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Grendel

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cortex Biochem, Inc.
v.
Roche Diagnostics GmbH
(a German Limited Liability Company)

Opposition No. 91123244
(to application Serial No. 75941114
filed on March 10, 2000)

Cortex Biochem, Inc.
v.
Roche Diagnostics Corporation
(an Indiana Corporation, f/k/a
Boehringer Mannheim Corporation)[1]

Cancellation No. 92040577
(involving Registration No. 2504968
issued November 6, 2001, from an
application filed on August 28, 1998)[2]

and

[1] Change of name recorded on February 13, 1999 at Reel 1847, Frame 0627.

[2] We note that the defendant in Cancellation No. 92040577, Roche Diagnostics Corporation, is not the same entity as the defendant in Opposition No. 91123244, Roche Diagnostics GmbH. However, the the parties have treated the two companies as a single entity and a single party throughout these proceedings. In view thereof, and because it would appear that the two entities are likely to be in privity with each other, we shall treat them as such. In this opinion, we shall refer to them collectively as Roche or as the Roche entities. As noted below, both of these Roche entities are parties plaintiff in the third proceeding, Opposition No. 91159233.

Roche Diagnostics GmbH, and
Roche Diagnostics Corporation
v.
Cortex Biochem, Inc.

Opposition No. 91159203
(to application Serial No. 76289333
filed on July 24, 2001)[3]

Kevin R. Martin of McNichols Randick O'Dea & Tooliatos, LLP for Cortex Biochem, Inc.

Amy L. Rankin of Bose McKinney & Evans, LLP for Roche Diagnostics GmbH and Roche Diagnostics Corporation.

Before Quinn, Grendel[4] and Rogers, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

I. INTRODUCTION

The first of the three above-captioned proceedings (Opposition No. 91123244) involves Roche's application, Serial No. 75941114, to register the mark MAGNA PURE (in

[3] The first two of the three cases captioned above, in each of which the plaintiff is Cortex Biochem, Inc. (hereinafter Cortex) and the defendant is one of the Roche entities, were previously consolidated by order of the Board, and they were fully litigated by the parties. The third case captioned above, in which both Roche entities are plaintiffs and Cortex is the defendant, was not consolidated but instead was suspended prior to trial pending the outcome of the first two proceedings. In its final brief in the consolidated proceedings, Roche requested that the third case be "accelerated" and decided along with the two previously-consolidated cases. In its reply brief, Cortex joined in Roche's request. Accordingly, we hereby add Opposition No. 91159233 to previously-consolidated Opposition No. 91123244 and Cancellation No. 92040577, and we shall decide all three cases in this single opinion.

typed form, PURE disclaimed) for goods identified in the application as follows:

> in vitro diagnostic agents for medical use; biochemicals, namely chemical reagents for the purification of nucleic acids for medical use, in Class 5;
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> apparatus for the purification of nucleic acids for scientific use; accessories, namely tops of pipettes and test tubes; apparatus for the pre-analytical processing for scientific use, in Class 9; and
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> apparatus for the purification of nucleic acids for medical use; accessories, namely tops of pipettes and test tubes; apparatus for the pre-analytical processing for medical use, in Class 10.

The application was filed on March 10, 2000, and it is based on Roche's asserted bona fide intention to use the mark in commerce.

Cancellation No. 92040577 involves Roche's Registration No. 2504968, which is of the mark MAGNA PURE (in typed form, PURE disclaimed) for goods identified in the registration as "biochemicals, namely, chemical reagents for the purification of nucleic acid for scientific or research use," in Class 1. The registration issued on November 6, 2001 from an application filed on August 28, 1998. In that application, Roche alleged January 18, 2000 as the date of first use of the mark and the date of first use of the mark in commerce.

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[4] Formerly known as Bottorff.

On June 12, 2001, Cortex Biochem, Inc. (hereinafter Cortex) filed a timely notice of opposition (Opposition No. 91123244) to Roche's above-referenced application Serial No. 75941114. On May 3, 2002, Cortex filed a petition for cancellation (Cancellation No. 92040577) of Roche's above-referenced Registration No. 2504968. As its ground for opposition and cancellation in the respective cases, Cortex asserts a claim under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Specifically, Cortex alleges that Roche's MAGNA PURE mark, as applied to the goods identified in the application and registration, is likely to cause confusion vis-à-vis Cortex's asserted family of MAGA-prefix marks, including MAGAPHASE, MAGACELL, MAGACROLEIN, MAGACHARC, MAGACELL-X, MAGABEADS, MAGNETITE and MAGAROSE, each of which Cortex alleges to be "one word comprised of the arbitrary term MAGA and the generic endings." (Notice of Opposition at paragraph 7; Petition to Cancel at paragraph 4.) Also, Cortex alleges in both cases that it adopted its family of marks in 1992, a date prior to any date on which Roche can rely, and that it uses its marks on "various types of particles used for immuno separation, cell separation, and DNA/RNA separation. These particles are also coupled with a variety of reagents for purification and/or extraction and

isolation processes." (Notice of Opposition at paragraph 4; Petition to Cancel at paragraph 1.)[5]

In its amended answer to the notice of opposition in Opposition No. 91123244 and in its answer to the petition for cancellation in Cancellation No. 92040577, Roche denies the salient allegations of Cortex's pleadings, except that Roche admits "that its MagNA Pure product line is used for scientific purposes to isolate DNA and RNA" and that "magnetic glass particles are used in the process." Roche further admits that no Allegation of Use has been filed in connection with application Serial No. 75941114, but denies that it has not actually used the mark in commerce. Roche's answers also include, as an affirmative defense, an allegation that "[t]he alleged family of 'MAGA' marks upon which Cortex relies for purposes of [these proceedings] is merely descriptive, when applied to the products that such alleged family mark is used in connection with, and thus

