

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Oral Hearing: December 12, 2007 Mailed: March 18, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

The Mentholatum Company,  
substituted for SmithKline Beecham Corp.<sup>1</sup>  
v.  
TherOx, Inc.

Opposition No. 91160810  
to application Serial No. 78116976

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

Tawnya R. Wojciechowski of TRW Law Group for TherOx, Inc.

Before Hairston, Cataldo and Mermelstein,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On March 22, 2002 applicant, TherOx, Inc., filed an application to register the mark OXIUM, in standard character form on the Principal Register, based upon its assertion of a bona fide intention to use the mark in commerce for "oxygenated skin care preparations, namely,

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<sup>1</sup> In an interlocutory order issued on November 30, 2005, the Board granted opposer's motion to substitute The Mentholatum Company as party plaintiff herein in view of an assignment of opposer's pleaded marks thereto. The assignment was recorded with the Assignment Branch of the USPTO at Reel/Frame 3149/0867.

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creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations," in International Class 3.

Registration has been opposed by The Mentholatum Company ("opposer"). As grounds for opposition, opposer asserts that it is the owner of the following OXY and OXY-formative marks, previously used and registered on the Principal Register by opposer and its predecessor in interest, for the following goods:

OXY (in typed form)

for "acne medication" in International Class 5;<sup>2</sup>



for "acne medication" in International Class 5;<sup>3</sup>

OXY 10 (in typed form)

for "medication for treatment of acne" in International Class 5;<sup>4</sup>

THINK OXY, THINK OXYGEN (in typed form)

for "acne medication" in International Class 5;<sup>5</sup>

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<sup>2</sup> Registration No. 1869207 issued on December 27, 1994. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>3</sup> Registration No. 1873555 issued on January 17, 1995 with the following lining statement: The mark is lined for the color pink. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

<sup>4</sup> Registration No. 1141969 issued on December 2, 1980 with a disclaimer of "10" apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.



for "topical acne medication, medicated face wash and medicated skin wipes" in International Class 5;<sup>6</sup>



for "topical acne medication, medicated face wash and medicated skin wipes" in International Class 5;<sup>7</sup>



for "topical acne medication, medicated face wash and medicated skin wipes" in International Class 5;<sup>8</sup>

OXY BALANCE ON-THE-GO (in typed form)

for "acne medication" in International Class 5;<sup>9</sup> and

THE OXYGENATOR (in typed form)

for "video game software which is downloadable from a global computer network for the specific purpose of promotion of applicant's skincare products" in International Class 9; and

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<sup>5</sup> Registration No. 2582225 issued on June 18, 2002.

<sup>6</sup> Registration No. 2919984 issued on January 18, 2005.

<sup>7</sup> Registration No. 2874733 issued on August 17, 2004.

<sup>8</sup> Registration No. 2919983 issued on January 18, 2005.

<sup>9</sup> Registration No. 2480829 issued on August 21, 2001 with a disclaimer of "ON-THE-GO" apart from the mark as shown.

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"entertainment services, namely, providing an on-line computer game for the specific purpose of promotion of applicant's skincare products" in International Class 41.<sup>10</sup> Opposer argues that it has made use of its OXY and OXY-formative marks in connection with the above goods and services since prior to the filing date of applicant's intent-to-use application; and that applicant's mark, OXIUM, when used on applicant's goods so resembles opposer's OXY and OXY-formative marks for its recited goods and services as to be likely to cause confusion, to cause mistake, and to deceive.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.<sup>11</sup>

**The Record**

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case consists of the pleadings and the file of the involved application. In addition, during its assigned testimony period, opposer submitted the testimony depositions, with exhibits, of James C. Brown, Brand Manager for the OXY brand at opposer's predecessor in interest; and the testimony deposition of Todd S. Cantrell, Brand Manager for the Oxy brand at opposer. In addition, opposer filed

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<sup>10</sup> Registration No. 2685219 issued on February 11, 2003.

<sup>11</sup> In addition, applicant asserts certain affirmative defenses. However, these affirmative defenses were not pursued at trial and, accordingly, are considered waived.

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notices of reliance upon the following: (1) status and title copies of its 9 pleaded registrations showing that opposer is the current owner and that each is valid and subsisting; (2) copies of 27 third-party registrations in which marks identify both cosmetics in International Class 3 and acne preparations in International Class 5; and (3) copies of 6 additional third-party registrations in which marks identify both cosmetics in International Class 3 and acne preparations in International Class 5.

During its assigned testimony period, applicant submitted the testimony deposition, with exhibits, of Jeffrey Creech, Program Manager of Research and Regulatory Affairs for applicant.<sup>12</sup>

In addition, pursuant to a stipulated protective agreement, both parties designated certain portions of the above testimony and evidence "confidential" and submitted such under seal. Accordingly, we will refer to such testimony and evidence that was submitted under seal in only a very general fashion.

