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Hearing:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

King Bio Pharmaceuticals, Inc.

v.

King Pharmaceuticals, Inc.

Opposition No. 111,332
to Application Serial Nos.
74/508,722, filed on April 4, 1994;
74/700,380, filed on July 12, 1995;
and 74/700,382, filed on July 12, 1995.

Steven C. Schnedler of Carter & Schnedler, P.A. for King
Bio Pharmaceuticals, Inc.

Jon L. Roberts, John F. Mardula and Shauna M. Wertheim of
Roberts & Abokhair, LLC for King Pharmaceuticals, Inc.

Before Seeherman, Wendel and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

King Bio Pharmaceuticals, Inc. (hereafter "opposer")
has opposed three applications filed by King

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Pharmaceuticals, Inc. (hereafter "applicant") to register the marks KING PHARMACEUTICALS (PHARMACEUTICALS disclaimed),¹ KING and design² and KING PHARMACEUTICALS and design (PHARMACEUTICALS disclaimed),³ as shown below, for "pharmaceuticals for human and veterinary use, namely, morphine, codeine, and related injectables; cough syrup, antihistamines, decongestants, dermatological preparations, and vitamins." All three applications were based on asserted use of the marks in commerce.



As grounds for opposition, opposer has alleged that since 1990 it has used KING BIO PHARMACEUTICALS as a trademark and trade name in connection with "its products and the marketing and distribution of its products"; that opposer has filed two applications to register KING BIO

¹ Application Serial No. 74/700,382, filed July 12, 1995, and asserting first use and first use of the mark in commerce on June 30, 1994.

² Application Serial No. 74/508,722, filed April 4, 1994, and asserting first use on January 10, 1994 and first use in commerce on January 20, 1994.

³ Application Serial No. 74/700,330, filed July 12, 1995, and asserting first use and first use in commerce on June 30, 1994.

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PHARMACEUTICALS as a trademark (for goods identified as "homeopathic dietary supplements for humans and animals" and "reference manuals devoted to homeopathic remedies"), and the Trademark Attorney examining each of opposer's applications has stated that, if applicant's applications Serial Nos. 74/700,382 and 74/508,722 (two of the applications opposed herein) mature into registrations, the Examining Attorney may refuse registration of opposer's marks pursuant to Section 2(d); and that the issues with reference to applicant's application Serial No. 74/700,380 are the same as those with respect to applicant's other two applications.

Applicant has denied the allegations of the notice of opposition and has asserted, affirmatively, that opposer's action is barred by estoppel and waiver; that opposer corporation was dissolved by the state of North Carolina; and that opposer "has filed an application for a mark which is primarily a surname and thus non-registrable ... and therefore is barred from bringing this suit."⁴

⁴ With the exception of its continuing assertion that KING BIO PHARMACEUTICALS is primarily merely a surname, applicant has not pursued its affirmative defenses, and therefore we will give them no further consideration.

The record includes the pleadings; the files of the opposed applications; the trial testimony, with exhibits, of opposer's witnesses Frank J. King, Jr. and Eric Thiele, and of applicant's witnesses John A.A. Bellamy and Joseph Ridgeway, Sr.; and opposer's responses to certain of applicant's interrogatories and requests for admission, and portions of applicant's discovery depositions of Frank King, Jr. and Sherry Frisby, submitted by applicant under a notice of reliance.⁵ The case has been fully briefed, and both parties were represented at a hearing before the Board.

The Board previously decided the parties' cross-motions for summary judgment and granted partial summary judgment in favor of opposer on the issue of priority, holding that opposer had shown priority of use of the mark KING BIO PHARMACEUTICALS for "non-prescription homeopathic remedies."⁶ In that decision, the Board noted

⁵ Although opposer's own applications were not formally introduced into the record, both parties have discussed them in their briefs, and we therefore deem them to have been stipulated into the record.

⁶ We note that opposer has shown prior use of its mark on, inter alia, dermatological preparations (products for acne and for eczema/rashes/hives) and medications for allergies, for colds and flu (including symptoms of congestion and dry cough) and for coughs. This evidence was submitted with opposer's cross-motion for summary judgment. Although normally materials submitted in connection with a motion for summary judgment are not of record unless specifically made of record during the testimony period, in this case the issue of priority was decided

that a party relying on common law rights in a mark, as opposer is here, must prove it has proprietary rights in the mark. Applicant had asserted in its motion that opposer could not show such rights because of applicant's contention that the mark KING is primarily merely a surname, and the Board found that there were genuine issues as to this point.

As the Board said in the decision on summary judgment, opposer, as the party opposing registration on the basis of likelihood of confusion with its own mark, must establish that KING BIO PHARMACEUTICALS is distinctive of its goods either inherently or through the acquisition of secondary meaning. See **Hoover Co. v. Royal Appliance Manufacturing Co.**, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001); **Towers v. Advent Software, Inc.**, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990).

