Mailed: June 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Genzyme Corporation
v.
Hilali Noordeen

Opposition Nos. 91264008 and 91265657[1]

Richard Lehv and Kimberly B. Frumkin of Fross Zelnick Lehrman & Zissu, P.C., for Genzyme Corporation.

Gregory B. Phillips and Alexander G. Trimes of Knobbe Martens Olson & Bear, LLP for Hilali Noordeen.

Before Zervas, Goodman and Pologeorgis, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

[1] On January 14, 2021, the Board consolidated proceedings, for presentation on the same record and briefs. Opposition No. 91264008 was designated as the "parent" case. 10 TTABVUE.

Citations in this opinion refer to TTABVUE, the Board's online docketing system. *See Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number for Opposition No. 91264008, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

Hilali Nordeen ("Applicant") seeks to register the mark REGENAL, in standard characters, on the Principal Register for "pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements" in International Class 5.[2] Applicant also seeks to register the mark REGENALL on the Principal Register for "pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements; none of the aforementioned in relation to the treatment of skin or complexion or in relation to the treatment of livers" in International Class 5.[3]

Genzyme Corporation ("Opposer") filed Notices of Opposition opposing registration of Applicant's marks on the sole ground of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer pleaded (i) prior common law rights in the mark RENAGEL in connection with "pharmaceuticals, namely, phosphate binders for treatment of hyperphosphatemia";[4] and (ii) ownership of Registration No. 1978935 for mark RENAGEL for "phosphate binders for treatment of hyperphosphatemia" in International Class 5.[5]

[2] Application No. 88361290, the subject of Opposition No. 91264008, was filed on March 28, 2019 and seeks registration pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. § 1126, based on a United Kingdom registration.

[3] Application No. 88361302, the subject of Opposition No. 91243796, was filed on March 28, 2019 seeks registration pursuant to Section 44(e) of the Trademark Act, 15 U.S.C. §1126, based on a United Kingdom registration.

[4] Notice of Opposition ¶1, 1 TTABVUE 3.

[5] Registration No. 1978935 registered on June 4, 1996 and has been twice renewed.

Applicant denied the salient allegations of the Notices of Opposition in its Answers.[6]

I. Trial Record

In addition to the pleadings, the trial record automatically includes the file history of the involved applications pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). The trial record also contains:

1. Opposer's Notice of Reliance and exhibits. (19 TTABVUE.)

2. Opposer's Trial Declaration of Onur Sebzeci, Director of Growth Initiatives of Opposer's parent corporation ("Sanofi"), and exhibits. (19 (confidential version)-20 (non-confidential version) TTABVUE.)

3. Opposer's Notice of Reliance and exhibits. (21 TTABVUE.)

4. Applicant's Notices of Reliance and exhibits attached thereto. (22-23 TTABVUE.)

5. Applicant's Trial Declaration of Dr. Hilali Noordeen, dated June 15, 2022. (24-25 TTABVUE.)

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Chutter, Inc. v. Great Mgmt. Grp.*, LLC, 2021 USPQ2d 1001, at *10 (TTAB 2021); *see also Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671

[6] 8 TTABVUE.

(2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *reh'g en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *cert. denied*, 142 U.S. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388 at *1 (TTAB 2020) (citing *Corcamore*, 2020 USPQ2d 11277, at *4); *see also Empresa Cubana*, 111 USPQ2d at 1062.

Opposer's entitlement to oppose registration of Applicant's marks is established by its pleaded registration, which Opposer has entered into the record, showing Opposer's ownership and active status.[7] *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing). Mr. Sebzeci testified as well as to the registration's active status and Opposer's ownership thereof. Applicant does not dispute Opposer's entitlement to a statutory cause of action.

III. Priority

Because Opposer's pleaded registration is of record and there is no pending counterclaim to cancel the registration, priority is not at issue with respect to the mark and goods covered by the registration. *See King Candy Co. v. Eunice King's*

[7] 21 TTABVUE 4-11.

Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998).

IV. Likelihood of Confusion

Our determination of Opposer's claim of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *see also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §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, 29 (CCPA 1976). We discuss below these and other relevant factors. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence and argument).

