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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SmithKline Beecham Pharmaceuticals Company
v.
L. Molteni & C. dei F.lli Alitti S.p.A.

Opposition No. 105,213,925 to application Serial No. 75/024,925 filed on November 28, 1995

Roberta Jacobs-Meadway, Karol A. Kepchar and Scott W. Goode of Panitch Schwarze Jacobs & Nadel, P.C. for SmithKline Beecham Pharmaceuticals Company.

Lawrence E. Abelman and Julie Seyler of Abelman, Frayne & Schwab for L. Molteni & C. dei F.lli Alitti S.p.A.

Before Hanak, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

L. Molteni & C. dei F.lli Alitti S.p.A. has filed an application to register the mark "DIABREZIDE" for "pharmaceutical preparations for diabetes."[1]

SmithKline Beecham Pharmaceuticals Company has opposed registration on the ground that applicant's mark, when applied to applicant's goods, so resembles the mark "DYAZIDE," which opposer

[1] Ser. No. 75/024,925, filed on November 28, 1995, based upon an allegation of a bona fide intention to use such mark in commerce.

has previously used in connection with "diuretics and antihypertensive pharmaceuticals" and has registered for a "diuretic,"[2] as to be likely to cause confusion, mistake or deception.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.[3]

The record includes the pleadings; the file of the involved application; and, as part of opposer's case-in-chief, the testimony, with exhibits, of Meg Begley, its "DYAZIDE" product manager. As the rest of its case-in-chief, opposer has submitted notices of reliance upon (i) a certified copy of its pleaded registration showing that the registration is subsisting and owned by opposer; (ii) applicant's answers to certain of opposer's interrogatories; and (iii) copies of various articles from printed publications of general circulation. Applicant, as its case-in-chief, has furnished the testimony, with exhibits, of Giuseppi Seghi Recli, its managing director, and has filed notices of reliance on (i) opposer's answers to certain of applicant's interrogatories; (ii) copies of a number of third-party registrations; (iii) copies of excerpts from several medical reference works, including medical dictionaries; and (iv) copies of selected articles from printed publications of general

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[2] Reg. No. 755,837, issued September 3, 1963, which sets forth dates of first use of January 7, 1963; first renewal.

[3] While the answer also sets forth various allegations as "AFFIRMATIVE DEFENSES," the allegations are merely amplifications of applicant's denials of the salient allegations of the notice of opposition and therefore are not, properly speaking, affirmative defenses.

circulation. The record contains no rebuttal evidence. Briefs have been filed, but an oral hearing was not requested.

Priority is not in issue inasmuch as the certified copy of opposer's pleaded registration shows that such registration, as noted above, is subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In any event, the record also sufficiently establishes, as discussed below, that opposer is the prior user of its pleaded "DYAZIDE" mark in the United States. The only real issue to be determined, therefore, is whether applicant's "DIABREZIDE" mark, when used in connection with pharmaceutical preparations for diabetes, so resembles opposer's registered and/or previously used "DYAZIDE" mark for, respectively, diuretics and antihypertensives as to be likely to cause confusion as to the source or sponsorship of the parties' goods.

According to the record, opposer is one of the top ten pharmaceutical companies and is very well known in the pharmaceutical field. Opposer sells a variety of prescription drugs, including central nervous system products, antiarthritics, antiinfectives, antivirals, oncology products, cardiovascular products and endocrinology products. Opposer also sells over-the-counter drugs through its consumer health care subsidiary. One of its top three pharmaceuticals is a diuretic which, since the introduction thereof in the early 1960s, has continuously been sold by opposer under the mark "DYAZIDE" for use chiefly as an antihypertensive. Opposer's "DYAZIDE" product lowers blood pressure in patients through diuresis; that is, it removes water

from the body but is potassium sparing. The "DYAZIDE" product, however, is a prescription rather than an over-the-counter drug and has always been such.