[5] In the notice of opposition, but not in the petition for cancellation, Cortex also has alleged that Roche "is not the owner of the mark shown in Serial No. 75941114 because Opposer [Cortex] is the sole owner of 'MAGA' in connection with MAGA family of products used in the isolation and purification of DNA and RNA and all related or similar goods and services and has granted no license, right or title in the same to Applicant [Roche]. Therefore, Applicant is not entitled to registration." (Notice of Opposition, Paragraph 9.) To the extent that this allegation was intended by Cortex to constitute a separate ground of opposition (i.e., in addition to the Section 2(d) ground), we decline to treat it as such. On its face, it appears to be a mere restatement of the Section 2(d) ground. In any event, in its briefs Cortex has not argued this "ownership" ground as a separate ground, and therefore is deemed to have waived such ground.

falls within the statutory prohibition of 15 U.S.C. §1052(e), as amended."[6]

In the third of the three above-captioned proceedings, Opposition No. 91159203, the parties' positions are reversed. The opposition involves Cortex's application Serial No. 76289333, by which Cortex seeks to register the mark MAGAPURE (in typed form) for "chemical reagents for scientific or research use in the isolation, purification, and extraction of biochemicals," in Class 1, and "diagnostic reagents for clinical or medical laboratory use for the isolation, purification, and extraction of biochemicals," in Class 5. The application was filed on July 24, 2001, and is based on use in commerce. February 2001 is alleged in the application as the date of first use of the mark anywhere and first use of the mark in commerce.

On March 14, 2003, Roche filed a timely notice of opposition to registration of Cortex's MAGAPURE mark. In the notice of opposition, Roche pleads ownership of its

[6] In its answers, Roche also alleges, as affirmative defenses, that Cortex's pleadings fail to state a claim upon which relief can be granted, that Cortex's actions are barred by the doctrines of waiver, laches and estoppel, and that no likelihood of confusion exists between the parties' respective marks. To whatever extent the first two of these defenses might be legally available in these proceedings, we find that they have been waived due to Roche's failure to argue them in its brief. They are unproven in any event. The third "defense," i.e., that there is no likelihood of confusion, is not properly deemed an affirmative defense at all; we have treated it as merely a further denial of Cortex's Section 2(d) likelihood of confusion claim.

MAGNA PURE registration (Registration No. 2504968), the registration involved in Cancellation No. 92040577, as well as ownership of its prior-pending MAGNA PURE application (Serial No. 75941114), the application involved in Opposition No. 91123244. Roche alleges that Cortex's MAGAPURE mark, as applied to the goods identified in the application, is likely to cause confusion vis-à-vis Roche's previously-used and registered MAGNA PURE mark. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Roche further alleges that, in Opposition No. 91123244, Cortex has conceded that actual confusion exists between Cortex's MAGAPURE mark and Roche's MAGNA PURE mark.

In its answer, Cortex denies Roche's allegations of priority and likelihood of confusion. (Answer, Paragraph 2.) Cortex affirmatively alleges that its rights in its MAGA- family of marks are senior to Roche's rights in its MAGNA PURE mark, and that Roche's use of MAGNA PURE infringes on Cortex's senior rights in its MAGA-prefix family of marks.

The evidence of record includes the parties' pleadings, and the files of the involved applications and registration. In addition, each party submitted evidence.[7] Cortex made

[7] We note that due to the the timing and provisions of the Board's order consolidating Opposition No. 91123244 and Cancellation No. 92040577, each party essentially ended up with multiple testimony periods. We have considered all evidence properly submitted during any of these testimony periods.

the following evidence of record at trial: copies of three patents owned by Roche; Roche's responses to, and documents produced in response to, certain of Cortex's discovery requests (and Roche's stipulation as to the authenticity of the produced documents); the testimony deposition (as revised) of Cortex's president Leonard Karp, and the exhibits thereto; the testimony deposition (as revised) of Cortex's consultant William Cook, and the exhibits thereto; and the testimony deposition of Cortex's customer Dr. Jesus Ching.

For its part, Roche made the following evidence of record at trial: a status and title copy of Roche's Registration No. 2504968 (the registration involved in Cancellation No. 92040577, and on which Roche relies as plaintiff in Opposition No. 91159203); excerpts and exhibits from the Rule 30(b)(6) discovery deposition of Cortex's president Leonard Karp; pursuant to Trademark Rule 2.120(j)(5), Roche's responses to, and documents produced in response to, certain other of Cortex's discovery requests; Cortex's responses to, and documents produced in response to, Roche's discovery requests (and Cortex's stipulation as to the authenticity of the produced documents); the file wrapper of Cortex's application to register the mark MAGAPHASE (Serial No. 76289336); the (two) testimony depositions of Roche's officer Sharon Sheridan, and the

exhibits thereto; and the testimony deposition of Roche's employee Barney Crum, and the exhibits thereto (which is of record only for purposes of Cancellation No. 92040577).[8]

At this point, a short summary of what the record shows to be the relevant chronology regarding the parties' adoption of their respective marks is in order. Cortex adopted and began using the marks MagaCell and MagaRose in 1990. Cortex adopted, used and ceased use of several additional marks over the years, such that, as of 1996 and continuing through 1999 and beyond, Cortex was using the marks MagaCell, MagAcrolein, MagaCharc, MagaPhase and MagaBeads on its various products. (Karp Test. Depo., Exh. Nos. 3-6, 8, 14 and 16.)

On August 28, 1998, Roche filed its application to register MAGNA PURE in International Class 1; this application eventually matured (on November 6, 2001) into Registration No. 2504968, the registration involved in Cancellation No. 92040577. It appears that, prior to the August 28, 1998 filing date of Roche's trademark

[8] In addition, both parties have attached, as exhibits to their final briefs, certain documentary materials which had not been made of record at trial. Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during trial. *See* TBMP §704.05(b)(2d ed. rev. 2004) and cases cited therein. Likewise, we give no consideration to Roche's statements (at page 35 of its brief) regarding the alleged existence of certain third-party registrations and applications which were not made of record at trial. See TBMP §704.06(b)(2d ed. rev. 2004) and cases cited therein.

application, Roche had filed three patent applications (Nos. 6,214,979, 5,487,972 and 5,804,375), in each of which a reference is made to Cortex Biochem and its MagaCell product. (Cortex September 4, 2002 Notice of Reliance.)[9]

In October 1999, Roche made its first actual use of its MAGNA PURE mark on goods in Classes 1, 5, 9 and 10. (Sheridan 11/26/02 Depo. at 12-14, 21-22.) On March 10, 2000, Roche filed an intent-to-use application to register MAGNA PURE in Classes 5, 9 and 10. (Serial No. 75941114, the application involved in Opposition No. 91123244.)