We keep in mind that "where the marks are used on pharmaceuticals and confusion as to source can lead to serious consequences, it is extremely important to avoid that which will cause confusion." *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).[8]

[8] J. Thomas McCarthy, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:32 (5th ed. 2023), states,

> The tests of confusing similarity are modified when the goods involved are medicinal products. Confusion of source or product between medicinal products may produce physically harmful

A. The "fame of the prior mark" and the "number and nature of similar marks in use on similar goods

We next turn to the *DuPont* factors known as the fifth *DuPont* factor, *i.e.*, the "fame of the prior mark (sales, advertising, length of use)," *DuPont*, 177 USPQ at 567, and the sixth *DuPont* factor, *i.e.*, the "number and nature of similar marks in use on similar goods." *Id*. We do so because both factors bear on the strength of Opposer's RENAGEL mark and the scope of protection to which it is entitled.

Opposer argues that its mark is a strong mark because "[t]he RENAGEL mark does not describe or suggest any characteristics or qualities of the recited goods in the RENAGEL registration," and "Opposer and its predecessor-in-interest has continuously used the RENAGEL Mark for almost three decades … generat[ing] approximately $... in sales between March 2015 and February 2022 throughout the entirety of the United States ... [and] market[ing] its RENAGEL product through the website renvela.com and through the Sanofi.com website."[9] (italics removed).

1. The Fifth *DuPont* Factor

"Fame of an opposer's mark, if it exists, plays a 'dominant role in the process of balancing the *DuPont* factors.'" *Palm Bay Imps. v. Veuve Cliquot Ponsardin Maison*

> results to purchasers and greater protection is required than in the ordinary case. If the goods involved are medicinal products each with different effects and designed for even subtly different uses, confusion among the products caused by similar marks could have disastrous effects. For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations.

[9] Opposer's brief, 26 TTABVUE 21. The dollar amount has been designated confidential so we do not reveal it.

Fondee en 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). (quoting *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). "A mark 'with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark," *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018) (quoting *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)), and a "very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis." *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (citing *Palm Bay Imps.*, 73 USPQ2d at 1694).

"[L]ikelihood of confusion fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). In placing Opposer's mark on that spectrum, our "applicable viewpoint is that of the relevant market." *Id.* (citing *Palm Bay Imps.*, 73 USPQ2d at 1694 ("Fame for confusion purposes arises as long as a significant portion of the relevant consuming public … recognizes the mark as a source indicator," and "a mark's renown within a specific product market is the proper standard.")). "Because of the wide latitude of legal protection accorded a famous mark and the dominant role fame plays in the likelihood of confusion analysis, the party asserting fame must clearly prove it." *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1353 (TTAB 2014).

"In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of

marketplace recognition of the mark, its commercial strength." N*ew Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *10 (TTAB 2020); *see also In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength …"); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength).

a. Inherent or Conceptual Strength

The inherent or conceptual strength of Opposer's mark is not at issue. Opposer's Mark for its listed goods is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. *See Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006)). Registrations on the Principal Register are entitled to all of the presumptions, including validity, afforded by Section 7(b) of the Trademark Act, 15 U.S.C. 1057(b).

Applicant offers no argument regarding the inherent or conceptual strength of Opposer's mark. Applicant states, however, in his discussion of the first *DuPont* factor that "Applicant's Marks contain the recognizable element 'regen-,' as in 'regenerate,' and, in the case of the REGENALL mark, the word 'all.' Opposer's Mark, on the other hand, contains the element 'rena-,' as in 'renal' (relating to the kidneys), and the word 'gel.'"[10]

[10] Applicant's brief, 28 TTABVUE 15.

Although RENAGEL is a coined term, we acknowledge that "rena-" is proximate to "renal," and "renal" means "relating to, involving, affecting, or located in the region of the kidneys."[11] To those who make the connection, the term will suggest that the identified goods pertain to the kidneys and perhaps chronic kidney disease. Applicant, however, has not provided any evidence that consumers will make that connection, and has not identified any significance of the term GEL for "phosphate binders for treatment of hyperphosphatemia." When considered as a whole, we find that the mark is an arbitrary coined term and hence an inherently strong mark.

b. Commercial Strength

"Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source." *New Era,* 2020 USPQ2d 10596, at *10. It "may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark," and may be "supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services." *Id*. at *10-11. Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, Opposer has the duty to prove the fame of its mark clearly. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed.

[11] We take judicial notice of this definition, accessed at https://www.merriam-webster.com/dictionary/renal on May 15, 2023.

