

**THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB**

Oral Hearing:
August 14, 2003

Mailed: March 10, 2004
Paper No. 44
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Pharmaceutical Association
v.
American Association of Pharmaceutical Scientists

Opposition No. 91115985
to Application No. 75569580
filed on October 12, 1998

Michael H. McConihe and A. Statton Hammock, Jr.
of O'Brien, Butler, McConihe & Schaefer and Laurence R.
Hefter, Linda K. McLeod and Douglas A. Rettew of Finnegan,
Henderson, Farabow, Garrett & Dunner for American
Pharmaceutical Association.

Alan S. Cooper, Nancy S. Lapidus and Caroline C. Smith of
Shaw Pittman for American Association of Pharmaceutical
Scientists.

Before Cissel, Walters and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

American Pharmaceutical Association filed its
opposition to the application of American Association of

Pharmaceutical Scientists to register the mark AAPS PHARMSCI for "computer services, namely, providing an on-line journal of interest to researchers in the pharmaceutical and drug field" in International Class 42.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used marks JOURNAL OF PHARMACEUTICAL SCIENCES and J. PHARM SCI for its "peer-reviewed periodical in the field of pharmaceutical sciences" as to be likely to cause confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Applicant, in its answer, denied the salient allegations of the claim.

Preliminary/Procedural Matters

1. Grounds of Opposition.

In addition to likelihood of confusion, opposer asserted in its notice of opposition that applicant's mark falsely suggests a connection with opposer, under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a); that "[t]hrough extensive use of J. PHARM SCI in the pharmaceutical field, [opposer's] J. PHARM SCI mark has become distinctive and famous" and that applicant's mark will dilute the distinctive quality of such mark, under

¹ Application Serial No. 75569580, filed October 12, 1998, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.

Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c); and that applicant made false and fraudulent statements in the declaration to its trademark application opposed herein because it had knowledge that the public used J. PHARM SCI to identify opposer and its journal. In its answer, applicant denied the salient allegations of these claims.

However, in its brief (p. 12, footnote 8), opposer stated that it will proceed only on its claim of likelihood of confusion under Section 2(d) of the Act. Therefore, we consider these claims to have been expressly stricken and we have not considered them. We note, further, that only the issue of likelihood of confusion was tried by the parties.

2. Opposer's Motion for Leave to File a Substitute Reply Brief.

Trademark Rule 2.128(b), 37 CFR 2.128(b), states that "a reply brief shall not exceed twenty-five pages in its entirety." However, opposer's reply brief, including the table of contents and index of cases, is more than twenty-five pages. Opposer was advised by the Board at the oral hearing, on August 14, 2003, that its reply brief exceeded the page limit and that the Board may decide, at its discretion, not to consider opposer's reply brief.

On August 25, 2003, opposer filed its motion for leave to file a substitute reply brief. Opposer stated that it had inadvertently printed its originally-submitted reply brief in 13-point type rather than 12-point type; and that

the substitute brief is identical to the originally-submitted brief except that it is 12-point type and it omits the table of contents, thus bringing it within the twenty-five-page limit. Opposer contends that consideration of its substitute reply brief will not prejudice applicant, who had received the substance of the brief in its original form and had not objected thereto; and that it would aid the Board in determining the case on the merits.

Applicant opposed the motion, contending that the table of contents is a required portion of the reply brief; that opposer's motion is untimely because leave to file a brief that exceeds the page limit must be filed on or before the due date for the brief; that the Board is prejudiced by acceptance of a substitute brief because the Board did not have an opportunity to question opposer at the oral hearing on assertions made in the substitute reply brief, or obtain applicant's position on such assertions; and that opposer had an opportunity to summarize the arguments in its reply brief at the oral hearing and, thus, submission of a written brief is unnecessary.

While we hold parties responsible for ensuring that the papers submitted in a proceeding are in proper form and we do not condone opposer's apparent oversight in submitting a brief that exceeded the maximum page limit, we have exercised our discretion in favor of considering opposer's

substitute reply brief in this case. Except for the deletion of the table of contents, the substitute brief is purportedly identical in substance to the originally submitted brief, and applicant does not contend otherwise. Contrary to applicant's contention, the table of contents is not a required element, although it is a strongly recommended portion of a brief because it enables the Board to locate easily particular portions of the party's argument and it concisely outlines the brief's contents. However, we find that neither the Board nor applicant is prejudiced by our consideration of the substitute brief and, further, it has assisted our determination of the merits of this case.