Opposer sells its "DYAZIDE" product only to wholesalers, who in turn distribute it to hospitals, pharmacies, managed care facilities and nursing homes for use by patients for control principally of hypertension (high blood pressure). While opposer's witness testified that the "DYAZIDE" mark was coined by opposer, it is clear from the record that the suffix "-ZIDE" is derived from, and hence is suggestive of, hydrochlorothiazide, which is one of the active ingredients in opposer's diuretic as well as a number of other antihypertensives, and that the prefix "DY-," which is the phonetic equivalent of the prefix "DI-," is derived from, and thus is suggestive of, a diuretic. For many years, "DYAZIDE" has been "a considerable product" for opposer and, in 1994, opposer reformulated such product so as to make it available in a new strength. (Begley dep. at 12.) However, according to Ms. Begley, who from 1991 to 1995 was a sales representative for opposer before becoming "DYAZIDE" product manager in August of 1995, such product "was so well known [among doctors that] there was not a lot of educational effort involved" insofar as making physicians aware of the drug's benefits for patients with hypertension. (Id. at 14.) Moreover, despite the expiration of patent protection for opposer's "DYAZIDE" product and the increasing availability of generic substitutes since 1997, such product has remained the standard for antihypertensive diuretics of its kind.

Ms. Begley affirmed that hypertension is a condition which can occur in persons with diabetes. While, as a graduate of Rosemont College with a Bachelor's degree in French, she conceded that she is "not a diabetics expert," she indicated that "because of what's going on endocrinologically they ... have more problems cardiovascularly than others, and hypertension is one of the ways that that manifests itself." (Id. at 20-21.) In particular, she testified that:

> Q. Do you have any idea what percentage of diabetic patients may suffer from hypertension?
>
> A. I would say it's more than half, maybe 60%.

(Id. at 21.) She additionally pointed out that opposer's "DYAZIDE" product would be prescribed by a wide variety of doctors and specialists, including endocrinologists and "anyone who's treating a patient who would likely have high blood pressure." (Id. at 17.)

Opposer advertises and otherwise promotes its "DYAZIDE" product to doctors by detailing it in consultations conducted by sales representatives,[4] staffing booths at medical conventions, running advertisements in medical journals, sending direct mail flyers, providing product literature and free samples for distribution to patients, and furnishing other "give-aways," such

[4] The term "detailing," according to Ms. Begley, involves a process of first calling on doctors and "explaining a ... disease state and what to look for, and then ... explain[ing] to them why your product works in this disease state. And then you may explain to them why your product should be the one chosen or used over a competitor." (Begley dep. at 14.) While a detailing session can last a couple of minutes to a half an hour, on average the duration is "eight to ten minutes." (Id. at 37.)

as writing tablets, pocket lab test guides and calipers for quick reading of EKG charts, which bear the mark. While ads appearing in certain journals target the "DYAZIDE" product to, for example, primary care physicians, family practitioners, general practitioners and cardiologists, the product is also advertised in publications "that every doctor reads regardless of their specialty," such as the Journal of the American Medical Association and the New England Journal of Medicine. (Id. at 38.) Opposer also runs ads for its "DYAZIDE" product which are directed to pharmacists in such journals as Drug Topics, Pharmacy Times, U.S. Pharmacist, Triple I Prescribing Guide and Monthly Prescribing Reference. The "DYAZIDE" product, furthermore, is listed, as is the case with other medications in actual use, in the Physicians' Desk Reference, an annual compilation which sets forth indications[5] for pharmaceuticals and their prescribing information.[6]

The "DYAZIDE" mark is used on packaging, product literature and prescribing information. The product itself is available in single unit packages of 100 capsules, patient starter packages of four capsules, and bottles of 100 and 1,000 capsules. Sales of the "DYAZIDE" product in 1997, the last year for which such figures were available (and not stated to be confidential), were in excess of $48.9 million. According to Ms.

[5] According to Ms. Begley, an "indication" is "clearance that the FDA has given for a particular product to be sold for a particular disease state." (Id. at 19.)

[6] Ms. Begley noted in her testimony that, in addition to physicians, nurses and pharmacists, she "know[s] a lot of lay people who read" such publication. (Id. at 46.)

