

Oral Hearing
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10/4/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Special Products Corporation "SPECO"

Serial No. 75/216,236

Thomas J. Moore of Bacon & Thomas, PLLC for Special Products Corporation "SPECO".

John D. Dalier, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Special Products Corporation "SPECO" has filed an application to register the mark "BIO-ST JOSEPH" for "food supplements; and dietary supplements of vegetal origin."¹

¹ Ser. No. 75/216,236, filed on December 20, 1996, which alleges dates of first use of March 1989.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "ST. JOSEPH," which is registered in the format shown below

for "aspirin,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

Turning first to consideration of the respective goods, applicant argues that its food supplements and dietary supplements of vegetal origin "are part of a general program of nutrition, and [are] not indicated for treatment of any special condition" as is the aspirin offered by registrant. Aspirin, applicant contends, "is typically sold in the over-the-counter (OTC) section of a retail store," which "would typically also include various brands of acetaminophen and ibuprofen, as well as cough and cold remedies, and the like." By contrast, applicant asserts that "[t]he OTC section would

² Reg. No. 436,204, issued on January 27, 1948, which sets forth dates of first use of January 1, 1893; second renewal.

not typically include food supplements, and dietary supplements of vegetal origin."

In addition, applicant maintains that the goods at issue would be purchased with care rather than impulsively. According to applicant:

[C]onsumers would make a relatively careful decision in deciding whether to purchase the "food supplements; dietary supplements of vegetal origin" of the present application. These goods are typically purchased by someone who has a higher than average interest in his or her diet. The typical consumer of the present goods would not be a so-called junk food junkie, but someone who is interested in improving the quality of his or her life through good nutrition. Thus, careful scrutiny would be involved in the purchasing decision.

Likewise, a careful decision would be made in the purchase of the "aspirin" of the cited registration. This OTC medicine is typically purchased for a specific condition that affects the purchaser, or the children of the purchaser. Such condition usually involves discomfort or pain. A careful purchasing decision would be made, in an effort to alleviate the pain or discomfort. Medications are usually the subject of a careful purchasing decision, given their use, possible side effects, and possible conflicts with other medications.

In consequence of the differences noted above in the respective goods, applicant urges that there is no likelihood of confusion.

The Examining Attorney, on the other hand, correctly observes that it is well settled that goods need not be

identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Here, as support for his position that applicant's and registrant's goods are so closely related that, if marketed under the same or similar marks, confusion as to the source or sponsorship of such goods would be likely, the Examining Attorney has made of record ten use-based third-party registrations of marks which are registered for "dietary food supplements," "dietary supplements" or "dietary fibre" [sic] on the one hand and "aspirin" or "children's aspirin" on the other. Although the third-party registrations are admittedly not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they

serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. In light of such evidence, we agree with the Examining Attorney that, even though applicant's goods typically would not be sold in the same section of retail outlets as registrant's OTC medication, applicant's food supplements and dietary supplements of vegetal origin are nevertheless so closely related in a commercial sense to registrant's aspirin that, if sold under the same or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Turning, therefore, to consideration of the marks at issue, applicant maintains that, when considered in their entirety, the respective marks engender different commercial impressions. Noting, in particular, that the labels submitted with the application as specimens of use describe one of applicant's products as "a high quality nutrient concentrate made of yeasts" and further state that the "whole of the yeast's nutriments are commonly called 'BIOS'," applicant argues that:

The first and primary portion of the commercial impression of the ... BIO-ST JOSEPH mark is made by the initial term BIO, which suggests the BIOS in the goods.

This term BIO does not appear in the mark of the cited registration. There is no suggestion of this term in the mark of the cited registration.

Applicant further asserts that because registrant's "ST. JOSEPH" mark "appears ... in a style of print that is quite different from the style of print which appears on the specimens" for applicant's "BIO-ST JOSEPH" mark, "consumers of the goods of the cited registration ... have come to recognize the particular style of print as an integral part of the trademark of the cited registration" and thus would "immediately" distinguish such mark from applicant's mark.

The Examining Attorney, on the other hand, contends that confusion is likely because the respective marks "create the same overall impression in that both contain the terms ST. JOSEPH." According to the Examining Attorney, "applicant has merely added the common prefix BIO to the registered mark," the mere addition of which is not sufficient to avoid a likelihood of confusion. As to the stylization of registrant's mark, the Examining Attorney insists that, because applicant seeks registration of its mark in typed form and such form necessarily includes the same stylized format as that in which registrant's mark appears, "there are no design elements to aid in distinguishing the marks."

