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Mailed: September 26, 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allergan, Inc.

v.

Bioelements, Inc.

Opposition No. 91171473

Kenneth L. Wilton of Seyfarth Shaw LLP for Allergan, Inc.

Janice Bader of Symbus Law Group, LLC for Bioelements, Inc.

Before Hairston, Drost and Mermelstein, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Bioelements, Inc. has filed an application to register the mark PROBOTIX (in standard character form) for "skin cream and non-medicated skin serum" in International Class 3.[1]

Registration has been opposed by Allergan, Inc. on the ground that applicant's mark, when applied to applicant's

[1] Serial No. 78652857, filed on June 17, 2005, based on an allegation of a bona fide intention to use the mark in commerce.

goods, so resembles opposer's previously used and registered mark BOTOX for pharmaceutical preparations as to be likely to cause confusion. Opposer also alleged that its BOTOX mark is famous, and pleaded ownership of the following three registrations for such mark:

> (1) Registration No. 1692384 (Issued on June 9, 1992; renewed) for "pharmaceutical preparations, namely ophthalmic muscle relaxants;"
>
> (2) Registration No. 1709160 (Issued on August 18, 1992; renewed) for "pharmaceutical preparations for the treatment of neurological disorders;" and
>
> (3) Registration No. 2510675 (Issued on November 20, 2001; Section 8 affidavit accepted and Section 15 affidavit filed) for "pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, automatic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pain."

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

Before outlining the evidence in this case, we must discuss an evidentiary matter. Applicant submitted a notice of reliance on a copy of an article that appeared in the January 2007 issue of "Elle" magazine that discusses skin products, including applicant's "Probotix Anti-Aging Serum." Applicant seeks to rely on this article to show that probiotics are used in skin products. Opposer has objected to the magazine article, arguing that it constitutes inadmissible hearsay and is irrelevant.

To the extent that applicant seeks to rely on the magazine article for the truth of the matters contained therein, i.e., that probiotics are used in skin products, this is clearly inadmissible hearsay, and we sustain opposer's objection in this regard. The article is admissible only to show that certain skin products, including applicant's "Probotix Anti-Aging Serum," were the subject of an article that appeared in the January 2007 issue of "Elle" magazine.

The record consists of the pleadings and the file of the involved application. Opposer submitted the trial testimony (with exhibits) of Tom Albright, its vice-president for global strategic marketing; and a notice of reliance on certified copies of its pleaded registrations, showing that each registration is subsisting and owned by opposer. Applicant did not take testimony, but as discussed above, submitted a notice of reliance on a copy of a magazine article.

Both parties filed briefs.

Priority of use is not an issue in this proceeding inasmuch as opposer has proven that, as noted above, each of its pleaded registrations is subsisting and is owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer's ownership of these registrations also serves to establish

its standing to bring this proceeding. 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).

Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in In re E. I. duPont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The duPont factors deemed relevant in this proceeding are discussed below.

We consider first the duPont factor of fame. The fame of a plaintiff's mark, when fame is shown in the record, is an important factor because a famous mark deserves a broad scope of protection. Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); Recot Inc. v. M.C. Becton, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the Federal Circuit stated in Bose Corp. v. QSC Audio Products, Inc., 63 USPQ2d at 1305:

> 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.

According to the record, opposer began marketing a pharmaceutical preparation under the mark BOTOX around 1990. (Albright dep. at 9-10). Since that date, opposer has continuously marketed the pharmaceutical preparation, which has therapeutic use. In 2002, the United States Food and Drug Association (FDA) approved opposer's BOTOX brand product for cosmetic use, namely, for the temporary improvement in the appearance of the frown lines that appear in the middle of the forehead. (Albright dep. at 8-9, Exhs. 14 and 17). The product's chemical formulation remained the same. (Albright dep. at 8). However, when marketed for cosmetic use (as opposed to therapeutic use), opposer was required to use "Cosmetic" next to the BOTOX mark. Thus, in marketing the product, opposer's mark appears as "BOTOX® Cosmetic." (Albright dep. at 8-9).

Once the FDA approved the BOTOX product for cosmetic use, opposer began aggressively advertising the product on the Internet, in publications, and on television. (Albright dep. at 17-18). In 2002, opposer spent over $6 million in the United States on print advertising for the BOTOX cosmetic product, with advertisements appearing in over twenty magazines and other publications. Also, in 2002, opposer spent nearly $10 million on television advertising

for the BOTOX cosmetic product. (Albright dep. at 18-19, Exh. 9). In 2003 and 2004, opposer spent approximately $10 and $12 million, respectively, in the United States on print advertising, with advertisements appearing in numerous publications, and approximately $10 and $15 million, respectively, in television advertising. (Albright dep. at 20-22; Exhs. 10-19).

In terms of sales, between 1999 and year end 2005, opposer's revenues of goods sold under the BOTOX mark totaled over $3.2 billion, 70% of which were received in the United States. (Albright dep. at 14-15, 17; Exh. 8).

