UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/742737

MARK: GP PHARM

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: GP-PHARM, S.A.

CORRESPONDENT'S REFERENCE/DOCKET NO:
1539-195
CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

Applicant is requesting reconsideration of a final refusal issued/mailed January 17, 2007.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration.

Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2503669. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.*

Applicant requested reconsideration of the final refusal. The trademark examining attorney has considered applicant's arguments carefully and found them unpersuasive for the reason below.

Comparison of the marks:

In the request for reconsideration, the applicant argued that the distinguishing elements in the marks should not be overlooked. Specifically, these elements are the design elements and applicant's addition of the term "PHARM."

The applicant correctly argues that the marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); TMEP §1207.01(b)(viii).

The letters "GP" are clearly the dominant features of the marks. First, the literal portions are generally the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554 (TTAB 1978). For this reason, greater weight is often given to the literal portions of marks in determining whether there is a likelihood of confusion. TMEP §1207.01(c)(ii). Second, disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation,* 229 USPQ 709 (TTAB 1986).

In this case, it is the letters "GP" that are most likely to create an impression in the minds of consumers, and are most likely to be used when asking for the applicant's or registrant's products by name.

The applicant further argued that the examining attorney overlooked the significance of the third party registrations that also contain the term "GP." In fact, the examining attorney did consider these registrations and found that they did not show that the designation "GP" is weak in the pharmaceutical industry. These registrations either have a distinguishing factor that separates them from the "GP" marks at issue in this case, or are registered for unrelated goods. In the request for reconsideration, the applicant added many more registrations to this list, all registered for goods and services that are unrelated to the goods at issue here.

Comparison of the goods:

The applicant argued that the applicant's goods are significantly dissimilar to the registrant's goods. The examining attorney respectfully disagrees. As shown in the evidence of record, pharmaceuticals of the type listed in the application and the cited registration commonly emanate from the same source. Therefore, consumers familiar with registrant's "GP" preparations who encounter applicant's "GP PHARM" preparations are likely to think the applicant's goods originate with the registrant. Applicant's argument that the Office must show that the essential characteristics of the parties' goods are similar in order to show a likelihood of confusion is unpersuasive. The fact that the goods of the parties may differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

Any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely pharmaceutical preparations for treatment of

conditions of the skin and for use in oncology and hormonal development, are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). These registrations, as well as the Internet evidence of record, demonstrate that applicant's goods are within the registrant's normal field of expansion.

Finally, the courts and scholarly authorities have long recognized a "doctrine of greater care" in pharmaceutical cases because of life and death risks to consumers regarding trademarks for drugs. This doctrine mandates a conservative approach to determining a likelihood of confusion between trademarks used on pharmaceutical preparations due to the harmful (and potentially lethal) consequences of mistakenly taking the wrong medication. "For these reasons, it is proper to require a lesser quantum of proof of confusing similarity for drugs and medicinal preparations." 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §23:12; (4th ed. 2003); *See also Glenwood Laboratories, Inc., v. American Home Products Corp.*, 455 F.2d 1384, 173 USPQ 19 (C.C.P.A. 1972); *Sterling Drug, Inc., v. Sankyo Co.*, 139 USPQ 395 (TTAB 1963); *American Home Products Corp. v. USV Pharmaceutical Corp.*, 190 USPQ 357 (TTAB 1976); *Schering Corp. v. Alza Corp.*, 207 USPQ 504 (TTAB 1980). Thus courts have allowed a lower threshold of proof of confusing similarity for drugs and medicinal preparations.

