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OF THE TTAB

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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wyeth, by change of name from American Home Products
Corporation
v.
Fempro, Inc.

Opposition No. 91121800
to application Serial No. 75170167
filed on September 23, 1996

Marie V. Driscoll and John P. Margiotta of Fross Zelnick
Lehrman & Zissu, P.C. for opposer.

Thomas J. Moore of Bacon & Thomas, PLLC for applicant.

Before Simms, Chapman and Bottorff, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed on September 23, 1996 by
Fempro Inc. (a corporation of Canada) to register on the
Principal Register the mark shown below



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for goods amended to read as "feminine hygienic products, namely, panty liners, sanitary napkins, tampons, absorbent pads" in International Class 5. Upon requirement of the Examining Attorney, applicant included in the application the following statement: "The stippling in the drawing is for shading purposes only." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), and, in addition, applicant claimed priority under Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d), based on its Canadian Application Serial No. 821,380, filed August 22, 1996.

American Home Products Corporation (a Delaware corporation) (now Wyeth, by change of name) filed an opposition against this application, alleging that "opposer is and, through its Wyeth-Ayerst division, has long been a leader in the development and marketing of a variety of women's health products" (paragraph 1); that from a date prior to any date on which applicant can rely, opposer "has marketed under the mark PREMPRO a pharmaceutical product containing conjugated estrogens and medroxyprogesterone, intended for use in treating the symptoms of menopause and in the prevention of osteoporosis" (paragraph 2); that opposer has continuously used the mark PREMPRO, which has become a strong trademark entitled to a broad scope of

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protection; that applicant's mark FEMPRO and design, when used on or in connection with its goods, would so resemble opposer's previously used mark as to be likely to cause confusion, mistake, or deception; that opposer's mark is a famous trademark and became famous prior to applicant's first use of its mark; that PREMPRO is a strong and highly distinctive mark; and that applicant's use of its FEMPRO and design mark "causes and is likely to cause dilution of the distinctive quality of the PREMPRO trademark" (paragraph 12).¹

Applicant, in its answer, denies the salient allegations of the notice of opposition. Applicant also asserts the "affirmative defense" that opposer is estopped from asserting the mark PREMPRO in this opposition because opposer had applied to register the mark PREMPRO for "pharmaceutical preparation for use in female hormone replacement therapy" (Serial No. 74524810), but its application was opposed and then abandoned.

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Todd Law, a product director for opposer's Premarin family

¹ In its brief, opposer expressed the issue before the Board as that of likelihood of confusion. Opposer made no reference at all to the issue of dilution. The Board considers the issue of dilution to have been waived by opposer. In any event, in view of our decision on likelihood of confusion, we need not reach the issue of dilution.

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marketing team; applicant's eight notices of reliance on (1) certain of opposer's discovery responses to applicant's various discovery requests, (2) printouts of or from various printed publications, and (3) photocopies of the official records of opposer's application to register the mark PREMPRO and the opposition in which it was involved; and opposer's four notices of reliance on various printed publications and one Internet web site.

Both parties have filed briefs on the case; and both parties were represented at the oral hearing held before the Board on July 15, 2003.

Evidentiary Matters

First, we note that opposer's motion (filed October 25, 2002) to strike applicant's notices of reliance Nos. 3-8 was denied by Board order dated May 14, 2003.

Second, opposer has objected to three matters referenced in applicant's brief as not part of the evidentiary record: (1) Webster's Dictionary definitions of several terms; (2) reference to and purported quotes from a website identified by applicant as 4women.gov; and (3) Appendix A attached to applicant's brief, consisting of a several page "PACER Docket Report" for Case No. 95-CV-237, The Upjohn Company v. American Home Products Corporation, before the U.S. District Court for the Western District of Michigan.

