

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Abbott Laboratories)
) Trademark Examiner
Serial No.: **77/116,366**) Tina M Kuan
)
Mark: **TRILIPIX**) Law Office 108
)
Filing Date: February 26, 2007)

Commissioner for Trademarks
P.O. Box 1451
Alexandria , VA 22313-1451

RESPONSE TO OFFICE ACTION DATED APRIL 18, 2007

I. INTRODUCTION

In the Office Action of April 18, 2007, the Examiner refuses registration of Applicant’s mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because she believes that Applicant’s TRILIPIX mark (hereafter “TRILIPIX Mark” or “Applicant’s Mark”) so resembles the mark LIPEX in U.S. Reg. No. 3,092,250 in the name of Northern Lipids, Inc. (hereafter “Northern Lipid’s LIPEX mark” or the “cited mark”) as to be likely to cause confusion, to cause mistake, or to deceive. Further, the Examiner has also requested identification of any significance of the term TRILIPIX.

Applicant responds fully as follows:

II. THERE IS NO LIKELIHOOD OF CONFUSION

A. Introduction

The paramount concern under a Section 2(d) analysis is whether the public is likely to be confused:

The ex parte determination [] made under the provisions of Section 2(d) of the statute is grounded upon the right to be free from confusion, mistake and deception in the marketplace, rather than upon the protection of a registrant's right.

Mercantile Stores Co. v. The Joseph & Feiss Co., 112 U.S.P.Q. 298, 300 (Comm'r of Patents 1957). "The confusion sought to be prevented by the statute is not that of examiners, lawyers, board members, or judges. Confusion is likely, if at all, only in the marketplace, where the marks are used." *In re The Clorox Company*, 198 U.S.P.Q. 337, 240 (C.C.P.A. 1978).

B. There is no likelihood of confusion because the marks are different in appearance, sound and impression.

In testing for likelihood of confusion, the Examiner must consider the similarity or dissimilarity of the marks *in their entireties* as to appearance, sound, and commercial impression and meaning. *In re E.I. DuPont de Nemours*, 476 F.2d at 1361 (emphasis added). Based on differences between the marks in terms of appearance, sound and commercial impression, the marks, when viewed in their entireties, are not likely to be confused.

In a likelihood of confusion analysis, the marks must be compared in their entireties and not dissected into their component parts because the commercial impression on an ordinary prospective consumer is created by viewing the mark as a whole. Importantly, "[a] mark should not be dissected or split up into its component parts and then compared with the corresponding parts of the conflicting mark to determine the likelihood of confusion. 3 Thomas J McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:41 (west 1998). See e.g., *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 U.S.P.Q. 272, 272 (C.C.P.A. 1974) ("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."), and *In re National Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985)("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.").

In this Action, the Examiner has compared only the suffix portion of Applicant's Mark with Northern Lipid's cited mark, and has concluded that the alleged similarities between the cited mark "LIPEX" and Applicant's suffix -LIPIX creates a likelihood of confusion under Section 2(d). However, Applicant's mark is not LIPIX but TRILIPIX. When properly comparing the Mark in its entirety to the cited mark, it is clear that the marks are sufficiently dissimilar in terms of appearance, sound and commercial impression such that confusion is not likely. Whereas Applicant's Mark includes use of a prominent prefix TRI- and consists of 3 syllables, the cited mark consists of just two syllables.

The fact that the proposed mark includes a portion, or even the entirety, of the cited mark is not dispositive of a likelihood of confusion. Several courts, including the C.C.P.A. and T.T.A.B., have consistently held marks not confusingly similar notwithstanding one mark's incorporation of a portion, or the entirety, of another mark, and the use of both marks in connection with related products or services. *See, e.g., Plus Prod. v. General Mills, Inc.*, 188 U.S.P.Q. 520, 522 (T.T.A.B. 1975)(applicant's PROTEIN PLUS for breakfast cereal held not confusing similar to registrant's PLUS used in connection with vitamin products and food supplements and fortifiers notwithstanding both marks shared the common term PLUS and were used on similar products; *Lever Bros. Co. v. Barcole Co.*, 463 F. 2d 1107, 1109 (C.C.P.A. 1972)(applicant's ALL CLEAR! used in connection with household cleaner held not confusingly similar to registrant's ALL used with household cleaning products even though the two marks shared the common term ALL and were used on virtually identical products); *In re P. Ferrero and C.S.p.A.*, 479 F.2d 1395, 1397 (C.C.P.A. 1973)(applicant's TIC TAC used in connection with candy held not confusingly similar to registrant's TIC TAC TOE used in connection with ice cream and sherbet notwithstanding one mark incorporated two-thirds of the other and both marks were used in connection with similar goods); *Bell Lab., Inc. v. Colonial Prod., Inc.* 644 F.Supp. 542, 550 (S.D. Fla. 1986)(applicant's FINAL used in connection with rat poison held not confusingly similar to registrant's FINAL FLIP also used with rat poison even though both marks shared the common term FINAL and were used on identical products); and *Conde Nast Publications, Inc. v. Miss Quality, Inc.*,