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief. In addition, counsels for

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<sup>12</sup> Applicant asserts that it also submitted as evidence opposer's responses to applicant's interrogatories. However, opposer argues that applicant did not submit such interrogatory responses and, in any event, opposer's interrogatory responses are not of record.

the parties presented arguments at an oral hearing held on December 12, 2007.

**Procedural and Evidentiary Objections**

Subsequent to opposer's submission of its reply brief, applicant filed a "supplemental brief" in this proceeding. Inasmuch as there is no provision for the filing of a reply or rebuttal brief by a party in its capacity as defendant in a Board inter partes proceeding, opposer's motion to strike applicant's "supplemental brief" is hereby granted. See TBMP §§ 801.02(d) and 539 (2d ed. rev. 2004) and the authorities cited therein. We observe nonetheless that even if applicant's "supplemental brief" had been considered, the result in this case would be the same.

In its main brief, applicant objects to "any evidentiary value of any of Opposer's registrations which were applied-for after Applicant's March 22, 2002 filing date, namely, U.S. Registration Nos.: 2,919,984; 2,874,733 and 2,919,983, all filed more than a year after Applicant's OXIUM application filing date." (brief, p.2, footnote 1.) Applicant asserts that such registrations are "irrelevant" and should be disregarded. (*Id.*) Applicant's objection is noted, and the registrations in question, along with the rest of the testimony and evidence adduced herein, have been accorded such probative value as they are due.

**Opposer's Standing and Priority of Use**

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the OXY and OXY formative marks therefor and goods and services covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We note in addition that applicant does not contest either opposer's standing to bring this proceeding or priority of use.

**Likelihood of Confusion**

Our likelihood of confusion 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 likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65

USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We will concentrate our discussion of the issue of likelihood of confusion on that registration of opposer's which is closest to the mark for which applicant is seeking registration for the most similar goods, namely, opposer's Registration No. 1869207 for OXY in typed form for "acne medication" in International Class 5.

Fame of Opposer's OXY Mark

We begin our likelihood of confusion analysis with the fifth *du Pont* factor, which requires us to consider evidence of the fame of opposer's OXY mark and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp. v. QSC Audio Products Inc.*, supra, 63 USPQ2d at 1305.

Upon careful review of the record in this case, we are not persuaded that opposer's OXY mark is famous. 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 OXY mark continuously since the mid 1970s on its line of acne treatment products. Opposer's products are sold throughout the United States in mass merchandiser stores, drug stores and grocery stores such as Wal-Mart, Target, CVS, Rite Aid, Eckerd, Brooks and Longs. Opposer has advertised and promoted its acne medications under the OXY mark in national magazines such as *Teen People*; *MAD Magazine*; *DC Comics* 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 programs such as MTV and other teen-focused programs; and on opposer's website ([www.oxyoxygen.com](http://www.oxyoxygen.com)).

More recently, opposer has conducted Internet contests and other promotions directed to the teenage market through opposer's website. The 2004 contest attracted 989,000 visitors to the website, with 6.9 million users of the OXY instant messaging system generating 38 million instant

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messages. It is estimated that "over 840 million people saw the instant messaging imagery" (brief, p. 25, quoting Brown Testimony, Ex. 7) during this promotion. In addition, opposer is a primary sponsor of MTV television shows, and a promoter of the "extreme sports" Dew Tour, which exposes thousands of viewers and participants to OXY branded products.

Opposer has submitted under seal recent sales and advertising figures. These numbers, though substantial, do not demonstrate that opposer's OXY mark has achieved fame. In addition, opposer submitted a brand awareness study covering the years 2005 to 2006 which indicates an increase in recognition of the OXY brand among users and purchasers of acne medication. However, such evidence falls short of demonstrating the extent to which the increased awareness of opposer's products translates into widespread recognition of the OXY mark in relation to other acne treatment products.

Accordingly, we find on this record that the evidence falls short of establishing that opposer's OXY mark is famous for purposes of our likelihood of confusion determination. Nevertheless, we find that the evidence is sufficient to show that opposer's OXY mark 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.

The Marks

We turn then to the first *du Pont* factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot, supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

In this case, we find that applicant's mark, OXIUM, is highly similar to opposer's mark, OXY. The letters "OXI" comprising the beginning of applicant's mark are nearly identical to the letters comprising opposer's strong and distinctive OXY mark. Because of the nearly identical nature of the first three letters of applicant's mark and the entirety of opposer's mark, the similarities in appearance between OXY and OXIUM outweigh the differences.