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Opposer's objection to the dictionary references is overruled as the Board hereby takes judicial notice of those dictionary definitions. Opposer's objections to applicant's reference to the 4women.gov website and applicant's Appendix A (the "PACER Docket Report") are sustained because this material was not properly made of record during trial. See Trademark Rule 2.123(1); and *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, footnote 18 (TTAB 1984).

Applicant asserts (brief, p. 7) that the circumstances in this case make it appropriate for the Board to take judicial notice of the "information in the PACER system of the U.S. Federal Courts." We disagree. Applicant had the opportunity to submit testimony and other evidence during its trial period. Applicant chose to submit the eight notices of reliance mentioned above, but not including any testimony or other evidence relating to either the web site or the *Upjohn v. American Home Products* civil action. Accordingly, the 4women.gov web site and the PACER Docket Report were not considered in reaching our decision herein. We note that even if considered, these materials would not alter our decision regarding the registrability of applicant's mark.

The Parties

Opposer, Wyeth (formerly American Home Products Corporation), is a pharmaceutical company which makes both prescription and over-the-counter drugs. Some of its more famous over-the-counter pharmaceuticals include products sold under the brand names Chap Stick, Advil, Centrum, and Preparation H. Opposer is an industry leader in women's health care, including contraceptive products and hormone replacement therapy. Among many other prescription drugs, opposer offers a female hormone replacement therapy (HRT) sold by prescription under the mark PREMPRO. Opposer, like many other companies in this industry, makes a major, coordinated effort to bring prescription drugs to the over-the-counter market.

According to Todd Law, a product director for opposer's Premarin family marketing team,² who joined the company in 1990, PREMPRO is used to relieve menopausal symptoms such as

² For a better understanding of opposer's "Premarin family," we note that Mr. Todd Law explained that the PREMARIN family of products consists of PREMARIN tablets, PREMARIN vaginal cream, PREMPRO tablets, and PREMPHASE tablets. He testified PREMARIN was first used in 1942 and this hormone treatment is used for women who have had a hysterectomy; PREMPRO was first sold in April 1995 and this hormone treatment is used for women who have not had a hysterectomy; PREMPHASE (also first sold in 1995) is used in a similar way but in a cycled regiment (i. e., estrogen for 14 days, then estrogen plus progestin for 14 days). To be clear about the record, the opposition is based solely on opposer's asserted rights in the mark PREMPRO. Opposer did not plead rights in PREMARIN or any other additional marks in the notice of opposition and it did not argue same in its brief or at the oral hearing.

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night sweats and hot flashes, and it is used for vaginal atrophy and for protection from osteoporosis. Prior to the introduction of the single-tablet PREMPRO, certain patients requiring HRT needed to take two tablets consisting of a conjugated estrogen such as opposer's PREMARIN and a progestin. Opposer's PREMPRO product combines PREMARIN and a progestin in a single tablet, significantly increasing patient convenience and compliance.

This PREMPRO hormone replacement drug is generally sold in one month or three month supplies in the form of dial packs, blister packs, or in packages, all of which show the trademark appearing not only on the packaging for the dial packs or blister packs, but also on the dial pack/blister pack itself. (Opposer's exhibit Nos. 5 and 6.)

Approximately three million women take PREMPRO tablets on a daily basis. The average patient stays on opposer's PREMPRO drug for approximately 2.5 to 2.7 years. When the patient begins treatment on this drug and she is adjusting back to hormones, a common side effect of the drug is that the patient experiences irregular vaginal bleeding or spotting, and this can last from a few months to a year.

Opposer received FDA approval for this product in December 1994, and it was sold under the mark PREMPRO as of April 1995. Annual sales of opposer's PREMPRO products grew

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from about \$40 million in 1995 to over \$750 million (sales of its entire 'Premarin' line were \$2.1 billion in 2001).

Opposer has approximately 1,100 employees who work on the sales and marketing of the PREMPRO product. The sales force calls on approximately 40,000 physicians, about two-thirds are family practitioners and one-third are ob/gyn practitioners. Opposer sells its prescription drugs through pharmacies including those in grocery stores and large retail stores.

