

Hearing:
December 9, 1997

Paper No. 44
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SmithKline Beecham Corporation

v.

Tocad Co., Ltd.

Cancellation No. 23,622

Roberta Jacobs-Meadway of Panitch Schwarze Jacobs & Nadel,
P.C. and Gary D. Krugman of Sughrue, Mion, Zinn, MacPeak &
Seas for SmithKline Beecham Corporation.

Michael O. Warnecke of Mayer, Brown & Platt for Tocad Co.,
Ltd.

Before Simms, Cissel and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

SmithKline Beecham Corporation has filed a petition to
cancel the registration of the mark AQUA FLOSS for a "water
jet oral hygiene device for cleaning and irrigating gums and
spaces between teeth."¹

As grounds for cancellation, plaintiff alleges that,
through its related companies and predecessors, it has for
many years developed, manufactured and sold pharmaceutical

Cancellation No. 23,622

and dental care products; that since at least as early as August 1972 plaintiff has used the marks AQUA FRESH and AQUAFRESH for toothpaste and other oral hygiene care products; that it is the owner of registrations for the following marks: AQUA FRESH²; AQUAFRESH³; and AQUA-FRESH⁴ for toothpaste; and AQUA-FRESH FLEX for toothbrushes⁵; that the above marks constitute a family of AQUA FRESH marks; and that defendant's mark, when applied to the goods identified in its registration, so resembles plaintiff's previously used and registered marks for its products as to be likely to cause confusion.

Defendant, in its answer, has denied the salient allegations of the petition to cancel.⁶

The record includes, inter alia, the pleadings; the file of the involved registration; trial testimony taken by both parties; plaintiff's notice of reliance on its pleaded registrations as well as a number of its other registrations;⁷ plaintiff's notice of reliance on third-

¹ Registration No. 1,660,337 issued October 8, 1990; Section 8 affidavit accepted.

² Registration No. 1,006,820 issued March 18, 1975; renewed.

³ Registration No. 1,006,821 issued March 18, 1975; renewed.

⁴ Registration No. 1,097,151 issued July 25, 1978; Sections 8 & 15 affidavit filed.

⁵ Registration No. 1,662,981 issued October 29, 1991; Sections 8 & 15 affidavit filed.

⁶ Defendant, in its answer, also asserted the affirmative defense of laches. However, at the oral hearing on this case, defendant's counsel stated that defendant was not pursuing this defense and, thus, we have not considered it.

⁷ We note that plaintiff has not relied on these other registrations in its likelihood of confusion claim.

Cancellation No. 23,622

party registrations to show the relatedness of the parties' goods; plaintiff's notice of reliance on defendant's responses to requests for admissions; defendant's notice of reliance on plaintiff's responses to requests for admissions; plaintiff's notice of reliance on excerpts from the NEXIS data base and the Internet to show the strength of plaintiff's AQUA FRESH mark; defendant's notice of reliance on third-party registrations to show the weakness of marks which include the term AQUA; and the parties' stipulation to admit into evidence copies of correspondence between the parties' counsel. In addition to the trial testimony, the record includes numerous exhibits introduced in connection therewith.

According to the record, plaintiff first sold toothpaste under the mark AQUA FRESH in 1972. However, it was not until 1979 that plaintiff began to heavily promote its AQUA FRESH toothpaste and to enjoy significant sales under the AQUA FRESH brand. In addition to its basic AQUA FRESH flouride toothpaste, plaintiff has developed and now offers several other toothpastes designed for specific purposes, i.e., AQUA FRESH TRIPLE PROTECTION, AQUAFRESH SENSITIVE, AQUAFRESH WHITENING and AQUA-FRESH FOR KIDS. Also, plaintiff offers toothbrushes under the marks AQUAFRESH FLEX, AQUA-FRESH FLEX, AQUAFRESH FLEX DIRECT and AQUAFRESH FLEX OUTRAGEOUS COLORS. According to plaintiff's

Cancellation No. 23,622

witness, each of the above marks was selected to take advantage of the fame and reputation of the AQUA FRESH mark.

Plaintiff's toothpastes and toothbrushes are sold in ninety-five percent of the grocery stores, drug stores and mass merchandisers in the United States. Plaintiff's toothpastes and toothbrushes retail for between \$1.00 and \$6.00. Its sales of toothpastes have risen from 70 million units in 1979 to 124 million units in 1995, and AQUA FRESH is and has been for many years the nation's third leading brand of toothpaste.

Since 1979 plaintiff has spent tens of millions of dollars in advertising and promoting its products.⁸ It has nationally advertised its products through a variety of media, including television, newspapers and magazines. In addition, plaintiff has promoted its products through the use of coupons, inserts in publications, in-store displays and by sponsorship of a race car. By virtue of the extensive advertising, promotion and sale of AQUA FRESH toothpaste, plaintiff's AQUA FRESH mark is well known. This fact is confirmed by two market research studies, one of which was conducted by the Landis Research Group in April-May 1994. According to this study, eighty percent of the respondents had heard of AQUA FRESH toothpaste; fifty-seven percent remembered seeing advertising in the past year for

Cancellation No. 23,622

AQUA FRESH toothpaste and forty-three percent had used AQUA FRESH toothpaste. The second study was conducted by the Icon research organization in February 1996 and demonstrated an aided awareness of AQUA FRESH brand toothpaste of ninety-five percent and an unaided awareness of forty-six percent.

