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THE TTAB

Hearing: October 19, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Mentholatum Company substituted for SmithKline Beecham
Corporation¹

v.

Skin Products, Inc.

Opposition No. 91160694

Gary D. Krugman, Leigh Ann Lindquist and Shahrzad Poormosleh of
Sughrue Mion, PLLC for The Mentholatum Company.

Michael A. Painter of Isaacman, Kaufman & Painter for Skin
Products, Inc.

Before Holtzman, Rogers and Kuhlke, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Skin Products, Inc. has filed an application to
register the mark OXYCEUTICALS (in standard character form) for
"non-medicated acne treatment creams and lotion" in Class 3;²

¹ Opposer filed a consented motion to substitute The Mentholatum Company as plaintiff in this proceeding in view of an assignment of opposer's pleaded marks thereto. A copy of the assignment documents has been submitted. The motion to substitute is granted.

² Application Serial No. 76498695, filed March 12, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

Opposer filed a notice of opposition against the application on May 24, 2004, asserting as its ground for opposition, priority and likelihood of confusion under Section 2(d) of the Trademark Act. Opposer alleges prior use and registration of five marks consisting of or comprising the term OXY, including Registration No. 1869207 for the mark OXY for "acne medication." Opposer claims that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered OXY and OXY formative marks as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations of the opposition.³

The record includes the pleadings; the file of the involved application; opposer's notice of reliance on status and title copies of four of its pleaded registrations; opposer's testimony, with exhibits, of James Corbett Brown, opposer's brand manager;⁴ and applicant's testimony, with exhibits, of Jeffrey Steven Lapin, applicant's president.

Both opposer and applicant filed briefs. An oral hearing was held.

³ Applicant also asserted affirmative defenses of estoppel and acquiescence. However, these defenses were not pursued at trial and they are accordingly considered waived.

⁴ Portions of the testimony and exhibits have been designated confidential pursuant to a stipulated protective agreement filed by the parties on June 16, 2005.

Priority

Opposer has made of record status and title copies of the following registrations:⁵

OXY (in typed form)

for "acne medication" in Class 5 (Registration No. 1869207; issued December 27, 1994; renewed);



for "acne medication" in Class 5 (Registration No. 1873555; issued January 17, 1995; renewed);

OXY 10 (in typed form)

for "medication for treatment of acne" in Class 5; (Registration No. 1141969; issued December 2, 1980; renewed); and

THINK OXY, THINK OXYGEN. (in typed form)

for "acne medication" in class 5 (Registration No. 2582225; issued June 18, 2002).

Thus, opposer's standing has been established, and its priority with respect to the registered marks for the goods identified therein is not in issue. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer has demonstrated first use of the

⁵ The record copies of the registrations show ownership of the registrations in the name of the original plaintiff SmithKline Beecham Corporation. However, the parties have stipulated that title to the registrations has passed to The Mentholatum Company, and we take judicial notice that Office records have now been updated to reflect ownership of the registrations in the name of The Mentholatum Company. See TBMP §704.03(b)(1(A)) (2d ed. rev. 2004).

mark OXY on a variety of acne treatment products prior to the March 12, 2003 constructive date of first use of the subject application.

Likelihood of confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In our likelihood of confusion analysis we will direct our attention to the registered mark of opposer which can be considered closest to the mark in the subject application, namely Registration No. 1869207 for the mark OXY (in typed form) for "acne medication."⁶

We turn first to the goods, keeping in mind that the question of likelihood of confusion must be determined on the basis of the identification of goods set forth in the application

⁶ We note applicant's argument in its brief regarding the likelihood of confusion with opposer's "OXY family of trademarks." However, opposer neither pleaded a family of marks nor argued a family of marks in its brief. Furthermore, opposer's counsel confirmed during the oral hearing that opposer was not basing its claim of likelihood of confusion on a family marks. We have given applicant's argument no consideration.

and registration, rather than on what any extrinsic evidence might show the actual nature of the goods or their channels of trade or purchasers to be. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Based on the identification of goods, applicant's "non-medicated acne treatment creams and lotions" must be considered essentially identical to opposer's "acne medication" for purposes of assessing likelihood of confusion.⁷ Further, while applicant's product involves a five-step process using a set of five solutions, including cleansers and creams, and opposer's products consist of individual containers of cleansers, creams, ointments or lotions, the products are in fact functionally identical. Both parties' products are used for the treatment of common acne.

