

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: October 9, 2002

Paper No. 14

cl

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Horizon Pharmaceutical Corporation

Serial No. 75/894,932

Judith A. Powell of Kilpatrick Stockton LLP for Horizon
Pharmaceutical Corporation.

Brian A. Rupp, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Simms, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Horizon Pharmaceutical Corporation (applicant), a
Georgia corporation, has appealed from the final refusal of
the Trademark Examining Attorney to register the mark FIRST
HORIZON PHARMACEUTICAL ("PHARMACEUTICAL" disclaimed) for
prescription pharmaceutical preparations for humans,
namely, pain medications, chelating agents, antihistamine-
decongestants, eardrops, expectorants, liquid antitussives,
sustained-release medications for treating heart rhythm

Serial No. 75/894,932

disorders, synthetic anticholinergics, preparations for treating cardiology conditions, preparations for treating gastroenterology conditions, preparations for neurology conditions and preparations for treating women's health.¹

The Examining Attorney has refused the registration under Section 2(d) of the Act, 15 USC §1052(d), based upon Registration No. 1,977,627, issued June 4, 1996, Section 8 accepted and Section 15 acknowledged, for the mark HORIZON for vitamins, dietary herbal supplements and nutritional supplements. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.²

It is the Examining Attorney's position that confusion is likely. The Examining Attorney contends that the dominant part of applicant's mark ("HORIZON") is identical to the registered mark and that the marks are similar in commercial impression. In this connection, the Examining

¹Application Serial No. 75/894,932, filed January 13, 2000, based upon applicant's bona fide intention to use the mark in commerce. Applicant has claimed ownership of Registration No. 2,000,679, issued September 17, 1996, for the mark HORIZON PHARMACEUTICAL ("PHARMACEUTICAL" disclaimed) for prescription pharmaceutical products, namely, antihistamine-decongestants, eardrops, expectorants and liquid antitussives.

²The Examining Attorney has objected, under Trademark Rule 2.142(d), to material submitted for the first time with applicant's appeal brief. This material includes a copy of an agreement between registrant and a third party which is part of a file of the cited registration, wherein the registrant agreed to use its mark HORIZON in connection with its "Natural Products" line. The Examining Attorney's objection is sustained, and we have excluded all material attached to the applicant's brief for the first time. (Copies of material previously submitted have been considered.) Applicant's contingent request for remand in its reply brief to consider this material is denied.

Serial No. 75/894,932

Attorney argues that one feature of a mark may be more significant in creating a commercial impression. In particular, the word "FIRST" is assertedly commonly used and the word "PHARMACEUTICAL" is generic and disclaimed. The Examining Attorney argues that purchasers would call for applicant's goods by the name "HORIZON." The Examining Attorney also notes that the recollection of the average purchaser may be imprecise, because he or she may normally retain only a general impression of a trademark.

With respect to the goods, it is the Examining Attorney's position that applicant's goods could encompass registrant's vitamins and supplements, and that, in fact, according to applicant's Web site, applicant sells vitamins and minerals. The Examining Attorney also points to a number of third-party registrations showing that other entities sell both over-the-counter vitamins and supplements as well as prescription drugs under the same mark. Finally, the Examining Attorney asks us to resolve any doubt in favor of the registrant.

Applicant, on the other hand, contends that the marks are different in sound, appearance and connotation, with applicant's mark suggesting that applicant's product is a pharmaceutical which is first in line, value or quality. Applicant also notes the existence of various third-party

Serial No. 75/894,932

marks, such as HORIZON for veterinary preparations (this registration was previously cited by the Examining Attorney as a bar but later withdrawn) and HEALTHY HORIZONS for multivitamin supplements. Applicant argues, therefore, that the mark HORIZON is a weak one entitled to a limited scope of protection.

Applicant also argues that registrant's goods and applicant's goods are specifically different products sold in different channels of trade and by different marketing methods. Applicant contends that registrant's vitamins and supplements are sold over the counter in health food stores, grocery stores and drug stores for purchase by ordinary consumers, whereas applicant's prescription drugs are prescribed by doctors and purchased by wholesale pharmacists. While applicant's goods are eventually purchased by ordinary consumers, applicant contends that the fact that its goods are prescription drugs shows that there is a high degree of care in the purchasing decision for these goods. With respect to the third-party registrations made of record by the Examining Attorney, applicant's attorney argues that many of those are for house marks covering a wide range of products. Further, applicant argues that the probability of a health food

Serial No. 75/894,932

company such as registrant expanding into prescription products is low.