We now make clear that we find opposer's mark KING BIO PHRAMACEUTICALS to be inherently distinctive, and that opposer's use of this term as a trademark prior to applicant's first use is sufficient to establish

in opposer's favor on summary judgment, and therefore opposer was under no obligation to submit evidence of priority at trial. In these circumstances, we think it appropriate to consult that evidence submitted in connection with the summary judgment motion to ascertain the specific homeopathic products for which opposer was determined to have shown priority.

opposer's priority. Although KING is the surname of opposer's principal, Mr. Frank J. King, Jr., and the words BIO PHARMACEUTICALS are descriptive of opposer's goods, as shown by opposer's disclaimer of them in its two pending applications, the term KING is not primarily merely a surname. Rather, KING has a well-recognized meaning as an ordinary word (see definitions set forth at footnote 12 of the Board's November 30, 2000 decision on the cross-motions for summary judgment). Accordingly, KING, and the mark KING BIO PHARMACEUTICALS, cannot be primarily merely a surname. As Assistant Commissioner Leeds explicitly stated in **Ex parte Rivera Watch Corp.**, 106 USPQ 145 (Comr Pats 1955), "If the mark has well known meanings as a word in the language and the purchasing public, upon seeing it on the goods, may not attribute surname significance to it, it is not primarily merely a surname. 'King', 'Cotton' and 'Boatman' fall in this category." See also **Fisher Radio Corp. v. Bird Electronics Corp.**, 162 USPQ 265 (TTAB 1969) (BIRD and design held not primarily merely a surname, even though Bird was the name of applicant's president).

This brings us to a consideration of the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in

evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The parties have each highlighted certain du Pont factors in their briefs and, while we have considered each relevant factor, we have focused our discussion on those that we and the parties have considered most important.

Turning first to the goods, the evidence shows that opposer produces a wide variety of homeopathic pharmaceuticals for both humans and animals, while applicant uses its mark on prescription allopathic drugs.⁷ Much of applicant's argument focuses on these differences in the parties' goods, and specifically the assertion that applicant's goods are prescription pharmaceuticals, while opposer's are non-prescription homeopathic products. (Homeopathic products are made with all-natural ingredients.)

As a preliminary matter, we note that, although opposer has traditionally produced homeopathic products that are sold without prescription, as part of its trial

⁷ John Bellamy, applicant's Executive Vice President and General Counsel, testified that applicant was not selling vitamins or any products for veterinarian use. Accordingly, if applicant were to ultimately prevail in this proceeding, the file will be remanded to the Trademark Examining Attorney, pursuant to Trademark Rule 2.131, for consideration of the registrability of the marks for such goods.

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testimony it presented evidence that it was in the process of producing prescription medicines. But such evidence is not necessary for us to find that the parties' goods are, in part, legally identical. Although applicant makes much of the fact that its pharmaceuticals are prescription products, the identifications of the goods set forth in the applications do not limit the products in this manner. We can, of course, take judicial notice that the morphine, codeine and related injectable pharmaceuticals for human and veterinary use are prescription products because of the controls on narcotic drugs. Indeed, opposer acknowledges this in its brief. However, the identifications in applicant's applications also include cough syrup, antihistamines, decongestants and dermatological preparations, and such products may be sold over-the-counter as well as by prescription, and may be homeopathic as well as allopathic. Indeed, opposer sells many of these products without prescription.

The latter products-- cough syrup, antihistamines, decongestants and dermatological preparations--are legally identical to many of the products on which opposer uses its KING BIO PHARMACEUTICAL marks. It is well settled that the question of likelihood of confusion

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must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and /or services recited in an opposer's registration, rather than what the evidence shows the goods and/or services to be. **Canadian Imperial Bank of Commerce v. Wells Fargo Bank**, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this case, of course, opposer does not have a registration, but applicant's goods must be considered as they are identified in its applications, and those identifications are not limited to prescription or even allopathic drugs. Thus, applicant's identification of goods must be read to encompass, for example, non-prescription homeopathic cough syrup, decongestants and dermatological preparations.

In view of this legal identity of the products, the channels of trade must be considered to be the same. And, in fact, the evidence shows that both parties' products are sold in drugstores. Although applicant contends that sales of opposer's products will occur through pharmacies "sometime in the future," brief, p. 23, in fact the evidence shows that since 1999 opposer has focused its marketing efforts on drugstores and pharmacists, and that opposer currently sells its over-

the-counter products through general pharmacies such as Eckerd's.

Moreover, the classes of purchasers of the products must also be considered to be, in part, the same. Specifically, because applicant's identification is not limited to prescription pharmaceuticals, its goods must be deemed to be marketed to the general public and not just to physicians and pharmacists, as applicant asserts. The general public are also the purchasers of opposer's "mass market" goods.