Because the goods are considered essentially identical, we must presume that the channels of trade and purchasers for the goods are identical as well. Opposer's product is an over-the-counter acne medication sold through mass merchandiser stores

⁷ The fact that applicant's acne products are classified in Class 3 (Cosmetics) whereas opposer's products are classified in Class 5 (Pharmaceuticals) has no affect on our determination. Classification of goods for registration purposes "is designed primarily to facilitate administration within the Office and cannot serve to extend or to limit a registrant's rights in the registered mark in a proceeding of this character." *Acomb v. Polywood Plastics Corporation*, 187 USPQ 188, 191

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such as Wal-Mart, national drug store chains such as CVS and Walgreens, food stores such as Kroger and Safeway; and convenience stores. Opposer's products are purchased by teenagers as well as adults with acne problems. Applicant's products are also used for treating acne in teenagers and adults. However, applicant's products are not sold in the retail market or purchased by ultimate consumers. The products are sold only to licensed skin care professionals or medical practitioners who use and apply the products in providing the treatment.

Applicant's products, as identified, may include, but are not limited to sale in the professional market. In the absence of any specific restrictions in the application, it must be presumed that applicant's acne treatment products would be sold through all normal channels of trade, including all the usual retail outlets for such goods; and that they would reach all the usual classes of consumers, including ordinary consumers. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant appears to recognize that absent a limitation in the identification of goods the respective products must be deemed to be sold in the same channels of trade. At the same time, however, applicant argues that due to the expensive nature of applicant's product, "the purchasers of Applicant's product

(TTAB 1975) (noting, however, that classification may serve "as an inkling or clue to the general character of such products").

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will be deemed to be discriminating purchasers." (Brief, p. 11.) Applicant's set of acne treatment products sells for \$200. Opposer's various acne treatment products range from \$3.50 to \$5.00, depending on the size of the container, the type of product and/or the strength of the formulation. Again, the problem with applicant's argument is that applicant's identification of goods is not limited to any particular price point. We must presume that applicant's acne treatment products sell in all the normal price ranges which would include the inexpensive price range of opposer's products. See *In re Opus One*, 60 USPQ2d 1812 (TTAB 2001).

Further, while these consumers may care about the products they are purchasing, or exercise a certain degree of care in selecting these products, they are not necessarily sophisticated purchasers or likely to exercise a high degree of care in terms of examining the trademarks. In fact, because opposer's products and those which we must presume to be encompassed by applicant's identification are inexpensive, common consumer products, purchasers may exercise less care in their purchasing decision, thus increasing the risk of confusion. See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289.

We turn next to a discussion of the marks, and first to the factor of fame because this factor "plays a 'dominant role' in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

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We are not persuaded by the record in this case that OXY is a famous mark. See *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005) ("it is the duty of a plaintiff asserting that its mark is famous to clearly prove it.").

Opposer has used the mark OXY continuously for over 30 years on acne treatment products. The mark is used in connection with a line of acne treatment products sold in a variety of sizes, forms and strengths. The products include Oxy Maximum Strength Daily Cleaning Pads, OXY Blackhead Clearing, Oxy Maximum Strength Wash, and Oxy Sensitive Skin Vanishing Treatment. Opposer's products are sold throughout the United States in mass merchandiser stores such as Wal-Mart, K-Mart and Target; national drugstores, such as CVS and Walgreens; grocery store chains such as Safeway and Food Lion, "club" stores such as BJ's and Costco, and convenience stores.

Opposer has advertised and promoted its products over the years in national magazines such as *Teen People* and *Sports Illustrated for Teens*; through in-store displays and shelf advertisements; in free-standing inserts in newspapers; on radio and on national network and cable television on programs such as MTV and other teen-focused programs; and on opposer's website (www.oxyoxygen.com).

