7.) Applicant has not yet submitted the ciclesonide product for Food and Drug Administration approval and the ciclesonide product is not currently being marketed under the AMAVIO mark in any countries. (Feiler Dep. at pp. 15, 33 and 59.) According to Dr. Feiler, ciclesonide is not used to treat psoriasis, any dermatological diseases, or any autoimmune diseases, and it is the patient who administers AMAVIO, by inhaling a metered dose. (Feiler Dep. at p. 20.) There are specific dosages of the product, and the product is dispensed by prescription only. (Feiler Dep. at p. 21.)

Standing/Priority

As noted, opposer has submitted at trial a status and title copy of Registration No. 2470063. The registration is extant and is owned by Biogen Idec Ma, Inc., by assignment from Biogen, Inc.⁶ Because of opposer's proof of ownership

⁶ See Assignment Division records at Reel No. 3003, Frame 0366.

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of its registration, and also because of the evidence of record regarding opposer's use of its registered mark, we find that opposer has established its standing to oppose registration of applicant's mark. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Also, because opposer's pleaded registration is of record, Section 2(d) priority of use is not an issue in this case as to the mark and goods covered by opposer's registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). 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 §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.*

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Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The salient question to be determined is not whether the involved goods and/or services of the parties are likely to be confused, but rather whether there is a likelihood that the relevant purchasing public will be misled to believe that the goods and/or services offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435 (CCPA 1965); and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976).

The Marks

Opposer's mark comprises the single coined word AMEVIVE. Applicant's mark AMAVIO also consists of a single word. The record reflects the existence of a Portuguese word "amavios," which translates into English as follows: "m. pl. 1. love potion ..., 2. means of seduction, 3. charms: a) incantations, b) allurements." *Michaelis Illustrated Dictionary*, Vol. II (Portuguese-English), Edicoes Melhoramentos. There is no evidence in the record that "amavios" ever appears in the singular form as "amavio," and the parties do not so contend in their briefs. However, even if "amavio" is the singular form of "amavios," we find that both marks are arbitrary terms in the context

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of the identified goods, and, taken as a whole, without meaning in the English language. (See Winkler Dep. at p. 8.)

Both parties' marks are shown in standard character form and both marks begin with the same prefix "AM" and have the letter combination "VI" in the middle of the mark. Although the third letter in applicant's mark is an "A" and the third letter in opposer's mark is an "E," these vowels could be pronounced similarly. The parties do not agree on a pronunciation of the marks or which syllable of the marks is emphasized, e.g., the first, second or third syllable. However, there is no "correct" pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. See, e.g., *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985). In view thereof, and because the record does not include any evidence as to how the purchasing public actually pronounces each mark, we find that the purchasing public may pronounce the marks in a manner such that the terminal portion of each mark is the only difference between the marks when spoken. In our view, this difference in the endings of the marks is minor in comparison to the other similar features of the marks. In their entireties, we find that the marks would be or could be pronounced very similarly.

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In terms of appearance, we find that the marks are similar, differing only by one letter in the middle of the marks and by their endings. Overall, we find the marks to be more similar than dissimilar in terms of appearance.

Applicant points out that opposer's mark contains one more letter than applicant's mark; that applicant's mark contains one more syllable than opposer's mark; and that the ending of applicant's mark is a combination of two vowels, i.e., "I" and "O" (pronounced "eeo"), while the ending of opposer's mark is a "V" sound. However, both marks are of sufficient length such that the additional letter of opposer's mark is likely to be virtually unnoticeable. Also, the minor differences between applicant's mark and opposer's mark are not likely to be recalled by purchasers seeing the marks at separate times.

In terms of connotation, applicant argues that "[t]he term 'vive' [in AMEVIVE] suggests 'life', e.g., 'survive' (meaning to remain alive), 'revive' (meaning to bring back to life), and 'vivacity' (meaning liveliness). The root vive derives from the Latin 'vivere', meaning 'to live.'" In contrast, AMAVIO "has no such connotation." (Applicant's Brief at p. 4.)

