

**THIS DISPOSITION
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Paper No. 28

9/14/00

BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Nutramax Laboratories, Inc.

v.

NaturalMax, Inc.

Opposition No. 110,801
to application Serial No. 75/310,610
filed on June 17, 1997

Michael D. Oliver of Bowie & Jensen, LLC for Nutramax
Laboratories, Inc.

Timothy P. Getzoff of Holland & Hart LLP for NaturalMax,
Inc.

Before Chapman, Wendel and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by NaturalMax, Inc. to
register the mark NATURALMAX for "dietary supplements" in
International Class 5. Applicant claims a date of first use
and first use in commerce of February 1, 1995.

Nutramax Laboratories, Inc. has opposed the
application, alleging that it is a manufacturer and

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distributor of food supplements and nutraceuticals¹; that opposer owns federal registrations for several of its product marks (e.g., BIOSEL, COSAMIN and COMAX, all for "a food supplement," COMAL and COSEQUIN, both for "a dietary supplement for veterinary use," and MACROSORB for "organic fertilizers for agricultural, and commercial use"); that opposer owns trademark applications for, inter alia, the marks, NUTRAMAX LABORATORIES for "dietary food supplements,"² and the mark shown below

for "food supplements for veterinary and human use"³; that opposer first used the mark NUTRAMAX LABORATORIES on November 18, 1991, and first used the NUTRAMAX LABORATORIES-THE NUTRACEUTICAL COMPANY and design mark on March 31, 1993, and both of these marks have been in continuous use; that opposer's principal products, both of which are "nutraceuticals/food supplements that are taken orally, for the purpose of aiding in protection and rebuilding of

¹ According to opposer, "nutraceuticals are non-drug naturally occurring compounds manufactured under higher standards than food supplements." (Notice of Opposition, paragraph 2.)

² This pleaded application Serial No. 74/295,816 (filed July 16, 1992) issued as Registration No. 2,231,260 on March 16, 1999.

³ Action on this pleaded application (Serial No. 74/720,731) has been suspended in Law Office 105.

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cartilage in joints" (Notice of Opposition, paragraph 6), are marketed under the marks COSAMIN "on sale after April 1992", and COSEQUIN "on sale after October 1992" (Notice of Opposition, paragraph 5); and that applicant's mark, when used on or in connection with its goods, so resembles opposer's previously used marks, NUTRAMAX LABORATORIES and NUTRAMAX LABORATORIES, INC.--THE NUTRACEUTICAL COMPANY and design, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition. Applicant also asserted as a defense that "Applicant and its predecessor have been using the mark 'MAX' alone and in combination with other words since at least 1989, and as such, Applicant has superior rights to Opposer in 'MAX' marks."⁴

The record consists of the pleadings; the file of the opposed application; the following evidence submitted by opposer: (1) a current status and title copy of opposer's Registration No. 2,231,260, (2) applicant's answers to opposer's first set of interrogatories, (3) applicant's catalogue (a 4-page document), (4) the testimony, with

⁴ To whatever extent this argument was made with regard to priority, inasmuch as opposer has a registration of its mark entered in this record, the issue of priority does not arise. (See the discussion of priority, *infra*.) Moreover, to whatever extent applicant intended its "family" of marks argument as a defense to opposer's claim, that is a defense which is unavailable in Board proceedings. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

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exhibits, of Edgar Sharbaugh, opposer's executive vice president, and (5) the testimony, with exhibits, of Bruce R. Hough, president of applicant's parent company (Nutraceutical Corp.), and a director of applicant (taken by opposer as an adverse witness); and the following evidence submitted by applicant: (1) opposer's answers to applicant's requests for admission Nos. 1-8, (2) the file histories of opposer's application Serial Nos. 74/295,816 and 74/720,731; and (3) portions of applicant's discovery depositions taken of Robert Webb Henderson, opposer's president, Edgar Sharbaugh, opposer's executive vice president, and Kristen E. Blanchard, opposer's legal and regulatory affairs director.

Both parties have filed briefs on the case.⁵ Neither party requested an oral hearing.

The Parties

Nutramax Laboratories, Inc. has continuously used the mark NUTRAMAX LABORATORIES since November 18, 1991. Opposer sells health care products (human and veterinary) and agricultural products (amino acid-based biofertilizers that provide plants with amino acids and other nutrients) under its house mark NUTRAMAX LABORATORIES. The products COSAMIN (for humans) for "managing arthritis and arthritic-type

⁵ Only applicant's brief included a description of the record, and applicant included the complete submissions of both parties.