Finally, applicant points to its ownership of a similar mark (HORIZON PHARMACEUTICAL) which was allowed over the cited mark, and maintains that the applied-for mark is even more distinct than its previously registered one. Applicant further contends that there have been no instances of actual confusion with respect to its registered mark HORIZON PHARMACEUTICAL since those products were introduced in 1992, and that there has been no actual confusion between the registered mark and the applied-for mark in the two years since this product has been on the market.

The record on behalf of the Office includes numerous copies of third-party registrations. However, some of them are not use-based, but rather based on Section 44 of the Act, 15 USC §1126. Because these registrations do not show that these goods have ever been sold in this country, they are entitled to no weight. Some of the registrations do appear to be in the nature of house marks, but the marks identify the products of pharmaceutical companies, not diversified manufacturing companies. For example, Novopharm Ltd. owns the registered mark n and design for vitamins and minerals as well as antihistamines,

Serial No. 75/894,932

antibiotics, anticholinergics, cardiovascular, central nervous system and other drugs; Medisave Pharmacies, Inc. owns the mark MEDISAVE for vitamin and mineral supplements as well as pharmaceutical preparations for treating cold and flu, analgesics, antacids, cough drops and eye drops; Mission Pharmacal Company owns the registered mark MISSION PHARMACAL and design for vitamin and mineral preparations as well as for laxatives, analgesic preparations, antispasmodic treatments, anticholinergics, antihistamines, antibiotics and other drugs; Formulation Technology, Inc. owns FORMULATION TECHNOLOGY for dietary supplements and for pharmaceutical preparations for the treatment of infectious diseases, immunology and allergic disorders, cardiovascular disorders, gastrointestinal, metabolic and neurologic and other disorders; and Henry Schein Inc. owns the registered mark SCHEIN for such goods as vitamin supplements and analgesics, antacids, antibiotics, antihistamines, depressants and expectorants. Other registrations are for the mark HEALTH BALANCE for both vitamins and nutritional supplements as well as analgesics, antihistamines, decongestants and allergy medications; and the mark MNL for vitamin and mineral supplements as well as decongestants, antacids, motion sickness pills, laxatives, antihistamines, cough medicines and expectorants.

Serial No. 75/894,932

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973).

However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood-of-confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.

With respect to the marks involved, the principle is well established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Disclaimed or descriptive and generic terms, though they must be considered when comparing marks, typically are less significant. *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001, 1003-04 (Fed. Cir.

2002). Here, while applicant's and registrant's marks must be compared in their entireties, we agree with the Examining Attorney that the dominant part of applicant's mark is the word "HORIZON," because the word "FIRST" is either descriptive or highly suggestive and the word "PHARMACEUTICAL" is generic. These marks, while not identical, have obvious similarities in sound and appearance and similar commercial impressions.

While we agree with applicant that the marks at issue are distinguishable on the basis of a side-by-side comparison, such is not the proper test to be used in determining the issue of likelihood of confusion, inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is, accordingly, on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*,

Serial No. 75/894,932

211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Turning now to the goods, it is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services be related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer, or that there is an association between the producers of the goods and/or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

In this regard, the Examining Attorney has made of record numerous third-party registrations indicating that registrant's goods (vitamins, dietary and nutritional supplements) as well as applicant's goods (such as antihistamines, decongestants, expectorants, anticholinergics, and preparations for cardiovascular and neurologic conditions) are sold under the same marks by the same kinds of companies. This is probative evidence that

Serial No. 75/894,932

purchasers are likely to assume a source connection between these goods. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783; and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). Moreover, both registrant's and applicant's goods are relatively inexpensive and are or will be sold in the same retail stores such as grocery stores and drugstores.

Although applicant's attorney has indicated that there has been no actual confusion of its applied-for mark and the registered mark for approximately two years, evidence of actual confusion is notoriously difficult to come by and, in any event, such evidence is not required in order to establish likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992); *Block Drug v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989); and *Guardian Products Co. Inc. v. Scott Paper Co.*, 200 USPQ 738, 743 (TTAB 1978). Additionally, the absence of evidence of actual confusion in this case is offset, under the eighth *du Pont* factor, by the absence of sufficient evidence upon which we might base a conclusion that there has been any meaningful opportunity for actual confusion to have occurred. That is, we have no information concerning the level of sales or advertising of the respective products to ascertain that the absence of

Serial No. 75/894,932

actual confusion is legally significant. See *Gillette Canada Inc. v. Ranir Corp.*, *supra*. In sum, we find on this record that the seventh and eighth *du Pont* factors, which pertain to actual confusion, essentially are neutral in this case.

Finally, any doubts we might have as to whether a likelihood of confusion exists must be resolved against applicant and in favor of the registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe*, *supra*.

Decision: The refusal of registration is affirmed.