More recently, opposer has conducted "back-to-school" Internet contests and other promotions directed to the teenage market. These promotions were run at or through opposer's

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website. Between 2003 and 2004, opposer conducted three such promotions including a contest called the "New Face of Oxy" which featured instant messaging and the opportunity to win prizes. The contest attracted 989,000 visitors to the website and 843,000,000 "impressions" over the three-months the contest was run. It is unclear whether the popularity of the contest would be attributed to brand recognition of the OXY product or the fact that the contest provided the opportunity for instant messaging which, as Mr. Brown states, is "something that is very popular with teens today." (Test., p. 27.)

Opposer has introduced the results of a marketing study conducted to track OXY brand awareness among consumers.⁸ The study was conducted in 2002 and was prepared as part of opposer's regular business activities and not in connection with litigation. The study tested both aided and unaided brand awareness among teenagers and adults. We have only the summary of the results and not the specific questions that were asked during the study except for Mr. Brown's general comment about what an "unaided" and "aided" brand awareness question might be. It is difficult to evaluate the reliability of the study or the significance of the results. Nevertheless, it appears to us that although the level of "unaided brand awareness" for OXY products

⁸ The marketing study as well as opposer's sales and advertising figures (discussed below) are confidential. Accordingly, specific numbers and figures relating to this information will not be discussed.

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ranks high among the different brands of acne treatment products, at the same time, it is not the highest, and its ranking falls well below the brand with the highest level of unaided awareness.

Opposer has submitted sales figures for the years 1999-2004 which show a steady decrease in sales since 2000 and since the time the 2002 marketing study was conducted. Opposer has also submitted advertising expenditures for 1999, and also for the years 2002 through the first half of 2004. These figures show a similar decline in advertising expenditures since 2002. In addition, the marketing study summary indicates a double-digit decline in Oxy brand usage from the previous year.

Notwithstanding what appears to be extensive advertising and promotional activities, the evidence overall tends to show a downward trend in consumer awareness in recent years.

Mr. Brown estimated that opposer has a 10% share of the acne treatment market but this figure is not particularly meaningful in a vacuum. This percentage, on its face, does not appear to be a large market share, and we cannot determine the level of dominance in the market that figure represents. For example, there is no testimony as to how many other companies compete in the market or whether that percentage is large or small in relation to the shares of those other companies.

Accordingly, the evidence falls short of establishing fame. Nevertheless, we find that the evidence is sufficient to show that opposer's mark OXY has achieved at least some degree of

recognition and strength in the market and that the mark is therefore entitled to a broader scope of protection than might be accorded a less distinctive mark.

Applicant, however, argues that opposer's mark is neither distinctive nor strong and that it is entitled to only a limited scope of protection. Applicant contends that the term "oxy" is an abbreviation for the word "oxygen" and that it designates products that include and/or use oxygen to perform the stated function of the products. In support of its contention, applicant points to two dictionary references, Acronyms, Initialisms, & Abbreviations Dictionary Seventh Edition; and Abbreviations Dictionary Eighth Edition, with definitions of "oxy" as abbreviations for, among other things, "oxygen"; Mr. Lapin's testimony that applicant selected the term "OXY" to denote "oxygenation" (Test., p. 19) as an antibacterial agent to kill bacteria that causes or contributes to acne; and printouts from about 16 third-party websites selling various products that utilize or include oxygen to perform the function of the product under names that include the term "Oxy." Based on this evidence, applicant argues that the widespread use of the term shows a "crowded" market and suggests that consumers have become so conditioned by the third-party uses that consumers are accustomed to distinguishing the marks even on the basis of small differences in the marks.

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The website evidence does not persuade us that opposer's mark is weak or that purchasers of opposer's acne treatment products would understand the meaning of OXY as "oxygen." The factor to be considered in determining likelihood of confusion under *du Pont* is the number and nature of similar marks "in use on similar goods." See *In re E. I. du Pont de Nemours & Co.*, supra at 567. While the website evidence is evidence of use, it is of limited probative value particularly since there is no information as to the extent of exposure of the websites to the public or the public's familiarity with them. See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782 (TTAB 2001). Moreover, with one possible exception, "Oxy" is not used on these websites in connection with similar goods. In fact they are for distinctly different goods. For example, "Oxy Twist" is for an exercise machine (nugaforlife.com); "Oxy-Cleanse" capsules are for "colon care" (centipedeindustries.com); "Oxy-Septic" is for septic system drainfield cleaner (oxyboost.com); "Oxi Clean" is for fabric stain remover (oxiclean.com); and "Oxy-Chum" is for live bait tank oxygen systems (oxyedge-chum.com). In the majority of examples, "Oxy" is used in connection with dietary or nutritional supplements. Some examples of these are "Oxy-Response by Source Naturals" (taoofherbs.com); "Oxy Life, Oxygen with Colloidal Silver & Aloe Vera" (southnatural.com); and "Oxy-Gen Caps" (oxyinfo.com). There is no indication that the dietary supplements are used to