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situations," and COSEQUIN (for animals) for "musculoskeletal-type of arthritic type of problems for small animals and horses" (Sharbaugh testimony dep., pp. 8 and 10) account for about 90% of opposer's business. These two products "enhance the cartilage matrix" in joints. (Sharbaugh discovery dep., p. 19.)

Opposer sells its goods intended for humans directly to health care professionals (e.g., doctors, nurses, physical therapists), through pharmaceutical distributors, and through independent wholesalers, the latter two of which generally sell to pharmacies (chain and independent); and opposer does not sell direct to the end consumer. Opposer provides pharmacies with display boxes and literature, and opposer requests that the pharmacies market opposer's products (e.g., COSAMIN) as an "assisted sale item where the pharmacist would explain the use of the product to the customer and keep it at the pharmacy counter." (Sharbaugh testimony dep., p. 28.)⁶ However, some of the larger chain pharmacies, e.g., CVS, Rite-Aid and Walgreens, put some of opposer's products on the shelf, and some pharmacies put a sample bottle on the shelf with directions to see the

Neither party objected to any evidence in their briefs on the case.

⁶ Although opposer's goods are not drugs, opposer claims that it has established a reputation for "consistent quality-type products manufactured very close to the same standards that are used in the pharmaceutical industry." (Sharbaugh testimony dep., p. 17.)

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pharmacist. Opposer's goods cost from \$40 to \$75 for bottles of 90 to 120 capsules.

Opposer advertises and promotes its goods to health

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care professionals with some advertising directed to the end consumer. The advertising to opposer's direct customers includes presentations to doctors and other health care professionals, ads in trade magazines to health care professionals, and exhibits at trade shows; while in its advertising to the end consumer, opposer has utilized television, radio and magazines such as Redbook and Good Housekeeping.

Applicant, a subsidiary of Nutraceutical Corp., offers a line of "dietary and nutritional supplements containing combinations of vitamins, minerals, herbs, and other natural ingredients for general consumption by humans."

(Applicant's answer to opposer's interrogatory No. 4.)

Applicant first used a trademark with the suffix MAX on February 26, 1979 (applicant's answer to opposer's interrogatory No. 1)⁷; and applicant has continuously used the mark NATURALMAX since February 1, 1995, as a house mark for many of its products, including those sold under applicant's MAX-suffix marks, e.g., MULTI-MAX, ENERMAX, DIETMAX, GINSAMAX and TRANQUILMAX. The impression applicant intended to create with its house mark was that its line of products are natural and have maximum effectiveness. (Hough dep., p. 39.)

⁷ The Board notes that in applicant's answer to the notice of opposition, it pled use of the mark MAX alone and in combination with other words since at least 1989.

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Applicant sells its goods only to health food stores, including General Nutrition Center (GNC) stores, independent health food stores, and health food stores affiliated with local, regional or national health food chains (e.g., Whole Foods Market, Wild Oats Market), through a total of about 7000 retail health food stores nationwide. Applicant does not sell its goods to drugstores, supermarkets or health care providers. Although applicant has experimented with selling through a catalogue for health food store customers, applicant does not currently sell directly to the end consumer, and applicant has no website (at the time of Bruce Hough's testimony in June 1999). Applicant does not advertise on radio or television, but advertises its goods in magazines available in health food stores, e.g., Let's Live, Better Nutrition and Energy Times. It distributes brochures and cardboard stands for display in health food stores. The goods are sold at prices ranging from \$7 to \$40 for applicant's various lines of vitamin, mineral and herb products, and its top two selling products are those sold under the product marks DIETMAX and CHITOSAN (both being diet products).

Priority

Preliminarily, we will address applicant's argument that "opposer is limited to the common law trademark rights pled in its notice of opposition." (Applicant's brief, p.

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10). Applicant contends that opposer never amended its pleading to reflect registration of the pleaded application, and that by relying on its federal registration, opposer now seeks to change the issues in this case. Applicant specifically argues that the Board should consider the actual goods and the actual trade channels used by opposer.