For these reasons, the applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

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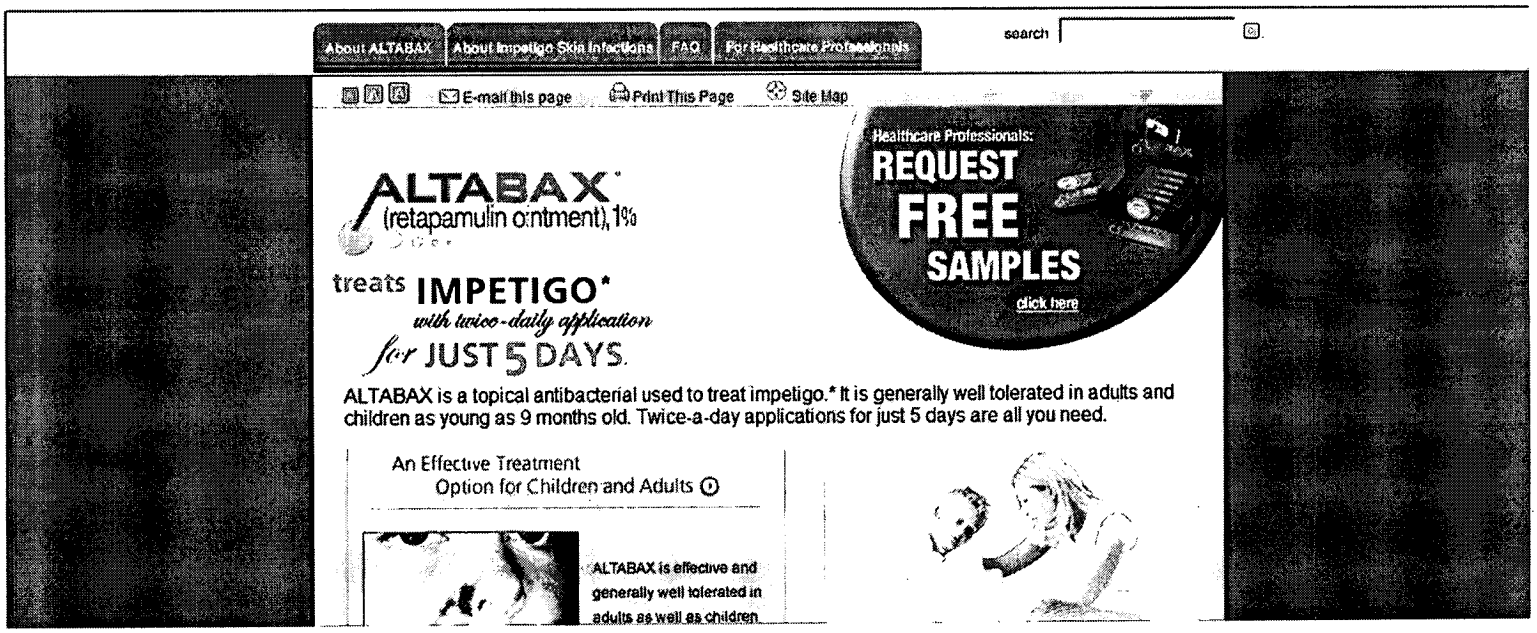

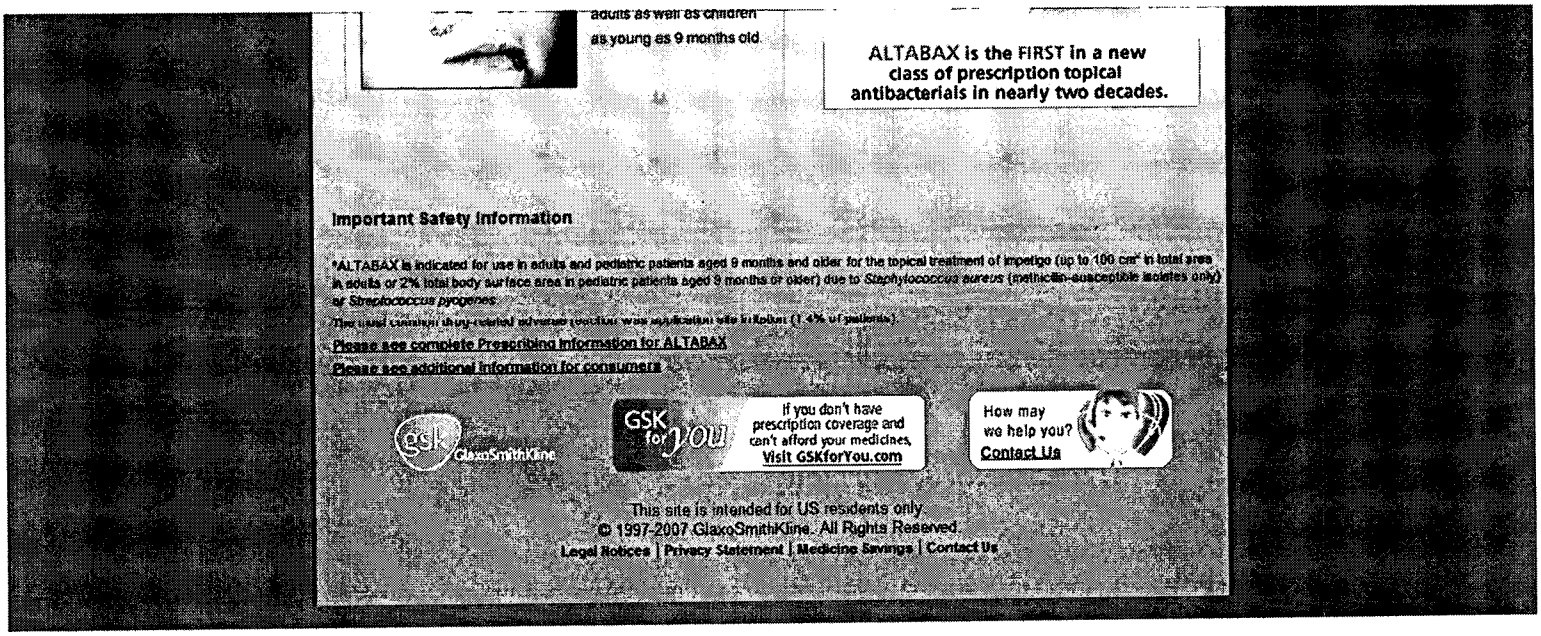

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