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THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Schering-Plough Healthcare Products, Inc.

v.

William E. Nordt, III, M.D.

Opposition No. 119,220
to application Serial No. 75/800,644
filed on September 16, 1999

David J. Kera of Oblon, Spivak, McClelland, Maier &
Neustadt for Schering-Plough Healthcare Products, Inc.

William E. Nordt, III, M.D., pro se.

Before Hanak, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by William A. Nordt,
III, M.D. to register the mark DYNASLIPPER for a "medical
device, namely a tension splint used to alleviate the
symptoms of plantar fasciitis."¹

Registration has been opposed by Schering-Plough Healthcare Products, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks shown below as to be likely to cause confusion:

DYNASTEP (typed drawing) for a "medical device, namely a footwear insert that relieves pain caused by overpronation of the foot and arch;"²



for a "medical device, namely, a footwear insert that relieves pain;"³ and

DYNASTEP (typed drawing) for "footwear."⁴

Applicant, in his answer, has denied the salient allegations of the notice of reliance.

The record consists of the pleadings; the file of the involved application; and the testimony depositions of opposer's witnesses Michael Anthony Pietrangelo;

¹ Serial No. 75/800,644, filed September 16, 1999, based upon an allegation of a bona fide intention to use the mark in commerce.

² Registration No. 2,027,808 issued December 31, 1996; affidavits under Section 8 and 15 accepted and acknowledged, respectively.

³ Registration No. 2,116,480 issued November 25, 1997; affidavits under Section 8 and 15 accepted and acknowledged, respectively.

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Brenda Sue Fulton, and Laura Jane Crane, with exhibits.

Opposer has

⁴ Registration No. 2,352,218 issued May 23, 2000.

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also filed under a notice of reliance status and title copies of its pleaded registrations; applicant's responses to opposer's interrogatories and requests for admissions; portions of applicant's discovery deposition, with exhibits; and copies of printed publications.

Applicant did not take testimony or properly introduce any evidence on his behalf.⁵

Both parties have briefed the issues before the Board; no oral hearing was requested.

The record shows that opposer uses the DYNASTEP mark in connection with footwear inserts. In addition, opposer has licensed the Pagoda Shoe Company to use the mark on a line of shoes. Opposer first used the DYNASTEP mark on footwear inserts in 1997. Opposer's footwear inserts are used to provide relief from heel pain, including heel pain caused by plantar fasciitis.⁶ Persons who overpronate, i.e., tend to roll the arch of the foot inward excessively, are particularly prone to plantar

⁵ Applicant did submit several exhibits with his brief on the case. However, exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See TMBP Section 705.02 and cases cited therein. Here, applicant did not make the exhibits of record during his testimony period. Thus, they are not part of the record, and we have not considered them in reaching our decision herein.

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fasciitis. Opposer's footwear inserts are sold in a variety of retail outlets, including food supermarket chains, drug chains, independent food stores and drug stores, mass merchandisers, sporting goods chains and military commissaries.

Opposer has promoted its DYNASTEPP footwear inserts in displays at meetings and conferences of professional organizations, by providing leaflets and brochures to podiatrists for distribution to patients, and at opposer's website. Opposer has advertised in consumer magazines and professional journals, and on television.⁷ Further, the record shows that opposer's footwear inserts have received a good amount of coverage in the trade and general press.

The information we have about applicant is from his discovery responses and discovery deposition. Applicant began selling his DYNASLIPPER tension splint, which is in the nature of a slipper, in January 2000. Applicant's goods are used to alleviate the symptoms of plantar

⁶ Plantar fasciitis is a condition where the plantar fascia, a thick layer of fibrous tissue that connects the heel to the toe, becomes inflamed.

⁷ Opposer's sales and advertising figures were deemed confidential information and were introduced into the record pursuant to a protective order. The record shows substantial sums in both categories.

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fasciitis by stretching the foot. He has sold approximately 6000 units with sales totaling about \$70,000. Applicant has advertised his goods by postcard mailings to orthopedic surgeons and podiatrists and in magazines. Applicant sells the majority of his tension splints directly to physician's offices who in turn prescribe the splints to patients. In addition, he

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sells some of his tension splints in the Westbury Pharmacy in Richmond, Virginia and through his website. Applicant has contacted several drug store chains in an attempt to have them sell his goods, but he was unsuccessful.

Inasmuch as opposer has focused its arguments in this case on the use of the DYNASTEP mark for footwear inserts, we will give no further consideration to opposer's registration for the DYNASTEP mark for footwear, per se. Thus, we will determine the issue of likelihood confusion vis-à-vis opposer's DYNASTEP mark for footwear inserts and applicant's mark DYNASLIPPER for tension splints used to alleviate the symptoms of plantar fasciitis.