Advertising figures for 1995 were about \$30 million and growing to about \$75 million annually for the last four years. The product is advertised through print media (e.g., "Reader's Digest," "Good Housekeeping," "Ladies' Home Journal," "New England Journal of Medicine," "JAMA"), television, on the Internet, and through health care providers. The advertising and promotions are done as direct-to-consumer, to health care providers (e.g., patient brochures, display tent cards, patient starter kits, calendars, magnetic clips, scratch pads), to samples of the product (over \$4 million per year), to medical education; and about one-half of the advertising dollars are spent on direct-to-consumer type promotions. Opposer has a web site for www.prempro.com, which gets about 12,000 to 20,000 visitors per month; and opposer sponsors symposiums on

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women's health (targeting women of all ages), and PREMPRO displays are utilized at those symposiums.

Opposer plans to add to the PREMARIN family of products, all in the area of pharmaceuticals, and opposer has no plans to add products such as tampons and absorbent pads to this line. Opposer is not aware of any instances of actual confusion.

Applicant, Fempro Inc., makes feminine hygiene products, and has asserted a bona fide intention to sell panty liners, sanitary napkins, tampons, and absorbent pads under the mark FEMPRO and design. In response to opposer's interrogatory Nos. 3-5 (opposer's exhibit No. 25 to the Todd Law deposition) applicant stated that the mark "is intended to be used for feminine hygiene"; that the goods of applicant "are sold at the retail level in pharmacies, grocery stores, large retail outlets, national retail department stores" and "may be sold through the Internet ... [and/or] through a distributor, wholesaler"; and that "the purchasers may be anyone from adolescents to adults, male or female ... the users are adolescent and adult females." There is no evidence that applicant has commenced use of the mark for the identified goods.

Standing

Applicant argued in its brief that opposer has not established adequate standing to assert the mark PREMPRO

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because opposer "has admitted" that it uses the mark pursuant to a license from The Upjohn Company; that "the license is obviously non-exclusive, because Upjohn would hardly have sued for infringement of the mark PROVERA unless Upjohn intended to continue using the trademark PROVERA"; and that only an exclusive licensee can assert a trademark in an opposition. (Brief, pp. 18-19.)

Opposer contends that it has established standing through its sale of billions of dollars worth of its PREMPRO pharmaceutical; that applicant's conjecture about the agreement between Upjohn and opposer is exactly that-conjecture; that the agreement is not of record because it is confidential and can be produced only by court order, and applicant would not agree to a protective order; that, in any event, there is no limitation on standing only for exclusive licensees; and that the case cited by applicant involves not a licensee, but a United States distributor for a foreign entity.

Opposer's evidence clearly supports its standing to oppose registration of applicant's mark herein. It has established common law rights in the mark PREMPRO for a pharmaceutical product used to treat the symptoms of menopause. The fact that opposer responded to applicant's document request No. 12 (applicant's notice of reliance No. 3) with a reference to opposer's "license agreement with The

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Upjohn Company" does not negate opposer's standing. See William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1871, footnote 2 (TTAB 1994), and cases cited therein.

Priority

A party asserting a claim under Section 2(d) of the Trademark Act must establish prior use of a trademark (or service mark, or trade name or other indication of origin). See Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990); and Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Under the case of Otto Roth & Co. v. Universal Foods Corp., supra, 209 USPQ at 43, a plaintiff opposing registration of a trademark on the ground of likelihood of confusion with the plaintiff's own unregistered term cannot prevail unless the plaintiff shows its term is distinctive of its goods, either inherently, or through acquired distinctiveness.

In view of the absence of evidence to the contrary, we find that opposer's mark is inherently distinctive. With regard to the issue of priority and opposer's claim of common law rights in the mark PREMPRO for a female hormone replacement pharmaceutical product, the evidence establishes opposer's continuous use of the mark for these goods since 1995, which is prior to applicant's filing date of September

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23, 1996.³ Opposer has established its priority with regard to common law rights in the mark PREMPRO for a female hormone replacement pharmaceutical product.