Cir. 2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

Mr. Sebzeci testified:

> 15. The RENAGEL product is promoted on the website www.renvela.com as well as on the Sanofi website, www.sanofi.com. ...
>
> 16. Sales of the product for the past five years are provided on Exhibit F, and are marked HIGHLY CONFIDENTIAL, ATTORNEYS' EYES ONLY.[12]

Mr. Sebzeci has not indicated whether the figures presented in Exhibit F reflect global sales or only sales in the United States. They hence have limited probative value.[13] Further, there is no information regarding Opposer's market share of pharmaceutical preparations identified in its identification of goods – its information must be placed in context (e.g., a comparison of advertising figures with competitive products or services, market share, reputation of the product or service, etc.). *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002). Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of Opposer's mark into context. *Id.* There are no advertising figures, and no notice by independent sources of the goods identified by the mark or the general reputation of the goods. With regard to Opposer's efforts on the two noted websites, there is no indication of the number of visitors to those websites. On this record, we find that Opposer's mark does not fall on the very strong

[12] 20 TTABVUE 4.

[13] Opposer states in its brief that the figures represent sales in the United States, but that is not reflected in any evidence.

end of the fame spectrum and, therefore, is entitled to no more than "the normal scope of protection to which inherently distinctive marks are entitled." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

2. The Sixth *DuPont* Factor

In connection with "'[t]he number and nature of similar marks in use on similar goods,'" *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *DuPont*, 177 USPQ at 567), "[t]he Federal Circuit has held that evidence of the extensive registration and use of a term by others can be powerful evidence of the term's weakness." *Tao Licensing*, 125 USPQ2d at 1075 (citing *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). "Use evidence may reflect commercial weakness, while third-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services." *Id*. The "controlling inquiry is the extent of third-party marks in use on 'similar' goods or services." *Omaha Steaks*, 128 USPQ2d at 1694 (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)).

Applicant relies on 40 third-party registrations and 10 third-party uses to demonstrate that Opposer's mark is entitled to a limited scope of protection. *See*, *e.g.*:[14]

[14] *See*, *e.g.*, 23 TTABVUE 9-311.

Reg. No.	Mark	Goods
1923240	REGENRX	Homeopathic pharmaceutical preparations for the treatment of glandular, organ, and other such body dysfunctions
2265366	REGENESIS	medical devices for inducing cell proliferation, namely, for stimulating angiogenesis, soft tissue regeneration and wound healing, and related documentation and manuals shipped with the goods as a unit therewith
2373636	REGENECARE	wound dressing liquid hydrogel containing aloe vera, glycerin, collagen and vitamin E
2443165	REGENICEL	medicated healing ointment for use in the treatment of minor cuts, scrapes and burns
2405341	REGENAFIL	Malleable, solid, semi-solid, gel or paste compositions formed from bone or tissue, namely, bone, bone derivatives, cartilage, cartilage derivatives, gelatin, growth factors, and combinations thereof for filling defects in bone and orthoses
3922275	REGENLAB	Pharmaceutical and veterinary preparations, namely, solutions for application on and under tissue, bone and organ for the purpose of promoting cellular regeneration, tissue adhesion, wound healing, bone or periodontum growth and bone, organ or tissue regeneration; sanitary preparations for medical purposes; adjuvants for medical purposes; pharmaceutical skin lotions; tissues impregnated with pharmaceutical lotions for the treatment of damaged skin and tissue; medical dressings; surgical tissues; medicated skin care preparations; pharmaceutical preparations and substances for the treatment of damaged skin and tissue; products and preparations for medical purposes for cleaning the skin; Allograft tissue reconstitution solution kits; cells for medical or clinical purposes; disinfectants for sanitary purposes; disinfectants for hygiene purposes; human, plant and animal cells and human, plant and animal tissues for use as anti-aging agent or skin repairing agent such as a scar repairing agent, lipoatrophy repairing agent, a wrinkle filling and repairing agent, for esthetic preparation, aging management, volume corrector and hair stimulator

Reg. No.	Mark	Goods
3995805	REGENCELL	medical apparatus for taking, administering or manipulating blood; containers for storing and transporting cells for medical purposes; instruments for medical injections with needles medical apparatus for taking blood; medical apparatus for taking blood samples; apparatus for separating blood components for medical purposes
4778232	REGENAVATE	Human allograft materials comprised of demineralized bone matrix for subsequent dental implantation

Applicant also submitted webpages showing the following uses:[15]

Mark	Goods/Services
REGENESIS BIOMEDICAL	Pharmaceutical sales
REGENECARE	Wound care gel
REGENATIVE	"A proprietary blend of highly bioavailable native whey proteins with supporting micronutrients."
REGENEXX	supplements
REGENACYN	Scar management solution
REGENERA	supplements

Most of these marks are dissimilar to Opposer's mark, or pertain to unrelated goods, and hence are irrelevant to the sixth *DuPont* factor. Twelve marks are for treatment of COVID-19 and related respiratory issues, with all but one including "COV" within the mark.[16] None of the marks end with the letters "GEL," and only five end with the letter "L." Three of those, REGENESOL,[17] REGENAFIL,[18] and

[15] 23 and 24 TTABVUE.

