

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB FEB. 8, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Richard A. Deer

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Serial No. 75/256,845

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Gregory B. Coy of Woodard, Emhardt, Naughton, Moriarty &  
McNett for Richard A. Deer.

Michael Hamilton, Senior Trademark Examining Attorney, Law  
Office 104 (Sidney Moskowitz, Managing Attorney).

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Before Chapman, Wendel and Bottorff, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 13, 1997, Richard A. Deer filed an  
application, based on a claimed date of first use of  
December 1, 1995, to register the mark MINI PSEUDO for  
"pharmaceuticals, namely decongestant preparations".<sup>1</sup>

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<sup>1</sup> During the prosecution of this application, and in response to  
an inquiry from the Examining Attorney, applicant claimed  
ownership of Registration No. 1,529,295, issued March 3, 1989,  
Section 8 affidavit accepted, Section 15 affidavit acknowledged,  
for the mark MINI THIN for "bronchial dilator tablets";  
Registration No. 1,749,203, issued January 26, 1993, Section 8

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of two prior registrations issued to the same entity<sup>2</sup>--(1) the mark PSEUDO 60'S for "pharmaceuticals, namely nasal decongestant,"<sup>3</sup> and (2) the mark SUPER PSEUDO 60'S for "pseudoephedrine tablets."<sup>4</sup> The Examining Attorney contends that applicant's mark, when applied to his identified goods, so resembles the previously registered marks as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but applicant did not request an oral hearing.

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).

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affidavit accepted, Section 15 affidavit acknowledged, for the mark MINI SLIMS for "appetite suppressants"; and Registration No. 1,834,299, issued May 3, 1994, for the mark MINI STIMS for "pharmaceutical stimulants".

<sup>2</sup> The registrant is PDK Labs, Inc. located in Hauppauge, New York.

<sup>3</sup> Registration No. 1,979,774, issued June 11, 1996. The claimed date of first use is July 11, 1995.

<sup>4</sup> Registration No. 2,030,696, issued January 14, 1997. The application which matured into this registration was filed on August 22, 1994 based on a bona fide intent to use the mark in commerce. The claimed date of first use is September 27, 1994.

See also, G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990).

The Examining Attorney contends that the involved goods are closely related, and are sold to the same purchasers; that the term PSEUDO is the dominant feature in each mark, the term SUPER being merely laudatory, the number 60'S describing the size of the dosage (i.e., 60 milligrams), and the term MINI being a descriptive adjective meaning "small" or "miniature"<sup>5</sup> (and, as stated on applicant's specimens of record, referring to the tablets as being "small and easy to swallow"); that when considered in their entirety there is a likelihood of confusion as to these marks; and that in cases involving medicinal products, great care must be taken to prevent any likelihood of confusion due to the potential serious consequences. Finally, in response to applicant's argument and evidence that there has been no actual confusion, the Examining Attorney argues that the lack of actual confusion is not the test used to determine if there is a likelihood of confusion.

Applicant argues that there are several relevant du Pont factors pertinent in this case which have been

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<sup>5</sup> The Examining Attorney submitted The American Heritage Dictionary (1982) definition of "mini."

overlooked by the Examining Attorney, including, the dissimilarity of the marks, the fact that the cited registrant's marks are not famous, the number and nature of similar marks in use on similar goods, the lack of any instances of actual confusion during three years of use in similar trade channels, applicant's ownership of a family of marks, the market interface between applicant and the owner of a prior mark, and applicant's right to exclude others from using his mark on goods. Applicant asserts that when all of the evidence is considered, there is no likelihood of confusion.

Applicant submitted the declaration of Karen Windle-Burcham, president of Body Dynamics, Incorporated (hereinafter BDI).<sup>6</sup> In her declaration, Ms. Windle-Burcham avers that BDI sells a variety of over-the-counter pharmaceuticals and dietary supplements predominantly to wholesalers and distributors, who, in turn, sell primarily to retail convenience stores; that BDI uses the MINI marks, which are owned by Richard A. Deer, in accordance with written agreements between Mr. Deer and BDI; that generally these agreements give BDI an exclusive license to use the

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<sup>6</sup> Applicant's specimens of record include the following wording: "MARKETED BY: BDI Pharmaceuticals, a division of Body Dynamics, Inc."

