

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC. 18, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SmithKline Beecham Corporation

v.

Xechem, Inc.

Opposition No. 102,846
to application Serial No. 75/000,905
filed on October 3, 1995

Karol A. Kepchar of Panitch Schwarze Jacobs & Nadel, P.C.
for SmithKline Beecham Corporation

Joel E. Siegel of Dressler, Goldsmith, Shore & Milnamow,
Ltd. for Xechem, Inc.

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Xechem, Inc. to
register the mark PAXETOL for "pharmaceutical preparations
for use in the treatment of cancer".¹

¹ Application Serial No. 75/000,905, was filed on October 3,
1995, based on an alleged bona fide intent to use the mark in
commerce.

Opposition No. 102846

SmithKline Beecham Corporation has opposed the application, alleging that since February 1993 opposer has continuously used the mark PAXIL for pharmaceuticals, namely, antidepressants; that opposer's mark PAXIL used on antidepressants has become well known to the relevant public and trade; that pharmaceutical companies "customarily market and sell a variety of goods for the treatment of a variety of illnesses and symptoms"; that patients receiving treatment for cancer often require treatment for depression as well, and therefore doctors may prescribe and patients may take concurrently pharmaceuticals to treat cancer and depression; and that applicant's mark, if used on its goods, would so resemble opposer's previously used and registered mark, PAXIL for "pharmaceuticals, namely, antidepressants"², as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; a status and title copy of opposer's pleaded registration submitted under a notice of reliance; the testimony of Bonnie Rossello, opposer's product director - PAXIL; opposer's notices of reliance on certain of applicant's answers to opposer's interrogatories and to opposer's requests for admission; and opposer's notice of reliance on several printed publications

² Reg. No. 1,821,952, issued February 15, 1994.

"as available on the Nexis database and/or the Internet."³
Applicant submitted no testimony or other evidence. Opposer filed a brief; applicant did not file a brief. No oral hearing was requested.

In this case opposer has filed a status and title copy of its pleaded registration. Because opposer owns a valid and subsisting registration of its pleaded mark, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696 (TTAB 1987). Opposer's priority is also clearly established by the testimony and other evidence of record.

Thus, the only issue before the Board is likelihood of

³ The evidence submitted under Trademark Rule 2.122(e) consists of photocopies of articles appearing in magazines and newspapers, printouts from Nexis, and printouts from the Internet. (We note that the notice of reliance under Trademark Rule 2.122(e) also included a few pages of additional miscellaneous papers, which were not referred to in the notice of reliance. Because these materials were not referred to, the Board has not considered them.)

The photocopies of newspaper and magazine articles and the printouts from Nexis are acceptable under Trademark Rule 2.122(e). However, submissions of printouts from the Internet are not generally considered printed publications under Trademark Rule 2.122(e). See *Racioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). A few of the materials submitted under the notice of reliance were also submitted as exhibits to Ms. Rossello's testimony, and are therefore properly of record. (See, e.g., Exhibits 13 and 24). Further, one other Internet submission in the notice of reliance (a photocopy of applicant's Internet home page) was authenticated through applicant's answers to opposer's requests for admission Nos. 57 and 58. With regard to the remaining Internet printouts submitted under this notice of reliance, as they are not generally considered printed publications, they will not be considered herein. See *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979).

confusion. Based on the record before us in this case, we find that confusion is likely.

The testimony of Bonnie Rossello, opposer's product director - PAXIL, establishes that opposer is a large pharmaceutical company which manufactures and markets a wide variety of prescription and over-the-counter pharmaceuticals; that opposer has sold a prescription antidepressant drug under the mark PAXIL since February 1993, shortly after opposer received FDA approval therefor; that opposer's involved product is a member of the class of antidepressants called selective serotonin reuptake inhibitors (which also includes drugs sold under the trademarks PROZAC and ZOLOFT); that opposer's involved drug was approved by the FDA for treatment of panic disorder and obsessive-compulsive disorder in May 1996; and that opposer has extensively marketed and sold its PAXIL product for all of these illnesses.