3. Applicant's Motion to Amend Application to Disclaim the Exclusive Right to Use "PHARMSCI."

On November 16, 2001, the last day of its testimony period, applicant filed a motion to amend its application herein to add a disclaimer of the term PHARMSCI. The motion has been contested by opposer. The motion was deferred until final decision; thus, we now consider applicant's motion.

Applicant contends that an accepted international standard exists for abbreviations of the titles of scientific journal names, excerpts of which are in the record; that this standard identifies the accepted abbreviation of "Pharmaceutical Sciences" in scientific journal titles as "Pharm. Sci."; that, therefore, the term

PHARMSCI in applicant's mark is merely descriptive of the subject matter of applicant's publication and a disclaimer thereof is "appropriate and warranted." (Motion, p. 2.)²

Opposer objects to entry of a disclaimer and contends that the fact that two publications may identify "Pharm" and "Sci" as abbreviations for the respective terms "pharmaceutical" and "sciences" does not necessarily lead to the conclusion that the unitary term PHARMSCI is merely descriptive in connection with the goods and services involved herein; that "there is no evidence that the combination of these abbreviations of descriptive terms results in a descriptive composite" (Response, p. 3); and that "the term PHARMSCI points uniquely to opposer's well-known mark J. PHARM. SCI." (Response, p. 3-4.)

Trademark Rule 2.133(a) provides "an application involved in a proceeding may not be amended in substance ... except with the consent of the other party or parties and the approval of the [Board], or except upon motion." Ordinarily this motion should be made before trial and when such a motion is not made prior to trial, as in this case, the Board will normally deny the motion if granting it would affect the issues involved in the proceeding. See *Trademark*

² Although there is no provision in the rules for submitting reply briefs on motions, the Board has considered applicant's reply brief in this instance because it has been of assistance in deciding the merits of applicant's motion.

Trial and Appeal Board Manual of Procedure (2nd ed. June 2003), § 514.03 and cases cited therein.

We deny applicant's motion to add to its application a disclaimer of PHARMSCI. While the issue of the distinctiveness of opposer's mark J. PHARM SCI is an issue that was tried by the parties, the specific issue of whether disclaimer of the combined phrase PHARMSCI in applicant's mark is permissible and whether it obviates likelihood of confusion was not tried by express or implied consent of the parties. To avoid any appearance that entry of the disclaimer could affect the substantive issues herein, we find this unconsented motion to be improper at this time.

However, had we permitted applicant's voluntary entry of a disclaimer of exclusive rights in PHARMSCI, under Section 6 of the Trademark Act, 15 U.S.C. 1056, our analysis and conclusion in this case would remain the same. The following words of Judge Nies in the case of *In re National Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985), 224 U.S.P.Q. 749 (Court affirmed Board finding that CASH MANAGEMENT EXCHANGE, with voluntarily entered disclaimer of CASH MANAGEMENT, confusingly similar to CASH MANAGEMENT ACCOUNT, both for financial services) are equally applicable in the case before this Board:

The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been

disclaimed during prosecution of the trademark application at the PTO. It appears that National voluntarily disclaimed these words, as a tactical strategy, believing it would assist in avoiding a holding of likelihood of confusion with the cited mark. However, such action cannot affect the scope of protection to which another's mark is entitled. (*Footnotes omitted.*)

In conclusion on this issue, applicant's motion to amend its application to add a disclaimer of PHARMSCI is denied.

4. Applicant's Motion to Amend the Pleadings to Conform to the Evidence and to Assert the Defense of Acquiescence.

On November 16, 2001, the last day of its testimony period, applicant filed a motion to amend its answer to include a defense of acquiescence, citing Fed. R. Civ. P. Rule 15(b). The motion has been contested by opposer. The motion was deferred until final decision; thus, we now consider applicant's motion.