Likelihood of Confusion

Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *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). Based on the record before us in this case, we find that confusion is likely.

Opposer contends (brief, p. 12) that the relevant du Pont factors in this case are the similarities or dissimilarities between the marks, the strength of opposer's mark, the relationship of the goods, the similar trade channels, the conditions under which and the buyers to whom sales are made, and the extent of third-party use, if any. Applicant argues (brief, p. 3) that the relevant factors are those asserted by opposer, as well as the additional factors

³ Applicant's application was originally based on two sections of the Trademark Act: Section 1(b) (intent-to-use) and Section 44(d) (foreign application--here, Canadian application Serial No. 821,380, filed August 22, 1996). During the ex parte prosecution of the application, applicant apparently chose not to submit the Canadian registration and dropped the foreign registration as a basis for its United States application. It appears that applicant so informed the Examining Attorney and he noted applicant's choice on his prior February 9, 2000 Office action.

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of actual confusion and "any other established fact probative of the effect of use."

We turn first to consideration of the similarities or dissimilarities of the marks. Opposer contends that its mark PREMPRO and the word portion -- that is, the dominant portion -- of applicant's mark, FEMPRO, are phonetically, visually and aurally similar. Applicant argues that the word portion of its mark FEMPRO connotes "feminine" and "professional," whereas, opposer's mark PREMPRO consists of the syllable "PREM" used in several of opposer's marks and the syllable "PRO" which connotes the trademark PROVERA owned by The Upjohn Company; that the dominant visual impression of applicant's mark is the design of the stylized leaf; and that the parties' respective marks create different commercial impressions.

It is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing Court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000);

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Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). In this case, the word portion of applicant's mark, FEMPRO, would be used by purchasers in calling for the products, thus, adding to the dominance of the word portion of this mark. Opposer has established common law rights in the word PREMPRO.⁴

While the differences described by applicant are accurate, we nonetheless find that these marks, PREMPRO and FEMPRO and design, are similar in sound, appearance and commercial impression. Inasmuch as the record includes Webster's Third New International Dictionary of the English language Unabridged (1986) definition of "fem" as "1. female, 2. feminine," applicant's mark is, at least in part, suggestive of the relation of the products to women. Both marks begin with the rhyming syllables "PREM" and "FEM," respectively, and both marks end in the same syllable, "PRO." While these marks do not connote the same specific meaning, nonetheless we find the difference in connotation and the design of the leaf and the square with stippling in applicant's mark, does not offer sufficient differences to

⁴ Although opposer sometimes uses PREMPRO with a design feature appearing above the word, the evidence clearly establishes opposer's use of the word PREMPRO alone for female hormone replacement prescription drugs. We will determine the question

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create a separate and distinct commercial impression. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

For the reasons discussed, we find that the marks are more similar than dissimilar.

Turning to the du Pont factor of the fame of opposer's mark, opposer has established that its mark PREMPRO for female hormone replacement therapy is famous within the meaning of the du Pont factors as shown by opposer's extensive sales (recently over \$700 million per year), advertising (around \$75 million per year), and the tremendous success and exponential growth of the PREMPRO

of likelihood of confusion based on opposer's rights in the word

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product from its launch in 1995 to 2002, with three million women taking the drug daily. Applicant has not contested opposer's claim that its mark is famous for purposes of the fifth du Pont factor; indeed, at the oral hearing applicant conceded such fame.

The fame of opposer's mark increases the likelihood that consumers will believe that applicant's goods emanate from or are sponsored by the same source. See *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys Inc. v. Rose Art Industries Inc.* 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As the Court stated in the Kenner Parker case at 22 USPQ2d at 1456:

A strong mark, on the other hand, casts a long shadow which competitors must avoid. See e.g., *Nina Ricci*, 889 F.2d at 1074.

Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls.

And the in the Recot case at 54 USPQ2d at 1897 the Court stated:

Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.

...

This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used

mark.

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with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive.

This factor, the fame of opposer's mark, weighs heavily in opposer's favor.

The next du Pont factor is the similarity or dissimilarity in the nature of the parties' goods, as identified in the application, and in connection with which opposer has shown prior use of its mark. Applicant essentially contends that the goods are "pharmaceuticals" and "paper products," and that opposer does not intend to offer such "paper products" in the future. (Brief, p. 10.) Applicant does not make "paper products" in the sense of printed matter and stationery, but rather applicant asserts an intention to make feminine hygienic products such as tampons and sanitary napkins.

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that

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could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *Chemical New York Corp. v. Conmar Form Systems Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *In re International Telephone and Telegraph Corporation*, 197 USPQ 910 (TTAB 1978).

Applicant's goods are identified as "feminine hygienic products, namely, panty liners, sanitary napkins, tampons, absorbent pads." Opposer has established prior common law rights in its mark for a prescription drug which is a female hormone replacement therapy used for the treatment of menopausal symptoms and to prevent osteoporosis, and one significant side effect thereof is vaginal bleeding and spotting. Applicant's products could be used to deal with that side effect of opposer's drug treatment. Applicant has not argued to the contrary; indeed, applicant conceded at the oral hearing that the parties' respective goods are complementary in this respect.

We find that these goods are complementary products in the field of women's health care; and while the goods are noncompetitive, they are closely associated. See *American Home Products Corporation v. USV Pharmaceutical Corporation*, 190 USPQ 357 (TTAB 1976); and *Sterling Drug Inc. v. The Merritt Corp.*, 119 USPQ 444 (TTAB 1958), *aff'd*, 125 USPQ 584 (CCPA 1960). See also, *Penwalt Corp. v. Center*

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Laboratories, Inc., 524 F.2d 235, 187 USPQ 599 (CCPA 1975); and Sterling Drug Inc. v. Sebring, 515 F.2d 1128, 185 USPQ 649 (CCPA 1975).

That is, there is a commercially significant relationship between opposer's hormone replacement drugs relating to the treatment of menopausal symptoms and applicant's feminine hygienic products, such as sanitary napkins and tampons. See Hewlett-Packard Company v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services"); and Recot Inc. v. M.C. Becton, supra, 54 USPQ2d at 1898("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.").

Applicant urges that the goods are not sold in the same trade channels, and that each purchasing decision is carefully made. However, applicant's identification of goods is not limited in any way as to trade channels. Moreover, applicant stated in answering interrogatories that it will sell its products in pharmacies, grocery stores and

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large retail stores (which have pharmacies therein), and may sell its goods over the Internet. Opposer's product is sold at pharmacies and over the Internet. Opposer advertises nationwide in all types of media, and if applicant commences use and advertising of this product under this mark, it will, of necessity, be advertised in places and manners where opposer advertises. Both parties' products are directed to women consumers. The parties' respective goods travel in overlapping trade channels to the same classes of purchasers.

Regarding the care purchasers would use in buying these goods, we agree with applicant that certainly the purchase of prescription drugs is made with a degree of care and in consultation with a physician. Further, we will assume that applicant is correct (even absent evidence) that purchasers of its goods also exercise care because of the sensitive nature of applicant's feminine hygienic products, and because failure of the product to achieve its intended purpose could cause physical and emotional discomfort to the woman using it. Thus, we find that purchasers would exercise at least some degree of care in purchasing applicant's goods, and they would exercise an even higher degree of care in purchasing opposer's prescription drug.