Begley, during the time in the 1990s in which she has been involved with the "DYAZIDE" product, sales thereof have been substantial and such drug has been an important product for opposer.[7] Moreover, while it appears that annual sales of the "DYAZIDE" product peaked around 1986 and have steadily declined since then, annual sales have remained "considerable," with several million prescriptions for the product having been written in 1997 and another couple of hundred thousands therefor having been written in January 1998 alone. (Id. at 59.) In the case of advertising and promotional expenditures, Ms. Begley conceded that, with the coming of generic substitutes in 1997, opposer has backed off its spending thereon, but it is still the case that it has expended appreciable sums, totaling in the neighborhood of a couple hundred million dollars, to advertise and promote its "DYAZIDE" product since the introduction thereof around 1963.[8] However, at present the product is not actively promoted.

In addition, as to the commercial success of opposer's "DYAZIDE" product and the asserted fame of such mark, Ms. Begley testified as follows:

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[7] Although opposer's witness did not testify as to any specific sales figures other than those for 1997, she did identify opposer's Exhibit 17 as a listing of sales and advertising amounts for the years 1964 through 1996. Furthermore, even though marked "CONFIDENIAL ATTORNEY'S EYES ONLY," opposer's main brief nevertheless sets forth specific sales and advertising totals for such period as well as for the late 1980s. While we will not state those figures in this opinion since they were offered as confidential business information, suffice it to say that sales of opposer's "DYAZIDE" product during the 33-year period covered by Exhibit 17 exceed several billion dollars and totaled a few hundred million dollars in the late 1980s.

[8] Again, while opposer's main brief lists a specific total amount, such amount is not set forth in this opinion since it was indicated at trial to be confidential business information.

> Q. Do you believe that the Dyazide product is well known among patients who have hypertension?
>
> ....
>
> A. I believe it, yes.
>
> Q. Based on what?
>
> A. Based on the fact that so many people are still using Dyazide.

(Id. at 69.) Furthermore, opposer also offered, by means of a notice of reliance, a number of unsolicited articles appearing in the popular press which happen to mention its "DYAZIDE" product.

As of the March 19, 1998 date of her testimony, Ms. Begley noted that opposer does not sell a drug for the treatment of diabetes. She added, however, that opposer does have plans for a diabetes drug, but conceded that she does not have any involvement therewith and did not provide any specifics as to such plans. Finally, with respect to any third-party marks which are similar to opposer's mark, she testified as follows:

> Q. Are you aware of any trademarks other than "Dyazide" that start with a D-Y-A and end in Z-I-D-E?
>
> A. No.
>
> Q. Are you aware of any trademarks that start with D-I-A and end in Z-I-D-E?
>
> A. No.

(Id. at 73-74.) Ms. Begley admitted on cross-examination, however, that she was familiar with competitors of opposer using marks, such as "MAXZIDE," which utilize as a portion thereof the suffix "-ZIDE" in connection with diuretics/antihypertensives in

which a major ingredient, like opposer's "DYAZIDE" product, is hydrochlorothiazide.

Applicant is an Italian pharmaceutical company located in Florence, Italy. Its "DIABREZIDE" product, of which the active ingredient is gliclazide, is "for the treatment of non-insulin dependent diabetes mellitus." (Rechi dep. at 2.) Although applicant's managing director has no direct knowledge of the derivation of such mark since applicant bought the mark and its associated product from another Italian pharmaceutical company in 1991, Mr. Rechi testified that he suspected that the "-ZIDE" suffix is reflective of the suffix portion of the name of the active ingredient in the "DIABREZIDE" product while the prefix "DIAB-" is obviously suggestive of a diabetes treatment.

Although applicant is currently using its "DIABREZIDE" mark in Italy on product packaging for its prescription pharmaceutical preparation for diabetes, such mark is not in use in the United States for any goods nor is the associated product sold in the United States. Likewise, applicant has not advertised or otherwise promoted its "DIABREZIDE" product in the United States; such product has not been discussed at any conferences or professional meetings here; and it has not been the subject of any clinical trials conducted here or of any other studies that have been reviewed or presented here. In short, while the "DIABREZIDE" product is not sold or marketed in the United States, applicant insists that it intends to use such mark in the United States, but only in connection with a prescription product for treatment of non-insulin dependent diabetes millitus.

