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Paper No. 8
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Astro West Inc.**

Serial No. 75/**481,838**

Albin H. Gess of **Price and Gess** for **Astro West Inc.**

David E. Yontef, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before **Cissel, Hohein and Wendel**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Astro West Inc. has filed an application to register
the mark "VIRILE-X" for an "herbal food supplement for male
sexuality and virility."¹

¹ Ser. No. 75/481,838, filed on May 8, 1998, which alleges dates of first use anywhere and in commerce of October 1997. Although the goods in the application, as filed and prior to submission of applicant's appeal brief, were identified as an "herbal food supplement," in such brief applicant has requested that the identification of its goods be amended to read: "herbal food supplement for male sexuality and virility." While the Examining Attorney, citing TMEP §1110, asserts in his brief that the request "should properly have been provided in a request for reconsideration," he nonetheless notes that "the change is acceptable and does not affect the ... issue [on appeal]." In view thereof, the

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 "VIRILEX," which is registered for "ayurvedic preparations being food supplements,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³ Although applicant attempts to distinguish the respective marks by arguing, among

identification of goods is accordingly deemed to be amended by Examiner's Amendment to read as indicated above.

² Reg. No. 2,010,372, issued on October 22, 1996, which sets forth dates of first use anywhere and in commerce of June 1993.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

other things, that while "the letters may be the same in both marks, the use of the hyphen [in applicant's mark] to break out the 'X' creates not only a different visual impression, but a different sound and a different meaning" from registrant's mark,⁴ there is simply no question that, as the Examining Attorney observes, the respective marks are identical in sound and

⁴ While applicant also asserts, for the first time in its brief, that "[t]here are at least two other VIRILE formative marks registered for use on dietary supplements for adults to provide male health (see registrations 2,069,536 and 2,323,587)," copies thereof were not made of record and the Board does not take judicial notice of third-party registrations. See, e.g., *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). In any event, even if the two registrations sought to be relied upon by applicant were properly of record, so that we would have an indication of the actual marks and goods covered thereby, it is pointed out that, as stated in *AMF Incorporated v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973):

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registration is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

Furthermore, with respect to applicant's additional contention that the marks at issue are used on distinctively different labels, suffice it to say that not only is the labeling used to display a mark subject to change at any time, but the issue of likelihood of confusion, insofar as the registrability of applicant's mark is concerned, is determined on the basis of such mark and registrant's mark as they are respectively set forth in the application and cited registration. This is because Section 2(d) of the Trademark Act precludes registration of "a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely ... to cause confusion" Thus, the fact that both applicant and registrant use their respective marks on labels containing additional matter, including different design elements, is irrelevant and immaterial. See, e.g., *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (TTAB 1972) and cases cited therein.

overall are substantially similar in appearance, suggestive connotation and commercial impression, differing only in the inconsequential presence of a hyphen in applicant's mark.

Inasmuch as the contemporaneous use thereof on the same or similar goods plainly would be likely to cause confusion, the focus of our inquiry is accordingly on the similarities and dissimilarities in the respective goods.

Applicant, in this regard, asserts that its "product is directed specifically at a very precise segment of the male population, [namely,] those men that are interested in herbal supplements to enhance their male sexuality and virility," while registrant's product "is an Ayurvedic herbal preparation that is recommended as a fitness supplement for men." The fact that both products are herbal preparations, applicant maintains, "is a generalization which, while analytically convenient and sometimes superficially persuasive," does not mean that the respective goods are related because "[t]he issue of relatedness is not one of semantics, but of consumer expectations." In particular, applicant contends its herbal food supplement for male sexuality and virility is "sold in health clubs, mini food markets, ... [drug stores] and the food sections of major retailers such as K-Mart." By contrast, applicant asserts that the term "ayurvedic preparations" in the identification of

registrant's goods "defines the goods more than [the words] 'food supplements'" in that such products are "sold through Ayurvedic practitioners, and perhaps through the Internet and at shops specializing in Ayurvedic preparations."

"Ayurvedic medicine," applicant explains, "is a form of alternative medicine based upon the principle that disease is caused by an imbalance of life forces" According to applicant, Ayurveda "is the oldest existing method of medical practice and is regarded by proponents as a complete way of life aimed at spiritual, mental and social well being as well as physical health." Among other things, applicant indicates that an "Ayurvedic practitioner diagnoses a patient's constitutional type and imbalances" through various techniques and then makes specific recommendations to correct the imbalances observed. "Ayurvedic therapies," applicant points out, "focus on lifestyle changes and herbal remedies" Applicant insists that "Ayurvedic preparations, both in India and in the United States[,] are used by recommendation from ... licensed Ayurvedic practitioners" and are thus "a part of the treatment being prescribed as a curative therapy resulting from the diagnosis of the Ayurvedic practitioner." Consequently, applicant urges that:

In a case such as this ... the trade channels are different, [with] applicant's goods being advertised to retail purchasers

and sold in retail outlets, while the registrant's goods are part of a treatment prescribed by an Ayurvedic practitioner, [so that] the likelihood of confusion is considerably reduced. This is true not just because the goods travel in different channels of trade which do not overlap. It is also true because the goods of the ... [registrant] are acquired only after consultation with experts, thereby increasing the degree of care utilized by the purchaser of the cited registrant's goods and reducing the likelihood of confusion.