The record is devoid of any evidence of any relevant third-party uses. Applicant agrees that "there is no

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evidence of the extent of use of 'fem' or 'pro' in the relevant trade," but argues that the record does show opposer uses "prem' as the first syllable of a family of marks, and that The Upjohn Company uses "pro" as the first syllable of its mark (PROVERA). Applicant further argues that it "does not have the burden to show that other parties are using marks that comprise 'fem,' 'prem' or 'pro.' Rather, Opposer has the burden of proof, and has the burden to submit relevant evidence during the trial." (Brief, p. 14.)

While opposer bears the burden of proof in establishing its claim of priority and likelihood of confusion, opposer is under no obligation to submit evidence on du Pont factors which might favor applicant. If applicant wanted evidence on this factor to be of record in the case, it was free to present such evidence at trial in defense of opposer's claim. Applicant did not do so.

Applicant also argues that there have been no instances of actual confusion, as established by opposer's answers to certain of applicant's discovery requests (made of record by applicant's notices of reliance), indicating that opposer was not then aware of any instances of actual confusion. However, importantly in this case, applicant's application is based on applicant's assertion of a bona fide intention to use the mark in commerce, and there is no evidence that

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applicant has commenced use in the United States of this mark for the identified goods. Thus, the absence of actual confusion is not surprising, and this du Pont factor is neutral. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

In balancing the du Pont factors in this case, we keep in mind the holding of our primary reviewing Court that fame, when present, plays a "dominant" role in determining the question of likelihood of confusion. For example, in the Recot case at 54 USPQ2d at 1897 and 1898 the Court stated:

The fifth *DuPont* factor, fame of the prior mark, when present, plays a "dominant" role in the process of balancing the *DuPont* factors. Famous marks thus enjoy a wide latitude of legal protection. (Citations omitted.)

...

Accordingly, we hold that the fame of the mark must always be accorded full weight when determining likelihood of confusion.

...

Indeed, this court and its predecessor court have consistently stated that the fame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods.

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Given the fame of opposer's mark, and the long shadow it casts, we find that the marks and the goods are sufficiently similar to support a finding of likelihood of confusion. (And in this case it is also established that there are overlapping trade channels and similar purchasers.)

To the extent we have doubt as to the presence of likelihood of confusion, we resolve that doubt against the newcomer (applicant) and in favor of the prior user (opposer). See *In re Pneumatiques, Caoutchouc Manufacture*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973) ("If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant.") See also, *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *In re Hyper Shoppes*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290-1291 (Fed. Cir. 1984).

Unclean Hands Defense

Applicant contends that opposer is barred from bringing this opposition and/or obtaining any relief under the

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opposition because it asserts opposer is guilty of "unclean hands." Specifically, applicant contends that opposer adopted the mark PREMPRO "to intentionally confuse patients into a mistaken belief that the PREMPRO pharmaceutical contained both the PREMARIN pharmaceutical and the PROVERA pharmaceutical"; that The Upjohn Company sued opposer which resulted in a preliminary injunction against opposer; and that opposer's "[intentional] false statements to patients should bar Wyeth from enforcing any alleged common law rights in the trademark PREMPRO." (Brief, p. 19.)

First, this defense was not pleaded by applicant. Second, there is virtually no evidence of record thereon. Although applicant cites to its notice of reliance No. 6, which consists of photocopies of the papers comprising the file history of Opposition No. 97,402 (The Upjohn Company v. American Home Products Corporation), in that opposition (based on Upjohn's mark PROVERA), the applicant (opposer's predecessor) filed an abandonment without prejudice, of its application for the mark PREMPRO, with Upjohn's written consent and Upjohn filed a withdrawal, without prejudice, of its opposition, with that applicant's written consent. This simply resulted in a Board order holding that application abandoned, and that opposition dismissed. In addition, the complaint from the civil action between Upjohn and American Home Products was included as part of the record of the

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opposition proceeding. But there is otherwise no information of record about the civil suit, with the exception of the PACER Docket Record. While we have not considered the PACER Docket Record, as discussed above, we note that applicant makes much of the entry thereon relating to a preliminary injunction issued on April 6, 1996. However, the PACER Docket Record also indicates an appeal to the Court of Appeals for the Federal Circuit (May 6, 1996), a stipulation and order to dismiss the case without prejudice on May 20, 1996, and a voluntary dismissal of the appeal to the Court of Appeals for the Federal Circuit on May 28, 1996.