507 F.2d 1404 (C.C.P.A. 1975)(applicant’s COUNTRY VOGUES used in connection with women’s dresses held not confusingly similar to registrant’s VOGUE used in connection with a women’s fashion magazine, even though both marks utilized the term VOGUE, and even though there was “substantial proof of a relationship between VOGUE magazine and [women’s] wearing apparel,” reasoning that COUNTRY VOGUES and VOGUE do not look or sound alike. The only similarity between them is that VOGUE is part of the mark COUNTRY VOGUES...”).

C. The public is not likely to be confused because the parties’ respective goods function differently and serve distinct purposes.

The relevant consuming public is not likely to be confused because the parties’ respective goods function very differently and serve distinct purposes.

The examiner must consider the similarity or dissimilarity of the identified goods/services. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In fact, the mere dissimilarity of goods/services can be enough to obviate a likelihood of confusion. *See in re American Olean Tile Co.*, 1 U.S.P.Q.2d 1823 (T.T.A.B. 1986) (no likelihood of confusion between MILANO for ceramic tile and MILANO for wood doors for exterior and interior use, based on the fact that “the goods are substantially different”), and *Triumph Machine Co. v. Kentmaster Mfg. Co.*, 1 U.S.P.Q.2d 1826, 1829 (T.T.A.B. 1987)(no likelihood of confusion between HYDRO-CLIPPER for power-operated de-horning shears and HYDRO-CLIPPER and Design for a power mower attachment, because “there is no likelihood of confusion from the virtually identical marks on these widely disparate products”).

The identified goods for the LIPEX cited mark are as follows:

Cl. 1: Lipids for use in the manufacture of pharmaceuticals; liposomes for use in the manufacture of pharmaceuticals.

Cl. 7: Machines for the manufacture of lipids and liposomes; machines in the nature of apparatus for the production, refinement, extrusion and storage of lipids and liposomes.

Based on the above identification of goods, the cited mark LIPEX is used in connection with lipids and liposomes that are sold to others for use in the manufacture of pharmaceutical products and machinery related to the manufacture of lipids and

liposomes. As noted clearly in the identification of goods and in the cited mark's own file history, use of the mark relates to the provision of the goods in the *manufacture* of pharmaceuticals and the mark is "not used for finished pharmaceuticals." See **Ex. A**, copy of LIPEX post-publication amendment filed by Northern Lipids. In other words, the cited mark is not used in connection with the final pharmaceutical product that is sold and marketed to the final end user. To the contrary, Applicant's Mark is filed for use in connection with "pharmaceutical preparations for the treatment of cardiovascular disorders." Applicant's Mark is intended for use in connection with the manufacture and sale of a finished pharmaceutical good that will be marketed to the end user, the patient with a cardiovascular disorder.

As noted above, the parties' respective goods serve very different purposes. Applicant's product is a finished manufactured pharmaceutical that is intended for patients with cardiovascular disorders. In stark contrast, the cited mark uses the LIPEX mark in connection with ingredients used in the manufacture of a pharmaceutical. Here the ingredients are "lipids" that can be broadly defined as fat-soluble, naturally occurring molecules and "liposomes" that are used to improve drug delivery. See **Ex. B**, general information on "lipids" and "liposomes" from wikipedia.com. There is no overlap of the intended use of the respective goods. The consumer is not subjected to the cited mark LIPEX or its possible use in connection with the end product, a pharmaceutical.

In *H. Lubovsky, Inc. v. Espirit de Corp.*, 228 U.S.P.Q. 814 (S.D.N.Y. 1986), the court found that there was no likelihood of confusion between defendant's mark, ESPRIT, used in connection with women's and children's sportswear, and plaintiff's mark, ESPRIT, used in connection with women's shoes, notwithstanding the fact that both marks were identical and used in connection with related (but different) goods. *Id. at 821*. In denying plaintiff's request for damages and injunctive relief, the court noted that although:

there is proximity between women's shoes and women's sportswear..., there is also an appreciable distance between plaintiff's shoes and defendant's clothing which diminishes the likelihood of confusion.