On or about January 23, 2001, Cortex gained actual knowledge of Roche's MAGNA PURE mark via a search of the Trademark Office records. (Karp Test. Depo. at 138.) At around the same time (January 2001), but subsequent to its acquisition of knowledge of Roche's MAGNA PURE mark, Cortex adopted and began using the mark MAGAPURE for a new product. (Karp Disc. Depo. at 111; Karp Test. Depo. at 138-40.)

On April 17, 2001, Roche's intent-to-use application to register MAGNA PURE in Classes 5, 9 and 10 (Serial No. 75941114) was published for opposition. By May 2001, Cortex had become aware of apparent instances of actual confusion between its MAGAPURE mark and Roche's MAGNA PURE mark.

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[9] Inasmuch as these patents refer only to one of Cortex's marks, i.e., MagaCell, they do not support Cortex's contention that Roche was aware of Cortex's asserted family of marks at the time it filed the patent applications.

(Karp Test. Depo. at 146.) On June 12, 2001, Cortex filed its notice of opposition to Roche's intent-to-use application Serial No. 75941114. On July 24, 2001, Cortex filed an application to register the mark MAGAPURE. (Serial No. 76289333, the application involved in Opposition No. 91159233.)

In September 2001, Roche's attorneys sent a cease-and-desist letter to Cortex's attorneys regarding Cortex's use of the MAGAPURE mark, claiming priority and likelihood of confusion with its MAGNA PURE mark. Subsequent to its receipt of that letter, Cortex adopted and began using MAGAZORB as a replacement mark for MAGAPURE, apparently pending the outcome of these proceedings. (Karp Test. Depo. at 179, 182-84.)

II. OPPOSITION NO. 91123244 and CANCELLATION NO. 92041577

In Opposition No. 91123244, Cortex opposes Roche's application to register MAGNA PURE for goods in Classes 5, 9 and 10. In Cancellation No. 92040577, Cortex petitions to cancel Roche's registration of MAGNA PURE for goods in Class 1. In both cases, Cortex asserts a Section 2(d) claim based on Cortex's asserted ownership of a family of MAGA-prefix marks.

The evidence of record establishes, and Roche does not dispute, that Cortex uses various MAGA-prefix marks on

various types of magnetizable particles used for immuno separation, cell separation, and DNA/RNA separation. In view thereof, we find that Cortex has standing to bring these opposition and cancellation proceedings. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Cortex's Section 2(d) claim in Opposition No. 91123244 and in Cancellation No. 92040577 is based on its alleged ownership and prior use of a family of MAGA- prefix marks, identified as "one word comprised of the arbitrary term MAGA and the generic endings." (Notice of Opposition at paragraph 7; Petition to Cancel at paragraph 4.) That is, Cortex's Section 2(d) claim is not based on its ownership of any of its individual marks, or on the alleged existence of a likelihood of confusion as between Roche's MAGNA PURE mark and any of those individual marks. Rather, Cortex's Section 2(d) claim is that Roche's MAGNA PURE mark is confusingly similar to Cortex's previously-used family of MAGA- prefix marks, such that purchasers are likely to mistakenly assume that products sold under the mark MAGNA PURE are part of Cortex's line of products sold under its MAGA family of marks.

Thus, to establish its Section 2(d) priority in this case, Cortex must prove that it owns a family of marks, and that such family was in existence and recognized by

purchasers at least as early as the earliest date on which Roche can rely for priority purposes.[10] *See Han Beauty Inc. v. Alberto-Culver Co.,* 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001)(substantial evidence supports Board's finding that plaintiff's family of marks "exists and arose before [defendant's] filing date"); and *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1218 (TTAB 1988)(plaintiff asserting family of marks must prove "first, that prior to the entry into the field of the opponent's mark, the marks containing the claimed 'family'

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[10] In the usual Section 2(d) opposition proceeding before the Board, priority is not an issue if the plaintiff has proven its ownership of extant registration(s) of its pleaded mark(s). See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In this case, it appears that registrations of the marks MAGACELL, MAGACHARC, MAGACROLEIN, MAGAPHASE and MAGABEADS were issued to Cortex subsequent to the institution of these proceedings. However, Cortex did not properly make these registrations of record, and we therefore have given them no consideration. *See* Trademark Rule 2.122(d), 37 C.F.R. §2.122(d). Even if we were to consider them, however, our analysis and decision would not be affected, because Cortex is not relying on any individual mark (registered or otherwise) but instead is relying solely on its ownership of an asserted family of marks. For that reason, priority, i.e., whether Cortex owned a family of marks prior to Roche's earliest priority date(s), is an issue to be decided in this opposition proceeding.

In any cancellation proceeding, priority is an issue. Again, however, because Cortex is relying on its asserted family of marks rather than on any individual mark, the priority dispute in this cancellation proceeding requires us to determine whether Cortex's acquisition of rights in its asserted family of marks predates the earliest date on which Roche may rely for priority purposes.

Thus, the priority issue in Opposition No. 91123244 and in Cancellation No. 92040577, in both of which cases Cortex is the plaintiff, is the same. As discussed *infra*, however, because Cortex is the defendant in the third of these consolidated proceedings, Opposition No. 91159203, it is not entitled to rely on the "family of marks" doctrine to establish its priority in that case.

feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature…").