Applicant contends that on June 28, 2001, opposer and applicant entered into an agreement whereby applicant will post on its Internet website the table of contents and article abstracts of opposer's publication J. PHARM SCI; that applicant will provide to subscribers hyperlinks directly to articles in opposer's J. PHARM SCI; that opposer agreed that applicant's website shall include images of the print version cover and contents pages of opposer's J. PHARM SCI; that opposer was aware at the time of the agreement that applicant's mark AAPS PHARMSCI is featured on applicant's website; that "[b]y the affirmative act of

entering in the agreement, opposer acquiesced in applicant's use of the mark AAPS PHARMSCI and thus is estopped from contesting applicant's right to register this mark"

(Motion, p. 2); and that the issue relative to the agreement was raised during trial.

In opposing the motion, opposer contends that it will incur substantial prejudice if applicant is permitted to add this defense at this stage of the proceeding, five months after the agreement was concluded and three weeks after the close of both parties' testimony periods; that the defense is meritless because the June 28, 2001 agreement contains no reference to applicant's online journal or to this opposition proceeding; that the evidence establishes that opposer gave no assurances, either express or implied, that it would not assert its trademark rights against applicant; and that the parties had agreed to separate the issues involved herein from the issues addressed in the agreement.

Rule 15(b) Fed. R. Civ. P. provides as follows:

(b) Amendments to Conform to the Evidence.

When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure to so amend does not affect the result of the trial of these issues. If evidence is objected to at trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely

when the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits. The court may grant a continuance to enable the objecting party to meet such evidence.

As the basis for its motion, applicant submitted a copy of the June 28, 2001 agreement between the parties. Also in support of its motion, applicant submitted a printout alleged to be from applicant's website, e-mail correspondence, and excerpts from the trial testimony of Dr. Gans and Mr. Cox.

The agreement which forms the basis of applicant's proposed defense provides, in pertinent part, that "AphA [opposer] will provide the tables of contents and abstracts for all issues of the Journal [of Pharmaceutical Sciences] ... to AAPS [applicant] for posting on the AAPS website Pharmaceutica web portal" (Agreement, p. 1, para. 1); and that "AphA will provide an Internet hyperlink between each table of contents entry and each abstract posted on the AAPS Pharmaceutica that will take the user directly to that portion of a website ... that contains the referenced articles in the Journal. ... These hyperlinks will be so arranged on the AAPS Pharmaceutica that the full text of the Journal articles may only be accessed by those who hold individual subscriptions to the Journal..." (Agreement, p. 1, para. 2).

Dr. John A. Gans, opposer's executive vice president and CEO, testified during opposer's main trial period that he was familiar with the June 28, 2001 agreement between the parties herein. When asked if the issue of applicant's use of PHARMSCI came up during discussions leading up to the June 28, 2001 agreement, Dr. Gans stated the following:

Answer - Yes. When we originally started to sort out, map out what kind of relationship we wanted to have, I tried again to resolve this issue of the name and put it as one of the criteria. And they didn't want to deal with it so they took it off the negotiation table. Which is another mistake because it could have been dealt with then.

Question - More particularly, what did they say?

Answer - We will deal with this later.

During cross examination, Dr. Gans was questioned, under opposer's counsel's objection based on relevance, about the substance of the June 28, 2001 agreement.

John B. Cox, applicant's executive director, testified during applicant's trial period that discussions leading up to the June 28, 2001 agreement began in approximately June, 2000. He also confirmed that the agreement between the parties had, in fact, been implemented, stating that abstracts from opposer's journal were appearing on applicant's website. On cross examination, Mr. Cox gave the following answers to the questions shown:

Question - So you and the president of AAPS had discussions regarding this proceeding at the same time you were discussing this agreement...?

Answer - Actually, not at the same time. My understanding is that he spoke to Dr. Gans and said why not take this off the table. We'll never get to an agreement on the important thing, the important thing being a linking agreement. So siderail it, sidebar it, and that's where we proceeded from.

Question - Siderail it or sidebar it, what did you take that to mean?

Answer - That it would be addressed at a later time.

After a review of the record we conclude that there clearly was no express consent by opposer to applicant's assertion of the defense of acquiescence. To find that there was implied consent to trial of this previously unasserted defense, we would have to find that opposer raised no objection to the introduction of evidence on the issue, and that opposer was fairly apprised that the evidence was being offered in support of the issue. See *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); and *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collecttivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978).