Applicant, moreover, does not manufacture or sell a prescription or non-prescription diuretic/antihypertensive drug and it is not in applicant's "actual foreseeable plans" to do so. (Id. at 18.) Mr. Rechi admitted, however, that patients with diabetes may suffer from hypertension, but he claimed to lack the medical background necessary to know whether such conditions occur often in the same patient as claimed by Ms. Begley.

In addition, Mr. Rechi conceded on cross-examination that he is not aware of any pharmaceutical mark other than "DIABREZIDE" which combines both a "DIA-" prefix and a "-ZIDE" suffix. Similarly, he stated that he knows of no pharmaceutical mark other than "DYAZIDE" which combines both a "DYA-" prefix and a "-ZIDE" suffix. He further testified, however, that based upon consultation of the 1998 edition of Physicians' Desk Reference, he has personal knowledge that the following marks are in use in the United States for diuretics and/or antihypertensives which have hydrochlorothiazide as an active ingredient: "PRINZIDE," "CAPOZIDE" and "ALDACTAZIDE". Nevertheless, Mr. Rechi also testified that he had never seen any packaging for such products nor did he have any knowledge as to how long the products have been sold in the United States.

Like opposer, applicant promotes its "DIABREZIDE" product by having sales representatives detail the goods to physicians and intends to detail such product to doctors in the United States.[9] However, unlike the "DYAZIDE" antihypertensive

[9] Mr. Rechi testified that, in the context of promoting pharmaceutical products, he understood the term "detailing" to mean "bringing to the

sold by opposer, applicant obviously has no need to detail its "DIABREZIDE" diabetes drug to cardiologists. While applicant, like opposer, has distributed samples of its product to doctors, Mr. Rechi claims that whether applicant intends to do such in the United States "will depend on the marketing strategy adopted." (Id. at 41.) Applicant, in addition, details its "DIABREZIDE" product directly to hospitals, but whether it intends to do so as to hospitals in the United States likewise "will depend on the marketing strategy adopted." (Id.)

Applicant's "DIABREZIDE" product, unlike opposer's "DYAZIDE" product, has not received any coverage in the media. The former also has not been submitted to the U.S. Food and Drug Administration or any other U.S. regulatory agency for approval. According to Mr. Rechi, he first became aware of applicant's "DYAZIDE" product on receiving the notice of opposition which commenced this proceeding. He also testified that he is unaware of any occasion in which there was confusion between the respective marks, noting that no one has ever expressed a concern or otherwise mentioned to him that the marks "DIABREZIDE" and "DYAZIDE" are similar.

Finally, by notice of reliance applicant has shown that a number of articles appearing in printed publications of general circulation make mention of third-party marks featuring the suffix "-ZIDE" for various medications, including preparations

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physician's attention the product's properties." (Rechi dep. at 37.) He further noted, however, that applicant is not certain whether it will detail pharmacists in the United States with respect to its "DIABREZIDE" product.

for treatment of hypertension such as "OPTIZIDE," "MICROZIDE," "RAUZIDE," "MINIZIDE," "PRINZIDE," "MAXZIDE," "APRESAZIDE," "HYDRA-ZIDE" and "ALDACTAZIDE," while two other articles refer to the third-party mark "DIABEX," which utilizes the prefix "DIA-" in connection with a product which is an oral antidiabetic drug. Another notice of reliance by applicant reveals that primary or active ingredients listed for various brands of antihypertensives are polythiazide in the case of the "MINIZIDE" product and hydrochlorothiazide in instances of the "PRINZIDE," "CAPOZIDE" and "ALDACTAZIDE" products. Additionally, a notice of reliance by applicant is accompanied by copies of numerous third-party registrations for marks with the suffix "-ZIDE," including those for diuretics and/or antihypertensives such as "LOZIDE," "MICROZIDE," "RAUZIDE," "MINIZIDE," "PRINZIDE," "MAXZIDE," "APRESAZIDE," "ALDACTAZIDE," "HYDROZIDE" and "VISKAZIDE," along with several other third-party registrations for marks with the prefix "DIA-," including those for pharmaceutical preparations for treating diabetes such as "DIAMICRON" and "DIABEX."

