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Mailed:
July 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Orphan Pharmaceuticals, U.S.A., Inc.

Serial No. 76207867

Michael W. Garvey of Pearne & Gordon LLP for Orphan
Pharmaceuticals, U.S.A., Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Bucher, Grendel and Cataldo, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below



for goods and services identified in the application, as amended, as "pharmaceuticals for the treatment of rare diseases, namely in the field of cardiology, diseases affecting immunocompromised patients, genetic disorders, haematology, infectious diseases, metabolic disorders, oncology, palliative [sic - palliative] care, poison control, respiratory diseases, urology and psychiatric diseases" in Class 5, and "product research and development of prescription and over-the-counter drugs" in Class 42.¹ Pursuant to the Trademark Examining Attorney's requirement, applicant has disclaimed the exclusive right to use ORPHAN apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney's refusal to register applicant's mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, as applied to applicant's goods and services, so resembles two previously-registered marks (both are owned by the same entity) as to be likely to cause confusion, to cause mistake, or to deceive.

The first cited registration is on the Principal Register, of the mark ORPHAN MEDICAL (in standard character

¹ Serial No. 76207867, filed February 9, 2001. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application includes the following description of the mark: "The design is a globe."

form; MEDICAL disclaimed) for "mail order services for distribution of prescription drugs, medical products and authoritative educational materials to individuals with chronic health conditions; mail order services for the distribution of authoritative educational materials to health professionals," in Class 42.²

The second cited registration, likewise on the Principal Register, is of the mark depicted below (MEDICAL disclaimed)



for "research and development of prescription and over the counter drugs for others," in Class 42.³

The record includes the Trademark Examining Attorney's submission of a printout (printed on June 18, 2001) of a web page from the United States Food and Drug

² Registration No. 1843925, issued July 5, 1994; renewed. Affidavits under Sections 8 and 15 accepted and acknowledged.

³ Registration No. 1906107, issued July 18, 1995; renewed. Affidavits under Sections 8 and 15 accepted and acknowledged.

Administration's website, headed "Orphan Drugs."⁴ Pertinent text from this printout includes the following: "The term 'orphan drug' refers to a product that treats a rare disease affecting fewer than 200,000 Americans. The Orphan Drug Act was signed into law on January 4, 1983. Since the Orphan Drug Act passed, over 100 orphan drugs and biological products have been brought to market."

Also of record is a brochure, submitted by applicant, which advertises a September 24-25, 2001 conference titled "2nd Annual Orphan Drugs for Pharmaceutical and Biotechnology Companies." Typical text in the brochure includes the following: "Today, thanks to the incentives of the Orphan Drug Act, the biotech pipeline is currently bursting with promising orphan drug developments designed to treat one of the estimated 6,000 rare diseases that affect up to twenty-five million people in the United States alone and countless more worldwide"; "Despite the fact that orphan drug development continues to be a complex issue for the biopharmaceutical industries, scores of biotech companies are joining in the race to develop orphan products"; "Orphan drug development frequently presents

⁴ This printout was submitted by the Trademark Examining Attorney in support of his requirement, made in the first Office action, for a disclaimer of ORPHAN.

many challenges concerning the funding, distribution, and marketing of rare disease treatment products"; "Incentives provided by the 1983 Orphan Drug Act enable developers and marketers of orphan pharmaceuticals to benefit millions of patients"; "This timely forum provides you with a unique opportunity to hear the latest information on regulatory issues, discuss strategies and discover solutions to overcoming the obstacles of orphan drug development."

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the Section 2(d) refusal based on Registration No. 1906107, which is of the ORPHAN MEDICAL and design mark (depicted *supra*) for "research and development of prescription and over the counter drugs for others."