The record before us includes essentially no evidence of actions by opposer amounting to unclean hands; and therefore, applicant's unclean hands defense must fail. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, footnote 4 (TTAB 1989), aff'd unpub'd, but appearing at 17 USPQ2d 1726 (Fed. Cir. 1990).

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

Simms, Administrative Trademark Judge, dissenting:

First, I agree with the majority that opposer's claim of dilution should be dismissed because opposer failed to argue this ground of opposition in its brief. Also, I agree

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that opposer has established its standing and priority of use of its common law mark PREMPRO. Opposer does not own a federal registration of this mark. Applicant's unclean hands defense is impermissible and without merit.

I would dismiss the opposition because confusion is unlikely. I conclude that there is no likelihood of confusion because of the cumulative differences in the marks and goods, and, while opposer's drugs may be sold in the same stores as applicant's sanitary napkins and other goods, the goods of the parties are or will be sold for completely different purposes under completely different conditions to largely different classes of purchasers.

First, as to the marks, I disagree with the conclusion of the majority that these marks are similar in sound, appearance and commercial impression and that they are not sufficiently different to create separate and distinct commercial impressions. To the contrary, while PREMPRO and FEMPRO, the dominant part of applicant's mark, are rhyming words, they are otherwise sufficiently different in sound, appearance and meaning. The marks begin with different letters (PR- vs. F-), which is a significant difference. Of course, while a word mark must be considered as a whole, the first syllable of a mark is the first to impress the purchaser and is often considered more significant in making a commercial impression than the last syllable or the suffix

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of a mark. These different letters in the marks lead to different pronunciations and to different visual appearances of the marks. Equally important, as the majority seems to acknowledge, the marks have different suggestive meanings or connotations. The "FEM-" part of applicant's mark suggests "female" or "feminine," while "-PRO" suffix perhaps suggests "professional." This is different from the suggestion or connotation of opposer's mark, with "PREM-" suggesting perhaps "premium" or, to those knowledgeable about opposer's PREMARIN family of products, the "PREM-" prefix of opposer's marks (PREMARIN, PREMPHASE and PREMPRO), while the suffix "-PRO" may suggest progestin also contained in the tablets.⁵ Indeed, opposer does not argue that the respective marks are confusingly similar because of any similarity in meaning or connotation. Reply brief, 3. Also, while purchasers' memories are not infallible, users of opposer's hormone replacement tablets consume them daily for two or three years and are unlikely under those circumstances to forget the drug they are taking is PREMPRO and not FEMPRO. I conclude that opposer's mark PREMPRO is sufficiently distinguishable from applicant's mark FEMPRO and, in particular, the mark here sought to be registered:

⁵ Opposer sometimes prominently uses the marks PREMARIN and PREMPRO together in its advertising and promotional materials.



Contrary to the majority's conclusion, I believe these two marks clearly create separate and distinct commercial impressions.

As to the goods, it is not sufficient in my view that both opposer's drugs and applicant's feminine hygienic products can be categorized as "women's health care products" or as "related to women's health." Opposer's hormone replacement prescription tablets are different in a number of significant ways from applicant's sanitary napkins, tampons, absorbent pads, etc. First, opposer's drugs are prescribed by doctors or physicians after consultation with the patient and are dispensed by pharmacists at drug counters. They are purchased with considerable care. They are prescribed for the purpose of alleviating certain symptoms of menopause in postmenopausal women by replacing hormones lost during menopause and to prevent osteoporosis. These hormone replacement tablets

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are, therefore, intended for older women. Applicant's sanitary napkins, tampons, panty liners and absorbent pads, on the other hand, are for younger women who are experiencing menstruation ("adolescent and adult females," according to the record). They are sold over the counter for completely different purposes to a largely different age group of women. Therefore, and contrary to the majority's statements that these goods are complementary and closely associated products sold to the same or similar class of purchasers, I believe that these goods are largely unrelated and, for the most part, sold to a completely different segment of women purchasers for completely different purposes.