As to sound, it is settled that there is no correct way to pronounce a trademark. See *In re Belgrade Shoe*, 411 F.2d 1352, 162 USPQ 227 (CCPA 1969) and *Interlego AG v.*

*Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002). See also *In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). We note, nonetheless that the first two letters in the parties' marks ("OX") are identical, and the following letters, "Y" and "I" respectively, are phonetic equivalents with the same pronunciation. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217 (TTAB 2001). As such, we see no reason why OXY and the first two syllables of OXIUM would not be identical in pronunciation, leaving the final syllable of OXIUM as the only aural dissimilarity between the two. Thus, when taken as a whole, the marks OXY and OXIUM are highly similar in sound. Furthermore, while neither mark appears to have a known meaning, both marks convey a sense of oxygen or oxygenation resulting from the use of the products identified thereby. Thus, the marks are highly similar in connotations and convey highly similar overall commercial impressions.

In view of the similarities between the marks in appearance, sound, meaning, connotation and overall commercial impression, this *du Pont* factor favors opposer.

The Goods

With respect to the goods, it is well established that the goods or services of the parties need not be similar or competitive, or even offered through the same channels of

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trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978).

The goods identified in opposer's Registration No. 1869207 for its OXY mark are "acne medication" in International Class 5. Applicant's goods under its OXIUM mark are identified as "oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations," in International Class 3. Thus, as identified, applicant's goods specifically exclude those of opposer. However, the exclusive language in applicant's identification of goods is insufficient to forestall a finding that applicant's goods are related to those of opposer. Nor is the difference in classification of the goods (International Class 3 for applicant's goods versus International Class 5 for those of

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opposer) determinative of the issue of relatedness for purposes of likelihood of confusion. See *Jean Patou Inc. v. Theon Inc.*, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). The issue is not whether purchasers would confuse the goods themselves, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In this case, we observe that opposer's goods improve the appearance and health of skin by treating acne. Applicant's goods improve the appearance and health of the skin on the face, hands, feet and body. Applicant argues that its product "is a luxury good consisting of topical solution used as an anti-aging cosmetic product" (brief, p. 12). However, in making our determination regarding the relatedness of the parties' goods, we must look to the goods as identified in the involved application and pleaded registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant's identification of goods is not limited to luxury or anti-aging products. Thus, as identified, applicant's goods are oxygenated skin care preparations for use on the face, hands, feet and body. Opposer's goods are acne medication, obviously for use on the skin. As such, we find that the parties' goods are related inasmuch as they perform complementary functions.

In addition, opposer has submitted by notice of reliance a number of use-based third-party registrations which show that various entities have adopted a single mark for acne medications on the one hand and various skin care preparations on the other, that is, for substantially similar goods to those identified in applicant's application and opposer's Registration No. 1869207 for its OXY mark. 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, 1786 (TTAB 1993). Thus, the record in this case supports a finding that entities utilize a single mark to identify both applicant's and opposer's goods.

In view of the related nature of opposer's and applicant's goods, this *du Pont* factor also favors opposer.

Channels of Trade

Because the evidence introduced by opposer establishes that the above goods are related, and because there are no recited restrictions as to their channels of trade or classes of purchasers, we must assume that the goods are available in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for opposer's goods as well as

applicant's goods would be the same. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, *supra* ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") In view of the foregoing, we are not persuaded by applicant's arguments regarding differences in price, intended consumers, or channels of trade of the involved goods.

We find that, as a result of the foregoing, this *du Pont* factor also favors opposer.

Conditions of Sale

The next *du Pont* factor discussed by the parties is that of the conditions of sale. Applicant asserts that its goods are expensive, and would be purchased by careful and sophisticated users. However, as identified, applicant's goods are not limited to expensive, "high end" skin care

products. As such, we must presume that applicant's goods include skin care products of all types and price ranges common thereto. These would include inexpensive products that normally would be purchased without a great deal of thought in addition to more highly specialized and expensive products. Moreover, sophisticated purchasers are not necessarily knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812, 1814-1815 (TTAB 1988). In addition, even if we accept that applicant's goods are expensive, there is no evidence that they would be purchased only by highly sophisticated persons. Indeed, applicant's goods would be available to anyone with the income and inclination to use them. Moreover, even if some degree of care were exhibited in making the purchasing decision, the marks OXY and OXIUM are so similar that even careful purchasers are likely to assume that the marks identify goods and services emanating from a single source.

Thus, this *du Pont* factor also favors opposer.

Actual Confusion

Another *du Pont* factor discussed by the parties is the lack of instances of actual confusion. Applicant asserts that the absence of actual confusion suggests no likelihood of confusion. However, it is not necessary to show actual confusion in order to establish likelihood of confusion.

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*See Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Moreover, on the record before us there is no evidence as to whether there has been any opportunity for confusion to occur. Thus, this *du Pont* factor is neutral.

**Summary**

We have carefully considered all of the evidence pertaining to priority of use and the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion.

We conclude that opposer has established its standing to bring this proceeding; its priority of use; and that a likelihood of confusion exists between its OXY mark and applicant's OXIUM mark, as used in connection with their respective goods. To the extent that any of applicant's points raise a doubt about our conclusion, all doubt on the issue of likelihood of confusion must be resolved in favor of the prior user and against the newcomer. *See San Fernando Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977).

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