Because of this, we do not accept applicant's argument that the purchasers of its goods are physicians and pharmacists who are "capable of distinguishing between goods associated with allegedly confusing marks." Brief, p. 23. Whatever the care exercised by pharmacists and physicians, the question of likelihood of confusion must also be considered from the standpoint of the public at large. For similar reasons, we give minimal probative value to the survey done by applicant which concluded that there was "little likelihood of confusion between the two companies based on their respective corporate names" or their respective trademarks.⁸ The universe used

⁸ There is some question as to whether it is the use of the corporate names or the marks that would create little likelihood of confusion. The survey results reported in Exhibit 1 to the

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for this survey was pharmacists and drug wholesalers; Mr. Ridgway, the survey creator and director, testified that he was not asked to do any measure of likelihood of confusion among the general public. Thus, the survey does not provide any information about whether ordinary consumers are likely to be confused by the contemporaneous use of the parties' marks on over-the-counter pharmaceuticals such as cough syrup, decongestants and dermatological preparations.

We now turn to a consideration of the parties' marks, keeping in mind that when marks would appear on virtually identical goods or services, as is the case here in view of the legal identity of the goods, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1608, 1700 (Fed. Cir. 1992).

Opposer's mark is KING BIO PHARMACEUTICALS. Sometimes, with opposer's mass market products, this mark appears with a tiny diamond design containing a person

testimony deposition of Joseph Ridgway referred to "corporate names," but when Mr. Ridgway testified he referred to "trademarks."

superimposed on a globe.⁹ Applicant's marks, as noted above, are the words KING PHARMACEUTICALS, and KING and KING PHARMACEUTICALS, both of which are depicted within a crown design. Applicant contends that the inclusion of BIO between KING and PHARMACEUTICALS in opposer's mark is "sufficient to conclude lack of similarity." Brief, p. 12. We disagree.

It is well established that 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 a consideration of the marks in their entireties. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We find that the word KING is the dominant element in opposer's and applicant's marks. The word PHARMACEUTICALS is generic for both parties' goods, and has no source-indicating value. The word BIO in opposer's mark is at least descriptive, while the crown design in two of applicant's marks merely reinforce the word KING.

But it is not only because opposer's and applicant's marks have the same dominant word, KING, that they convey

⁹ There is also testimony that opposer has in the past used a crown design with the words, and may still be using it, but not for its mass market products.

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the same commercial impression. The marks look and sound alike as well. They all share KING as the first word and two of applicant's mark, as does opposer's mark, have PHARMACEUTICALS as the last word. We think it unlikely that, if used on identical goods which appear near each other on drugstore shelves, consumers are likely to even notice that the three letters BIO appear in opposer's mark between the words KING and PHARMACEUTICALS or are absent from applicant's mark. Even if consumers were to notice this difference, they are not likely to realize that the presence or absence of these letters indicates a separate source for the goods.

Applicant argues that opposer's mark is primarily merely a surname and, therefore is a weak mark. However, as we have previously stated, KING is not primarily merely a surname, in view of the commonly understood non-surname meaning of this word. Nor is there any evidence that there are KING marks being used by others in the pharmaceutical industry, such that we could conclude that consumers are accustomed to differentiating between various KING marks, and in particular would be able distinguish between opposer's and applicant's marks by the very minor differences we have discussed above. We recognize that KING has a suggestive laudatory

significance, such that it cannot be considered an arbitrary mark and accorded a broad scope of protection. Moreover, opposer's sales and advertising do not put its mark into the category of a well known or famous mark. However, even if we accord opposer's mark a relatively limited degree of protection, that protection still extends to the use of such similar marks as KING PHARMACEUTICALS, KING and crown design, and KING PHARMACEUTICALS and crown design for identical goods.

In addition to the foregoing, another factor favoring opposer is the fact that it uses KING BIO PHARMACEUTICALS as a house mark for a wide range of human and veterinary pharmaceuticals.

Accordingly, we find that applicant's use of its three applied-for marks for its identified goods is likely to cause confusion with opposer's mark KING BIO PHARMACEUTICALS for non-prescription homeopathic remedies. We would point out that in reaching this conclusion, we have not relied on the evidence of actual confusion submitted by opposer. Frank King, opposer's president, testified that he had received various inquiries as to whether there was a connection between opposer and applicant. The generalized nature of most of this testimony is not sufficient for us to find that

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there were instances of actual confusion. As for the more detailed testimony of specific instances of confusion, such instances do not show confusion by purchasers of the goods, but relate to misdirected mail by the U.S. Patent and Trademark Office, a solicitation for a charitable donation, and the leasing of equipment. On the other hand, we do not regard the lack of evidence of actual confusion as an indication that confusion is not likely to occur. Evidence of such confusion is notoriously difficult to obtain. In this case, the lack of confusion may be explained because of the actual differences in the parties' goods (that is, to this point opposer's goods are non-prescription and applicant's are prescription), differences that are not reflected in applicant's identification of goods.

Finally, we must address applicant's comment about opposer's "failure" to undertake a survey on likelihood of confusion. This Board has specifically stated that there is no requirement for a plaintiff to conduct such a survey, and that no negative inference will be drawn from a party's failure to offer survey evidence in a proceeding before the Board. **Hilson Research Inc. v. Society for Human Resource Management**, 27 USPQ2d 1423 (TTAB 1993).

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Decision: The opposition is sustained.