

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

MARK:	BIG ENOUGH TO MATTER SMALL ENOUGH TO CARE
SERIAL NO:	88452719
APPLICANT:	Hikma Pharmaceuticals Public Limited Company
FILING DATE:	May 30, 2019
INTERNATIONAL CLASSES:	5, 9, 10, 16, 19, 35, 40, 41, 42 & 44

The Examining Attorney (the “**Examiner**”) cites registered trademark U.S. Trademark Registration No. 5707813 (“**Cited Mark 1**”) and registered trademark U.S. Trademark Registration No. 5707814 (“**Cited Mark 2**”) and together with Cited Mark 1, the “**Cited Marks**”) for the related services in International Class 41. The Examiner has refused registration of Applicant’s Mark for the goods and services to be offered in the United States under International Classes 16, 41, 42, and 44 due to likelihood of confusion with the Cited Marks.

The U.S. Patent and Trademark Office recognizes that registration should not be refused in view of all similar marks, but only on the basis of those similar marks whose effect in the marketplace would be to create a likelihood of confusion or mistake on the part of the purchasing public. TMEP § 1207.01.

**I. Applicant Has Amended the Goods and Services Offered Under the Mark**

In order to clarify the goods and services offered under Applicant’s Mark, Applicant proposes the following changes to its descriptions of its goods and services:

**Class 5:** Pharmaceutical, medicinal, veterinary preparations and substances, namely systemic anti-infectives, pharmaceutical and medicinal substances for the prevention, curing, and treatment of viral, metabolic, alimentary, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, parasitic, psychiatric, and immune system related diseases and disorders; pharmaceutical and medicinal substances for the prevention, curing, and treatment of allergies, inflammation, pain, infectious diseases, blood diseases and disorders, nervous system diseases and disorders, malignant neoplastic diseases and disorders, and immunomodulating agent diseases and disorders; sanitary preparations and substances, namely, sanitary sterilizing preparations; chemical substances for use in human or veterinary medicine, namely, chemical preparations and reagents for medical purposes namely the treatment of viral, metabolic, alimentary, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, parasitic, psychiatric, and immune system related diseases and disorders, allergies, inflammation, pain, infectious diseases, blood diseases and disorders, nervous system diseases and disorders, malignant neoplastic diseases and disorders, and immunomodulating agent diseases and disorders; ~~chemicals and chemical preparations for medical purposes~~; substances used for medical and/or pharmaceutical purposes, namely, pharmaceutical preparations for the treatment of viral, metabolic, alimentary, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological,

gastrointestinal, hormonal, dermatological, parasitic, psychiatric, and immune system related diseases and disorders, allergies, inflammation, pain, infectious diseases, blood diseases and disorders, nervous system diseases and disorders, malignant neoplastic diseases and disorders, and immunomodulating agent diseases and disorders; dietetic substances for medical purposes, namely, dietetic foods adapted for medical purposes.

**Class9:** Downloadable electronic publications in the nature of articles, papers, books, booklets, journals, magazines, newsletters, periodicals, pamphlets, brochures, manuals, leaflets, informational flyers, informational sheets and newsletters, instructional worksheets, product descriptions, all in the fields of medicine, medical technology, pharmaceuticals, and healthcare.

**Class 10:** Medical apparatus and instruments, namely, apparatus for the prevention, curing, and treatment of viral, metabolic, alimentary, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, parasitic, psychiatric, and immune system related diseases and disorders, pharmaceutical and medicinal substances for the prevention, curing, and treatment of allergies, inflammation, pain, infectious diseases, blood diseases and disorders, nervous system diseases and disorders, malignant neoplastic diseases and disorders, and immunomodulating agent diseases and disorders; medical apparatus and instruments containing pharmaceutical, medicinal or sanitary preparations or substances, namely, medical apparatus for preparing and storing pharmaceutical or medicinal preparations and delivering pharmaceutical or medicinal preparations onto or into the human body; medical apparatus and instruments containing chemical substances for use in human-~~or~~ **veterinary** medicine, namely, medical apparatus for preparing and storing chemical substances and delivering chemical substances onto or into the human body.