We find, under the first *du Pont* factor (the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, meaning and overall commercial impression), that applicant's ORPHAN and globe design mark is similar to the cited registered ORPHAN MEDICAL and design mark only insofar as both marks include the designation ORPHAN. The marks are dissimilar to the extent that the cited registered mark also includes the additional word MEDICAL, and to the extent that the design elements of the two marks are different. Although we accord to the cited registered mark all of the presumptions to which it is entitled under Trademark Act Section 7(b), we nonetheless find, based on the evidence of record regarding the clear "term of art" significance of the term "orphan" in the industry (as quoted *supra*), that it is a relatively weak mark which is entitled only to a narrow scope of protection. Comparing the marks in their entireties, we find that the points of dissimilarity between the marks outweigh the only point of similarity, i.e., the presence in both marks of the term "orphan." We conclude that the marks are more dissimilar than similar, and that the first *du Pont* factor accordingly weighs against a finding of likelihood of confusion.

We find, under the second *du Pont* factor (the similarity or dissimilarity of the respective goods and/or services), that applicant's Class 42 services, i.e., "product research and development of prescription and over-the-counter drugs," are essentially identical to the services recited in the '107 registration. However, we also find, under the fourth *du Pont* factor (the conditions of purchase), that the prospective purchasers of these "research and development" services would be knowledgeable, sophisticated purchasers, i.e., pharmaceutical companies, who are likely to exercise a great degree of care in purchasing the services. We find that the fact that the respective Class 42 services are identical is more than offset, in our likelihood of confusion analysis, by the sophistication and care with which the services would be purchased. Given the weakness of the term "orphan" and the resulting overall dissimilarity between the marks, we find that these sophisticated and knowledgeable purchasers are not likely to be confused as to the source of the respective Class 42 services rendered by applicant and registrant.

Turning next to a comparison (under the second *du Pont* factor) of applicant's Class 5 goods and the Class 42 services recited in the '107 registration, we find that

they are related, but only to the extent that they both involve pharmaceutical products, generally. We also find (under the third *du Pont* factor) that applicant's Class 5 goods and registrant's Class 42 services would be marketed in different trade channels and to different classes of purchasers. Applicant's Class 5 pharmaceutical products would be marketed to patients (i.e., ordinary consumers) and their doctors. Registrant's Class 42 research and development services would be marketed to pharmaceutical companies, not to ordinary consumers. Given these differences in the marketing channels and purchasers, and given the overall dissimilarity between the marks, we find it unlikely that purchasers will be confused as to the source of the respective goods and services.

We turn finally to the Section 2(d) refusal based on Registration No. 1843925, which is of the mark ORPHAN MEDICAL (in standard character form) for "mail order services for distribution of prescription drugs, medical products and authoritative educational materials to individuals with chronic health conditions; mail order services for the distribution of authoritative educational materials to health professionals," in Class 42.

We find that applicant's Class 5 pharmaceutical products are related to the registrant's Class 42 "mail

order services" in the field of pharmaceutical products and educational materials, and that these respective goods and services would be marketed to the same classes of purchasers, i.e., patients/consumers and their doctors. However, for the reasons discussed above, we find that notwithstanding the relatedness of the respective goods and services, the scope of protection to be afforded to the cited registered ORPHAN MEDICAL mark is simply too narrow to warrant a finding of likelihood of confusion with applicant's dissimilar ORPHAN and globe design mark.

As for applicant's Class 42 research and development services, we find that they are similar to registrant's Class 42 mail order services only to the extent that both services generally involve pharmaceutical products. We find, again, that applicant's services would be marketed in different trade channels and to different classes of purchasers than would registrant's "mail order services." Registrant's services would be marketed to patients and their doctors, while applicant's research and development services would be rendered to pharmaceutical companies. When the differences between the respective services, trade channels and classes of purchasers are considered together with the overall dissimilarity of the marks, we conclude that there is no likelihood of source confusion.

In summary, we find for the reasons discussed above that there is no likelihood of confusion between applicant's mark and either of the cited registered marks. The scope of protection to be afforded registrant's marks simply is not broad enough to foreclose registration of applicant's mark for applicant's identified goods and services. The shared presence of the weak term ORPHAN in both marks is not sufficient to render the marks confusingly similar; rather, we find that applicant's mark and the cited registered marks are sufficiently dissimilar, when viewed in their entireties, that no confusion is likely.

Decision: The refusal to register is reversed.