Defendant's primary business is as a manufacturer of photographic and video accessories. In 1989 defendant was approached by Ricoh Elemex, a Japanese corporation, about distributing an oral irrigator within the United States. An oral irrigator is a battery-operated appliance that generates a stream of water through a nozzle to remove particles from the surfaces of the teeth and gums. Prior to beginning sales of the oral irrigator, defendant obtained approval from the Food and Drug Administration and a product endorsement from the American Dental Association. Defendant considered several possible trademarks to identify its oral irrigator and, after settling on AQUA FLOSS, began sales of the product under this mark at least as early as June 1, 1990. Defendant priced the oral irrigator at a suggested retail price of \$39.95. According to defendant's witness, during the period of 1990 to 1995 defendant's oral irrigator was nationally distributed through direct mail catalogs, catalog showroom stores, drug store chains, department stores and warehouse club merchandisers. Defendant has

⁸ Plaintiff's sales and advertising figures have been made of

Cancellation No. 23,622

advertised the oral irrigator on television and in print advertisements and promoted the product at trade shows. From 1990 to 1995 defendant spent between \$300,000 - \$500,000 on the advertisement and promotion of the AQUA FLOSS oral irrigator. Defendant has employed several independent sales representatives to nationally promote and sell the AQUA FLOSS oral irrigator. Most recently, the oral irrigator has been sold primarily through direct mail catalog merchandisers due to cost efficiencies. Also, defendant has been unable to maintain an inventory of oral irrigators due to a manufacturing problem. However, defendant's witness testified that in 1996 defendant shipped 300-400 units to customers and it fully intends to continue sales of the oral irrigator.

Turning first to the issue of priority, the record clearly establishes plaintiff's continuous use of the mark AQUA FRESH (and the variations AQUA-FRESH and AQUAFRESH) for toothpaste. Thus, plaintiff has established its priority with respect to these marks. We note that plaintiff has claimed ownership of a family of marks characterized by AQUA FRESH. However, in the context of this petition for cancellation, such a claim is not understood. Plaintiff owns the mark AQUA FRESH (and the variations AQUA-FRESH and AQUAFRESH) and that mark is well-known. That is the mark

record under seal.

that must be compared with defendant's mark AQUA FLOSS. Accordingly, we need not decide whether plaintiff has established a family of AQUA FRESH marks."⁹

We turn then to the issue of likelihood of confusion. Upon consideration of the relevant factors set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, it is our view that confusion as to source or sponsorship is not likely to occur. We acknowledge, in this regard, that while many factors favor plaintiff and, thus, a finding that confusion is likely, such factors are simply outweighed by the significant differences in the overall commercial impressions of the parties' respective marks.

There is no question that plaintiff's toothpastes and respondent's oral irrigators are sold through some of the same channels of trade to the same classes of customers. In addition, the substantial sales and advertising by plaintiff of its AQUA FRESH toothpaste, and the many years it has continuously used such mark, establish the considerable renown of the mark which, generally speaking,

⁹ If plaintiff were arguing that it had a family of AQUA marks (AQUA followed by different word marks), however, this would be relevant to the question of likelihood of confusion. That is, to the extent the purchasing public identified the prefix AQUA for oral care products with plaintiff, that would make more likely the confusion with defendant's AQUA FLOSS oral irrigator because the public may tend to believe that that product comes from plaintiff.

Cancellation No. 23,622

would entitle it to a substantial degree of protection against similar marks.¹⁰

Nevertheless, in this case, the mark AQUA FRESH and the related marks AQUA-FRESH and AQUAFRESH on the one hand, and the mark AQUA FLOSS, on the other, engender such different overall commercial impressions that there is no likelihood of confusion. We recognize that each of the marks includes the word AQUA followed by a short one-syllable word beginning with the letter "f", i.e., FRESH and FLOSS. However, "fresh" and "floss" have very different meanings. That is, "fresh" indicates an attribute as in "freshens breath" and "floss" indicates a function as in the action of defendant's oral irrigator. Plaintiff's AQUA FRESH, AQUA-FRESH and AQUAFRESH marks, on the one hand, connote freshness and defendant's AQUA FLOSS mark, on the other, connotes flossing with water. Thus, the marks in their entireties engender very different connotations and commercial impressions. Under such circumstances, the mere inclusion of the word "aqua" in the parties' marks is an

¹⁰ We should point out that the third-party registrations offered by defendant with respect to the alleged weakness of marks which include the word "aqua" in no way diminished the scope of protection to be accorded plaintiff's AQUA FRESH mark. Only three of the registrations covered oral care products, and there was no evidence that the marks listed in the registrations are in use. More importantly, the substantial sales and advertising by plaintiff of its AQUA FRESH toothpaste is more than sufficient to overcome any alleged weakness in the mark due to the inclusion of the word "aqua."

Cancellation No. 23,622

insufficient basis on which to hold that the marks are in conflict.

We should emphasize that, in arriving at our conclusion that confusion as to source is not likely, we are not relying on defendant's argument concerning the absence of evidence of instances of actual confusion. Our conclusion that confusion is not likely is based, quite simply, on the overall differences in the connotations and commercial impression of these marks. This fact is more important to the resolution of the issue of likelihood of confusion here than the strength of the AQUA FRESH mark as applied to toothpaste and the fact that the parties' marks are applied to goods which fall into the category of oral care products. See e.g., *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Cancellation No. 23,622

Decision: The petition to cancel is denied.

R. L. Simms

R. F. Cissel

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board