**Ser. No.** 75/256845

MINI marks; that of the approximately 80,000 total consumer outlets for BDI's products nationwide, about 16,000 to 20,000 such outlets carry the product sold under the mark MINI PSEUDO; that from January 1, 1995 to about October 1998, the mark MINI PSEUDO has been used on 30,000,000 units of product, with gross sales for this MINI PSEUDO product over \$27,000,000; that on or before October 1995 BDI and PDK Labs, Inc. of Hauppauge, New York (the cited registrant, and hereinafter referred to as PDK) entered into an agreement whereby PDK agreed to supply the product to BDI, subject to inspection by BDI to ensure quality standards, and BDI would then sell said product under the mark MINI PSEUDO; and that also in accordance with the agreement, BDI agreed that it would offer for sale PDK's product under the marks SUPER PSEUDO 60'S and/or PSEUDO 60'S in addition to BDI's product sold under the mark MINI PSEUDO. Ms. Windle-Burcham also avers that she would be the person to be informed of any reports of consumer confusion from wholesalers, distributors, retail owners/managers or customers themselves; and that she has received no such reports.

In addition, Ms. Windle-Burcham avers, on information and belief, that both BDI and the cited registrant began using the respective involved marks (MINI PSEUDO, and SUPER

PSEUDO 60'S and PSEUDO 60'S) at about the same time; that prior to the agreement between BDI and PDK, PDK was also selling a similar product under the marks SUPER PSEUDO 60'S and/or PSEUDO 60'S; that during the relevant time period during which BDI marketed PDK's products in addition to its own, the product sold under the MINI PSEUDO mark outsold PDK's products by a ratio of at least about five to one; that BDI's and PDK's involved products were both on sale at about 20,000 consumer outlets; that at no time has PDK believed "there was any likelihood that a consumer would be confused as to whether the quality standards of goods sold under the 'MINI PSEUDO' trademark were imposed by the same company or source imposing quality standards of goods sold under the 'SUPER PSEUDO 60'S' AND/OR 'PSEUDO 60'S' trademarks" (Declaration, paragraph 9); and that due to government labeling requirements, consumers recognize terms such as PSEUDO, SUDA and SUDO and associate such terms with the active ingredient in over-the-counter nasal decongestants, specifically, pseudoephedrine.

Applicant does not dispute either the fact that the respective goods are essentially identical, or the fact that they are sold in essentially the same channels of trade to the same or similar purchasers. In fact, applicant acknowledges that the goods are sold in the same

channels of trade in connection with its argument regarding Ms. Windle-Burcham's declaration that she was aware of no instances of actual confusion. We find that the goods, the channels of trade and the purchasers are the same or similar.

Turning to a consideration of the marks, it is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. That is, because it is the entirety of the involved marks which is perceived by the purchasing public, it is the entirety of the marks that must be compared.<sup>7</sup> See *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

In this case, there are marked similarities between applicant's mark and each of the two cited registered marks. Specifically, all three marks include the term

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<sup>7</sup> The Examining Attorney argues that the term PSEUDO is the dominant feature of the three involved marks, while applicant argues that the term MINI is the dominant feature of his mark. On this record, and in view of the nature of each of the three involved marks, we do not find either term is dominant, but rather we consider all three of the marks in their entirety.

PSEUDO<sup>8</sup>; all three marks include size indicators with the term SUPER (at least one meaning of which would be large) in one of the registered marks, the term MINI (small) in applicant's mark and the number 60'S<sup>9</sup> in both cited registrations; and the general composition of the three marks projects a similar impression. Both applicant's mark and the cited registered marks include suggestive or descriptive matter as it relates to the involved goods, nasal decongestants. The cited marks and applicant's mark convey very similar commercial impressions which might well lead us to a finding of likelihood of confusion.