It is true that, according to opposer's record, about one in five of opposer's PREMPRO users may experience, as a side effect, irregular vaginal bleeding for the first two or three (or several) months of use of the PREMPRO tablets, and that these users may need a product similar to those which applicant intends to sell. However, rather than concluding, as the majority has, that opposer's hormone replacement tablets and applicant's feminine hygienic products have a commercially significant relationship, I believe that the relationship between opposer's drug tablets and applicant's sanitary napkins, tampons, absorbent pads, etc., is largely tangential and incidental. Any overlap in consumers is too

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small and coincidental to be significant. Also, in any likelihood of confusion case, we are concerned with more than the mere possibility of confusion, or a situation that may lead to de minimis confusion. See, for example, *Bongrain International (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987) ("The statute refers to likelihood, not the mere possibility of confusion").

Further, while these goods may be sold in the same grocery, drug and retail stores, such stores sell a wide variety of goods, and the fact that opposer's drugs and applicant's hygienic products may be sold in the same stores is not determinative. The respective goods are sold in different sections of these stores--at the drug counter, on the one hand, and in an aisle that may sell such other goods as hair care products, toothpaste, first aid products, shaving cream and cold and flu medicine, on the other.

As the majority has observed, opposer's sales of PREMPRO tablets in 2001 were around \$700 million, with advertising and promotional expenditures around \$75 million. About one-third to one-half of these expenditures are geared to the general public in such media as television and magazines. Opposer's mark is a very strong, if not famous, one in the hormone replacement field, and the PREMPRO mark is said to be the leader in its drug category. About three

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million women take PREMPRO tablets daily. According to the record, a typical user may take these tablets for two to three years. However, while fame may play a dominant role, this does not mean that we must inevitably find confusion in all cases involving famous marks and, in so doing, disregard or give insufficient weight to the remaining relevant du Pont factors.

It is noteworthy that the record contains no evidence of, for example, joint promotion of prescription hormone replacement pharmaceuticals with feminine hygienic products similar to applicant's. Nor has opposer shown that either it or its competitors offer hormone replacement tablets and feminine hygienic products under the same mark. Such evidence could help demonstrate that the public is accustomed to encountering such products bearing the same mark in the marketplace. Rather, opposer has only pointed to certain drugs which have moved from the prescription arena to over-the-counter medication (ORUDIS and ORUDIS KT, AXID and AXID AR, for example), and pharmaceutical companies making or selling products to complement their prescription goods under slightly different marks (ROGAINE hair growth treatment and PROGRAINE shampoo). This evidence is inadequate to show that the relevant consumers are likely to expect that hormone replacement drugs and such goods as

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sanitary napkins and tampons are or will come from the same source.

Finally, while the record contains no examples of third-party marks similar to opposer's, a review of the ex parte examination of applicant's application reveals that the Examining Attorney initially refused to register applicant's mark under Section 2(d) of the Act on the basis of the registered mark PROFEM for hormonal preparations (Registration No. 814,333, issued September 6, 1966, renewed). That refusal was eventually withdrawn in the face of applicant's argument that applicant's feminine hygienic products are not used to treat conditions which require hormonal preparations.

For the reasons indicated above, I would find that applicant's FEMPRO and design mark for its feminine hygienic products does not so resemble opposer's PREMPRO mark used for female prescription hormone replacement tablets as to be likely to cause confusion. Accordingly, I would dismiss the opposition.