Applicant's questioning of Dr. Gans and Mr. Cox about the terms of, and negotiations leading up to, the June 28, 2001 agreement gives no indication, expressly or implicitly, that applicant was pursuing this line of questioning in contemplation of asserting a defense of acquiescence. Further, opposer's counsel objected to the relevance of applicant's line of questioning. Neither the evidence

submitted with applicant's motion nor any other evidence in the record warrants a conclusion that the defense of acquiescence was tried expressly or implicitly by the parties.

Moreover, the merits of the proceeding would not be served by permitting applicant to add its proposed defense of acquiescence because, based on the evidence, the defense is without merit. The affirmative defense of acquiescence requires applicant to show that opposer actively represented that it would not assert its claim of likelihood of confusion; that opposer inexcusably delayed in asserting its claim; and that the delay caused undue prejudice. See *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401 (11th Cir. 1991); and *Hitachi Metals International, Ltd. V. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ 1057 (TTAB 1981). In this case, not only did opposer never represent that it would not pursue its claim, but the testimony establishes that the parties actively agreed *not* to address the issue of the pending opposition in their discussions leading up to, or in, the June 28, 2001 agreement. It would be inequitable for applicant to make such assertions during discussions leading up to the agreement, and then be permitted to use the agreement against opposer to establish acquiescence.

Further, the agreement makes no reference to applicant's mark at issue herein.

Finally, evidence establishing that portions of opposer's journal appear on applicant's website along with applicant's journal identified by the mark herein may be relevant to the issue of likelihood of confusion, but such evidence is not reason to permit applicant to assert a defense of acquiescence, nor does it establish such a defense.

In conclusion, we deny applicant's motion to amend its answer to add a defense of acquiescence.

5. *Objections to Evidence.*

We next consider the objections to evidence made by applicant. Applicant contends that the testimony of Dr. Gans, p. 31, and Mr. Kane, opposer's vice president of publishing, pp. 11-12, regarding actual confusion is inadmissible on the grounds that it is hearsay and that opposer "failed to produce the documents pertaining to the purported actual confusion despite applicant's request for production of such documents during discovery" (applicant's brief, p. 24). Applicant alleges that it specifically requested during discovery "all documents which related to any instance of actual confusion of which opposer is aware [and that] in response to that request and subsequently, opposer has maintained that it possesses no such documents"

(applicant's brief, p. 26). Applicant states that the testimony of Dr. Gans and Mr. Kane indicates that Dr. Dolusio sent an announcement regarding applicant's use of its AAPS PHARMSCI mark to Dr. Gans and that Mr. Kane made notes of his telephone conversation with an unidentified caller. Applicant notes further that neither of these documents was produced.

Applicant objects to the admissibility of Mr. Kane's testimony in its entirety on the ground that the testimony was pursuant to a telephone deposition to which applicant objected at the time of the deposition. Applicant argues additionally that, even if this testimony regarding actual confusion is admissible, it is of little probative value.

Opposer contends that the evidence is admissible; that the statements by Dr. Gans and Mr. Kane are not hearsay and, if they are, then they are admissible under the state-of-mind exception. Opposer argues that the alleged documents were not, in fact, in opposer's possession, nor is opposer relying on documents to support its position that actual confusion has occurred.

Applicant's objections are overruled. The case law clearly establishes that Dr. Gan's and Mr. Kane's statements regarding third-party statements to them are evidence that the statements were made to them. The statements are not offered for the truth thereof. See *Corporate Fitness*

Programs, Inc. v. Weider health and Fitness, Inc., 2 USPQ2d 1682 (TTAB 1987).

Similarly, applicant's objection in its brief to the taking of Mr. Kane's testimony by telephone is overruled. The transcript of the deposition indicates that applicant's counsel received proper notice of the deposition and there is no indication that applicant had previously objected and been unable to resolve the objection prior to the deposition. Applicant's counsel participated in the deposition and has not shown any prejudice resulting from the fact that the deposition was conducted by telephone. Telephone depositions are widely utilized in cases before the Board as a viable means to obtain testimony and minimize costs.