The record is clear that opposer originally pled ownership of two pending federal trademark applications, including the one which ultimately issued as Registration No. 2,231,260 for the mark NUTRAMAX LABORATORIES. Thus, applicant was on notice that opposer claimed rights therein. In fact, not only was applicant aware of the claimed application from opposer's pleading, but applicant submitted into the trial record, photocopies of the file histories of both of opposer's pleaded applications. Applicant cannot (and does not) claim surprise. Further, during its testimony period, opposer submitted a current status and title copy of the registration, which applicant did not move to strike. While opposer did not move to amend its pleading, to whatever extent it is necessary, we consider the pleading amended to conform to the evidence under Fed. R. Civ. P. 15(b). Therefore, opposer's Registration No. 2,231,260 is considered of record herein, and opposer is not limited to its common law trademark rights.

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Because opposer has established that it owns a valid and subsisting registration of its pleaded mark, NUTRAMAX LABORATORIES, 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 *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the record establishes opposer's continuous use of its house mark, NUTRAMAX LABORATORIES, for dietary food supplements since late 1991, which is prior to applicant's established first use of its house mark NATURALMAX in February 1995.

Likelihood of Confusion

Thus, the sole issue before the Board is likelihood of confusion. Our determination of likelihood of confusion must be based on our analysis of all of the probative 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).

Turning first to a consideration of the similarity or dissimilarity of the goods, it is undisputed that both parties use their respective marks (applicant's mark NATURALMAX and opposer's marks NUTRAMAX LABORATORIES and NUTRAMAX LABORATORIES, INC.—THE NUTRACEUTICAL COMPANY and design) as house marks on a range of different products.

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We note that in this proceeding, opposer's goods, as identified in its registration, are "dietary food supplements"⁸ and applicant's goods are "dietary supplements." When asked "[i]s there a difference if I say food supplement, dietary supplement or nutritional supplement industry, is there a difference in those terminologies?" opposer's witness, Edgar Sharbaugh testified "[n]o, they're all the same." (Testimony dep., p. 31.) As identified in opposer's registration, and in applicant's application, we find that the parties' respective goods are essentially identical, or at the very least, are closely related.

Inasmuch as neither applicant's application nor opposer's registration includes any type of restriction as to trade channels or purchasers, we must presume in this administrative proceeding that the involved goods are sold in all the normal channels of trade to the usual classes of purchasers for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). That is, as identified, the parties' goods could be sold side-by-side in the same stores, but

⁸ Opposer pled that it is a manufacturer and distributor of "food supplements and nutraceuticals" (Notice of Opposition, paragraphs 2 and 6).

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even if sold in separate stores, the same customers could frequent both types of stores (pharmacies for opposer's goods and health food stores for applicant's goods). In fact, opposer's "Frequently Asked Questions" brochure for its COSAMIN DS (double strength) product includes the following statement on page 1: "[t]he recent surge of interest in cartilage-modifying agents has ensured that many brands of chondroitin sulfate and glucosamine are available in health food stores and other retail outlets, but CosaminDS is unique for several reasons."

We find that the channels of trade and the classes of purchasers for the parties' goods, with no restrictions in either identification of goods, are the same.

The record herein shows that dietary food supplements or dietary supplements are not particularly expensive goods, and they are sold to the general public, including ordinary consumers as well as health conscious consumers.⁹ Opposer's

⁹ Applicant contends that that during the ex parte examination of opposer's applications, opposer argued in response to the Examining Attorney's Office action citing marks under Section 2(d), that the purchasers of opposer's products were not impulse buyers, opposer's products were fairly expensive and were marketed through health care professionals. From that, applicant concludes that opposer should be estopped from arguing in this opposition proceeding that the parties' goods are low cost, impulse items, not sold to sophisticated purchasers. While opposer's earlier contentions on these factors at the ex parte examination level may be considered as "illuminative of shade and tone in the total picture confronting the decision maker" [Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151 (CCPA 1978)], opposer is not barred from taking a position in this opposition proceeding which is inconsistent with assertions made at the examination level. See Bost Bakery,

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executive vice president, Edgar Sharbaugh, testified that today the dietary supplement industry is a \$10 - \$12 billion industry with hundreds and hundreds of companies in this market. While the choice of a dietary supplement may not involve the same medical considerations as will be involved in the selection of a pharmaceutical, nonetheless, purchasers of dietary supplements are not merely casual, impulse purchasers, but rather, they will exercise some degree of special care in making their purchasing decisions, as to which dietary supplements to purchase, and for what function the dietary supplement is intended. See *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986).