Priority of use is not in issue inasmuch as opposer introduced status and title copies of its pleaded registrations for the mark DYNASTEP for footwear inserts by way of notice of reliance. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Further, the record shows that opposer has used the DYNASTEP mark prior to applicant's date of first use and the filing date of applicant's application.

We turn then to the issue of likelihood of confusion. Our determination of this issue is based on

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an analysis of all the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We find that, because of the similar commercial impressions of opposer's and applicant's marks, and the close relationship between opposer's goods and those identified in applicant's application, applicant's use of his mark is likely to cause confusion.

With respect to the parties' goods, we recognize that there are differences in footwear inserts and a tension splint. However, the issue to be determined under Section 2(d) of the Trademark Act, in cases such as this, is not whether the goods in question are likely to be confused, but rather whether there is a likelihood that purchasers or potential purchasers thereof will be misled into the mistaken belief that they emanate from the same source. It is for this reason that the goods need not be identical or competitive in nature in order to support a finding of likelihood of confusion, it being sufficient for the purpose that the goods be 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 circumstances that

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could give rise, because of the similarities between the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same source. See *In re International Telephone and Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978) and cases cited therein.

Further, it is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of a comparison of the goods or services set forth in the applicant's application vis-à-vis the goods or services set forth in the opposer's pleaded registration and/or those as to which opposer has shown prior use of its pleaded mark. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *Block Drug Co. Inc. v. Den-Mat Inc.*, 17 USPQ2d 1315 (TTAB 1989).

In the present case, we find that applicant's tension splint is sufficiently related to opposer's footwear inserts that when sold under identical or substantially similar marks, confusion is likely to occur. To begin with, both parties' goods are used in the treatment of heel pain caused by plantar fasciitis.

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In fact, the goods are complementary in that opposer's DYNASTEP footwear inserts are used in shoes when a person is up and about during the day and applicant's DYNASLIPPER tension split is used at night to stretch the foot. Furthermore, in the absence of any restrictions in applicant's identification of goods as to channels of trade or classes of purchasers, we must presume for purposes herein that applicant sells its goods in all the usual channels of trade to all of the normal classes of customers. In point of fact, both parties' goods are sold in drug stores/pharmacies over the counter to the general public.

Turning then to the marks, each mark consists of the prefix "DYNA" followed by a term which begins with the letter "S" and is suggestive/descriptive of the parties' respective goods--STEP, in opposer's case, signifying movement of the feet, and SLIPPER, in applicant's case, signifying the nature of applicant's product. Further, the evidence of record indicates that opposer's use and promotion of the DYNASTEP mark for footwear inserts has been extensive, with the result that the mark has acquired considerable goodwill and strength. In addition, there is no probative evidence of any current third-party use of the prefix "DYNA" as part of a mark in

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the foot care field. Rather, the evidence points to the uniqueness of opposer's DYNASTEPP mark in the field.

While consumers may well note the differences between applicant's mark DYNASLIPPER and opposer's mark DYNASTEPP, they are likely to ascribe the differences as denoting that the marks are used for different products of the same product line, rather than to indicate that there are different sources for the products.

Finally, the fact that there is no evidence of actual confusion does not persuade us to find that confusion is not likely. Aside from the fact that actual confusion is difficult to prove, we cannot conclude from the somewhat limited use of applicant's mark that there has been an opportunity for confusion to have occurred.

The essence of applicant's defense, as set forth in his brief on the case, is that opposer has failed to meet its burden of proof in showing a likelihood of confusion. As we have discussed, however, opposer has established a likelihood of confusion between its mark for footwear inserts and the applied-for mark for a tension splint to alleviate the symptoms of plantar fasciitis. Further, the brief is replete with factual assertions upon which applicant bases its arguments. As opposer has correctly noted, the problem is that applicant did not take

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testimony or properly offer any other evidence. Factual statements in a party's brief on the case have no evidentiary value and can be given no consideration unless they are supported by evidence properly introduced at trial. See, e.g., *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819 (TTAB 1981); and *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502 (TTAB 1978).

Finally, to the extent that any of applicant's arguments casts doubts on our conclusion (arguments, which we reiterate, are unsupported by any evidence of record), we resolve those doubts, as we must, in favor of the prior user. See: *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977).

We conclude that purchasers familiar with opposer's DYNASTEP footwear inserts would be likely to believe, upon encountering applicant's mark DYNASLIPPER for a tension splint use to alleviate the symptoms of plantar fasciitis, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained and registration to applicant is refused.

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