The Record

The record consists of the pleadings; the file of the involved application; various specified responses of opposer to applicant's interrogatories and requests for admissions,³ and excerpts from various publications, all made of record by applicant's notices of reliance; excerpts from opposer's publication and third-party publications, made of record by opposer's notices of reliance; the testimony depositions by opposer, all with accompanying exhibits, of Dr. John Gans,

³ Applicant also submitted by notice of reliance several responses of opposer to applicant's requests for production of documents to show that opposer stated it did not have certain documents.

opposer's executive vice president and CEO, John B. Cox, applicant's executive director, Harvey Kane, opposer's vice president of publishing, Ronald L. Williams, opposer's now-retired director of communications and strategic planning, and Samuel Kalman, opposer's now-retired director for development and administrator of opposer's foundation; and the testimony depositions by applicant of John B. Cox, applicant's executive director, Victor Van Buren, applicant's director of publishing, and Eva M. Nye, manager for technical and administrative services for applicant's counsel's law firm, all with accompanying exhibits. Both parties filed briefs on the case and an oral hearing was held.

Factual Findings

Opposer, American Pharmaceutical Association, was founded in 1852 in Philadelphia. It is a membership organization of pharmaceutical professionals comprised of three academies, the Academy of Pharmaceutical Sciences and Research, the Academy of Pharmacy Practice and Management, and the Academy of Students of Pharmacy, and a foundation. Opposer has published a scholarly and peer-reviewed scientific journal for nearly 100 years. The journal was originally entitled *Journal of the American Pharmaceutical Association, Scientific Edition*; however, in 1961, the name was changed to *Journal of Pharmaceutical Sciences*, its

present name. Regarding the name change, the editor of the January 1961 edition wrote the following [Exhibit 1 to deposition of Ronald L. Williams]:

The former name ... was criticized as being nondescriptive with regard to content, too unwieldy, easily subject to confusion with the Practical Pharmacy Edition, and difficult to cite correctly in literature references. The new title ... appears to overcome all of these objections.

Dr. Gans, opposer's executive vice president and CEO, acknowledges that the name of its journal is descriptive of the journal and its subject matter. He characterizes opposer's *Journal of Pharmaceutical Sciences* as one of the preeminent journals in the field of pharmaceutical sciences, noting that there are other periodicals in this field. Opposer's journal articles address all aspects of the pharmaceutical sciences, including research, discovery/development of pharmaceutical products, and the efficacy, quality and delivery, in whatever form, to the human body of such drugs.

Opposer's journal was published for some time in association with the American Chemical Society, but it is now published by John Wiley and Sons, a publisher of scientific periodicals. Opposer's journal is widely circulated to, inter alia, university and scientific libraries, corporations and individuals. The National Library of Medicine's database of health sciences literature and information, known as "Medline," includes opposer's

Journal of Pharmaceutical Sciences among its periodicals, showing its title in abbreviated form as *J Pharm Sci*.

Medline presents the titles in its database in abbreviated form according to the following standards⁴:

[The National Library of Medicine] NLM collects, indexes, preserves, and makes available health sciences literature to health professionals and serves as supplemental resource after other local, regional, and national resources have been contacted.

Journal title abbreviations are created following the rules established by the International Organization for Standardization (ISO) in ISO 4 Information and Documentation - Rules for the abbreviation of title words and titles of publications. The latest version of this standard is the 3rd edition, 1997. According to the ISO rules, single words and oriental language titles are never abbreviated, and all punctuation is removed. Abbreviations for individual words within a title are obtained from the List of Serial Title Word Abbreviations published by the International Serials Data System (2nd edition. Paris; c1991 and later supplements).

These referenced documents were made of record through the testimony of Eva M. Nye as Applicant's Exhibits 4 and 5 and provide, in relevant part, that, "very frequently used generic words" are abbreviated to a single letter, giving as an example "j" for "journal"; and that, in a title, English words with the root "pharmaceut-" are abbreviated as "pharm." and English words with the root "scienc-" are

⁴ Applicant's Exhibit 1 to Van Buren deposition - e-mail explanation, dated September 17, 2001, from C. Marks, National Library of Medicine customer service. The truth of this e-mail statement is established by applicant's testimonial witnesses, Victor Van Buren and Eva M. Nye, and is not disputed by opposer.

abbreviated as "sci." According to these standards, opposer's *Journal of Pharmaceutical Sciences* is abbreviated as *J. Pharm. Sci.*

Periodicals cited in articles and bibliographies in the record also present titles in abbreviated form, which form appears to follow the same or similar conventions followed by Medline. Throughout these various sources in the record, opposer's *Journal of Pharmaceutical Sciences* is written as *J. Pharm. Sci.* While there is no testimony as to when this convention was adopted with respect to opposer's journal, copies of articles in the record from as early as 1990 show use of this abbreviation in a bibliographic context.