The record establishes opposer's continuous use of its BOTOX mark for over fifteen years, and its revenues and advertising figures are impressive. Moreover, we note that applicant states in its brief that "[i]t is clear that the BOTOX mark has achieved celebrity." (Brief, p. 1). This is tantamount to a concession that opposer's mark is famous. Accordingly, we find that opposer's mark is famous for a pharmaceutical preparation with a cosmetic use. Furthermore, contrary to applicant's contention that "[c]onfusion is unlikely because the mark BOTOX is famous" (Brief, p. 9), it is well settled that the fame of a mark cannot serve to diminish the likelihood of confusion. In sum, the duPont factor of fame weighs heavily in opposer's favor.

We turn next to the duPont factor of the similarity or dissimilarity of the parties' goods. It is well established that the goods of the parties need not be similar, or even competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods 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 In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

It is also well established that the registrability of applicant's mark must be evaluated on the basis of the identification of goods as set forth in the involved application and the identifications of goods as recited in any pleaded registrations regardless of what the record may reveal as to the particular nature of the respective goods, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and Canadian

Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

Although the record shows that opposer's BOTOX product is given by an injection administered by a physician, this is not reflected in the identification of goods in opposer's registrations. As indicated, the record establishes that opposer's BOTOX product is for cosmetic use in that it improves the appearance of wrinkles. Applicant's identification of goods is broadly worded and, therefore, we must assume that the goods encompass all types of skin cream and non-medicated skin serum, including those that are intended to reduce the appearance of wrinkles.

Thus, for purposes of our likelihood of confusion analysis, we must presume that the products serve the same function or purpose, namely, to reduce the appearance of wrinkles on the user.

The duPont factor of the similarity of the goods favors a finding of likelihood of confusion.

We consider next the duPont factor of the similarity or dissimilarity of the trade channels and purchasers for the parties' goods. Neither opposer's goods nor applicant's goods are limited as to trade channels, and we therefore presume that the respective goods move through the channels of trade normal for these types of goods. Kangol Ltd. v. KangaROOS U.S.A., Inc., 974 F.2d 161, 23 USPQ2d 1945, 1946

(Fed. Cir. 1992). Those trade channels, such as drug stores, and supermarkets and mass merchandisers with pharmaceutical sections, are overlapping. Moreover, the same types of purchasers, namely ordinary consumers who are interested in reducing the appearance of skin wrinkles, would purchase such products.

Thus, the overlap in trade channels and class of purchasers for the parties' products weighs in favor of finding a likelihood of confusion.

We next turn to the duPont factor focusing on the similarity or dissimilarity of the marks. We must consider the marks in their entireties in terms of appearance, sound, meaning and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.2d 1369, 73 USPQ2d 1689, 1692. The test 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 their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser who normally retains a general rather than a specific impression of trademarks. Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

We find that when applicant's mark PROBOTIX and opposer's mark's BOTOX are considered in their entireties,

the overall similarities in the marks outweigh their differences. In this case, the marks are similar in sound and appearance due to the similarities in the –BOTIX portion of opposer's mark and applicant's mark BOTOX. Although applicant's mark also includes the term PRO, the addition of this term does not result in dissimilar marks. The term "pro," which could mean professional, would suggest a product that is marketed as having "professional" or added "strength."

Insofar as the connotation of the marks is concerned, applicant contends that its mark PROBOTIX suggests "probiotics," whereas opposer's mark BOTOX suggests an association with "Botulinum Toxin Type A." Indeed, the testimony of opposer's witness, Mr. Albright, indicates that opposer's BOTOX product is derived from Botulinum Toxin Type A. However, as discussed previously, applicant's evidence does not establish that probiotics are used in skin products.[2] Nonetheless, we find that any specific differences in meaning, as well as in sound and appearance between the marks BOTOX and PROBOTIX, are outweighed by the similarities. Further, the marks are sufficiently similar

[2] Moreover, we note that applicant's mark is PROBOTIX; not PROBIOTIX.

in their overall commercial impressions that consumers, when encountering the marks BOTOX and PROBOTIX, are likely to believe that the closely related products sold thereunder emanate from a common source.

The similarity between the marks weighs in favor of a finding of likelihood of confusion.

After careful consideration of the evidence of record pertaining to all of the relevant duPont factors, we find that a likelihood of confusion exists. Given that opposer's mark is a famous mark which is entitled to a broad scope of protection, the applicant's goods and opposer's goods are closely related, and the trade channels and customers overlap, we find that applicant's mark PROBOTIX is sufficiently similar to opposer's mark BOTOX that confusion is likely.

Specifically, purchasers familiar with opposer's pharmaceutical preparation sold under its famous BOTOX mark would be likely to believe, upon encountering applicant's PROBOTIX mark for skin cream and non-medicated skin serum, that the goods originated with or were somehow associated with or sponsored by the same source.

As the Federal Circuit and its predecessor have held, "there is no excuse for even approaching the well-known trademark of a competitor and that all doubt as to whether

confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc., 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)(internal punctuation marks omitted).

Decision: The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.