She further testified that opposer's promotional and advertising expenditures from 1993 to 1996 for its product sold under the mark PAXIL were in excess of \$100 million; and that opposer's sales of the product from 1993 to 1996 were in excess of \$1.7 billion⁴. Opposer's PAXIL product is

⁴ Opposer's annual advertising and annual sales figures were submitted as confidential under seal as a portion of the deposition of Bonnie Rossello. However, opposer referred to total figures in its brief (see pages i and 8). Therefore, the Board has utilized these general figures.

Opposition No. 102846

ranked among the top ten most often prescribed drugs in the Unites States, with 7 million prescriptions written for the drug from January - August 1997; and it is ranked third in sales among competing antidepressant pharmaceuticals after PROZAC and ZOLOFT brand antidepressants.

Opposer's PAXIL pharmaceutical is marketed to doctors through direct mail campaigns (especially regarding the new indications and uses of the PAXIL drug for panic attacks and obsessive-compulsive disorder); through the process of "sales force detailing"; and through "co-promotion" with another company's drug (a common practice in the industry), whereby more than one company "details" their companies' respective products to physicians and to nurses.

"Detailing" is a method of marketing pharmaceuticals to physicians whereby the sales representative reviews features and benefits of the product with the physician, generally one on one; answers any questions; and leaves samples and sales promotion and product information with the physician.

Opposer's "detailing" sales force assigned to the PAXIL product is 2000 people. (Rossello Dep., p. 17). Opposer engages in "detailing" activities specifically directed to oncologists. Opposer also distributes PAXIL promotional items, including mini-massagers, pens, scratch pads, and Swiss army knives. Opposer generally distributes such goods at conferences, conventions, and trade shows which are

directed to psychiatric doctors, family practice doctors, and physician assistant/nurse practitioners.

Opposer's PAXIL product is advertised in professional publications such as "The New England Journal of Medicine of the American Medical Association", "The American Journal of Psychiatry", and "The NIH Observer". It is also advertised to the general public through publications such as "Good Housekeeping", "People", and "Better Homes & Gardens", as well as through opposer's website. In addition, opposer's sales representatives offer a range of patient brochures to physicians so that the doctors may distribute them to their patients. Ms. Rossello further testified that opposer as well as other pharmaceutical companies have increased their directed consumer advertising for prescription drugs.

Opposer promotes its PAXIL drug to pharmacists through trade publications, advertisements in publications, and through opposer's national accounts department, whose personnel call on pharmacists as part of the "formulary decision making process".⁵ Opposer also promotes its PAXIL product to drug wholesalers, hospitals and managed care providers.

Ms. Rossello also testified that based on opposer's sales and advertising figures, the number of prescriptions

⁵ A "formulary" is a list of drugs compiled by an HMO to allow doctors to understand which drugs that HMO prefers the doctor to

Opposition No. 102846

written for the PAXIL antidepressant, independent marketing research surveys, and unsolicited press coverage, she believes opposer's mark PAXIL is well known among doctors, pharmacists, and the general public.

Opposer has submitted evidence to show that persons with chronic or terminal illness, such as cancer, are susceptible to depression; and that the same doctors and health care professionals may be "detailed" for both cancer treatment and depression treatment drugs. For example, opposer submitted evidence of a clinical trial study "looking at the efficacy and safety of PAXIL in treating depression in women with breast cancer" (Rossello Dep., p. 21, and Ex. 3).

Finally, Ms. Rossello testified that possible "pharmacist error" is a factor in choosing a trademark for a pharmaceutical product. That is, pharmacists may misread a prescription due to the inability to interpret the handwriting correctly, or a pharmacist may misunderstand a call-in prescription from a doctor. (Dep., pp. 13-14).