**Class 16:** Paper; cardboard; articles of paper or cardboard, namely, periodicals and books relating to pharmaceuticals and medicines, pharmaceutical and medicinal research and development, pharmaceutical, medicinal, sanitary and veterinary preparations and substances, chemical substances for use in human or veterinary medicine, medical apparatus and instruments, development; boxes of cardboard or paper; printed matter, namely, newspapers; stationery; printed instructional and teaching materials in the field of medicine; printed publications, namely newsletters, journals, books in the field of pharmaceuticals and pharmaceuticals research and development; packaging materials made of cardboard, foil, plastics and paper; printed matter, namely, printed books, booklets, journals, magazines, newspapers, periodicals, pamphlets, brochures, manuals, leaflets, informational flyers, informational sheets and newsletters, instructional worksheets all in the fields of medicine, medical technology, pharmaceuticals, and healthcare; printed instructional and teaching materials, namely, printed books, booklets, journals, magazines, newspapers, periodicals, pamphlets, brochures, manuals, leaflets, informational flyers, informational sheets and newsletters, instructional worksheets all in the fields of medicine, medical technology, pharmaceuticals, and healthcare.

**Class 19:** Packaging materials made from plastics, foil, paper or cardboard.

**Class 35:** Advertising; business management; business administration; providing office functions; marketing and promotional services, namely, promoting and marketing the goods and services of others by distributing advertising material, coupons and discount offers via printed materials and electronic means; public relations services; product

demonstrations and product display services, namely product promotion, marketing and merchandising for others in the nature of inventory display, conference presentations and displays; organisation of trade shows and trade exhibition ~~services~~ for business purposes; distribution of advertising, marketing and promotional material; retail and wholesale store services in relation to featuring pharmaceutical, medicinal, sanitary and veterinary preparations and substances, chemical substances for use in human or veterinary medicine, medical apparatus and instruments; business consultancy and advisory services; business analysis, research and information services; advice, and consultancy ~~and information for all~~ related to the aforesaid services.

**Class 40:** custom mManufacture of pharmaceutical, medicinal, sanitary and veterinary preparations and substances; custom manufacture of chemical substances for use in human or veterinary medicine; custom manufacture of medical apparatus and instruments; custom manufacture of medical apparatus and instruments containing pharmaceutical, medicinal or sanitary preparations or substances; custom manufacture of medical apparatus and instruments containing substances for human or veterinary use; advice, and consultancy ~~related to~~ ~~and information for all~~ the aforesaid services.

**Class 41:** Education services, namely, providing SEMINARS, CONFERENCES AND TRAINING classes in the fields of medicine, medical technology, pharmaceuticals, and healthcare and in the use and preparation of pharmaceutical, medicinal or sanitary preparations or substances for human or veterinary use; training services, namely, training in pharmaceutical, medicinal or sanitary preparations or substances and the use and operation of medical apparatus; education and training services, namely, providing SEMINARS, CONFERENCES AND TRAINING classes in the fields of medicine, medical technology, pharmaceuticals, and healthcare and in the use and preparation of relating to pharmaceutical, medicinal or sanitary preparations or substances for human or veterinary use; publication services, namely, publication of textbooks; publication services, namely, publication of printed matter in the fields of medicine, medical technology, pharmaceuticals, and healthcare and in the use and preparation of relating to pharmaceutical, medicinal or sanitary preparations or substances for human or veterinary use; organisation and arrangement of lectures, seminars and symposiums for educational purposes; publication of electronic books, magazines, journals and web blogs; Non-downloadable electronic publications in the nature of articles, papers, books, booklets, journals, magazines, newsletters, periodicals, pamphlets, brochures, manuals, leaflets, informational flyers, informational sheets and newsletters, instructional worksheets, product descriptions, all in the fields of medicine, medical technology, pharmaceuticals, and healthcare; advice, and consultancy ~~and information for all~~ related to the aforesaid services.