Considering next the question of the number and nature of similar marks in use by others for similar goods or services, applicant contends that there are several third-party marks similar to opposer's mark. Specifically, applicant referenced three marks (NUTRAMAX, NUTRIMAX PROCESS, and NUTRAMAX 2000, all with different owners, and the first two of which were pending applications, and the third was a registration) which were cited against opposer's then-pending application for the mark NUTRAMAX

Incorporated v. Roland Industries, Inc., 216 USPQ 799 (TTAB 1982). See also, Fed. R. Civ. P. 8(e)(2).

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LABORATORIES.¹⁰ Third-party pending applications have no probative value, and the third-party registration does not establish commercial use, or that the public is familiar with that mark. Moreover, opposer entered into a settlement agreement with the owner of the cited registration.

Opposer acknowledged that when it selected its mark, NUTRAMAX LABORATORIES, it was aware of one other use of the term NUTRAMAX, but the third-party use of NUTRAMAX was for unrelated products, i.e., disposable bottle liners, disposable douches, etc.

On this record, we find that there is insufficient evidence to prove any third-party uses of the term NUTRAMAX or NUTRIMAX on dietary supplements or related goods.

The absence of any instances of actual confusion by consumers relating to opposer's marks and applicant's mark used on the involved goods is not a crucial factor to our decision. The absence of confusion is not surprising given the differences between applicant's mark and opposer's marks, the relatively short duration of use by applicant of its mark, and the present marketing channels. Besides, the test is not actual confusion, but likelihood of confusion.

¹⁰ Applicant again argues that because opposer argued separate trade channels and differences in the types of goods during the ex parte prosecution of opposer's applications in order to overcome the cited marks, opposer is estopped from arguing to the contrary in this opposition, or at the least, "Opposer's prior factual assertions regarding the scope of its trademark rights should weigh heavily against it in this action." (Applicant's brief., p. 19.) We disagree. See footnote 9, *infra*.

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We note that "opposer does not contend...that Nutramax Laboratories® is a famous mark." (Reply brief, p. 8.) Further, fame was not established on the record before us.¹¹

Turning to a consideration of the similarity or dissimilarity of the marks, it is this factor which is pivotal in this case. See Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Opposer contends that the marks are similar in sound and appearance (both starting with NAT or NUT and ending with MAX); in connotation "(MAXimum nutrition)"; and "slightly less in commercial impression."¹² (Opposer's brief, p. 14.)

¹¹ Opposer, referencing the "Trademarks Amendment Act of 1999" and "dilution under Section 43(c)," argued in its brief (p. 2, footnote 4) as follows:

[that opposer's product mark] "Cosamin® is a famous mark in the dietary supplement industry, and that as discussed below, if Applicant's house mark for NaturalMax is permitted to be registered, such registration will have a dilutive effect on the Nutramax Laboratories® mark through its effect on the product-mark Cosamin®."

Suffice it to say that **opposer did not plead dilution as a ground, and opposer did not submit evidence proving that applicant's applied-for mark dilutes opposer's house marks. Obviously, any ground which is neither pleaded nor proven must fail.**

¹² Opposer explained its argument on commercial impression as follows: "Opposer's product packing (sic) and marked labels appear more like a pharmaceutical type of product, while Applicant's packaging has larger colors, and often large illustrations of people and other objects"; and applicant's packaging has "somewhat overblown graphics and a more 'consumer' oriented impression." (Opposer's brief., p. 14.) (ftnt. cont.)

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Applicant contends that the marks are dissimilar in sound, appearance, connotation and commercial impression. Specifically, applicant argues that the only common element in the marks is the suffix "MAX," which is a weak element of the marks (agreeing with opposer that "max" refers to "maximum" in both parties' marks); and that the dominant portions of the respective marks are NUTRA and NATURAL. According to applicant, the dominant portions of the marks look different and sound different; and the marks have separate and distinct meanings, creating separate commercial impressions. The prefix of applicant's mark, NATURAL, is an English word with a dictionary meaning relating to nature, while the prefix of opposer's mark, NUTRA, is not a word at all and has no meaning unless it is extrapolated to refer to "nutrition" or "nutrient." Finally, applicant argues that opposer's mark also includes the word LABORATORIES, which, even though disclaimed by opposer, remains part of the mark for consideration.