We concur with the Examining Attorney that the respective marks are so similar that, when used in connection

with applicant's and registrant's goods, confusion as to source or sponsorship is likely. Specifically, when considered in their entirety, the marks "BIO-ST JOSEPH" and "ST. JOSEPH" are substantially similar in sound, appearance and connotation due to the shared presence of the term "ST(.) JOSEPH," which on this record must be presumed to be an arbitrary term as applied to the respective goods. Although there is nothing in the record to substantiate the Examining Attorney's contention that use of the prefix "BIO-" in applicant's mark is "common" for food and dietary supplements, we nevertheless find such term to be highly suggestive and therefore insufficient to distinguish applicant's mark as a whole from registrant's mark. In particular, whether the prefix "BIO-" is regarded as highly suggestive of the "BIOS" or nutrients in the yeasts of applicant's products, as urged by applicant, or whether, as we judicially notice,³ such prefix is highly suggestive of a biological,⁴ as opposed to a

³ It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ In this regard, Webster's Third New International Dictionary (1993) at 218 lists for the prefix "bio-" the entry "see ²bi-," which in turn at 211 is defined in relevant part, under the entry "²bi- or bio- *comb form*," as "**2** : biology : biological," with the latter of such terms at 218 set forth as an adjective meaning "**1** : of or relating to biology or to life and living things : belonging to or

synthetic, origin for applicant's goods, which include several biologically or naturally derived components,⁵ the dominant source-indicative feature of applicant's mark is still the arbitrary term "ST JOSEPH," which as a practical matter is identical to registrant's "ST. JOSEPH" mark. Overall, the respective marks are therefore substantially similar in sound, appearance, connotation and commercial impression.

As to applicant's assertion that its mark and registrant's mark nevertheless differ significantly in their stylization, the Examining Attorney is correct in his contention that there is no distinguishing difference in appearance and that, in legal contemplation, applicant's mark must be regarded as suitable for presentation in the identical stylization as that utilized by registrant. This is because a typed drawing, which is the format in which applicant seeks to

characteristic of the processes of life ... **2** : used in or produced by practical application of biology <biological methods> ..." and as a noun connoting "a biological product (as a globulin, serum, vaccine, antitoxin, or antigen) used in the prevention or treatment of disease." In a similar vein, The Random House Dictionary of the English Language (2d ed. 1987) at 209 defines "bio-" as "a combining form meaning "life" occurring in loan-words from Greek (*biography*); on this model, used in the formation of compound words (*bioluminescence*)" and at 210 sets forth "biological" as "*adj.* **1.** Pertaining to biology. **2.** Of or pertaining to the products and operations of applied biology: *a biological test.* --*n.* **3.** *Pharm.* Any substance, as a serum or vaccine, derived from animal products or other biological sources and used to treat or prevent disease."

⁵ Specifically, applicant's labels list the following "INGREDIENTS : Plasmolysatus of yeasts, rosemary honey, mangrove honey, blackcurrant, blueberry."

register its mark, is not limited to the depiction of a mark such as "BIO-ST JOSEPH" in any special form. See Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Instead, "[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the mark] could be depicted". INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992). Here, we see no reason why applicant could not choose to present its entire mark in the same manner as registrant's mark and, in fact, the specimens of use indicate that applicant's most prominent use of its mark is in the format "BIO-St-JOSEPH," in which the "St" portion thereof is like the "St." portion of registrant's mark. Applicant's mark, therefore, not only cannot be viewed as distinguishable from the stylized format employed by registrant's mark, but it must be regarded as identical thereto in stylization.

Furthermore, at the oral hearing, applicant insisted that the "ST" portion of its "BIO-ST JOSEPH" mark could relate to or stand for anything and thus, unlike the term "ST." in registrant's "ST. JOSEPH" mark, would not necessarily be pronounced or understood as the word "saint". We judicially notice, however, that the both the terms "St" and "St." are

accepted abbreviations for the word "saint".⁶ Thus, and particularly since, as noted above, the "ST" part of applicant's mark as actually used is in the form "St" and, in addition, the specimens of use refer to applicant's goods as "Distributed by ST JOSEPH PHARMACY & GIFTS," applicant's mark would tend to be pronounced and viewed as "BIO-SAINT JOSEPH" just as registrant's mark is pronounced and understood as "SAINT JOSEPH". Aurally and connotatively, as well as visually, applicant's mark is therefore substantially similar to registrant's mark. On the whole, the respective marks consequently project substantially the same commercial impression.

As a final consideration, we observe that, even if customers for applicant's and registrant's goods were to be regarded as sophisticated and discriminating purchasers (despite the absence of any evidence on this record to support such an assumption), the fact that consumers may exercise care in selecting aspirin products and various food and dietary supplements to improve or maintain their health "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from

⁶ For instance, Webster's Third New International Dictionary (1993) at 2217 defines the term "st" as "*abbr 1 often cap saint,*" while The Random House Dictionary of the English Language (2d ed. 1987) at 1852 lists "St." as, inter alia, "1. Saint."

confusion as to source or sponsorship. Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

Accordingly, we conclude that customers and prospective purchasers, familiar with registrant's stylized mark "ST. JOSEPH" for "aspirin," would be likely to believe, upon encountering applicant's substantially similar mark "BIO-ST JOSEPH" for both "food supplements; and dietary supplements of vegetal origin," that such closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source. In particular, and even if consumers of such products were to notice the difference between applicant's mark and registrant's mark due to the presence of the highly suggestive prefix "BIO-" in the former, they could still reasonably believe that applicant's "BIO-ST JOSEPH" food and dietary supplements constitute a new or expanded product line from the same source as the producers of registrant's "ST. JOSEPH" aspirin.

Decision: The refusal under Section 2(d) is affirmed.

G. D. Hohein

Ser. No. 75/216,236

P. T. Hairston

C. M. Bottorff
Administrative Trademark
Judges,
Trademark Trial and Appeal
Board