With respect to Roche's rights in its MAGNA PURE mark for the Class 1 goods identified in its Registration No. 2504968 (the registration involved in Cancellation No. 92040577), the earliest date upon which Roche may rely for priority purposes is the filing date of the application which matured into that registration, i.e. August 28, 1998. Trademark Act Section 7(c), 15 U.S.C. 1057(c). With respect to Roche's rights in its MAGNA PURE mark for the Class 5, Class 9 and Class 10 goods identified in its application Serial No. 75941114 (the application involved in Opposition No. 91123244), the evidence of record clearly establishes that Roche began using the mark on those goods in October 1999, and therefore may rely on that date for priority purposes in this case. (Sheridan 11/26/02 Depo. at 12-14, 21-22.)

Having determined that Roche's earliest priority dates are August 28, 1998 (in Class 1) and October 1999 (in Classes 5, 9 and 10), we turn next to the question of whether Cortex, prior to those dates, had developed and acquired rights in a family of MAGA- prefix marks and thus

may rely on such family to establish its Section 2(d) priority in this case.

The family of marks doctrine has been explained by our primary reviewing court as follows:

> A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. … Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991). (Citations omitted.) The Board has held that, in determining whether a family of marks exists, we must examine (1) the pattern of usage, i.e., the manner in which, and the extent to which, the marks have been used in the sale and advertising of the plaintiff's goods or services, and (2) the distinctiveness of the family "surname." *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1218 (TTAB

1988). See also McCarthy on Trademarks and Unfair Competition (4th ed. 11/04) at §23:61.

We consider first the question of the distinctiveness of the term MAGA, which Cortex alleges to be the surname of its claimed family of marks. To establish a family of marks, the plaintiff must prove "that the 'family' feature [common to each of the marks] is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark." *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., supra,* 6 USPQ2d at 1218; *see also American Standard Inc. v. Scott & Fetzer Company,* 200 USPQ 457, 461 (TTAB 1978).

Roche argues that MAGA is merely descriptive as applied to Cortex's goods, that it has not acquired distinctiveness, and that it therefore cannot serve as the basis for Cortex's claimed family of marks. More specifically, Roche contends that Cortex's products are, in essence, magnetizable particles used for magnetic separation, and that Cortex adopted MAGA as the prefix to its marks specifically because it describes this "magnetizable" feature of the goods. Roche cites to Cortex's answer to Roche's Interrogatory No. 5.f, in which Cortex stated that "Cortex Biochem adopted the MAGA mark because it contained the first three letters of the word 'Magnetic' which was a principal property of the

Magnetic Separation Products." (Roche's 11/25/02 Notice of Reliance, RDG-1633.) Roche contends that this statement of Cortex's intent in adopting the mark is evidence of the mere descriptiveness of the family feature of Cortex's marks.

Additionally, Roche relies on the testimony of Cortex's technical and marketing consultant, William Cook, who consulted with Cortex concerning the launch of Cortex's MAGAPURE product in late 2000 and early 2001. He testified that, when he and Cortex's principals were considering what to name Cortex's new MAGAPURE product, the prefix MAGA was chosen because it "was an extension of the Maga product line which obviously was based on these particles being magnetic." (Cook depo. at 8.) He also testified that he thinks of "magnetizable particles" when he sees MAGA, that he believes MAGA is "descriptive" of magnetic properties or magnetizable particles, and that he assumes (without firsthand knowledge) that this is the reason Cortex initially adopted the MAGA prefix for its marks. (*Id*. At 23-24, 28-30.)

We are not persuaded that this evidence establishes that MAGA is merely descriptive of Cortex's goods. At most, it establishes that MAGA is suggestive of the goods. Although MAGA shares the first three letters of "magnetic" or "magnetizable," the prefix adopted by Cortex is MAGA, not MAG. There is no evidence that MAGA and MAG are viewed in

the industry as equivalent terms, nor any evidence that anyone besides Cortex uses MAGA (as opposed to MAG) in connection with magnetizable particles.

Roche relies heavily on Cortex's statement of its intention in adopting MAGA, as expressed in Cortex's answer to Roche's interrogatory, i.e., that it "adopted the MAGA mark because it contained the first three letters of the word 'Magnetic' which was a principal property of the Magnetic Separation Products"). Even assuming that Cortex's intent in adopting the term is relevant to our mere descriptiveness determination, and that this interrogatory answer is an admission of Cortex's intent, we are not persuaded that the answer is evidence of mere descriptiveness. At most, it shows that Cortex wanted its mark to suggest that the goods were magnetizable particles. We note as well that during his testimony deposition, Cortex's president Leonard Karp testified as follows regarding Cortex's intent in adopting the MAGA mark:

> In the beginning we wanted something that – we tried things like mag, and it just didn't sound right. … M-a-g, because we thought that would be – tell people at least that it was a product that was a magnetic solid phase, but we couldn't find one that sounded correctly, so we came up with Maga which flowed nicely and had a good phonetic sound to it.

(Karp. Depo. at 13.) Likewise in his discovery deposition (made of record by Roche), Mr. Karp testified that "'Mag'

was the original name that we thought would represent the magnetic properties, and we used the Maga to phonetically make it more pleasing." (Karp Disc. Depo. at 36.) As for Mr. Cook's testimony (quoted above), inasmuch as he is not shown to be an expert in trademark law or aware of the nuances of trademark law terminology such as the term "descriptive," we find that his use of that term in relation to Cortex's goods is entitled to no probative value.

In short, the evidence of record fails to establish that MAGA (as opposed to MAG) is merely descriptive of Cortex's goods, or that it is anything more than suggestive of the magnetic properties of those goods.

Having found that MAGA is distinctive as applied to Cortex's goods, and that it thus may serve as the basis for Cortex's claimed family of marks, we turn now to the question of whether whether Cortex has established that such a family of MAGA-prefix marks in fact exists and that it came into being prior to Roche's August 1998 and October 1999 dates of first use. To answer this question, we must look to the manner in which, and also the extent to which, Cortex used the marks during the period in question.[11] As the Board has previously noted:

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[11] Both Cortex and Roche have relied on evidence showing Cortex's manner of using its marks which post-dates Roche's August 1998 and October 1999 priority dates in this case. Such evidence is not relevant to the issue at hand, which is whether Cortex already had a family of MAGA-prefix marks as of Roche's earliest

> In order to establish or achieve a "family" of marks, it must be demonstrated that a number of the members of said "family" have been promoted together in such a manner and to such an extent over a period of years as to create recognition in the pertinent field as well as an association of common origin predicated on the "family" feature. … The only way that this can be ascertained is to place oneself in the position of a purchaser or prospective purchaser of [the plaintiff's] products and attempt to understand just what would be the normal reaction to [the plaintiff's] advertising and promotional material as it is encountered in the marketplace.