Opposer's *Journal of Pharmaceutical Sciences* is also referred to verbally in the testimonial depositions as "*J Pharm Sci*" and the testimony establishes that opposer's journal is verbally referred to as "*J Pharm Sci*" by scientists, academics and other professionals in the pharmaceutical sciences field, which is the source of its readership. While it is not clear how long people have so referred to opposer's journal, it clearly predates the filing date of the application in this case. Opposer's journal is not referred to as "*Pharm Sci.*"

Applicant, American Association of Pharmaceutical Scientists, was formed in 1986 and has many members in common with opposer. In fact, applicant's founders were

members of opposer's Academy of Pharmaceutical Scientists who left opposer's organization to form their own organization. Applicant's membership consists entirely of individuals, not business entities, who are professionals in the pharmaceutical sciences. There is substantial overlap in the membership of opposer and applicant.

Applicant also has a peer-reviewed journal, in partnership with a commercial publisher, entitled *Pharmaceutical Research*, which focuses on research in the pharmaceutical sciences field. More recently, in January 1999, applicant began online publication of another journal, covering all aspects of the pharmaceutical sciences, titled *AAPS PHARMSCI*, which is the subject of the opposed application herein.⁵ Consistent with the standards reviewed above for abbreviating titles, applicant's online journal is not abbreviated, but appears as "AAPS PHARMSCI" when cited in articles and bibliographies. There is substantial overlap in the readership of opposer's and applicant's periodicals.

Applicant organization has an Internet website at www.aapspharmaceutica.com. On its home page is reference to its electronic journal, *AAPS PharmSci*, with a list of

⁵ The application that is the subject of this opposition is based on an allegation of a bona fide intention to use the mark; however, the evidence clearly establishes that use of the mark in connection with the identified services has occurred and we have considered this evidence in reaching our decision.

articles. Through the site's search function, one can go to a screen entitled AAPS Annual Meeting Abstracts. From this screen, one can search "over 2,000 abstracts accepted for this year's AAPS Annual Meeting." Three boxes on the left side of this screen indicate "AAPS *PharmSci*," "*Pharmaceutical Research*" and, pursuant to the previously-discussed agreement between opposer and applicant, "*Journal of Pharmaceutical Sciences*." From this screen, one can search title, author and abstract data in these three journals. If one is a subscriber to *J. Pharm. Sci.*, one may go from an article abstract to the full article.

The record establishes that many scientific periodicals published in print form are also available electronically. Opposer has its Internet website at www.aphanet.org, where it refers to its publication as both *Journal of Pharmaceutical Sciences* and *J Pharm Sci*. As discussed *supra*, opposer and applicant entered into an agreement in June 2001, which has been implemented, whereby applicant posts on its Internet website the table of contents and article abstracts of opposer's journal, *J Pharm Sci*, with hyperlinks, for subscribers only, directly to the full text of articles in opposer's journal.

There are several third-party journals, all of which are available in the United States, that include in their titles a phrase which appears abbreviated in article and

bibliography citations as "Pharm. Sci." The following are "active" titles of such journals with the abbreviation shown in parentheses: *Advances in Pharmaceutical Sciences (Adv Pharm Sci)*; *European Journal of Pharmaceutical Sciences: Official Journal of the European Federation for Pharmaceutical Sciences (Eur J Pharm Sci)*; *Journal of Pharmacy & Pharmaceutical Sciences: a Publication of the Canadian Society for Pharmaceutical Sciences (J Pharm Pharm Sci)*; *PDA Journal of Pharmaceutical Science and Technology/PDA (PDA J Pharm Sci Technol)*; and *Trends in Pharmacological Sciences (Trends Pharmacol Sci)*. There is no evidence in the record regarding whether the citations for these third-party publications are used so as to have attained any recognition or whether the readership of these publications overlaps that of opposer's and applicant's publications.