We take judicial notice of the definition of "vive" in *English* as "[l]ong live; up with (a specified person or thing). [from French]." *Collins English Dictionary*,

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HarperCollins Publishers (2000). In view of this English language definition, we find that the connotations of the marks are different. However, we view this difference in connotation - due only to a portion of one of the marks - as slight, which is outweighed by the similarities in the sound and appearance of the two arbitrary marks.

In view of the foregoing, we find that the parties' arbitrary marks are similar in sound and appearance, and that hence the commercial impressions of the marks are similar. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). This *du Pont* factor hence is resolved in opposer's favor.

The Goods

Both opposer's and applicant's identifications of goods identify pharmaceutical preparations by disorder or disease, i.e., by psoriasis or dermatological, autoimmune or inflammatory disorders (for opposer), or by gastrointestinal and respiratory diseases (for applicant). There is no limitation in the identifications as to the types of dermatological, autoimmune or inflammatory disorders, or gastrointestinal or respiratory diseases.

Opposer's trial witnesses have testified that opposer has conducted clinical trials for AMEVIVE to examine the

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efficacy of the drug in three autoimmune diseases, i.e., scleroderma of the lung, rheumatoid arthritis and psoriatic arthritis, and that scleroderma of the lung is a respiratory condition. (Winkler Dep. at p. 16 and 54 - 55. Abel Dep. at pp. 43, 81). Additionally, they have testified that opposer has written protocols for clinical studies for Crohn's disease and plans have been made for ulcerative colitis, (Winkler Dep. at p. 57; and Abel Dep. at p. 44.) which are both gastrointestinal diseases. Thus, not only are opposer's and applicant's goods both pharmaceutical compounds, opposer's goods are the subject of clinical trials or are being evaluated for use in connection with gastrointestinal and respiratory diseases.⁷

Additionally, opposer has made of record several third-party registrations which show that the same mark has been registered by the same entity for pharmaceutical

⁷ Applicant challenges opposer's contention that its goods "'may' at some unspecified time in the future, have applications for other diseases" as "tenuous" and "only speculation." Applicant points to Dr. Winkler's response in his testimonial deposition to a question regarding whether AMEVIVE "could have any applications for asthma." According to applicant, Dr. Winkler "responded in a narrative about the 'whole cascade of how asthma evolves', but upon further questioning, admitted that presently, no possible application for asthma for AMEVIVE exists." (Winkler Dep. at p. 67-68.)

We cannot neglect the fact that in the future, opposer's drug may be used in connection with different diseases, and that opposer has initiated protocols and has actually conducted clinical trials to determine the effectiveness of its drug for applications other than psoriasis. In our analysis, we consider the scope of opposer's identification of goods, and find that opposer's identification of goods encompasses the potential uses

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preparations for the treatment of both (i) dermatological disorders, and (ii) respiratory and/or gastrointestinal disorders. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Specifically, opposer has introduced the following registrations into evidence which identify both pharmaceutical preparations for respiratory and dermatological diseases in their identifications of goods: Registration No. 2579002 for LIPOCLONAL, No. 2255322 for ACTHAR GEL, No. 2185127 for ORAPRED, No. 2654617 for EUKARION, No. 2124359 for LEVULAN, No. 2510743 for DEXCEL, and No. 1871803 for PHARMAGENESIS. Similarly, the following registrations are in evidence that identify both pharmaceutical preparations for gastrointestinal and dermatological diseases in their identifications of goods: Registration No. 2386195 for GENEBSITE, No. 2654617 for EUKARION, No. 2579002 for LIPOCLONAL, No. 2185127 for ORAPRED, No. 1871803 for PHARMAGENESIS, and No. 267861 for LEDERLE. These registrations suggest that pharmaceutical preparations for respiratory and dermatological diseases,

identified by opposer for AMEVIVE for which opposer has commenced

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and pharmaceutical preparations for gastrointestinal and dermatological diseases, may be related, and specifically that applicant's identified goods and opposer's identified goods may emanate from a single source and be sold under a single mark.⁸

Applicant has contended that the goods are not related because ciclesonide (the active compound in the AMAVIO preparation) is for the treatment of asthma, and the FDA has only approved AMEVIVE for the treatment of moderate to severe chronic plaque psoriasis. Applicant also has argued that the parties' goods differ because while applicant's goods are administered by an inhaler, opposer's goods "must be administered by a health care professional, and cannot be administered by the patient"; that "[i]t is likely to be administered in a health care environment, usually in a physician's office, and not in the home"; that "[i]t is only available in an injectable form"; that "[i]t can be administered only once a week during a twelve-week treatment program"; that "[p]atients must have their T cell blood count checked after each dose is administered"; that "[t]he

clinical trials and protocols.