**Class 42:** Scientific and technological services in the fields of medicine, medical technology, pharmaceuticals, and healthcare, diagnostic services for others in the fields of medicine, medical technology, pharmaceuticals, and healthcare and research related thereto; scientific ~~and technological~~ research and development services; ~~industrial analysis and technological~~ research in the fields of medicine, medical technology, pharmaceuticals, and healthcare; technological development services, namely, development of new technology for others in the fields of medicine, medical technology, pharmaceuticals, and healthcare services; design and development of computer hardware and computer software; design and development of computer hardware and computer software to assist in in the determination and development of pharmaceuticals and medicines; science and technology services, ~~including~~ namely, medical and

~~pharmacological-pharmaceutical~~ research services; engineering services; product safety testing, authentication of materials and processes for medical, veterinary and nutritional purposes used in the fields of medicine, medical technology, pharmaceuticals, and healthcare and quality control ~~services~~for others; quality control of preparations and goods for medical, veterinary and nutritional purposes; chemical analysis and research; design and testing of new products for others; diagnostic testing and analysis, namely, remote diagnosis of medical diagnostic imaging, clinical and biomedical equipment for determining the need for repair; design and monitoring of clinical research and studies for the pharmaceutical and veterinary industries, namely, conducting clinical trials for others; virological scientific research; biological and biochemical research; genetic testing for scientific research purposes; ~~and~~ genetic fingerprinting, namely, genetic mapping for scientific purposes; laboratory analysis in the fields of medicine, medical technology, pharmaceuticals, and healthcare; ~~laboratory and~~ research in the fields of medicine, medical technology, pharmaceuticals, and healthcare; technical advisory services relating to medicine, medical technology, pharmaceuticals and healthcare; ~~advice~~; and consultancy and information for all related to the aforesaid services.

**Class 44:** Medical services; veterinary services; hygienic and beauty care services for human beings or animals; human healthcare services; human healthcare services in the nature of medical services, dentistry, pharmaceutical ~~services~~advice, opticians' services, mental health services; human hygiene and beauty care services; genetic testing for medical purposes; ~~advice~~; and consultancy ~~and information for all related to~~ the aforesaid services.

## II. 2(d) Refusal

The controlling standard of determining likelihood of confusion is whether the relevant purchasing public would mistakenly assume that Applicant's goods or services originate with, are sponsored by, or are in some way associated with the services offered in connection with the Cited Mark. *FBI v. Societe: "M. Bril & Co."*, 172 USPQ 310 (TTAB 1971). Likelihood of confusion is determined by applying the following factors, among others: 1) the similarity or dissimilarity of the marks, 2) the relatedness of the goods or services offered in connection with the marks, 3) the channels of trade, and 4) the buyers to whom sales are made and the conditions under which sales are made (i.e. impulse vs. careful, sophisticated purchasing) (the "**du Pont Factors**"). *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). The first two factors are the key considerations to determine whether a likelihood of confusion exists. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (CCPA 1976).

### a) **The Nature of the Goods and Services Covered by Applicant's Mark is Distinct From the Nature of the Services Covered by the Cited Marks.**

The Examiner notes that Applicant's Mark and the Cited Marks contain identical wording. However, in considering whether a likelihood of confusion exists between Applicant's Mark and the Cited Marks, it is necessary to compare the goods and services encompassed by Applicant's recitation with the services set forth in the Cited Marks, even if the marks are identical. *Calypso Tech., Inc. v. Calypso Capital Mgmt., Lp*, 100 USPQ2d 1213 (TTAB. 2011) ("Even if marks are identical, the goods and services must also be sufficiently related and/or the circumstances surrounding their marketing be such that purchasers encountering them would mistakenly believe that they emanate from the same source for us to find that confusion is likely to occur."). Unrelated goods or services factor strongly against a likelihood of confusion. *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 67 USPQ2d 1420 (2nd Cir. 2003).

Because consumers are less likely to assume that dissimilar goods and services emanate from a single source, dissimilar goods and services are not likely to cause confusion. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ2d 1545 (9th Cir. 1999).

Here, Applicant respectfully disagrees that its Mark is likely to be confused with the Cited Marks because the goods and services offered under Applicant's Mark differ in nature and purpose from the services offered under the Cited Marks.