[16] *See* Applicant's Exhs. 47-58, 25 TTABVUE 35-79.

[17] Applicant's Exh. 36, 24 TTABVUE 124-38.

[18] Applicant's Exh. 12, 23 TTABVUE 104-49.

REGENICEL,[19] have four syllables, while Opposer's mark contains three syllables. Two marks, REGENSEAL,[20] and REGENCELL,[21] have more letters, and different letters, than found in the parties' marks, and sound very different from RENAGEL. With regard to the goods, twelve are for treatment of COVID-19,[22] three are for medical devices and apparatuses,[23] and others are for medical issues unrelated to Opposer's goods.

Because there is no significant evidence of use of similar marks on similar goods in the marketplace, we find the sixth *DuPont* factor to be neutral in our analysis of the likelihood of confusion.

B. The Similarity or Dissimilarity of the Marks

We turn now to the *DuPont* factor concerning the similarities or dissimilarities of the marks (known as the first *DuPont* factor), and compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression." *Palm Bay Imps.*, 73 USPQ2d at 1692. While marks must be compared in their entireties and the analysis cannot be predicated on dissecting the marks into their various components, different features may be analyzed to determine whether the marks are similar. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ

[19] Applicant's Exh. 11, 23 TTABVUE 92-103.

[20] Applicant's Exh. 28, 24 TTABVUE 61-4.

[21] Applicant's Exh.17, 23 TTABVUE 214-39.

[22] Applicant's Exhs. 47-58, 25 TTABVUE 35-79.

[23] Applicant's Exhs. 7, 13, 17, 23 TTABVUE 28-59, 150-174, 214-239.

233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See*, *e.g.*, *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Nat'l Data Corp.,* 224 USPQ at 751.

Similarity in any one of the elements of sound, appearance, meaning, or commercial impression is sufficient to support a determination of likelihood of confusion. *See*, *e.g.*, *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1519 (TTAB 2009).

Turning first to Opposer's RENAGEL mark and Applicant's REGENAL mark, the marks have the same number of letters and the same letters. Both are three-syllable marks, and both begin with the letters "re" and end with a letter "l." The last two letters in each mark may be pronounce similarly. In addition, the marks are standard character form marks and hence may be displayed in the same font, size and color. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("may be

presented in any font style, size or color, including the same font, size and color as the literal portions of Applicant's mark.").

The middle of each mark is where the more important differences lie – Opposer's mark has NAG and Applicant has the letters GEN. This difference in the middle of the marks may be missed by purchasers. *See Alfacell v. Anticancer Inc.*, 71 USPQ2d at 1305 (involving the marks ONCASE v. ONCONASE, stating, "[a]s seen and spoken, this middle portion may be missed by many of the relevant purchasers."). While a close side-by-side comparison of the marks could reveal the differences between them, that is not the proper way to determine likelihood of confusion, as that is not the way customers will view the marks in the marketplace. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *see also In re Solar Energy Corp.*, 217 USPQ 743, 745 (TTAB 1983) and cases cited therein; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016). In addition, we bear in mind that the "marks 'must be considered … in light of the fallibility of memory.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)). We thus find these marks to be similar in appearance and sound.

When considered as a whole, the differences in Opposer's REGENAL mark and Applicant's RENAGEL mark create only slight differences in appearance and sound – slight differences in appearance and sound as we have here do not normally create dissimilar marks. *See Alfacell v. Anticancer*, 71 USPQ2d at 1305 ("As seen and

spoken, this middle portion [ONCASE v. ONCONASE] may be missed by many of the relevant purchasers."); *Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 173 USPQ 19 (CCPA 1972) (MYOCHOLINE for a medicinal preparation for treatment of dysphagia, abdominal distention, gastric retention, and urinary retention similar to MYSOLINE for an anti-convulsant drug); *Mag Instr. Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1714-15 (TTAB 2010) (difference of a single letter does not suffice to distinguish MAG STAR from MAXSTAR).

Turning next to Applicant's REGENALL mark, the addition of a second letter "L" creates an additional point of difference between the parties' marks. Applicant's mark contains the English word "all" in its terminal portion, which Opposer's mark does not. This is a minor difference when weighed against the similarities between the marks and because the word ALL is integral with the remainder of the single-term mark. We therefore find that overall, the marks are similar in appearance.

With regard to sound, Applicant's marks REGENALL and REGENAL have the same sound. Thus, for the reasons set forth in our discussion above regarding the REGENAL and RENAGEL marks, we find RENAGEL and the REGENALL mark to be similar in sound as well.

That brings us to the meaning or commercial impression of REGENAL, REGENALL and RENAGEL. Applicant argues:

> The "regen-" component of Applicant's Marks is meant to evoke the concept of regeneration, as the products to be offered under those marks aid in the regeneration of skin tissue. Noordeen Decl. ¶ 5 (25 TTABVUE 81).
>
> [E]ach of the marks contains recognizable words, in part or in whole, that immediately distinguish the marks from

> each other. Applicant's Marks contain the recognizable element "regen-," as in "regenerate," and, in the case of the REGENALL mark, the word "all." Opposer's Mark, on the other hand, contains the element "rena-," as in "renal" (relating to the kidneys), and the word "gel."[24]

Applicant's argument is speculative because there is no input from purchasers, the group we focus on in determining likelihood of confusion.[25] There is no evidence that they recognize "regen" as invoking regeneration, "rena" as evoking "renal," and "gel" as a distinct element of the mark. Applicant's testimony at Paragraph 5 of his declaration does not say anything about how purchasers perceive the connotation or commercial impression of Applicant's mark, and naturally is biased in Applicant's favor.[26]

In addition, as previously stated, we must consider the marks as a whole and may not dissect them into component parts. *See Franklin Mint v. Master Mfg.*, 212 USPQ at 234 ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). We find that on this record, all three marks have no particular connotation and would be perceived as coined terms. Their commercial impression is similar, due to their lack of any particular meaning and similarities in appearance and sound.

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[24] 28 TTABVUE 14-15.

[25] "Attorney argument is no substitute for evidence." *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005); *see also Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018).

[26] Applicant states at Paragraph 5 of his declaration, "The 'regen' component of the marks REGENAL and REGENALL is meant to evoke the concept of regeneration, the medicinal drug and nutritional supplement aid in the regeneration for skin tissue." 25 TTABVUE 81.

In view of the above, we find that the similarities of the marks outweigh their differences, and the *DuPont* factor concerning the similarity of the marks favors a finding of likelihood of confusion between Opposer's RENAGEL mark and each of Applicant's REGENAL and REGENALL marks.

C. Similarity of Goods

We next consider the *DuPont* factors concerning the "similarity or dissimilarity and nature of the goods or services as described in an application or registration" and the "similarity or dissimilarity of established, likely-to-continue trade channels." *DuPont*, 177 USPQ at 567. We make our determinations concerning these factors based on the goods as they are identified in the opposed applications and the asserted registration. *See In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

It is settled that the respective goods at issue need not be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis under the *DuPont* factor regarding the goods. "Even if the goods … 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 …." *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 at 1004 (Fed. Cir. 2002). The issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. The goods need only be sufficiently related that consumers would be likely to assume, upon encountering the

goods marketed under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 1492 (TTAB 2007).

Opposer's goods are "phosphate binders for treatment of hyperphosphatemia." "Hyperphosphatemia is an electrolyte disorder, which results in elevated levels of phosphate in the patient's blood."[27] "RENAGEL is a phosphate binding medication used to treat hyperphosphatemia in patients with chronic kidney disease."[28] Applicant's goods are (i) "pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements"; and (ii) "pharmaceutical preparations for the treatment of damaged or injured tissue; nutritional supplements; none of the aforementioned in relation to the treatment of skin or complexion or in relation to the treatment of livers."[29] The limitation, "none of the aforementioned in relation to the treatment of skin or complexion or in relation to the treatment of livers" has no effect on the issues we address in this opinion because Opposer's goods do not concern the skin or complexion or livers.

[27] Sebzeci Decl. ¶ 7, 20 TTABVUE 3.

[28] *Id*.

[29] "Preparation" is defined in relevant part as "something that is prepared *specifically* : a medicinal substance made ready for use." (https://www.merriam-webster.com/dictionary/preparation, accessed on May 2, 2023.) The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). We take judicial notice of this definition.

There is no dispute that both parties' goods are medications.[30] The identifications specify that both medications are used for a "treatment," defined as "the action or way of treating a patient or a condition medically …."[31] It after this, however, where the parties part ways.

Opposer contends that its goods are intended as a treatment for a chronic kidney condition; and that "Applicant's broadly worded Applications include no limitations excluding the treatment of kidneys, and thus the 'damaged or injured tissue' [in Applicant's identification] could include kidney tissue."[32] Applicant responds that its "goods are a medicinal drug and nutritional supplement, derived from Vitamin A, that serve to accelerate regenerative healing and slow scar tissue formation";[33] and,

> Applicant's Applications identify the specific purpose of the pharmaceutical preparations disclosed therein, that is, treatment of damaged or injured tissues. This purpose is distinct from the treatment of hyperphosphatemia for kidney dialysis patients, the narrowly defined purpose for the phosphate binders identified in Opposer's Registration. … Opposer neglects to acknowledge that the goods identified in Opposer's Registration make no reference to the treatment of damaged tissues generally or damaged kidney tissues specifically. … While Opposer has established that the phosphate binders on the face of Opposer's Registration treat an electrolyte disorder, Opposer has not proffered any evidence to demonstrate that the phosphate binders treat damaged or injured tissue such that the goods recited in Applicant's Applications overlap with the goods recited Opposer's Registration. Furthermore, Opposer has not submitted any evidence

[30] *See* Sebzeci Decl. ¶ 7, 20 TTABVUE 3 ("RENAGEL is a phosphate binding medication ….").

[31] Accessed at https://www.merriam-webster.com/dictionary/treatment on May 15, 2023. We take judicial notice of this definition.

[32] 27 TTABVUE 18-19.

[33] Applicant's brief, 28 TTABVUE 22.

> that kidney dialysis patients have damaged kidney tissue or that they are looking for and purchasing a pharmaceutical to treat damaged kidney tissue.[34]

"Tissue" is defined as:

> an aggregate of cells usually of a particular kind together with their intercellular substance that form one of the structural materials of a plant or an animal and that in animals include connective tissue, epithelium, muscle tissue, and nerve tissue.[35]

Because the term "tissue" in Applicant's identification is not limited to a particular type of tissue, we find that "tissue" encompasses kidney tissue. "[W]here the goods in an application or registration are broadly described, they are deemed to encompass 'all the goods of the nature and type described therein….'" *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413 (TTAB 2018) (citing *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)). An entry for "renal system" in Encyclopedia Britannica refers to "kidney tissue":

> A cross section of a kidney reveals the renal sinus and two layers of kidney tissue distinguishable by their texture and colour. The innermost tissue, called the renal medulla, forms comparatively dark cones, called renal pyramids, with bases outward and apexes projecting, either singly or in groups, into the renal sinus.[36]

[34] 28 TTABVUE 18-20.

[35] Accessed at https://www.merriam-webster.com/dictionary/tissue on May 6, 2023. We take judicial notice of this definition.

[36] Accessed at https://www.britannica.com/science/human-renal-system on May 6, 2023.) We take judicial notice of this Encyclopedia Britannica entry. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013) (judicial notice taken of entry for "tea" from Encyclopedia Britannica).

Because Opposer's goods are for treating aliments affecting the kidneys, and Applicant's identified goods can be construed as encompassing pharmaceutical preparations for treating damaged kidney tissue, both goods must be considered as intended for conditions affecting human kidneys. As such, we find the parties goods to be are related to one another.

We are not persuaded by Applicant's arguments that its goods are derived from Vitamin A and serve to accelerate regenerative healing and slow scar tissue formation; that its goods do not control serum phosphorus in patients and thus do not serve the same purpose as Opposer's goods; and "[n]o person would prescribe the REGENAL and REGENALL-branded products … to control serum phosphorus in patients or to treat chronic kidney disease."[37] First, "[i]t [is] proper … for the Board to focus on the application and registrations rather than on real-world conditions, because 'the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application.'" *Stone Lion Cap. Partners v. Lion Cap*, 110 USPQ2d at 1162 (quoting *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed Cir. 1990))). Second, as noted above, however, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *See Black & Decker v. Emerson Elec.*, 84 USPQ2d at 1492; *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

[37] Applicant's brief, 28 TTABVUE 22 (citing Noordeen Decl. ¶¶ 3, 6, 16 and 18, 25 TTABVUE 82).

In view of the foregoing, the second *Dupont* factor favors finding a likelihood of confusion.

D. Similarity of Trade Channels and Purchasers

We look to the identifications of goods in Opposer's registration and Applicant's applications to determine the channels of trade and classes of consumers for those goods. *Stone Lion Cap. Partners v. Lion Cap*,, 110 USPQ2d at 1161-62. There are no limitations as to channels of trade or classes of purchasers in the identifications of goods in Opposer's registration and in Applicant's applications, and "[i]t therefore is presumed that [the] goods move in all channels of trade normal for those goods, and that they are available to all classes of purchasers for those goods." *Id*. at 1161.

Mr. Sebzeci testified that Opposer's goods are "sold by prescription through all channels that dispense prescription pharmaceuticals in the United States, including chain and independent pharmacies, clinics, hospitals, long-term care facilities, and others."[38] Further, the evidence reflects that Opposer's mark is promoted on the websites www.renvela.com and www.SanofiGenzyme.com, and that Opposer's target market consists of doctors and their patients.[39]

Applicant also argues that his goods are "prescription-based drugs,"[40] and that he "intend[s] to market REGENAL and REGENALL branded products to medical

[38] Sebzeci Decl. ¶ 5, 20 TTABVUE 2-3. *See also* Opposer's answer to Applicant's Interrog. No. 14 ("The product is sold by prescription through all channels that dispense prescription pharmaceuticals in the United States, including chain and independent pharmacies, clinics, hospitals, long-term care facilities, and others."). 22 TTABVUE 9.

[39] *See* answers to Applicant's Interrog. Nos. 11, 25 and 27, 22 TTABVUE 9, 12.

[40] Noordeen Decl. ¶ 7, 25 TTABVUE 81.

providers, pharmacists, and clinicians who will be prescribing and distributing the products to patients ….”[41] In addition, Applicant asserts that patients are consumers of both parties’ goods, albeit different patients for each good. Applicant states, “the consumers for both parties’ goods are differing medical professionals and patients under those respective professionals’ care and supervision.”[42] Further, Applicant argues that “Opposer has submitted no evidence to show that the prescribing professionals or trade channels for pharmaceuticals treating damaged or injured tissue overlap with those for phosphate binders for food to treat hyperphospatemia.”[43]

Because Opposer’s goods and Applicant’s pharmaceutical preparations as identified may only be obtained through a prescription written by a medical professional, and both of such goods pertain to kidney health, we find those involved in purchasing decisions of both of such goods to include the same nephrologists, and other medical professionals involved in kidney health.

With regard to the patients Applicant has identified, we find that they too participate in purchasing decisions for both parties’ goods.[44] In *Alfacell v. Anticancer*, 71 USPQ2d at 1306, the Board recognized that “[w]hile doctors and pharmacists play a gate-keeping role between patients and prescription drugs, they are not the ultimate consumers. Patients are. Courts have noted that drugs are increasingly marketed directly to potential patients through, for example, ask-your-doctor-about-

[41] *Id.* at ¶ 9, 25 TTABVUE 81.

[42] Applicant’s brief, 28 TTABVUE 24.

[43] *Id.*, 28 TTABVUE 21.

[44] Applicant’s brief, 28 TTABVUE 24.

Brand-X' style advertising." (citing *KOS Pharms. Inc. v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004)). We find, however, that the same patient may require both parties' goods, and possibly at the same time depending on the chronic kidney condition that the patient faces. Patients may, as the evidence reflects, obtain information on the Internet.

Because both parties' goods are pharmaceutical preparations prescribed by physicians, the trade channels for both goods include wholesale, retail and hospital pharmacies. Patients needing both goods may access marketing materials for such goods through the Internet.

For the foregoing reasons, we find the trade channels and classes of purchasers of the involved goods to be overlapping.

E. Purchasing Conditions/Sophistication

Under the *DuPont* factor regarding the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing, *DuPont*, 177 USPQ at 567, we consider the least sophisticated potential consumer in the class. *See Double Coin Holdings v. Tru Dev.*, 2019 USPQ2d 377409 at *7 (TTAB 2019) (citing *Stone Lion Cap. Partners v. Lion Cap.*, 110 USPQ2d at 1163); *Alfacell v. Anticancer*, 71 USPQ2d at 1306. In the prior subsection, we identified potential purchasers as nephrologists and other medical professionals involved in the treatment of kidneys, as well as patients who are members of the general public.

Certainly, physicians and pharmacists constitute "a highly intelligent and discriminating public." *Warner-Hudnut, Inc. v. Wander Co.*, 280 F.2d 435,

126 USPQ 411, 412 (CCPA 1960). The same applies to other prescribing medical professionals. There is no evidence that patients are sophisticated purchasers, but because the goods as identified involve pharmaceutical preparations,[45] we find it likely that those patients involved in purchasing decisions would exercise care in their purchasing decisions. Others would delegate the decision to medical professionals who prescribe pharmaceutical preparations.

Opposer references a "longstanding rule that 'confusion of [pharmaceutical] products must be avoided,'" citing *Geigy Chem. Corp. v. Nutritional Quality Controls, Inc.*, 123 USPQ 393, 393 (TTAB 1959) ("The products of the parties while differing in chemical properties and medicinal uses are pharmaceutical preparations intended for internal use. Confusion of such products must be avoided.").[46]

"[T]here is no reason to believe that medical expertise as to pharmaceuticals will ensure that there will be no likelihood of confusion as to source or affiliation." *Alfacell v. Anticancer*, 71 USPQ2d at 1306. According to Professor McCarthy, "[e]ven though the goods may be prescription drugs, the rule regarding a lesser degree of likelihood of confusion for medicinal products should control over the supposed 'sophistication' of physicians and pharmacists." MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:32. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d

[45] Applicant argues that confusion is unlikely due to the cost of Opposer's goods. Opposer's goods cost approximately $7 per tablet or $1,338.66 per bottle of 180 tablets. *See* Sebzeci Decl. ¶ 7, 19 TTABVUE 2. However, there is no information about the anticipated cost of Applicant's goods which would allow us to determine how the costs of the goods factor into purchasing decisions. Also, Applicant is silent as to how health insurance affects the consumers' purchasing decisions.

[46] Rebuttal brief, 31 TTABVUE 9.

1384, 173 USPQ 19 (CCPA 1972); *see also Sterling Drug, Inc. v. Sankyo Co.*, 139 USPQ 395 (TTAB 1963) (ordinary consumer standard of confusion applied to nonprescription drugs); *Schering Corp. v. Alza Corp.*, 207 USPQ 504 (TTAB 1980) (that physicians and pharmacists are knowledgeable in their fields does not mean they are equally knowledgeable as to marks and immune from mistaking one mark for another); *Blansett Pharmacal Co. v. Carmrick Labs., Inc.*, 25 USPQ2d 1473 (TTAB 1992) (confusion and mistake is likely, even for prescription drugs prescribed by doctors and dispensed by pharmacists, "where these similar goods are marketed under marks which look alike and sound alike.").

Further, it is well-established that even sophisticated consumers are not immune from source confusion where both the goods and the marks are similar. *See Cunningham v. Laser Golf*, 55 USPQ2d 1842 at 1846; *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011) (finding that although "it stands to reason wholesale buyers should be accorded a higher degree of purchaser sophistication over the general public in terms of determining susceptibility to confusion," nevertheless, such consumers "are not immune from source confusion." (citations omitted)).

In sum, we find the fourth *DuPont* factor to be neutral as it pertains to Applicant's goods.

F. Absence of Actual Confusion

Applicant argues that Opposer has not submitted evidence of actual confusion.[47] This is a specious argument, since, Applicant's applications are based on an intent to use the marks, and he does not claim his marks are in use. Therefore, there would be no opportunity for actual confusion to arise. *See Motion Picture Ass'n of Am. Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1564 (TTAB 2007).

G. Conclusion.

In view of the foregoing, we find that Opposer has established, by a preponderance of the evidence, that the marks are similar, the goods are related, and the channels of trade and purchasers overlap. Applicant has not established any particular weakness in Opposer's registered mark. We therefore conclude that Applicant's REGENAL and REGENALL marks for the goods identified in the applications are likely to be confused with Opposer's RENAGEL mark for the goods identified in the registration.

To the extent that we have any doubts about our conclusion, we note the well-established principle that, if there are any doubts on the issue of likelihood of confusion, they must be resolved against the newcomer and in favor of the prior user. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); *Fricks' Foods, Inc. v. The Mar-Gold Corp.*, 417 F.2d 1078, 163 USPQ 619 (CCPA 1969); *Schenley Inds., Inc., v. Fournier, Inc.*, 357 F.2d 395, 149 USPQ 60, 62

[47] Applicant's Br. at 9, fn. 2, 28 TTABVUE 15.

(CCPA 1966) ("[W]e must resolve any doubt in favor of the first user as against the newcomer."). Following that principle is all the more important where the products in question are pharmaceuticals, where it is imperative that even a slight possibility of confusion should be avoided. *In re Merck & Co., Inc.*, 189 USPQ 355 (TTAB 1975).

Decision: The oppositions are sustained and registration to Applicant is refused with regard to application Serial Nos. 88361290 and 88361302.