

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 3, 99

Hearing:
June 17, 1999

Paper No. 43
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Oxycal Laboratories, Inc.
v.
Natural Organics, Inc.

Opposition No. 101,147
to application Serial No. 74/657,446
filed on April 7, 1995

Ronald W. Hind and Edward H. Renner of Cohn, Powell & Hind,
P.C. for Oxycal Laboratories, Inc.

Pasquale A. Razzano and Victoria J.B. Doyle of Fitzpatrick,
Cella, Harper & Scinto for Natural Organics, Inc.

Before Seeherman, Hairston and Wendel, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Natural Organics, Inc.
to register the mark ESTERPLEX for "dietary supplements."¹

Registration has been opposed by Oxycal Laboratories,
Inc. under Section 2(d) of the Trademark Act on the ground
of likelihood of confusion between applicant's mark and

¹ Application Serial No. 74/657,446 filed April 7, 1995, alleging
dates of first use of March 1, 1995.

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opposer's previously used and registered mark ESTER-C. Opposer is the owner of valid and subsisting registrations on the Supplemental Register and Principal Register for the mark ESTER-C for "vitamin and mineral supplements."²

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings, the file of the involved application, trial testimony (and related exhibits) taken by both parties; status and title copies of opposer's pleaded registrations; certain of applicant's responses to opposer's discovery requests filed by way of opposer's notice of reliance; and the file wrapper and contents of opposer's Registration No. 1,354,735 filed by way of applicant's notice of reliance. Both parties filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

The record shows that opposer has continuously used the mark ESTER-C for vitamin and mineral supplements since 1983. Opposer's particular ESTER-C product is Vitamin C in an esterified form, which is non-acidic and therefore causes less stomach upset than regular Vitamin C. Opposer's ESTER-C products are sold in about 95% of the health food stores in the United States under private labels such as Solgar,

² Registration No. 1,354,735 issued August 13, 1985 on the Supplemental Register, Section 8 affidavit filed; and

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Vitamin World, Pro Health, and Pure Planet. It is generally sold in tablet or capsule form and sometimes in combination with another vitamin or mineral. Opposer also sells ESTER-C products to direct sales companies such as Avon. Between 1994 and 1997 opposer spent approximately \$2.5 million in advertising and promoting ESTER-C products and between 1983 and 1997 opposer's sales of ESTER-C products totaled more than \$40 million.

The record shows that applicant is also in the business of marketing vitamin and mineral supplements to health food stores. Applicant is currently ranked number five among suppliers of vitamin and mineral supplements to health food stores. Applicant first used the mark ESTERPLEX in connection with a dietary supplement on March 1, 1995. Since that date, applicant's sales of ESTERPLEX dietary supplements have been approximately \$150,000 per year. Applicant's ESTERPLEX dietary supplement contains esterified Vitamin C and multiple ascorbate and is also gentle on the stomach.

Inasmuch as a status and title copy of opposer's Registration No. 1,598,104, which issued on the Principal Register, is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Registration No. 1,598,104 issued May 29, 1990 on the Principal

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

With respect to the goods, opposer's vitamin and mineral supplements and applicant's dietary supplements, are essentially identical. In fact, the record shows that the goods of both opposer and applicant are esterified Vitamin C. These kinds of goods are sold in the same channels of trade, namely, health food stores, to the same class of purchasers, namely, ordinary consumers.

Turning then to a consideration of the marks ESTER-C and ESTERPLEX, opposer argues that confusion is likely because the respective marks consist of three syllables and are dominated by the identical term ESTER.

Applicant, on the other hand, contends that confusion is not likely since the marks include different suffixes, and thus differ in their overall sound, appearance and meaning. Further, applicant contends that opposer's mark, because it contains the term "ESTER," is weak and therefore entitled to only a limited scope of protection. Applicant

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maintains that the term "ESTER" as applied to opposer's vitamin C product is highly suggestive and points to the following dictionary excerpts:

ester: a compound ether derived from an oxygenated acid. Funk & Wagnalls Standard Universal Dictionary (undated);
and

ester: any of a class of often fragrant compounds formed by the reaction between an acid and an alcohol usu[ally] with the elimination of water. Webster's Ninth New Collegiate Dictionary (1984).³

After careful consideration of the parties' arguments, we find that applicant's mark ESTERPLEX substantially resembles opposer's mark ESTER-C, such that when the marks are used on virtually identical products, confusion as to origin or affiliation is likely to occur. Each of the marks begins with the identical term ESTER and it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. *Presto Products Inc. v. Nice Pak Products Inc.* 9 USPQ2d 1895, 1897 (TTAB 1988); and *Mine Safety Appliances Co. v. Management Science America, Inc.*, 212 USPQ 105, 108 (TTAB 1987). Also, while we recognize the highly suggestive/descriptive significance of the term ESTER, this fact does not help to

³ Although applicant submitted this dictionary excerpt with its brief on the case, we have considered the excerpt even though it is technically untimely, inasmuch as the Board may properly take judicial notice of dictionary definitions. See *Hancock v. American Steel & Wire Rope Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953).

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distinguish the marks ESTER-C and ESTERPLEX. The term ESTER, as used in both marks conveys the same suggestive significance, namely that the Vitamin C is esterified.

Moreover, the suffixes "C" and "PLEX" in the respective marks are highly suggestive of an attribute (Vitamin C in the case of opposer's goods and a complex formula in the case of applicant's goods) of the particular products to which each mark pertains. In short, the marks are similarly structured with the term ESTER followed by a highly suggestive suffix, and when considered in their entireties, project essentially the same commercial impression when used in connection with the respective goods.

It must be remembered that, under actual marketing conditions, consumers do not have the luxury to make side-by-side comparisons between marks, and instead they must rely on hazy past recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). This is especially true in this case, because the goods can be relatively inexpensive and bought off the shelf in health food stores.

Another factor we have considered is that the record is devoid of any evidence of third-party uses and/or registrations of ESTER marks for goods similar to the types of goods involved in this case, namely, vitamin/mineral and dietary supplements.

Finally, notwithstanding any alleged weakness in opposer's mark, even weak marks are entitled to protection against the registration by a subsequent user of a substantially similar mark for virtually identical goods.⁴

In reaching our decision, we have not overlooked the instances of actual confusion that opposer asserts have occurred. Of course, applicant disputes that such instances constitute evidence of actual confusion. In view of our findings above with respect to the factors bearing on the issue of likelihood of confusion, we find it unnecessary to discuss whether actual confusion has occurred. However, to the extent that the instances constitute evidence of actual confusion, they merely reinforce our finding of likelihood of confusion.

Finally, to the extent that there is any doubt on the issue of likelihood of confusion, it is settled that such doubt must be resolved in favor of the prior registrant and against applicant. *Fernando Electric Mfg. Co. v JDF Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977).

⁴ While we note that opposer's first registration for the mark ESTER-C issued on the Supplemental Register which would indicate that the mark is merely descriptive, opposer's subsequent registration issued on the Principal Register without benefit of a claim of acquired distinctiveness. This latter registration would indicate that the mark is entitled to the full scope of protection.

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We conclude that purchasers familiar with opposer's vitamin and mineral supplements sold under the mark ESTER-C would be likely to believe, upon encountering applicant's mark ESTERPLEX for dietary supplements, that the respective goods originate with or are somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained.

E. J. Seeherman

P. T. Hairston

H. R. Wendel
Administrative Trademark Judges
Trademark Trial and Appeal Board