The essential inquiry is whether there is likely to be sufficient overlap of the educational services offered under the Cited Marks and Applicant's training, seminars, and scientific services in the medical field. As in this case, if there is minimal or no overlap, there is no likelihood of confusion. The Examiner claims that Applicant's goods and services are related to the services under the Cited Marks because Applicant's "goods and services are written broadly enough to encompass" the services under the Cited Marks. The Examiner specifically refers to the Applicant's "training services" and "education services." It is clear that the goods and services, as amended in Section I above, do not sufficiently encompass or overlap with the instruction courses and training offered under the Cited Marks. Here, based on the amended descriptions, Applicant offers training and seminars specifically related to the fields of medicine and pharmacy. The education services that Applicant offers are not specifically tied to courses and training at the undergraduate and graduate level, as set forth in the Cited Marks, but instead, the seminars and conferences are outside of the undergraduate and graduate system and relate specifically to the medical field. Similarly, the goods and materials that Applicant offers specifically relate to the medical field, including pharmaceutical research and developments.

As amended, the goods and services covered by the Mark clearly differ in substance from and do not sufficiently overlap with or encompass the undergraduate and graduate educational services offered under the Cited Marks.

**b) Applicant's Trade Channels and Classes of Consumers are Distinct from the Trade Channels and Classes of Consumers Covered by the Cited Marks.**

One factor that should be considered when determining likelihood of confusion is the similarity or dissimilarity of trade channels for the goods and services offered under Applicant's Mark and the services offered under the Cited Marks. *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (holding that identical marks for towable trailers and trucks would not likely cause confusion because of the difference in goods, the difference in the channels of trade, and the high level of consumer care to be exercised when purchasing the goods). The channels of trade and the classes of consumers covered by Applicant's Mark and covered by the Cited Marks are distinct.

Applicant's goods and services are directed towards consumers in the medical field for medical and veterinary purposes. The education and training services, specifically the conferences and seminars, and the printed materials are directed towards professionals in the medical and veterinary field. It is intended that consumers of Applicant's goods and services use such goods and services as additional training. On the other hand, the educational services offered under the Cited Marks are related to undergraduate and graduate students attending a university. See Exhibit A. Even though it is possible that some undergraduate and graduate students could utilize the educational and training services of the Applicant, the intended consumers and trade channels are distinct, and no sufficient overlap exists. The Applicant's goods and services are not primarily marketed to undergraduate and graduate students. Nonetheless, any potential overlap in trade channels does not automatically result in a likelihood of confusion. See *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1395 (TTAB 1991) (finding no confusion between HPM & design and HP & design, both for medical

equipment, stating, “we concur with applicant that the fact that both parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely”). Therefore, even though some consumers may potentially be the same, no sufficient overlap exists, and thus Applicant’s Mark is not likely to cause confusion with the Cited Marks.

**c) Consumers of Applicant’s goods and services are sophisticated enough to distinguish the goods and services covered by Applicant’s Mark and those services covered by the Cited Marks.**

It is well settled that confusion is unlikely where purchasers and potential purchasers exercise careful consideration in buying the identified goods sold through distinct channels of trade. *See, e.g., In re N.A.D., Inc.*, 224 USPQ 969 (Fed. Cir. 1985); *In re Bay State Brewing Company, Inc.*, 117 USPQ2d 1958 (TTAB 2016) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”) (quoting *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000)).

Here, Applicant’s goods and services are directed towards consumers who will use careful consideration because of the nature and cost of the services. The education and training services offered under Applicant’s Mark are intended for individuals and potentially businesses looking to gain more institutional knowledge in the medical field. The services also include diagnostic testing, scientific and technological research, and other medical services. Because consumers using Applicant’s services and purchasing Applicant’s goods will rely on such goods and services for important analysis and research in the medical field, consumers will exercise careful consideration. Similarly, undergraduate and graduate students will undoubtedly exercise careful consideration when purchasing and employing the educational services offered under the Cited Marks. Attending a university is a large time and monetary commitment, especially when tuition equals \$29,930. *See Exhibit B*. Because attending a particular university can impact the career trajectory and financial situation of a student, it is likely that attendees of a university will research and take careful consideration before enrolling. Therefore, confusion as to the source of Applicant’s goods and services and the source of the services offered under the Cited Marks is highly unlikely.

**III. Conclusion**

In light of the foregoing, although Applicant’s Mark and the Cited Marks may be identical, the goods and services are not similar, the trade channels are distinct, and consumers will undoubtedly use careful consideration. Therefore, a likelihood of confusion is unlikely, and Applicant’s Mark is registrable on the Principal Register.