Applicant has not submitted any testimony or any other evidence in this case. Specifically, there is no evidence regarding applicant itself, the anticancer drug applicant intends to sell under the mark PAXETOL, any third-party uses of any similar marks, and/or any evidence that the letters

prescribe. Opposer's PAXIL product is on most major HMO

Opposition No. 102846

"PAX" have any significance such that purchasers will look to other portions of the words to distinguish the marks.

Thus, the information we have regarding applicant is essentially that submitted by opposer in the form of applicant's answers to certain of opposer's interrogatories and to certain of opposer's requests for admission. From applicant's discovery responses, made of record herein, it is clear that applicant intends to market a pharmaceutical for the treatment of cancer under the mark PAXETOL; that applicant conducted a preliminary trademark search which revealed the existence of opposer's mark PAXIL; that applicant first made the mark known to the public through a brochure sent out in late 1995; that applicant intends to sell the drug to hospitals, hospital pharmacies, and to overseas markets; that applicant intends to "co-promote" the product with other pharmaceutical companies; and that applicant intends to "detail" physicians regarding applicant's PAXETOL product, and to distribute samples of the product to clinics, hospitals, and pharmacies.

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by

formularies. (Rossello Dep., p. 34)

Opposition No. 102846

the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978); and *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992).

In this case both parties' products are pharmaceuticals. Even though the parties' respective drugs may be used for different purposes, nonetheless the record shows that such drugs may be prescribed for treatment of a particular illness. Specifically, opposer's antidepressant product may be prescribed for and used by patients with cancer who may also be treated with a cancer drug such as applicant's.

Moreover, both parties' products can be marketed and sold through the same channels of trade to the same groups of consumers. Specifically, opposer advertises and promotes its antidepressant drug to doctors, including oncologists, who would most likely prescribe cancer treatment drugs. Opposer's product is sold to hospitals and retail pharmacies; it is prescribed by doctors and sold to end users through hospital and retail pharmacies; and it is specifically promoted directly to the general public. In addition, opposer "co-markets" its product with the products of other pharmaceutical companies. Applicant has acknowledged that it intends to target the same entities;

and that it will "co-market" its product sold under the mark PAXETOL. Thus, the channels of trade, and the potential purchasers are the same for both parties' products.

Accordingly, we find the parties' goods to be related.

With respect to the marks, they both begin with the letters "PAX" and end with the letter "L". We recognize that the marks have different string letters in between, but we do not find these internal differences sufficient to distinguish these marks. These two marks still have a similar appearance, and somewhat similar pronunciation, and the chance of confusion is increased by the fact that pharmacists are generally presented handwritten prescriptions and telephoned orders.

Moreover, it has long been held that it is necessary, for obvious reasons, to avoid confusion in the dispensing of pharmaceuticals; and that where ethical goods are sold and careless use is dangerous, greater care should be taken in the use and registration of trademarks to assure that no harmful confusion results. See *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972); *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); and *Schering Corporation v. Alza Corporation*, 207 USPQ 504 (TTAB 1980).

We would also point out that, as shown by opposer's advertising and sales figures, and the numerous unsolicited

publications referencing opposer's PAXIL products, that opposer's mark PAXIL for a pharmaceutical to treat depression, panic attacks, and obsessive-compulsive disorder is a strong mark entitled to a wide latitude of legal protection. As indicated previously, defendant has not provided any evidence of third-party use of PAX-prefixed marks, or any information which would indicate that PAX has a suggestive significance in the medical field. Thus, even if doctors, pharmacists, and ordinary consumers note the difference between PAXIL and PAXETOL, they may well believe that applicant's goods emanate from or are sponsored by the same entity.

Finally, we would point out that applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, at 1774 (TTAB 1992).

In conclusion, we find that applicant's use of the mark PAXETOL for a pharmaceutical for the treatment of cancer would be likely to cause confusion, mistake, or deception with opposer's mark PAXIL for a pharmaceutical for the treatment of depression, panic attacks, and obsessive-compulsive disorder.

Opposition No. 102846

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

E. J. Seeherman

C. E. Walters

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal