

The Examining Attorney has refused registration of Applicant's mark, TAVALZA, for pharmaceutical preparations for the treatment of immune system diseases and disorders, pharmaceutical preparations for the treatment of inflammatory diseases and disorders, anti-inflammatory pharmaceutical preparations, pharmaceutical preparations for the treatment of hematological conditions, diseases and disorders, and pharmaceutical preparations for use in chemotherapy in class 5, on the grounds of a likelihood of confusion with Sanofi's Registration No. 5563625 for TIVOLZA for pharmaceutical preparations for the prevention and treatment of cancer in class 5. Applicant respectfully disagrees that there is a likelihood of confusion between the marks and presents the arguments below in support of registration.

**A. The Marks Differ Sufficiently In Sound and Appearance to Avoid a Likelihood of Confusion.**

When determining whether marks are so similar as to cause a likelihood of confusion regarding the source of the associated goods, the Examining Attorney must consider the marks themselves for similarities in sight, sound and meaning. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). In performing this analysis, the Examining Attorney is required to consider the marks in their entirety, and not dissect the marks into their component parts with each part then compared to a corresponding part of the potentially conflicting mark. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (C.C.P.A. 1976); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-546 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.").

Here, the Examiner argues that Applicant's mark and the cited registration are confusingly similar because it is impossible to predict how consumers would pronounce the marks. Although this is technically correct, in this case, the differences in spelling and sounds are so obvious that a consumer will never pronounce them so that they sounded alike. See, e.g., *Lebow Bros., Inc. v. Lebole Euroconf S.p.A.*, 503 F. Supp. 209 (E.D. Pa. 1980) (no likely confusion between LEBOW clothing and LEBOLE clothing). In other words, there are two critical differences in spelling and pronunciation between the marks, which results in marks with different commercial impressions. First, the first syllables of the marks are noticeably different: Applicant's mark starts with "TA" which will have the sound "tuh" or "tay." In contrast, the cited mark starts with "TI" and therefore will have the sound "tee" or "ti." Overall, it is very unlikely that "ta" will be pronounced the same as "ti." Furthermore, the second syllables of the marks are also very different. In Applicant's mark, the second syllable is "val," which will likely be pronounced as "vail" or "val" as in "value." In contrast, the second syllable of the cited mark is "vol," which will likely be pronounced as "vole" or "vol" as in "volume." Thus, the different vowels in the marks result in the marks that will be substantially dissimilar in pronunciation.

Furthermore, Applicant's mark TAVALZA differs in appearance from the cited registration TIVOLZA. Here, Applicant's mark has only the vowel "A," giving some symmetry to the appearance of the mark. In contrast, the cited mark has three different vowels. Applicant's mark and the cited registration are therefore visually distinct. Accordingly, TAVALZA differs

sufficiently in sound, appearance and connotation from TIVOLZA so that the marks have different commercial impressions and are able to avoid a likelihood of confusion.

**B. Third Party Registrations Weaken the Likelihood of Confusion Argument**

Widespread use of similar marks in the same field results in the trademark rights of each of the marks being limited to “substantially the identical mark as set forth in its registration. *Puma-Sportschuhfabriken Rudolf Dassler K.G. v. Superga S.p.A.*, 210 U.S.P.Q. 316, 317 (T.T.A.B. 1980) (finding that a registered mark for stripes on a sport shoe was limited to its identical design due to the widespread use of stripes on sport shoes). Where the cited mark is but one in a highly crowded market using the same or similar terms, there should be no finding of likelihood of confusion. See e.g., *Miss World (UK) Ltd., v. Mrs. America Pageants, Inc.*, 856 F.2d 1445 (9th Cir. 1988).

Here, the following similar marks co-exist for pharmaceutical preparations in class 5.

Ser. No./Reg. No.	Mark	Goods	Owner
87517408  Filed: July 6, 2017	TALFONZA	<u>Class 5</u> : Human pharmaceutical preparations for the prevention and treatment of viral diseases, auto-immune and inflammatory diseases, cardiovascular diseases, central nervous system diseases, pain, dermatologic diseases, gastro-intestinal diseases, infectious-related diseases, metabolic diseases, oncologic diseases, ophthalmic diseases, and respiratory diseases; vaccines	Johnson & Johnson
88143523  Filed October 4, 2018	TEPTOLZA	<u>Class 5</u> : Pharmaceutical preparations, namely, an anti-cancer agent	Nektar Therapeutics
87871122  Filed: April 10, 2018	TAVSCENZA	<u>Class 5</u> : Pharmaceutical preparations for the treatment of genetic diseases and disorders; Pharmaceutical preparations for use in enzyme therapy	Biomarin Pharmaceutical Inc.
88216781  Filed: December 4, 2018	TEPEZZA	<u>Class 5</u> : Pharmaceutical preparations for the treatment of thyroid disorders; pharmaceutical preparations for the treatment of ocular disorders	HZNP LTD

If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005); see also *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2d 1464, 1470 (TTAB 2016) (noting that evidence that third

parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak").

Since the marks in above table co-exist for the same or highly related goods, this leads to the conclusion that the cited registration's trademark rights are limited to TIVOLZA. Thus, Applicant's mark is not confusingly similar to the cited registration.

### **C. There Is No Evidence The Goods Are Related**

An examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Here, the Examining attorney argues that "the registration uses broad wording to describe its pharmaceutical preparations for cancer, which presumably encompasses all goods of the type described, including applicant's more narrow pharmaceutical preparations." The Examiner, however, has not produced any evidence that "preparations for the prevention and treatment of cancer" will include "preparations for the treatment of immune system diseases and disorders, preparations for the treatment of inflammatory diseases and disorders, anti-inflammatory pharmaceutical preparations, and pharmaceutical preparations for the treatment of hematological conditions, diseases and disorders." There is no evidence that cancer includes the sub categories of immune system diseases, inflammatory diseases, anti-inflammatory conditions, or hematological conditions, so that the same pharmaceutical preparations would be used to treat all the same conditions. Accordingly, the Examiner has not met her burden of proving that the associated goods are related.

### **D. Applicant's and Registrant's Goods Will Be Marketed To Sophisticated Purchasers.**

The sophistication of the purchaser is an important factor when determining the likelihood of confusion. *See, Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q. 2d 1390, 1396 (T.T.A.B. 1992) (finding no likelihood of confusion because the medical equipment sold by both applicant and opposer would be selected by "highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in its selection."); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1465 (TTAB 1992) (holding that, due to the nature of the computer equipment sold by both applicant and opposer, "both parties' offerings would be carefully scrutinized by prospective purchasers, and any purchasing decisions would be made after careful consideration).

Here, Registrant's goods, "pharmaceutical preparations for cancer," and Applicant's goods, preparations for the treatment of immune system diseases inflammatory diseases, anti-inflammatory pharmaceutical preparations, and preparations for the treatment of hematological conditions, are sophisticated drugs prescribed by doctors and pharmacists, and not over the counter medications. Such drugs such as pharmaceutical preparations for cancer and preparations for the treatment of immune system diseases usually have major side effects, and must be carefully

prescribed. Thus, such products are typically marketed to professional purchasers such as doctors and pharmacists, who must exhibit great care in choosing treatments for their patients, to make sure the treatments will be effective and not interact with other medications the patient may be taking. In fact, courts have consistently viewed doctors and pharmacists as highly discriminating purchasers. *See e.g., Warner-Hudnut, Inc. v. Wander Co.*, 280 F.2d 435 (C.C.P.A. 1960) (physicians and pharmacists said to be a “highly intelligent and discriminating public”); *see also, Barre-National, Inc. v. Barr Laboratories, Inc.*, 773 F. Supp. 735 (D.N.J. 1991) (care and sophistication exercised by professional pharmacists who purchase pharmaceuticals makes confusion unlikely).

Accordingly, pharmaceutical products for the treatment of various types of diseases and disorders are not purchased on impulse. Instead, consumers will only be exposed to the drugs dispensed by highly-trained professionals like pharmacists and doctors. These professionals are required to take the utmost care in prescribing and/or disbursing these type of products, and are the only ones legally allowed to do so - which results in the average consumer not being involved in the purchasing decision. Accordingly, given the highly regulated nature of pharmaceutical products, the likelihood of confusion between the Applicant’s mark and the cited registration is virtually inexistent.

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney reconsider its refusal and allow the application for registration to proceed.