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that on this record confusion as to source or affiliation is not likely to occur. As a starting point, it is plain that while the respective goods are prescription pharmaceutical preparations which would be sold through the same channels of trade, such as wholesale, retail and hospital pharmacies, managed care facilities and nursing homes, and would

be prescribed by physicians for purchase and use, ultimately, by patients from the general public, the goods are nevertheless specifically directed to different indications. Opposer's diuretic is principally utilized as an antihypertensive while applicant's product is for the treatment of diabetes. Although the record indicates that hypertension and diabetes can coincide in the same patients and that, in particular, hypertension can occur in up to 60 percent of persons with diabetes, the fact remains that such medical conditions are not the same illness. Hence, the drug treatments therefor, even though they may be prescribed in many instances by the same doctor, are not identical.

Moreover, on this record, there is nothing which shows that the same pharmaceutical companies market both diuretics and/or antihypertensives, on the one hand, and preparations for the treatment of diabetes, on the other, much less that such is done under the same or similar marks. Here, not only does applicant not market an antihypertensive and has no plans to do so in the foreseeable future, but it is particularly telling that opposer, which is a top ten pharmaceutical company and is very well known in such field, does not sell a drug for the treatment of diabetes. Although opposer's witness testified to a generalized intent on the part of opposer as to plans for a diabetes drug, she provided nothing specific. Physicians, pharmacists, nurses and others in the pharmaceutical field would thus not be conditioned to expect that the same drug company

typically makes and/or sells any and all kinds of pharmaceutical preparations.

The conditions of sale surrounding prescription pharmaceuticals also lessen the prospects for any likelihood of confusion as to product origin or affiliation. Specifically, the industry standard practice of company sales representatives calling upon doctors and pharmacists to educate and advise them with respect to the company's prescription drugs and their indications necessarily means that such customers would typically know the source of the pharmaceutical preparations they prescribe and/or buy. Notwithstanding that such detailing sessions on average last only eight to ten minutes, physicians, pharmacists and nurses are, by the very nature of their professions, highly knowledgeable and sophisticated customers when it comes to medications, given their training in pharmacology and the care, due to the recognized potential for harmful drug interactions, they must exercise in prescribing medications for particular indications. See, e.g., Warner-Hudnut, Inc. v. Wander Co., 280 F.2d 435, 126 USPQ 411, 412 (CCPA 1960) [physicians and pharmacists constitute "a highly intelligent and discriminating public"]. While patients, as the ultimate consumers, would admittedly lack such specialized knowledge, it must be remembered that unlike the case with over-the-counter medications, it is the patient's doctor or pharmacist which, in the case of prescription drugs, selects the medication and the patient, relying upon the expertise of the medical practitioner, simply has his or her prescription filled without the need for any deliberation.

Furthermore, while the record contains testimony that it is becoming an increasingly common practice in the industry, due to a generalized shortage of and the expenses associated with sales representatives, for pharmaceutical companies to detail the prescription drugs of other such companies as well as those of their own, this development does not increase the prospects for confusion as to origin or affiliation to occur. In particular, it is highly unlikely that if, as contended by opposer, confusion as to source or sponsorship is likely from the contemporaneous sale and marketing of its "DYAZIDE" diuretic/antihypertensive and applicant's "DIABREZIDE" diabetes treatment, opposer would detail applicant's product in conjunction with its own or authorize applicant to detail opposer's product along with applicant's pharmaceutical preparation. Contrary to opposer's contentions, circumstances simply do not exist which, as a practical matter, would foster a likelihood of confusion among the parties' prescription drug products.[10] The conditions of sale, instead, are such that the respective goods would be marketed primarily to careful and sophisticated medical professionals who plainly would

[10] While it is possible that another pharmaceutical company might detail both opposer's products as well as those of applicant, it seems unlikely that opposer would knowingly allow such a situation to occur. Moreover, as our principal reviewing court has cautioned in this regard:

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from Witco

not impulsively select and prescribe the products for their patients.