Id. at 818. The court observed that the trademark examiner, after rejecting defendant's application on two previous occasions, published defendant's ESPRIT mark for clothing because "plaintiff's ESPRIT registration for shoes 'stands as no bar to the registrability of applicant's [ESPRIT] mark [for clothing].'" *Id. at 816.* The examiner's decision was "based on the fact that [whereas] registrant's goods are shoes, applicant's goods contain no footwear items," *Id.*

Applicant submits that there is an appreciable distance between Applicant's TRILIPIX pharmaceutical preparation and Northern Lipids' LIPEX lipids and liposomes such that the relevant consuming public is not likely to be confused.

D. The public is not likely to be confused because the parties' respective goods are sold through distinct channels of trade.

Another factor that must be considered is "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *In re E.I. DuPont de Nemours & Co.*, 476 F.2d at 1361; *In re The Shoe Works Inc.*, 6 U.S.P.Q.2d 1890, 1891 (T.T.A.B. 1988) (reversing the examiner's refusal to register PALM BAY and Design based on a likelihood of confusion with registration for PALM BAY for highly related goods, where "applicant's restricted trade channels are not the normal channels in which registrant's goods would be found.")

Applicant's pharmaceutical will be targeted to healthcare professionals and patients, specifically, physicians who treat cardiovascular disorders and patients who have a cardiovascular disorder. In contrast, the cited mark is targeted to a specialized field of research scientists and pharmaceutical companies for use in connection with research, development, market and/or distribution of new drug indication. Thus, the trade channels are completely distinct, which weighs heavily against a likelihood of confusion.

E. The public is not likely to be confused because the parties' respective goods are sold to different target consumers.

In testing for likelihood of confusion, the Examiner should also consider the target consumers for the respective goods/services. *In re Shipp*, 4 U.S.P.Q.2d 1174,

1176 (T.T.A.B. 1987) (reversing refusal to register because, among other reasons, the parties' respective goods/services "are not so related that they would come to the attention of the same kinds of purchasers"); *David Crystal, Inc. v. Soo Valley Co.*, 471 F.2d 1245, 1246 (C.C.P.A. 1973) (affirming dismissal of opposition, because appellee's thread is sold to garment manufacturers whereas appellant's finished garments are sold to the general purchasing public).

As noted above, Applicant's pharmaceutical will be targeted healthcare professionals and patients, specifically, physicians who treat cardiovascular disorders and patients who have a cardiovascular disorder. In contrast, the cited mark is targeted to a specialized field of research scientists and pharmaceutical companies for use in connection with research and development of a new drug indication. The cited mark is only seen in the business-to-business context as opposed to the Applicant's mark that is used with the direct end-consumer. In fact, Applicant submits that the parties' respective goods are so distinct that they would not even come to the attention of the same class of purchaser. Thus, there is very little, if any, chance of overlap of target consumers, which militates heavily against a likelihood of public confusion. See *In re Shipp*, 4 U.S.P.Q.2d at 1176 (holding PURITAN and Design for laundry and dry cleaning services not likely to be confused with PURITAN for commercial dry cleaning machine filters or PURITAN for a variety of cleaning preparations, because while the goods/services are related in the sense that they all exist in the laundry and dry cleaning industry, they are not so related that they would come to the attention of the same kinds of purchasers); see also *David Crystal, Inc.*, 471 F.2d at 1246.

F. The relevant public is not likely to be confused because they are highly sophisticated consumers.

Applicant's clients (and presumably Northern Lipids') are highly sophisticated consumers who are not likely to be confused. Purchasers of Applicant's goods are highly educated physicians who are seeking to prescribe a finished manufactured pharmaceutical for a specific purpose. Likewise, Northern Lipids' clients are research and pharmaceutical companies who are highly educated and knowledgeable when

seeking out molecules and related ingredients for use in the research and development of a new drug indication.

III. SIGNIFICANCE OF THE MARK

The Examiner has requested Applicant specify whether the word TRILIPIX has any significance in the pharmaceutical, cardiovascular, health field, medical field, trade or industry, or as applied to the goods in the application.

Applicant submits that to the best of its knowledge other than its meaning as a trademark, the mark TRILIPIX has no significance in the pharmaceutical, cardiovascular, health field, or medical field, trade or industry, or as applied to the goods in the application.

IV. CONCLUSION

Based on the foregoing, Applicant submits that the relevant consuming public is not likely to be confused because the parties' marks differ in sound, appearance and meaning, respective goods function very differently, serve different purposes and are sold through distinct channels of trade to different, sophisticated target consumers. Accordingly, Applicant respectfully requests that the Examiner remove the Section 2(d) refusal and pass the application for publication.

Respectfully submitted,

Abbott Laboratories

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By: ./emv/_____

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