It is well settled that marks must be considered in their entireties. As the Court of Appeals for the Federal

Opposer also explained that in addition to the similarity of the marks, applicant often includes the name "Nutraceutical Corp." on its labels, adding to the likelihood of confusion. We note that any use by applicant of the term "nutraceutical" is not in issue before this Board. Rather, we are constrained to consider the mark as applied for, which in this case is NATURALMAX (in typed form). Even when we consider opposer's common law rights in its mark NUTRAMAX LABORATORIES, INC.—THE NUTRACEUTICAL COMPANY, it does not alter our decision herein.

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Circuit (our primary reviewing Court) stated in the case of *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992)." In addition, the Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

The only common elements of the parties' marks are the syllable "MAX," and the first letter "N." The prefixes, or first portions of the respective marks, NUTRA and NATURAL are obviously different in appearance and sound and have different meanings. When spoken or read by purchasers, applicant's mark begins with the English word NATURAL, connoting the commonly understood dictionary meaning thereof

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to the purchasing public¹³; whereas opposer's mark begins with the syllable NUTRA, which is not a word, but comes closest to a connotation of "nutrition" or "nutrient." In its brief (p. 14) opposer contends that both parties' marks connote "maximum nutrition." We agree with opposer that the prefix of opposer's mark connotes "nutrition," but we disagree that the word "natural" also connotes "nutrition." That is, opposer's mark suggests maximum nutrition; while applicant's mark connotes maximum effectiveness in completely natural dietary supplements, i.e., those made of natural rather than synthetic ingredients.¹⁴ In addition, we cannot overlook the additional word "laboratories" in opposer's mark.

Both parties' marks are highly suggestive in relation to the involved goods. See *Hans Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (CCPA 1965); *Jones & Laughlin Steel Corporation v. Jones Engineering Co.*, 292 F.2d 294, 130 USPQ 99 (CCPA 1961); *Cluett, Peabody & Co., Inc. v. Savatux Facing Company*, 277 F.2d 944, 125 USPQ 574 (CCPA 1960); and *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958).

¹³ We take judicial notice of the following definition of the word "natural" from *The American Heritage Dictionary*: "1.[p]resent in or produced by nature; not artificial or man-made." See TBMP §712.

¹⁴ Opposer's witness, Edgar Sharbaugh, testified that opposer does not use the word "natural" in any of its advertisements or literature. Testimony dep., pp. 54-56.

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As stated by the Court of Appeals for the Federal Circuit, in the case of *In re National Data Corporation*, supra: "Where consumers are faced with various usages of descriptive words, our experience tells that we and other consumers distinguish between these usages." The mere fact that opposer's and applicant's marks both include "max" is not enough for a finding of likelihood of confusion, given the weakness or suggestiveness of "MAX" and the specific differences in the prefixes NUTRA and NATURAL, as well as the differences in the overall marks. See also 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:73 and 11:74 (4th ed. 2000).

In this case opposer's marks and applicant's mark, considered in their entirety, are dissimilar in sound and appearance, with different meanings or connotations of the marks, and conveying separate commercial impressions.

Based on the record before us, we find confusion is not likely. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992) (FIBER 7 FLAKES and FIBER ONE, both for ready to eat breakfast cereal, held not likely to cause confusion); *Stouffer Corporation v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900 (TTAB 1986) (LEAN LIVING and LEAN CUISINE, both for food products, held not likely to cause confusion); *Electronic Water Conditioners, Inc. v. Turbomag Corporation*, 221 USPQ 162 (TTAB 1984) (TURBO-MAG and

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ELECTRO-MAG, both for water conditioning units for electromagnetically treating water and removing scale, held not likely to cause confusion); Burger Chef Systems, Inc. v. Sandwich Chef, Inc., 201 USPQ 611 (TTAB 1978), aff'd at 203 USPQ 733 (CCPA 1979) (SANDWICH CHEF and design and BURGER CHEF and design, both for restaurant services, held not likely to cause confusion); American Standard Inc. v. Scott & Fetzer Company, 200 USPQ 457 (TTAB 1978) (AQUA STREAM for faucets and AQUAMIX, AQUAMETER, and AQUARIAN II, all for faucets, as well as AQUASEAL for valves, et al., held not likely to cause confusion); and Fort Howard Paper Company v. Marcal Paper Mills, Inc., 189 USPQ 305 (TTAB 1975) (SOF-PAC for toilet tissue and SOF-KNIT for paper towels and toilet tissue and SOF-NAP for paper napkins held not likely to cause confusion).

Decision: The opposition is dismissed.

B. A. Chapman

H. R. Wendel

G. F. Rogers

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Administrative Trademark Judges,
Trademark Trial and Appeal Board