

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

4/28/00

Opposition No. 99,944

T. E. Williams Pharmaceuticals
of Arkansas, Inc.

v.

Trend Pharmaceuticals, Inc.

Before Hanak, Walters and Wendel, Administrative Trademark
Judges.

By the Board:

Applicant has filed an application to register the mark
shown below

Tri-Slim

for a "dietary food supplement" in Class 5.¹ As grounds for the
opposition, opposer alleges that applicant's mark, when used on
the identified goods, so resembles opposer's previously used and
registered mark, T-LITE for "food supplements for weight loss" in

¹ Application Serial No. 75/627,739, filed on January 31, 1995, and
claiming use in commerce since August 1, 1994.

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Class 5,² as to be likely to cause confusion, mistake, or to deceive.

In its answer, applicant denies the salient allegations of the notice of opposition.

Applicant, on May 21, 1996, filed a motion for summary judgment arguing that it is entitled to judgment as a matter of law because there are no genuine issues of material fact, and the parties' respective marks are so dissimilar that there can be no likelihood of confusion. In its response, opposer indicated that the parties were involved in civil litigation in the United States District Court for the Northern District of Florida.³ The Board, after reviewing the complaint in the civil action, concluded that a stay of this proceeding was appropriate pending final determination of the court action. In response to Board inquiries as to the status of the civil action, opposer, on June 19, 1998, indicated that the parties had settled the civil litigation, and filed a copy of the settlement agreement. In an order dated August 12, 1998, the Board allowed opposer time to file a supplement to the pending motion for summary judgment showing why the agreement in the civil litigation should not result in the granting of applicant's motion for summary judgment herein.⁴ Opposer filed a supplemental response on October 13,

² U.S. Registration No. 1,888,184, registered April 11, 1995, and claiming use in commerce since December 31, 1988.

³ *T.E. Williams Pharmaceuticals of Arkansas, Inc. v. Trend Pharmaceuticals, Inc. and Hamp Bentley*, civil action No. 95-30015-RV.

⁴ Opposer's consented motions for extensions of time to respond to the Board's order, filed on September 11, 1998 and September 28, 1998,

1998, and applicant filed a supplemental response on November 6, 1998.

By the terms of the settlement agreement in the civil action, applicant would agree not to infringe on opposer's trade dress. The terms further provided that applicant was to deliver, per a schedule, specified quantities of product to opposer; that applicant was permitted a period of time in which to sell, in the ordinary course of trade, its pre-existing inventory of "TRI-SLIM product and literature bearing the phrase 'Lose Up to 10lbs. In 3 Days';" and that the court may enter an order enjoining applicant from "any use in substantially similar manner to Plaintiff's Diet Card and or/any confusingly similar trademark to Plaintiff's T-LITE trademark in connection with weight loss products and/or any use of the phrase 'Lose Up to 10lbs. In 3 Days' in connection with herbal weight loss products." Opposer agreed that, for the purposes of settlement, applicant's TRI-SLIM mark per se did not infringe any rights of opposer.

In its supplemental response, opposer argues that the parties' respective marks, when viewed in their entirety and in a commercial environment, are likely to cause confusion. In particular, opposer argues that, contrary to the provisions of the settlement agreement, "applicant continues to sell its products in containers bearing the confusingly similar slogan 'Lose up to 10lbs. In 3 Days'." Accompanying opposer's

respectively, are granted. See Fed. R. Civ. P. 6(b); and Trademark Rule 2.127(a).

supplemental response is one copy each of an advertisement of applicant and an advertisement of opposer.⁵

In its supplemental response, applicant argues that opposer is not contending that its T-LITE mark and applicant's TRI-SLIM mark are confusingly similar, but opposer challenges applicant's trade dress. In addition, applicant argues that the parties' settlement agreement makes it clear that opposer agrees that applicant's TRI-SLIM mark does not infringe on any rights of opposer.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

⁵ The Board is an administrative tribunal of the United States Patent and Trademark Office, empowered to determine only the right to register. Opposer's arguments concerning applicant's alleged breach of the settlement agreement are more appropriately brought in state or federal court, and will be given no further consideration herein. To the extent, however, that the Board needs to consider the agreement, to decide the issues properly before us in this proceeding, the Board shall do so. See *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 614 (Fed. Cir. 1983).

In the present case, we find that applicant has adequately met its burden of proof of showing that no genuine issue of material fact exists, and that there is no likelihood of confusion as a matter of law. We believe that the circumstances here are similar to those in *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), in that the single DuPont⁶ factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion.

In bringing its motion for summary judgment based solely on the dissimilarities of the parties' respective marks, applicant has effectively conceded all other relevant DuPont factors in opposer's favor for the purposes of applicant's motion, and the Board has so considered those factors as favoring opposer. Thus, even viewing the other relevant DuPont factors in opposer's favor, the dissimilarities of the marks are so great as to avoid likelihood of confusion.

Opposer's argument that the contemporaneous use by both parties of the slogan "Lose up to 10lbs. In 3 Days" in conjunction with their respective marks somehow makes the marks confusingly similar is simply unpersuasive. In determining likelihood of confusion, the Board must compare the marks in question as to appearance, sound, meaning, and connotation. Any

⁶ See *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 463 (CCPA 1973).

issues regarding trade dress similarities are not relevant herein.

Here, although both marks begin with the letter T and contain a hyphen, the pre-hyphenated terms, T in opposer's mark, and TRI in applicant's mark, and the post-hyphenated terms, LITE in opposer's mark, and SLIM in applicant's mark, are different in sound, meaning, appearance, and connotation, both individually and in combination to form the parties' respective marks: T-LITE, in opposer's case, and TRI-SLIM, in applicant's case. Thus, the parties' respective marks are so dissimilar that there can be no likelihood of confusion.

Accordingly, applicant's motion for summary judgment is granted, and the opposition is dismissed with prejudice.⁷

E. W. Hanak

C. E. Walters

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

⁷ In view of the Board's decision herein, applicant's argument that the parties' stipulated settlement dismissal with prejudice of the civil action estops opposer from relitigating an issue that has been decided against opposer need not be considered.