The record establishes that opposer and applicant had negotiated unsuccessfully for several years to publish opposer's journal through some kind of joint arrangement. The record also establishes that, when applicant first began promotion and electronic publication of its journal, several individuals, including principals in both opposer's and applicant's organizations, communicated to persons in opposer's organization the mistaken belief that *AAPS PharmSci* was a collaboration between opposer and applicant.

Additionally, Mr. Kane, opposer's vice president of publishing, reported receiving a phone call from an individual responding to information regarding an opening for an editorial position with "*Pharm Sci*," although opposer's journal did not have such an opening.

Analysis

Opposer's standing is a threshold inquiry made by the Board in every inter partes case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer has submitted evidence of its ownership and publication of a scientific periodical titled *Journal of Pharmaceutical Sciences* and that this title is abbreviated as *J. Pharm. Sci.* We consider this evidence as sufficient to establish opposer's interest and, therefore, standing in this proceeding.

Regarding whether opposer's publication title and the abbreviation therefore are inherently distinctive and, if not, whether these terms have acquired distinctiveness as

trademarks, opposer contends that it has established that it has priority and that *Journal Of Pharmacheutical Sciences* and *J. Pharm. Sci.* are distinctive and well known trademarks of opposer for its journal, which is available both in print and online. Applicant, on the other hand, contends that "Pharm Sci" is a descriptive term; that *J. Pharm. Sci.* is merely descriptive in connection with opposer's journal; and that opposer has not established that *J. Pharm. Sci.* has acquired distinctiveness as a trademark.

There is no question that the title *Journal of Pharmaceutical Sciences* is merely descriptive, and thus not inherently distinctive, in connection with opposer's scientific periodical. However, it is equally clear from the evidence of record that this title, both in its full and abbreviated form, has acquired distinctiveness as a trademark for opposer's publication through use - for the full title, since at least 1961, and for the abbreviated form, since at least prior to the filing date of the opposed application. The record also supports the conclusion that opposer's journal, whether called *Journal of Pharmaceutical Sciences* or *J. Pharm Sci.*, is well known and respected among professionals in the pharmaceutical sciences field.⁶

⁶ The record falls short of sufficient factual information from which to conclude that *Journal of Pharmaceutical Sciences* or *J. Pharm. Sci.* is a famous trademark as used in connection with opposer's publication.

J. Pharm. Sci. is recognized in the scientific community as the accepted abbreviation for *Journal of Pharmaceutical Sciences* for citation in articles and bibliographies. The question about which the parties disagree is whether *J. Pharm. Sci.* also functions as a trademark as it is used in connection with opposer's publication. Because *J. Pharm. Sci.* is the recognized abbreviation for *Journal of Pharmaceutical Sciences*, it is similarly merely descriptive in connection thereof and, thus, it is not inherently distinctive. However, the evidence in the record, including use of *J. Pharm. Sci.* by those in the pharmaceutical field in their testimony herein, and acknowledgement by several witnesses that *J. Pharm. Sci.* is used to refer to opposer's publication, we find that *J. Pharm. Sci.* is used, and functions, as a trademark to identify opposer's publication.

In view thereof, opposer has established its priority of use of its trademarks *Journal of Pharmaceutical Sciences* and *J. Pharm. Sci.* in connection with a peer-reviewed scientific periodical in the pharmaceutical sciences field.

We turn now to a determination of the issue of likelihood of confusion, which, under Section 2(d), must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de*

Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Opposer contends that its mark is famous and entitled to a broad scope of protection; that the parties’ marks are substantially similar in sound, appearance, connotation and overall commercial impression; that the parties’ goods and services are identical and travel through the same channels of trade to the same class of purchasers; that there has been actual “meaningful” confusion; and that applicant has a duty to adopt a mark dissimilar from other marks in the field and “applicant ignored this duty and, with full and complete knowledge of opposer’s well known mark, adopted a near-identical imitation.” (Opposer’s Brief, p. 22.)