⁸ The registrations introduced by opposer but not identified in this decision are of no evidentiary value because they are not based on use in commerce. Our review of these registrations reveals that many of such registrations are based on Section 44 of the Trademark Act, rather than on use in commerce. Also, several of the registrations are for house marks covering a wide range of pharmaceutical products. Because these registrations do not show that these goods have ever been sold in this country, or cover such a wide range of goods, they are entitled to no weight.

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product is generally shipped directly to a doctor's office and in the vast majority of cases is not dispensed in a pharmacy"; and that "[t]he product may cause serious infections and malignancies in some patients, thereby requiring heightened cautionary measures in prescribing and administering the compound."⁹

However, a determination of the issue of likelihood of confusion between the applied-for and the registered marks must be made on the basis of the goods as they are identified in the involved application and registration. See *Cunningham*, 55 USPQ2d at 1848. In such circumstances, if there are no limitations in the identification, we must presume that the "registration encompasses all goods of the nature and type described." *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Because applicant's identification of goods is not limited to pharmaceutical treatments for the treatment of asthma and opposer's identification of goods is not limited to pharmaceutical preparations for the treatment of psoriasis, and because neither identification of goods contains limitations regarding the manner which the drugs are administered, where they are administered, and the frequency of administration, applicant's foregoing arguments

⁹ Applicant contends that such differences should be considered under the thirteenth du Pont factor, i.e., "any other established fact probative of use." *Du Pont*, 177 USPQ at 567. Because applicant's arguments really concern the parties' goods, we consider applicant's arguments under the second *du Pont* factor.

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are not arguments we may consider in determining whether the goods are related.¹⁰ *Id.*

It is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

In view of the foregoing, and based on the evidence of record and identifications of goods, we find that the

¹⁰ Opposer has also made of record third-party registrations to show that the "same mark is often registered and used for pharmaceutical products administered by injection and inhalation ..." Because opposer has only submitted a limited number of registrations, one registration is a duplicate of another, and not all of such registrations are based on use in commerce, and further because opposer's argument is of no moment, we give such registrations limited consideration.

parties' goods are related and resolve this factor too in opposer's favor.

Trade Channels

Inasmuch as the identifications of goods in both the registration and the application do not include any limitations with respect to trade channels, we assume that both parties' goods move through the same trade channels, namely all trade channels normal for goods of this type in the healthcare field. *Elbaum*, 211 USPQ at 640. These trade channels include hospitals and other healthcare facilities, hospital pharmacies, general pharmacies and physicians' offices. Thus, we resolve this factor in opposer's favor.

*Conditions Under Which And Buyers
to Whom Sales Are Made*

As discussed above, both parties' pharmaceutical preparations are only available by prescription from a physician, and may be purchased in hospitals and other healthcare facilities, hospital pharmacies, general pharmacies and physicians' offices. Thus, necessarily, healthcare professionals are involved in the purchasing decisions and dispensing each parties' goods. We find that these health professionals are sophisticated, having necessarily been educated about the benefits, side effects and dosages of each drug and being involved in dispensing prescription drugs on a daily basis. They hence are likely to exercise more than the normal degree of care in

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determining whether to prescribe the parties' drugs. See *Pennwalt Corp. v. Center Laboratories, Inc.*, 524 F.2d 235, 187 U.S.P.Q. 599 (CCPA 1975) ("... physicians may, as a group, be considered relatively careful or sophisticated purchasers ...") See also *Astra Pharmaceutical Products v. Beckman Instruments*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983); and *In re Istituto Sieroterapico E Vaccinogeno Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985).