DAP, Inc. v. Flex-O-Glass, Inc., 196 USPQ 438, 443 (1976). And, as Professor McCarthy has noted, the existence of a family of marks "is a matter of fact, not supposition." McCarthy, *supra* at §23:61.

It appears from the record that prior to Roche's entry into the field, Cortex was spending approximately $30,000 annually to advertise and promote its MAGA marks, "directly or indirectly." (Cortex's answer to Roche's Interrogatory No. 9; Karp Test. Depo., Exh. Nos. 10, 11, 15, 18-22. This does not reflect expenditures sufficient to support the

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priority dates. In particular, both parties rely on printouts from Cortex's website, which does not appear to have come online until sometime in 2001. (See Karp Test. Depo., Exh. 22. These invoices for advertising and promotional expenditures for the year 2001 are the first mention of expenditures for development of Cortex's website. Also, the content on the website bears a copyright notice dated 2001. The website printouts, and any documents in the record which on their faces include references to the website or the website URL address, are not probative evidence on the question of whether Cortex had a family of marks in August 1998 or October 1999, Roche's priority dates, and we have not considered them in reaching our decision.

establishment of a family of marks. More importantly, however, Cortex has failed to make of record any copies or samples of its actual advertisements which appeared prior to the 1998-1999 time frame we are interested in. We therefore have no way of determining how the MAGA-prefix marks would have been perceived by purchasers and prospective purchasers encountering the advertisements. The absence from the record of any samples of Cortex's actual advertisements is surprising, in view of the importance assigned by our case law to the consideration of such advertisements in the determination of whether a family of marks exists. *Witco Chemical Co. v. Chemische Werke Witten G.m.b.H.,* 158 USPQ 157 (TTAB 1968)("we look primarily to the nature and character of opposer's advertising and promotional material" in determining whether a family of marks exists). Likewise, although Cortex asserts that it has displayed its marks in its booths at trade shows over the years, the only photographic or other evidence showing the manner of such display is from a trade show which occurred in June 2001, after Roche's first use of its MAGNA PURE mark.[12]

As for the evidence which Cortex in fact has submitted, much of it does not support the family of marks claim. Cortex's product labels (Karp. Test. Depo., Exh. No. 26)

[12] Karp Test. Depo., Exh. No. 23. This photograph shows only the marks MAGAPHASE and MAGAPURE displayed together at Cortex's trade show booth.

each show use of a MAGA-prefix mark along with the Cortex Biochem trade name. However, we cannot determine whether these labels were in use prior to 1998-1999, and in any event each label bears only one of the MAGA-prefix marks, rather than displaying two or more of the marks conjointly. Cortex's November 1996 Business Plan includes mention of various Maga-prefix marks, but they are buried at pages 13-14 of the 30-page document. Moreover, there is no evidence that this Business Plan was directed to or encountered by purchasers or prospective purchasers of Cortex's goods. Exhibit No. 12 to the Karp Testimony Deposition is a reprint of an article authored by Cortex officers and/or employees which appeared in the July 1995 issue of Genetic Engineering News. Buried within the article are isolated references to Cortex's MAGAPHASE, MAGACELL and MAGACHARC products, but also references to various products marketed by other companies.

Cortex's 1992-93 Product List (Karp Test. Depo., Exh. 7), its 1994-1995 Product List (Karp Test. Depo., Exh. 9), and its 1999 Product Reference Manual (Karp Test. Depo., Exh. No. 2) all include what could be construed, for the most part, to be valid "family of marks" usage. The 1992-1993 product list includes listings for various types of "MagaCell" and "MagaRose" paramagnetic particles, as well as "MagaRack" and "MagaBlock" accessory products. On page 1 of

the product list, below the heading but above the listing of the various MagaCell and MagaRose products, the following introductory text is displayed:

> MagaCell™ is paramagnetic iron-oxide entrapped Cellulose.
>
> MagaRose™ is paramagnetic iron-oxide entrapped spherical agarose beads and particulate.

In the 1994-1995 product list (Karp Test. Depo., Exh. 9), the index identifies one section of the list as “MagaPhase Magnetizable Particles.” That section (at page 1), lists various types of paramagnetic particles called MagaCell, MagAcrolein, MagaCharc and MagneTite. The heading on this page includes the following introductory text:

> MagaCell™ is paramagnetic cellulose encapsulated iron-oxide.
>
> MagAcrolein™ is paramagnetic polyacrolein encapsulated iron-oxide.
>
> MagaCharc™ is paramagnetic polyacrylamide/charcoal encapsulated iron-oxide.
>
> MagneTite™ is precipitated paramagnetic iron-oxide, uncoated.

The 1999 Product Reference Manual has a section entitled “MAGAPHASE™ PRODUCTS” and “MAGAPHASE™ PRODUCT LINE” in which are listed, under separate subheadings and with explanatory paragraphs, the marks MagaCell, MagAcrolein, MagaCharc, MagaPhase and MagaBeads.

As stated above, for the most part this constitutes acceptable “family of mark” usage. However, we note that the 1992-93 and 1994-95 product lists display the MAGA-prefix marks intermingled among other “non-family” marks. Also, in the 1994-95 product list, two of the four claimed “family” marks, MagAcrolein and MagneTite, do not follow the claimed “family” pattern of having a MAGA-prefix; they instead use the prefixes “Mag” and “Magne.” The usage of a “Mag” prefix rather than a “Maga” prefix in the MagAcrolein mark also appears in the 1999 Product Reference Manual, and it appears to continue to this day. Such usage detracts from Cortex’s claim of a family of marks.