Applicant contends that evidence of third-party uses of *Pharm. Sci.* support the conclusion that there is widespread use of the term as an abbreviation of “pharmaceutical

science"; that evidence of third-party journals in the field of pharmaceutical science establishes that *Pharm. Sci.* is used as an abbreviation of "pharmaceutical science" in journal titles; that *Pharm. Sci.* is used as an abbreviation of "pharmaceutical science" as part of various domain names for web sites in that field; that opposer has not established that *J. Pharm. Sci.* is a strong and famous mark; that the purchasers of the parties' goods and services are sophisticated individuals within the pharmaceutical science field, all of whom are familiar with both parties and their goods and services; that opposer has not established actual confusion; and that there is no evidence that applicant adopted its mark in bad faith.

With respect to the goods and services of the parties, we observe that both parties' products are peer-reviewed scientific periodicals in the pharmaceutical sciences field. Opposer's publication is available in print and electronically via the Internet. Applicant's publication is available only electronically via the Internet. Thus, even if the goods and services are not identical, the parties' publications are closely related and/or substantially overlapping goods and services. Thus, this *du Pont* factor strongly favors opposer.

Further, the evidence establishes that the channels of trade overlap and the class of purchasers of the parties'

publications are the same, i.e., professionals and students in the pharmaceutical sciences. The record shows that the relevant public for both parties' publications is highly educated and sophisticated with respect to the scientific publications they read. While the *du Pont* factors of overlapping channels of trade and identical purchasers clearly favor opposer, the sophistication of those purchasers is a mitigating factor.

However, we also note opposer's reported instances of confusion among several pharmaceutical sciences professionals familiar with opposer's publication as to the source of applicant's electronic publication. We find this evidence to be credible and to indicate that even knowledgeable, experienced and well-educated professionals in the pharmaceutical sciences are not immune to trademark confusion. Thus, we find the instances of actual confusion to weaken the significance of the purchasers' sophistication in this case.⁷

Turning to consider the marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that in articulating reasons for

⁷ We have already addressed, *supra*, the admissibility of opposer's evidence of actual confusion. Other than applicant's technical objections to the admissibility of that evidence, applicant does not assert that this evidence is not credible. Moreover, given the knowledgeable individuals involved in at least two instances, we do not find these few instances to be *de minimus*.

reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

First, we note that *J. Pharm. Sci.* is equivalent to *Journal of Pharmaceutical Sciences* and *J. Pharm. Sci.* is commonly used to refer to opposer's publication. Therefore, we focus our comparative analysis on *J. Pharm. Sci.* The latter portion of applicant's mark, *AAPS PharmSci*, is identical to the latter portion of opposer's mark. The fact that applicant has merged "Pharm" and "Sci" to form a single word does not change the perception of that term as merely a telescoping of its two components, "Pharm" and "Sci." The marks differ only in their initial terms, opposer's "J." or "Journal," which is generic in connection with opposer's publication, and applicant's "AAPS," which is an abbreviation of its name. Thus, the marks are substantially similar.

Opposer would have us conclude that its marks are famous and entitled to a broad scope of protection. While opposer has established that its journal, as identified by its two marks, is a significant publication in its field and

is known among pharmaceutical sciences professionals, opposer has not established that its marks are famous, and we do not accord them as broad a scope of protection as they would be entitled to if fame had been established.

Applicant has shown us evidence of four other publications that include the term "pharmaceutical science(s)," which is abbreviated in each title as "Pharm. Sci." However, there is no evidence that these terms, or the abbreviations therefor, serve as trademarks in connection with those publications, nor do we know the extent to which professionals in the pharmaceutical sciences are familiar with these titles. Thus, we do not find this evidence determinative of whether opposer's mark has been weakened by third-party use.

We find this to be a very close case, but having considered all of the relevant *du Pont* factors, we resolve our doubts in favor of opposer, and we find that the addition of applicant's name, AAPS, to the telescoped term PharmSci, is insufficient to distinguish applicant's mark from opposer's marks in connection with their respective publications. It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior user or registrant.

See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976). There is absolutely no evidence that applicant adopted its mark in bad faith. However, applicant, as the newcomer who intended to use the new mark in connection with its electronic journal, had both the opportunity and the obligation to avoid confusion. Out of an entire universe of marks to choose from in naming its publication, applicant chose, with full knowledge of opposer's marks, a mark which is similar to the marks previously used by opposer in connection with its well established publication.

Decision: The opposition is sustained.