Applicant's argument regarding the number and nature of similar marks in use on similar goods is not persuasive. First, applicant merely included a typed list of five third-party registrations for nasal decongestants or cough medicine. A party may not make third-party registrations of record simply by setting forth a list of same. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974); and TBMP §703.02(b). Although the Examining Attorney could have

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<sup>8</sup> It is obvious that "pseudo" is the first six letters of the name of the active ingredient in the involved products. However, there is no evidence of record that the ingredient pseudoephedrine is also known as "pseudo."

<sup>9</sup> The number "60" perhaps refers to registrant's tablet dosage in milligrams, but there is no evidence of record on this point with regard to registrant's product. (We note that with regard to applicant's product, his specimens of record indicate "60mg" thereon.)

objected to applicant's third-party registrations as proffered, he did not do so. In fact, because the Examining Attorney treated the third-party registrations as if they were of record, so shall the Board. Second, applicant's list of five third-party registrations includes the two registrations cited by the Examining Attorney, and the three remaining third-party registered marks are SUDAFED, SUDAFED PLUS and SUDODRIN. Thus, there are no third-party registrations including the PSEUDO. Moreover, inasmuch as third-party registrations are not evidence of use of the marks shown therein, or that the public is familiar with them, these three third-party registrations have been accorded little weight in our determination of likelihood of confusion. See *Helene Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

This is a close case, and we are cognizant of the need for greater care in avoiding confusion in the dispensing of pharmaceuticals, even over-the-counter drugs (as they too can have serious consequences for certain individuals). See *Glenwood Laboratories, Inc. v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972); and *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992). Even with the inherent weakness of the marks, we would ordinarily find a likelihood of confusion.

However, in this case there are additional factors which affect our finding. From the ex-parte record before us it appears that applicant's exclusive licensee, BDI, is using the mark MINI PSEUDO for decongestant preparations with the knowledge of the registrant and that registrant has not objected thereto. Further, as stated earlier, the evidence submitted by applicant also indicates that applicant's exclusive licensee has experienced no actual confusion in three years of use of the respective marks in the same channels of trade. While likelihood of confusion, not actual confusion, is the test under Section 2(d) of the **Trademark Act**, in the case before us applicant's exclusive licensee avers (through its president) and applicant's attorney argues that from 1995 to the present, both applicant's and registrant's nasal decongestant products have been available through similar channels of trade (mainly convenience stores), with no instances of actual confusion of either wholesalers, store owners/managers, or consumers.<sup>10</sup>

Accordingly, we find that the overall evidence in this ex-parte record, as it relates to all relevant du Pont

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<sup>10</sup> Of course, our decision in this ex-parte proceeding is not binding on the Board in any subsequent proceeding brought by registrant (or any other entity), where we would have a different record, including registrant's perceptions of this situation.

factors, leads to a finding of no likelihood of confusion.

In reaching the conclusion of no likelihood of confusion, we have not considered applicant's argument that he owns a family of MINI marks (including, inter alia, the registered marks, MINI THIN, MINI SLIMS, and MINI STIMS). There is certainly no persuasive evidentiary support for applicant's contention that a family of "MINI" marks has been created and is recognized as such by the purchasing public.<sup>11</sup> See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991). Moreover, as the Board stated in the case of *In re Lar Mor International, Inc.*, 221 USPQ 180, 183 (TTAB 1983): "[T]he issue before us is the likelihood of confusion of applicant's mark vis-a-vis the registered mark." That is, the issue under Section 2(d) is whether applicant's mark sought to be registered so resembles the previously registered mark or marks as to be likely to cause confusion. Thus, an applicant can rely only upon its rights in that mark. See also, *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052 (TTAB 1992).

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<sup>11</sup> Applicant's only evidence in support of his asserted family of marks consists of a typed list of four registrations and three additional marks alleged to be in use; and Ms. Windle-Burcham's statements regarding the overall success applicant's marks have enjoyed in the marketplace. (See e.g., declaration, paragraph 5.)

**Ser. No.** 75/256845

Decision: The refusal to register under Section 2(d)  
is reversed.

B. A. Chapman

H. R. Wendel

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