As to the respective marks, we agree with applicant that they are distinguishable, both by those in the medical and pharmacy fields as well as by patients, with respect to sight, sound, connotation and commercial impression. Admittedly, there are similarities between the marks "DYAZIDE" and "DIABREZIDE" in that both begin, respectively, with the same sounding prefixes, "DYA-" and "DIA-," and both end with the identically appearing and pronounced suffix, "-ZIDE." However, when considered in their entireties, not only is the letter "Y" in the first syllable of opposer's three-syllable mark visually distinct, but significantly, the additional syllable "BRE" in applicant's four-syllable mark is totally dissimilar in sight and sound from opposer's mark. While there is no correct pronunciation of a mark, we essentially concur with applicant that, overall, even allowing for "[t]he fact that the letter 'y' will be pronounced as in 'why', DYAZIDE or DIE-A-ZIDE sounds not at all like DI-A-BRE-ZIDE" and that, furthermore (**emphasis by applicant**):

> Given the presence of the BRE-syllable, it would be highly unlikely for a purchaser to fail to pronounce Applicant's mark as DI[-]A-**BRE**-ZIDE. Similarly, a purchaser would only pronounce DYAZIDE as DY[-]A[-]ZIDE ... [and] would not insert an extra middle syllable. Thus, taking into account the fundamental principle of law that any inquiry as to whether the marks "sound alike" must focus on the "usual pronunciation by the ordinary consumer," *Smithkline Beckman, Corp. v. Proctor & Gamble Co.*, 223 U.S.P.Q. 1230,

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Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

> 1237 (N.D.N.Y 1984), it becomes apparent that the marks bear no [significant] verbal similarity.

Additionally, we concur with applicant that the marks at issue are connotatively distinguishable. Opposer's "DYAZIDE" mark is registered for a diuretic used as an antihypertensive. The compound hydrochlorothiazide is one of the active ingredients in opposer's "DYAZIDE" product and is also an active component of several third-party diuretics/antihypertensives available in the United States under such registered marks as "ALDACTAZIDE," "PRINZIDE" and "MAXZIDE" and the mark "CAPOZIDE". All of such marks feature the suffix "-ZIDE," which is also a formative in several other marks which are the subjects of third-party registrations for diuretics and/or antihypertensives, such as "LOZIDE," "MICROZIDE," "RAUZIDE," "MINIZIDE," "APRESAZIDE," "HYDROZIDE" and "VISKAZIDE." Although third-party registrations do not establish that the marks which are the subjects thereof are in use and that the purchasing public is familiar therewith, such registrations may be given some weight to show the meaning of a mark in the same way that dictionaries are used. See, e.g., Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976).

Here, it is apparent that, rather than being arbitrary, the suffix "-ZIDE" is highly suggestive of an active ingredient of diuretic/antihypertensive pharmaceutical products and it is plain, in light of the several third-party marks acknowledged to be in actual use, that physicians, pharmacists, nurses and others in the medical field are accustomed to distinguishing among marks

containing the suffix "-ZIDE." Moreover, irrespective of the presence of a "Y" instead of an "I" in the first syllable of opposer's mark, it is clear that that the prefix "DY-" is the phonetic equivalent of the prefix "DI-" and is thus suggestive of a diuretic.

Consequently, to those with training in medicine, pharmacology or nursing, opposer's "DYAZIDE" mark is suggestive of a diuretic which contains hydrochlorothiazide as a major ingredient. Applicant's "DIABREZIDE" mark, by contrast, is connotatively different in that the "-ZIDE" suffix thereof is suggestive of a different active ingredient, namely, gliclazide, and the prefix "DIA-," as confirmed by the third-party registrations for such marks as "DIAMICRON" and "DIABEX" for pharmaceutical preparations for treating diabetes, is suggestive of a diabetes treatment. Applicant's mark, therefore, intimates to doctors, nurses and pharmacists that it is a gliclazide-based preparation for use against diabetes.