Also, opposer has introduced evidence indicating that opposer markets AMEVIVE as a treatment for psoriasis to "people who suffer from psoriasis or have family with the condition." The record reflects that opposer has advertised its drug as a treatment for psoriasis in a supplement to *Reader's Digest*, maintains a website for all to access, has placed pamphlets in physicians' offices so that patients may have information with which to discuss opposer's drug with their physician, and has advertised in the National Psoriasis Association's journal.

As to this group, i.e., "people who suffer from psoriasis or have family with the condition," opposer maintains they are "not so knowledgeable or discriminating [and] [i]t is for that well established reason that greater care must be exercised in the use and registration of trademarks for pharmaceutical preparations to assure that no harmful confusion occurs." The Third Circuit has recognized

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the role of the patient in choosing medication, stating that "[w]hile doctors and pharmacists play a gate-keeping role between patients and prescription drugs, they are not the ultimate consumers. Patients are. Courts have noted that drugs are increasingly marketed directly to potential patients through, for example, 'ask-your-doctor-about-Brand-X' style advertising." *Kos Pharmaceuticals Inc. v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004).

Further, the Third Circuit in *Kos Pharmaceuticals* identified a standard of care to be exercised in such a situation where the patient is involved in selecting a medication, stating that "[w]here both professionals and the general public are relevant consumers, 'the standard of care to be exercised ... will be equal to that of the least sophisticated consumer in the class.'" *Id.* at 716.

In this case, where the record reflects that opposer's pharmaceutical preparations have been promoted directly to the patient, the relevant public involved in purchasing decisions for opposer's goods is not just limited to healthcare professionals, but also includes people who suffer from psoriasis or have family with psoriasis. In the future, if opposer decides to market AMEVIVE for other applications such as for Crohn's Disease, the relevant public involved in purchasing decisions for opposer's goods would expand to include people who suffer from such

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respiratory or gastrointestinal diseases and have family who suffer from such diseases, who are the same persons involved in purchasing applicant's goods. Such patients do not exercise the degree of care exhibited by medical professionals and cannot be deemed sophisticated consumers.

Of course, it appears reasonable to assume that any confusion that the patient may have due to his status as an unsophisticated purchaser will be mitigated by the assistance of healthcare professionals in prescribing, purchasing and/or administering the drugs. However, because the goods, as identified, do not contain use restrictions, we assume that, at some point in the future, the pharmaceutical preparations may be administered by the patient directly such as by self-injection or by means of a patch or by a pill, which can be taken by the patient at home. Dr. Winkler inasmuch testified in his testimonial deposition that opposer is exploring self-injection or administration of AMEVIVE by a patch or a pill. (Winkler Dep. at pp. 61 and 63.) Thus, any precautionary controls over opposer's pharmaceutical preparations that currently exist by virtue of having a healthcare professional such as a nurse, physician or technician administering the preparations will be lost when prescriptions for such drugs are regularly filled at the local drug store or pharmacy and administered by the patient.

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Also, health professionals are not immune from source confusion and likely would be involved in prescribing and dispensing both drugs. As discussed above, doctors, and nurses and pharmacists too, are sophisticated and are not prone to carelessness. Nonetheless, confusion is likely, even among these healthcare professionals, where these similar goods are marketed under the similar marks involved herein; there is no reason to believe that medical expertise as to pharmaceuticals will ensure that there will be no likelihood of confusion as to source or affiliation. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301 (TTAB 2004).

Applicant argues that "the relevant audience is highly sophisticated, since the vast majority of physicians who prescribe the AMEVIVE product are specialists - dermatologists." Applicant further argues that "[c]learly, dermatologists are even more sophisticated purchasers or prescribers of dermatological pharmaceuticals than general physicians, and it is therefore highly unlikely that they would be confused by a respiratory or gastrointestinal pharmaceutical named AMAVIO." (Applicant's Brief at pp. 7-8.) We cannot presume that all prescribing physicians are dermatologists, but must assume that any physician may prescribe AMEVIVE, because there is no restriction in the

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identification of goods. Thus, applicant's argument is not well taken.

Applicant also argues that AMEVEIVE "is extraordinarily expensive"; that "[o]ne 12-week treatment costs between \$8,400 and \$11,900"; and that this factor "weighs strongly in favor of finding of no likelihood of confusion." The identifications of goods, however, do not include any limitations regarding the prices of the goods. Further, as written, the identifications of goods encompass relatively inexpensive prescription generic drugs. Applicant's arguments regarding the costs of opposer's and applicant's drugs are, therefore, for purposes of this proceeding, irrelevant.