We agree with the Examining Attorney, however, that the respective goods are closely related, if not identical, and that when sold under such substantially similar marks as "VIRILE-X" and "VIRILEX," confusion is likely. As the Examining Attorney accurately observes, "applicant and the registrant provide the same goods, food supplements," which are in the nature of herbal remedies. Of record in support of the Examining Attorney's position is an excerpt from the Dictionary of Alternative Medicine (1998), which at 32-33 lists the following definitions (*emphasis added*):

ayurveda 1. The Indian philosophy that forms the basis for ayurvedic medicine; ... the major branches of ayurveda incorporated into current ayurvedic medicine are internal medicine, geriatrics, **aphrodisiac** medicine, and *panchakarma* 2. Ayurvedic medicine, see there.

....

ayurvedic herbal medicine ... A therapeutic system based on the classification of

foods and herbs into four groups
Specific herbs are used to increase or decrease the *doshas* See Ayurvedic medicine

....

ayurvedic medicine ... Sanskrit, *ayur*-Life, *veda*-knowledge. The oldest existing medical system in the world, which is practiced by approximately 300,000 physicians, primarily in the subcontinent of India; ayurvedic medicine encompasses aromatherapy, diet and nutrition, **herbal** medicine, massage, and vedic astrology; ayurvedic philosophy holds that disease is caused by an imbalance of homeostatic and immune mechanisms related to three physiological principles or "*doshas*"

Applicant has acknowledged, as mentioned previously, that the therapies in Ayurvedic medicine "focus on lifestyle changes and herbal remedies" and, as the above definitions make clear, there is no limitation on the types of herbal food supplements used in Ayurvedic medicine. Applicant's "herbal food supplement for male sexuality and virility," therefore, "could be used in an ayurvedic treatment or regimen," as the Examining Attorney persuasively notes, or such product could be used as an adjunct thereto. In any event, it is plain that applicant's product is an herbal food supplement which is specifically intended as a preparation for enhancing male sexuality and virility, while registrant's goods, which are broadly identified as "ayurvedic preparations being food supplements," likewise include herbal food supplements, such as

aphrodisiacs and other Ayurvedic herbal preparations for enhancing sexuality and virility.

Moreover, it is well settled that that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the subject application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods in the application at issue and in the cited registration are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described therein, but that the identified goods and services move in all channels of trade which would be normal for such goods and services and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Accordingly, not only is applicant's "herbal food supplement for male sexuality and virility" the kind of product which is encompassed by registrant's broadly identified "ayurvedic preparations being food supplements," but the respective goods must be regarded as suitable for sale in all customary trade channels for herbal food supplements, including

not just shops that specialize in Ayurvedic preparations, but also retail health food stores, drug stores, mass merchandisers, mini food markets, health clubs and the Internet. The channels of trade for the respective goods are therefore the same in legal contemplation.

Furthermore, while practitioners of Ayurvedic medicine are required to be licensed, there is nothing in the record which indicates that a person purchasing Ayurvedic preparations must first consult with an Ayurvedic medicine practitioner or have a prescription for such herbal food supplements. Rather, any adult may purchase herbal food supplements, whether such goods are Ayurvedic preparations or other products claimed to be remedies for a variety of constitutional conditions. For example, the record contains excerpts from various Internet retailers showing that Ayurvedic preparations and other herbal food supplements are both readily available, with or without prior consultation with a practitioner of Ayurvedic medicine.

Lastly, while applicant asserts that confusion is nevertheless unlikely because purchasers of registrant's goods select such products only after consultation with experts on Ayurvedic preparations, suffice it to say that, even if such is generally the case, the fact that consumers may be knowledgeable or sophisticated in a particular field and exercise a degree of care in their purchasing decisions "does not necessarily

preclude their mistaking one trademark for another" or that they otherwise are entirely immune from 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).

We accordingly conclude that consumers and potential customers, who are familiar or acquainted with registrant's "VIRILEX" mark for its Ayurvedic preparations being food supplements, would be likely to believe, upon encountering applicant's substantially similar "VIRILE-X" mark for its herbal food supplement for male sexuality and virility, that such identical in part and otherwise closely related medicinal products emanate from, or are sponsored by or associated with, the same source. In particular, even among customers who might notice the minor difference overall in the respective marks due to the presence of a hyphen in applicant's mark, it would still be reasonable for them to believe, for example, that applicant's "VIRILE-X" mark for its herbal food supplement for male sexuality and virility designates a new or additional product specifically formulated therefor and which emanates from, or is sponsored by, the same source as provides the other food supplements sold by registrant as Ayurvedic preparations under its "VIRILEX" mark.

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