Overall, given the above-noted differences in sound, appearance and connotation, we find that applicant's "DIABREZIDE" mark for its pharmaceutical preparations for diabetes so differs in commercial impression from opposer's "DYAZIDE" mark for its diuretic for antihypertensive use that confusion as to the source or sponsorship of the parties' prescription drug products would not be likely to occur. The differences in suggestiveness of the first and last syllables of each mark, as well as the differences in sound and appearance due to the presence of the additional syllable "BRE" in applicant's mark, sufficiently distinguish the

marks at issue, notwithstanding that such marks, as argued by opposer, "incorporate both a 'DYA/DIA' prefix and a '-ZIDE' suffix ...." See, e.g., Tektronix, Inc. v. Daktronics, Inc., supra at 694 ["[b]ecause marks, including any suggestive portions thereof, must be considered in their entireties, the mere presence of ... common, highly suggestive portion[s] is usually insufficient to support a finding of likelihood of confusion"].

Furthermore, as to the patients for whom the parties' medications have been prescribed, including those who are under treatment for both diabetes and hypertension, it is conceded that while the differences in suggestiveness of the "-ZIDE" suffix would not be apparent, it is still the case that the marks are sufficiently distinguishable. Plainly, even if patients are unaware of its meaning, the "-ZIDE" suffix is a commonly adopted formative for pharmaceutical preparations and the suggestiveness of the prefix "DY-" as used in connection with a diuretic and the prefix "DIA-" for a diabetes medication would still be readily apparent, even to persons lacking in medical, pharmacological or nursing backgrounds. Thus, even among the ultimate consumers of the parties' prescription pharmaceutical products, the marks "DYAZIDE" and "DIABREZIDE" are distinguishable and confusion, including the risk of harm from mistaking one brand of medication for another, is not likely.[11]

[11] It would appear to be speculative at best as to whether applicant's "DIABREZIDE" product for treatment of diabetes, if it is cleared for sale in the United States, and opposer's "DYAZIDE" product for control of hypertension would both be routinely prescribed for diabetes patients with hypertension. As stated in the excerpt about "DYAZIDE" made of record by opposer from The Pill Book (7th ed.), consumers are cautioned under the heading of "Drug Interactions" that "[i]f you

Opposer, however, claims in the recitation of facts in its initial brief that its "DYAZIDE" mark is famous and, hence, is entitled to a broad scope of protection. As indicated by our principal reviewing court in Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), "the fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection." We find, however, that on this record opposer simply has not proven its assertion of fame for its "DYAZIDE" mark.

In particular, while Ms. Begley testified, as noted earlier, that "DYAZIDE" has been "a considerable product" for opposer for many years, that it has remained the standard for pharmaceuticals of its kind and that she believes that such product "was so well known [among doctors that] there was not a lot of educational effort involved" insofar as detailing the drug's benefits, such opinions do not mean that opposer's "DYAZIDE" product had in fact become famous and/or that it still

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begin taking Insulin or an oral antidiabetic drug and begin taking Dyazide, the Insulin or antidiabetic dose may have to be modified." Further, under the heading of "Special Information," such publication warns that "[d]iabetic patients may experience an increased blood-sugar level and a need for dosage adjustments of their antidiabetic medicines." If true, it would thus seem questionable as to whether applicant's and opposer's products would be the prescription drugs of choice for treatment of diabetic patients who develop or have hypertension. Clearly, as pointed out in the excerpt from the Physicians' Desk Reference (52d ed. 1998), made of record by opposer as Exhibit 10 to Ms. Begley's deposition, "DYAZIDE" is contraindicated for use in diabetic patients with hyperkalemia (preexisting elevated serum potassium) in that: "Hyperkalemia has been reported in diabetic patients with the use of potassium-sparing agents even in the absence

is. Although the record also establishes, in particular, that opposer has enjoyed substantial sales of its "DYAZIDE" product, amounting to nearly $49 million in 1997 alone, and since the early 1960s has had significant and continuing commercial success with such product, despite recently declining sales due in part to the introduction in 1997 of generic substitutes, the record gives no indication as to the overall size of the market for diuretics/antihypertensives and, thus, what percentage share thereof the "DYAZIDE" product constitutes for opposer. Therefore, while we again note that opposer is presently one of the top ten pharmaceutical companies and its "DYAZIDE" product is one of its top three products, we cannot conclude therefrom that the "DYAZIDE" mark is necessarily famous.

