

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of Novo Nordisk A/S : Chris Doninger
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Mark: WEGOVY : Managing Attorney
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Serial No. 79/303393 : Law Office 111
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Filed: Oct. 29, 2020 :
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Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO LETTER OF SUSPENSION

This is in response to the Letter of Suspension issued in connection with the above-referenced application for WEGOVY based on a potential likelihood-of-confusion refusal with a prior pending application for TYGOVY, Ser. No. 87/953148. Applicant respectfully requests that the suspension be lifted, because there is no likelihood of confusion for the following reasons.

I. The Marks Are Visually and Phonetically Distinguishable

The differences between WEGOVY and TYGOVY are sufficient to avoid a likelihood of confusion. The marks' initial letters – WE and TY – are entirely different visually and phonetically.

It is well-recognized that consumers tend to view the initial elements of a mark as dominant. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1664 (TTAB 2010) (finding no likelihood of confusion between CITIBANK and CAPITAL CITY

BANK, and noting that CAPITAL CITY was dominant due to “its location as the beginning of applicant’s marks”); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”).

For pharmaceutical marks, the initial letters are particularly important in distinguishing products because healthcare providers typically order and fill prescriptions by selecting from a list of drug names displayed in alphabetical order on a computer screen. Thus, in the marketplace, WEGOVY and TYGOVY will be widely separated by other drug names, and are not likely to be confused.

The significance of distinguishing prefixes for pharmaceutical marks was emphasized in *Pharmacia Corp. v. Alcon Labs., Inc.*, where the court concluded that the differences in the marks TRAVATAN and XALATAN for competing glaucoma medications “strongly favor[ed]” a finding of no likelihood of confusion, and found that “the dominant prefixes of [the pharmaceutical marks] are distinctive and very different from one another.” 201 F. Supp. 2d 335, 352, 377 (D.N.J. 2002).

II. The Similarities in the Marks Are Weak Due to Coexisting Marks

The marks’ shared suffix should be discounted in the likelihood of confusion analysis due to the other marks in the market with the same “OVY” suffix. In particular, AJOVY and DESCOVY are widely available pharmaceutical preparations in the U.S. market. *See Ex. A* (AJOVY website and Statement of Use); *Ex. B* (DESCOVY website and Declaration of Use). At least five marks with the same “OVY” suffix have been registered or issued a Notice of Allowance in connection with pharmaceutical preparations. *See Ex. C* (USPTO records for AJOVY, DESCOVY, IXOVY, MELOVY and RULDOVY).

The other “OVY” suffix marks further demonstrate that the initial, distinguishing letters in WEGOVY and TYGOVY are dominant. *See, e.g., Pharmacia*, 201 F. Supp. 2d at 341 (finding the initial letters of pharmaceutical marks to be dominant elements where other pharmaceutical marks in the market bore similar suffixes). Indeed, in the context of pharmaceuticals, “suffix similarity is not uncommon and, for that very reason, not likely to confuse highly trained doctors.” *Id.* at 376 (citing *Upjohn Co. v. Schwartz*, 246 F.2d 254, 262 (2d Cir. 1957)).

III. The Differences in the Goods and Target Consumers Weigh Against Finding a Likelihood of Confusion

The WEGOVY application recites “pharmaceutical preparations for weight reduction and long term weight loss maintenance.” The TYGOVY application recites “pharmaceutical preparations, namely, leuprolide mesylate injectable suspension,” which the TYGOVY applicant’s website indicates is intended for treatment of advanced prostate cancer. *See* Ex. D (TYGOVY applicant’s press release regarding submission of leuprolide mesylate injectable suspension (LMIS) for FDA approval).

Obesity and advanced prostate cancer are unrelated health conditions that affect different patient populations, who are treated by different specialist healthcare providers – respectively, bariatricians and oncologists. Thus, the differences in the goods and target consumers further weigh against a likelihood of confusion.

IV. The Relevant Consumers Are Highly Sophisticated and Careful

In the context of treatments for advanced prostate cancer and obesity, “the relevant consumers are physicians because patients do not choose their own prescription drugs.” *Pharmacia*, 201 F. Supp. 2d at 374. *See also Smithkline_Beckman Corp. v. Pennex Prods. Co.*, 605 F. Supp. 746, 752-53 (E.D. Pa. 1985) (“Prescription drugs are a unique commodity. It is the

physician, not the consumer, who selects the prescription.”); *Pennwalt Corp. v. Zenith Labs., Inc.*, 472 F. Supp. 413, 422 (E.D. Mich. 1979) (“The dispensing physician is in fact the individual who truly exercises the consumer-patient’s freedom of choice in the marketplace when issuing a prescription.”)

Physicians are highly sophisticated and “capable of fine distinctions between marks, making confusion even less likely.” *Pharmacia*, 201 F. Supp. 2d at 374. *See also Doral Pharmamedics v. Pharmaceutical Generic Developers, Inc.*, 148 F. Supp. 2d 127, 138-39 (D.P.R. 2001) (no likelihood of confusion between prescription drugs EXOTIC-HC and GENEXOTIC-HC); *Pfizer Inc. v. Astra Pharm. Prods.*, 858 F. Supp. at 1309, 1328 (identical suffix unlikely to confuse physicians, who are “as sophisticated a group as one could imagine”); *Barre-National, Inc. v. Barr Labs., Inc.*, 773 F. Supp. 735, 742, 745 (sophistication made confusion between BARRE and BARR unlikely); *Schering Corp. v. Thompson Med. Co.*, 209 USPQ 72, 74 (S.D.N.Y. 1979) (no likelihood of confusion between POLARAMINE and PROLAMINE due to physician sophistication).

CONCLUSION

In view of the foregoing remarks and evidence, Applicant respectfully requests that the suspension be withdrawn, because there is no likelihood of confusion between the marks due to the marks’ distinguishing and dominant prefixes, the weakness of the similar portion of the marks due to coexisting similar marks, the differences in the goods and target consumers, and the sophistication of the relevant consumers.

Dated: New York, New York

May 12, 2021

Respectfully submitted,

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