More significantly, however, even if we assume that the 1992-93, 1994-95 and 1999 documents demonstrated ideal “family of marks” usage, their probative value is limited in this case because, with the exception of the 1994-95 product list, we cannot determine how many of them were distributed to purchasers and potential purchasers. Mr. Karp testified that 2,500 of the 1994-95 product lists were distributed during the 1994-95 period, but there is no testimony or other evidence showing how many of the 1992-93 lists or the 1999 Product Reference Manuals were distributed. Mr. Karp testified that these materials would have been sent to all of the clients on Cortex’s client list, but we have no testimony or other evidence as to how many such clients

Cortex had in the years prior to 1998-1999. The only client list of record is the one which was current as of the August 2002 testimony deposition of Leonard Karp. We thus have no evidentiary basis for finding, on this record, that these materials were so extensively distributed to and widely encountered by purchasers in the marketplace prior to Roche's entry into the field as to create in purchasers' minds a recognition that Cortex owned a family of MAGA-prefix marks. *See Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419 (CCPA 1965); *Varian Associates, Inc. v. Leybold-Heraeus Gesellschaft mit Beschranktor Haftung*, 219 USPQ 829 (TTAB 1983); and *Raypak, Inc. v. Dunham Busch Inc.*, 216 USPQ 1012 (TTAB 1982).

Additionally, Cortex's evidence regarding its pre-1998 sales figures for products bearing a MAGA-prefix mark does little to support a finding that a family of such marks existed during the period in question. Mr. Karp testified that Cortex's sales of products under its MAGA-prefix marks in the years 1990-1996 ranged from $50,000 to $400,000 annually, but he admitted that these were merely "guesstimates" and that the actual sales numbers could be off by half or twice as much. This testimony is equivocal, to say the least, and it does not persuade us that Cortex's sales were substantial enough to create in the minds of

purchasers a recognition of the alleged family of marks.[13] Moreover, there is no testimony or other evidence at all as to the amounts of Cortex's sales of MAGA products in the years 1997, 1998, 1999 and 2000.

Cortex relies heavily on the August 2002 testimony deposition of Dr. Jesus Ching to support its family of marks claim. Dr. Ching is a research and development manager for Cepheid Corporation, and a purchaser of the relevant goods who has made purchases from both Roche and Cortex. We will quote from his testimony at length:

On direct examination:

> Q. What is the nature of the relationship that you have with Cortex Biochem?
>
> A. A few years ago I gave them a call in terms of looking at what services they might be able to provide in terms of synthetic work of beads and whatnot, and the relationship progressed to the point where we were working with them on purification of the nucleic acids or isolation nucleic acids. We had tried to use some of our technologies and also have worked with them on some of their technologies pertaining to nucleic acid isolation.
>
> Q. Are you familiar with the product line of Cortex Biochem?
>
> A. I am loosely familiar with their product line, yes.

[13] Also, we cannot put these sales numbers in perspective because there is no evidence from which we might determine what is Cortex's share of the relevant market for these goods. Roche's sales numbers for its competing MAGNA PURE products were submitted under seal and will not be revealed here, but suffice it to say that they dwarf Cortex's sales, even though Roche's goods have been on the market for a much shorter time than Cortex's goods have been available.

Q. Is there any method in which you would identify a particular Cortex Biochem product in the marketplace as opposed to some other?

A. I'm sorry. Could you repeat that question?

Q. Sure. Is there any particular method or designation that you recognize as indiciating a Cortex Biochem product?

A. Oh, I see. Their magnetic particles that they have, yes, and their manufacturing of proteins or enzymes or what have you.

Q. And is there something about their product names that evidenced to you that it is a Cortex Biochem product?

A. Yes. Their Maga Particles or MagaZorb or Maga Pure.

Q. Would you spell that Maga part?

A. I think it is M-a-g-a.

Q. So is it when you see a Maga connected with some other description of the enzyme, is that what indicates to you Cortex Biochem product?

A. Yes. That was my original interpretation.

Q. Do you know what some of the Maga products are that Cortex manufactures?

A. Yes. I understand that they made – I'm more familiar with their nucleic acid isolation products, but I do understand that they make other products of other particles proactivated with different things on them.

Q. Do you know some of the names of their products?

A. No.

Q. Have you ever heard of a MagaZorb?

A. Yes, I have.

Q. What is MagaZorb as far as you understand?

A. MagaZorb was a particle that we had used to or evaluated for the isolation of nucleic acids. At the time all I knew it was a magnetic particle, and it had a nucleic acid isolation material on it.

Q. Are you familiar with MagaCell particles?

A. I've heard of it, but I'm not technically familiar with it.

Q. How about MagAcrolein?

A. I am familiar with it, but not technically.

Q. How about MagaCharc?

A. No.

Q. Did you have an occasion to make a purchase of a product titled "MagaPure"?

A. No.

Q. Were you ever aware of a product named MagaPure?

A. Yes.

Q. Would you describe to me what that – how it was that you were aware of MagaPure?

A. About two years ago we received a flyer for an invitation I think from Roche to attend their product launch with their purification system high through-put machines, and I had sent one of my associates over to attend a seminar and to look at their technology and to see if there was any compatibility with our needs, and my assumption was that that material that they were using from Roche was not too dissimilar from what Cortex was doing because at the time we were working with Cortex, and I had commented

to Matt at Cortex and congratulating him because he had mentioned that he was working with some other larger companies. I said, “So, you guys have your products in the Roche product line now,” and Matt did not say anything. And then I left it at that. And I don’t think we discussed it any further from that point. Maybe once or twice when he mentioned to me that they did not have a deal with Roche and that they were not using their products.

Q. And what was it about the advertisement or the subsequent discussion that you had with Roche that made you believe that that could possibly be a connection with Cortex Biochem?

A. It was the name, the M-a-g-n-a, and I had thought that maybe because Roche did not have a product prior that point that was named like that, so but because we were working with Cortex already, and I knew that they had that name on their products, I had just naturally thought that maybe it was Cortex’s products that was in the Roche instrumentation.