Moreover, opposer has submitted only a few examples of its advertising and promotional efforts over the years for its "DYAZIDE" product, such as a direct mail flyer distributed to physicians and pharmacists over five years ago to announce the reformulation of the "DYAZIDE" product in 1994. Of the other examples of its advertising and promotional materials in the record, including photographs of convention exhibit booths, sample give-a-ways, a couple of trade journal ads and a piece of educational patient literature, only the latter has additionally been directed to members of the general public rather than solely to pharmacists and those in various medical professions.

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of apparent renal impairment. Accordingly, serum electrolytes must be frequently monitored if *Dyazide* is used in diabetic patients."

Opposer appears, from its notice of reliance on excerpts from publications of general circulation, to base its claim of fame for its "DYAZIDE" mark in large measure on articles mentioning such mark principally in medical and pharmaceutical journals and occasionally in general interest newspapers and magazines. In particular, opposer points to an article from the July 1991 issue of FDA Consumer in which "DYAZIDE" is ranked sixth on a list of ten prescription drugs most often dispensed in U.S. pharmacies in 1990. In addition, it has not escaped our notice that a survey reported in the April 1994 edition of American Druggist listed "DYAZIDE" as thirtieth among the top 200 most prescribed drugs during 1993, down from its ranking as twenty-fourth in 1992. A similar survey appearing in the February 1997 issue of the same publication reveals, however, that among the top 200 most frequently dispensed drugs by community pharmacies, "DYAZIDE" had dropped to number 116 by 1996, with roughly 3,857,000 prescriptions, falling from number 76 in 1995. Nevertheless, opposer concludes from such evidence and passing mentions of "DYAZIDE" in the popular press as the brand name of a diuretic that: "As a result of Opposer's efforts and expenditures, 'DYAZIDE' product has received substantial unsolicited press coverage as being among the leading pharmaceuticals for the treatment of hypertension ...."

There are several reasons why we cannot agree with opposer's conclusion. First, to the extent that opposer is relying upon the articles excerpted from publications in general circulation for the truth of the statements therein (e.g., the

ranking in prescription popularity of its "DYAZIDE" product for certain years), as opposed to what they show on their face (e.g., the mentioning of the mark "DYAZIDE"), such evidence constitutes inadmissible hearsay which has not been shown to be within any exception thereto. Fed. R. Evid. 801, 802 and 803; and TBMP Section 708. Second, the exceedingly small number of excerpts furnished by opposer scarcely amounts to a demonstration of "substantial unsolicited press coverage," especially when consideration is given to the fact that its "DYAZIDE" product has been on the market since the early 1960s. Finally, even if the articles were to be accepted, in light of the lack of any objection from applicant in its brief, for the truth of the statements contained therein, it is apparent that any possible renown which opposer's "DYAZIDE" product may have at one time otherwise enjoyed has eroded appreciably, given the plunge in prescriptions for such medication during the 1990s.

In view thereof, and inasmuch as opposer, after the introduction of competition from generic substitutes in 1997, in any event no longer actively promotes its "DYAZIDE" product, we cannot concur with the assertion in opposer's initial brief that its "'DYAZIDE' product is ... extremely well known among the physicians who write the prescriptions and the pharmacists that fill them, as well as among patients who receive treatment for hypertension, including diabetics ...." That is, notwithstanding that opposer, since about 1963, has expended appreciable sums, totaling in the neighborhood of a couple hundred million dollars, to advertise and promote its "DYAZIDE" product and has had and

continues to have considerable (although declining) sales thereof, it simply cannot be said, in the notable absence of any indication as to market share, that as of the close of the trial herein opposer has proven that its "DYAZIDE" mark is famous for a diuretic/antihypertensive and that such mark is entitled to a correspondingly broad scope of protection.

Decision: The opposition is dismissed.

E. W. Hanak

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board