We resolve this factor concerning the conditions under which and buyers to whom sales are made in opposer's favor.

Number And Nature Of Similar Marks In Use On Similar Goods/Fame of the Mark

Opposer maintains that "[t]here is no evidence of any use by third parties of marks for pharmaceutical preparations which share the same AM prefix and employ only the same two consonants (M and V)"; that "[t]here is no evidence of any use of any similar marks for pharmaceutical preparations"; and that AMEVIVE is a strong mark. Applicant counters that opposer's mark does not have the level of recognition necessary to be considered a "famous" mark.

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Opposer, in its main brief, has not contended that its mark is famous. Applicant, in its main brief, only states that "AMEVIVE is used for a newly introduced bioengineered treatment only recently approved by the FDA" in support of its contention that the mark is not famous. It has not cited to advertising or sales figures, or other indicia of fame. We do not resolve the *du Pont* factor of fame in applicant's favor. As stated by the Federal Circuit in *Majestic*, 65 USPQ2d at 1205, "[e]ven if such evidence [of fame] were of record, though, it would have little probative value. Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, *DuPont*, 476 F.2d at 1361, 177 USPQ at 567 (factor five), we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous." Thus, the factor of fame is neutral, and is not resolved in either party's favor.

As for the strength of opposer's mark, opposer is correct that there is no evidence of use by third parties for pharmaceutical preparations. We therefore find on this record that AMEVIVE for the identified pharmaceutical preparations is a strong mark and that the scope of protection to which it is entitled is broad enough to preclude registration of applicant's mark for similar goods. See *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

Absence of Actual Confusion

As opposer has noted, applicant's product is not yet available on the market and has not yet been advertised. Accordingly, there has been no occasion for confusion. This factor is also neutral and not resolved in either party's favor.

Good Faith Adoption

Opposer maintains that applicant "has not proceeded in good faith in connection with its adoption" of its mark because it failed to have a trademark search conducted by competent trademark counsel; "[n]o comprehensive search from an agency such as Thomson & Thomson was ordered"; applicant filed and maintained its application "despite an apparent admission that there was no longer any bona fide intent to use the mark for some of the indications identified"; and it did not "meet its obligation as the junior party to select a mark not likely to cause confusion with the mark of another." (Applicant's Brief at p. 15.) There is no requirement that "a trademark search conducted by competent trademark counsel" be made or that any particular "agency" be used prior to adopting and filing for registration of a trademark. Also, Dr. Feiler, applicant's Director of Trademarks, testified in his deposition that he had never heard of the name AMEVIVE before applicant filed the application involved in this proceeding. Thus, these

factors are not resolved in opposer's favor, but rather are neutral.

Conclusion

We conclude, based on a preponderance of the evidence, and particularly in view of the similarities between the marks and the goods recited in the identifications of goods, that there is a likelihood of confusion when the marks AMEVIVE and AMAVIO are contemporaneously used on the parties' respective drugs. However, because there are differences between the appearances of the marks, we consider this case as a close case. To the extent that we have doubts as to the proper resolution of this case, we consider it appropriate to resolve such doubt against the newcomer (applicant) and in favor of the prior user and registrant (opposer). See *In re Pneumatiques, Caoutchouc Manufacture*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973) ("If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant.") See also, *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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As a final point, prior decisions state that, 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. This further supports our conclusion herein. See *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972); *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); and *Schering Corp. v. Alza Corp.*, 207 USPQ 504 (TTAB 1980). See also, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:32 (4th ed. 2005).

DECISION: The opposition is sustained and registration to applicant is refused.¹¹

¹¹ In view of our decision in this case, which is applicable to applicant's identification of goods in its entirety, i.e., as "pharmaceutical preparations for the treatment of gastrointestinal and respiratory diseases," applicant's contested motion (filed October 7, 2003) to amend its identification of goods to "pharmaceutical preparations for the treatment of respiratory diseases" is denied as futile. See TBMP § 514.03 (2d ed. rev. 2004).