Q. So you have an association between the Maga, M-a-g-a, marks and Cortex Biochem?

A. Yes.

Q. And because of the similarities between the two, you thought that that could perhaps be a Cortex Biochem product that was marketed by Roche?

A. Correct. I mean it was a fairly honest mistake, I guess, on my part.

Q. What experience had you had with Cortex regarding the nucleic acid isolation products?

A. Well, like I said, we started working with them a few years ago, and we have been working on various components of nucleic acid purification, and one of the things that we were working on was MagaZorb, and we were going into some rather detailed experimentation to look at their properties and whatnot.

> Q. What's the nature of your current relationship with Cortex Biochem?
>
> A. We are currently working with them on possibly getting their technology, their nuclear acid technology into our company.[14]

On cross-examination:

> Q. In your testimony you indicated that you have worked with MagaZorb; is that correct, sir?
>
> A. That's correct.
>
> Q. What other Cortex products have you worked with? And if you can identify those products by name.
>
> A. The MagaZorb, yes, and then whatever product that was prior to the MagaZorb which was I guess the MagaPure I had worked with them on.
>
> Q. So you had worked with both MagaPure and then MagaZorb?
>
> A. Yes. And then there was some other products that I worked with them on that are not in their product line that are more into R and D phase.
>
> Q. Okay. But is it fair to say when you hear MagaPure and MagaZorb, you relate that to Cortex; is that correct, sir?
>
> A. Yes.
>
> Q. And that's based on your experience in working with those two products; is that correct?
>
> A. Yes.

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[14] Roche argues that Dr. Ching is a biased witness, in view of the fact that his company, Cepheid, is "currently working with [Cortex] on possibly getting their technology, their nuclear acid technology into our company." Because we find Dr. Ching's testimony to be of little probative value on its face (see discussion *infra*), we need not reach the issue of whether his testimony also is biased.

Q. And, sir, the source of your confusion that you've testified about today, that relates to Magna Pure, Roche's Magna Pure?

A. Yes.

Q. And Cortex's MagaPure; is that correct?

A. Yes.

On re-direct examination:

Q. You testified earlier that the reason that you made an association with the Magna Pure product that you saw from the Roche advertisement was because you understood Cortex to have the Maga line of products; is that correct?

A. That's correct.

Q. So it wasn't so much that it was Magna Pure versus MagaPure. It was more use of the Magna versus the Maga; is that correct?

A. That's correct.

On re-cross examination:

Q. And just one follow-up. In this line of Maga products, sir, that you've testified about, your experience is limited to MagaPure and MagaZorb; is that fair to say?

A. In terms of my technical experience, yes.

Q. And in terms of use of Cortex products, that your use would be limited to the MagaPure and the MagaZorb?

A. No. I mean I'm familiar with their technology in some other areas that I've worked with them on, and they are not current product lines.

This testimony does little to support a finding that Cortex already owned a family of MAGA-prefix marks as of Roche's August 1998 and October 1999 priority dates. We note first that the only Cortex marks that Dr. Ching could identify without prompting and leading from Cortex's counsel were MagaPure and MagaZorb (which actually are two marks used on a single, renamed product – see discussion supra at p. 11), both of which were adopted by Cortex subsequent to Roche's 1998 and 1999 priority dates. We cannot conclude from this testimony that Dr. Ching was even aware of Cortex in 1998 or 1999, much less that he was aware of any family of MAGA-prefix marks at that time.

Second, Dr. Ching testified that he received the announcement from Roche regarding Roche's MAGNA PURE product "two years ago," which, as measured from the date of his deposition, would be in August 2000. Again, even if we assume that he was aware of Cortex's asserted family of MAGA-prefix marks at that time, there is no basis for concluding that he was aware of the asserted family in August 1998 or October 1999, which are the dates at issue here. We simply cannot determine, from this testimony, when (if ever) Dr. Ching actually became aware of the existence of the asserted family of marks.

Cortex also relies on the testimony of William Cook, who was a consultant to Cortex from December 2000 through

July 2001 in the development and marketing of its nucleic acid purification technology and product, including Cortex's decision to adopt the mark MAGAPURE for that product in January 2001.[15] Specifically, Cortex relies on the following testimony:

> Q. Based on your extensive experience [20-30 years] in the biotech industry and with the reagent market and to some extent in the DNA-isolation market, is it your understanding that Cortex had developed a notoriety for its Maga marks?
>
> A. I think Cortex was very well-known for that product line and that mark.

(Cook Depo. at 17.) This testimony does not support a finding that Cortex owned a family of MAGA-prefix marks as of August 1998 or October 1999. Moreover, when he was asked by Cortex's counsel during direct examination to identify the Cortex products with which he was familiar prior to entering into his consulting contract with Cortex in December 2000, he testified as follows:

> Q. Were you familiar with the names of those product lines?

[15] Roche argues that because Mr. Cook is a long-time personal friend of Cortex's principals, and because he was closely involved in the development and marketing of Cortex's MagaPure product, he is a biased witness whose testimony should be discounted. As was the case with Dr. Ching, however, we find (see *infra*) that Mr. Cook's testimony on its face does little to support a finding that Cortex owned a family of marks prior to Roche's entry into the marketplace. Accordingly, we need not reach the bias issue.

A. Yes.

Q. What were some of those?

A. MagaPhase, for example.

Q. Any others?

A. There was – probably that was the one that was the lead product and the one I'm most familiar with. I probably can't recall any others just offhand.

Q. Does MagaCell sound familiar?

A. Yes.

Q. MagAcrolein?

A. I've heard of it subsequently, but I hadn't heard of it before.

Q. MagaBeads?

A. Yeah.

(Cook Depo. at 7.) Although Mr. Cook also testified (at pages 15-16) that Cortex adopted the MAGAPURE mark in order to extend its "well-known" line of MAGA-prefix marks and products, we find that Mr. Cook's inability to name without prompting any of Cortex's MAGA-prefix marks (except for one) belies Cortex's claim that it owned a family of marks in 1998 and 1999. His testimony certainly cannot be deemed to support a finding that relevant purchasers in general were aware of any such family at the time in question.