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treat acne or are at all useful for that purpose. Also, Mr. Brown testified that unless the supplements were promoted for the treatment of acne, they would not be considered competitive goods. Thus, none of these third-party uses is particularly relevant. The single example of use of "Oxy" on an arguably similar product, "Oxy Skin Cream" (donsbach.com), is clearly insufficient to show a crowded field of "Oxy" marks. This evidence as a whole fails to show that "Oxy" is commonly used, or that it has a commonly understood meaning as "oxygen" in connection with acne treatment products. Similarly, applicant's reasons for selecting the term "OXY" as part of its mark are not persuasive. Applicant selected the term to refer to the benefits of its oxygenation machine, not the acne medication itself.

The two dictionary references to "oxy" as an abbreviation for "oxygen," in and of themselves, may not be sufficient to convince us that consumers would necessarily understand the meaning of "oxy" as "oxygen" or that they would necessarily associate that meaning with opposer's product. However, the record shows that opposer has promoted an association of OXY with "oxygen" and its beneficial effects in the treatment of acne. The domain name for opposer's website is "oxyoxygen.com"; opposer owns a registration that associates "oxygen" with OXY (THINK OXY, THINK OXYGEN) and opposer promotes the slogan in its print advertising (see, e.g., Brown Exh. 13); the wording "Releases active oxygen to kill acne-causing bacteria" appears in large

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print on at least one of opposer's packages (Brown, Exh. 3B) and "OXY works with oxygen to fight pimples" appears on another (Brown, Exh. 11, p. 3). Also Mr. Brown states that opposer "chose to feature" in communication and advertising "how active oxygen works" (Test., p. 58); and the results section of opposer's marketing study states that "The oxygen message is clearly getting through to teens."

We find that OXY would be perceived as a suggestive term when applied to opposer's acne treatment products. Nevertheless, while the mark is suggestive by its nature, it has been shown to be very strong and distinctive in the marketplace, and it is therefore not entitled to only a narrow scope of protection.

We turn then to a comparison of opposer's mark OXY with applicant's mark OXYCEUTICALS, keeping in mind that when goods are essentially identical, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Shen Manufacturing Co., Inc. v. The Ritz Hotel Limited*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004).

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *du Pont*, supra. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The parties' marks are similar in sound and appearance. The strong and distinctive term OXY is opposer's entire mark and, as the

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first term in OXYCEUTICALS, it is aurally and visually the dominant feature of applicant's mark. It is not significant that applicant's mark is presented as a single term. See *Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical").

Further, the term OXY is dominant in conveying the meaning and creating the commercial impression of applicant's mark. To the extent that "OXY" is viewed as a shortened form of "oxygen," thereby suggesting a benefit of opposer's products, that meaning, as applicant admits, would be the same in applicant's mark. The suffix CEUTICALS in applicant's mark does not change the meaning or commercial impression created by OXY alone, but instead merely enhances it, particularly in view of the suggestive nature of that suffix in relation to applicant's acne treatment product. Mr. Lapin testified that "ceuticals denotes pharmaceuticals or medical, quasi medical ingredients." (Test., p. 19.) Purchasers who are familiar with opposer's line of OXY products, upon later encountering applicant's mark OXYCEUTICALS on the essentially identical products, are likely to believe that opposer has added another medicated OXY product to its line.

Finally, the asserted absence of evidence of actual confusion is a neutral factor in this case. Applicant's mark has been in use a relatively brief period of time, since March 2003; applicant's products are sold in different channels of trade to different purchasers; and we have no information regarding the

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extent of applicant's use or whether a meaningful opportunity for actual confusion ever existed. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

In view of the foregoing, and because highly similar marks are used in connection with essentially identical goods, we find that confusion is likely.

Decision: The opposition is sustained, and registration to applicant is refused.