To summarize, we find that Cortex's sales and its expenditures on advertising and promotion of its alleged family of marks prior to Roche's August 1998 and October

1999 priority dates were meager, and certainly were insufficient to support a finding that Cortex's MAGA-prefix marks were recognized as a family of marks by relevant purchasers at that time. Moreover, we have no samples or copies of the actual advertisements or trade show displays, which precludes us from stepping into the shoes of purchasers and gauging their likely reaction to the manner in which Cortex used the marks. Cortex's product lists are in the record, and they are some evidence of "family" usage of the MAGA-prefix marks. However, we cannot conclude on this record that these lists were so extensively distributed by Cortex, or so widely encountered by purchasers, as to give rise to a family of marks. We note as well that at least two of the marks used and displayed by Cortex in these pre-1999 product lists, MagAcrolein and MagneTite (especially the latter), do not follow the claimed "family" pattern of using "Maga-" as a prefix; instead, they use "Mag-" and "Magne-" as prefixes. Finally, neither of Cortex's witnesses, Dr. Ching or Mr. Cook, could identify, without prompting and leading by Cortex's counsel, more than one or two of the alleged family of marks, and the two marks identified by Dr. Ching both were adopted by Cortex after Roche's priority dates.

After careful review of the evidentiary record, we find that Cortex has failed to meet its burden of proving by a

preponderance of the evidence that it owned a family of MAGA-prefix marks prior to Roche's August 1998 and October 1999 priority dates. Again, as noted by Professor McCarthy, a finding that a family of marks exists "is a matter of fact, not supposition." Cortex's factual showing in this case is insufficient to support a finding that its use of its MAGA-prefix marks had risen to the level of a family of marks prior to Roche's entry into the field.[16]

Because Cortex's Section 2(d) claim in Opposition No. 91123244 and in Cancellation No. 92040577 is based on its asserted ownership of a family of marks prior to Roche's entry into the field, and because we have found that no such family existed, Cortex's Section 2(d) claims in Opposition No. 91123244 and in Cancellation No. 92040577 fail for lack of priority. Because Cortex has not established its Section 2(d) priority as to the claimed family of marks, we need not reach the question of whether a likelihood of confusion

[16] In finding that Cortex has failed to establish that it owned a family of marks as of Roche's entry into the marketplace, we are not persuaded by Roche's argument that Cortex does not own a family of marks because it "instead" has a "family of products" which are marketed under the house mark "MagaPhase." If a family of marks is shown to exist, then it is not inconsistent to also find that the family marks are used on a line of products, or to find that they also are used in connection with a house mark. *See, e.g., Han Beauty Inc. v. Alberto-Culver Co., supra* (family of TRES- marks used on a line of products, all of which also bore the house mark TRESEMME). Here, Cortex has failed to prove that its MAGA-prefix marks rise to the level of a family of marks. That it has a family of products or uses a house mark as well is not dispositive.

exists as between Cortex's asserted family of marks and Roche's MAGNA PURE mark.[17]

III. OPPOSITION NO. 91159233

The parties have joined in a request that we decide Opposition No. 91159233 at this time, based on the evidence made of record in Opposition No. 91123244 and Cancellation No. 920430577. (Roche's Brief at 42-43; Cortex Reply Brief at 8.) In Opposition No. 91159233, Roche opposes registration of Cortex's MAGAPURE mark on the grounds that Roche is the senior user of its MAGNA PURE mark as well as the owner of a registration of such mark, and that Cortex's MAGAPURE mark is likely to cause confusion therewith.

In view of Roche's registration of its MAGNA PURE mark and its proven prior use of said mark (beginning in October 1999) vis-à-vis Cortex's first use (in January 2001) of the MAGAPURE mark which is the subject of the opposed application, we find that Roche has both standing to oppose and Section 2(d) priority. We also find that confusion between Roche's MAGNA PURE mark and Cortex's MAGAPURE mark is likely. Roche's MAGNA PURE mark, although not

[17] Cortex has not alleged or argued a Section 2(d) claim based on any of its individual MAGA-prefix marks that were in use prior to Roche's priority dates (MagaPhase, MagaCell, MagaCharc, MagAcrolein and MagaBeads). Even if it had, we would find that Roche's MAGNA PURE mark and those individual Cortex marks are sufficiently dissimilar, when viewed in their entireties, to preclude a finding of likelihood of confusion.

confusingly similar to Cortex's other MAGA-prefix marks when viewed in their entireties (see *supra* at footnote 17), is sufficiently similar to Cortex's MAGAPURE mark that confusion is likely to result from the parties' contemporaneous use of the marks. Cortex has not contended otherwise; indeed, Cortex has presented evidence which shows that instances of actual confusion between these two marks has already occurred. (Karp Test. Depo. at 118-120; Karp Disc. Depo. at 116-118.)

Cortex's sole argument with respect to this opposition (in which it is the defendant) is that it is entitled to prevail because it commenced use of its asserted family of MAGA-prefix marks prior to Roche's first use of its MAGNA PURE mark. As discussed above, we have found that Cortex had not established a family of marks prior to Roche's first use. Moreover, even if we had found that Cortex had established such a family of marks, Cortex would not be entitled to rely on such family in order to defeat Roche's Section 2(d) ground of opposition. It is settled that the "family of marks" doctrine may not be used by the defendant to establish priority in an inter partes proceeding before the Board. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733 (TTAB 2001); *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1373 (TTAB

1992); and *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPOQ2d 1048 (TTAB 1992).

Having found that Roche has standing to oppose, that Roche is the prior user of its MAGNA PURE mark, and that a likelihood of confusion exists between Roche's MAGNA PURE mark and Cortex's MAGAPURE mark, we sustain Roche's opposition to registration of Cortex's mark in Opposition No. 91159233.

Decision: Cortex's opposition to registration of Roche's MAGNA PURE mark in Opposition No. 91123244 is dismissed. Cortex's petition to cancel Roche's registration of MAGNA PURE in Cancellation No. 92040577 is denied. Roche's opposition to registration of Cortex's MAGAPURE mark in Opposition No. 91159233 is sustained.