

This Opinion is not a
Precedent of the TTAB

Oral Hearing: February 10, 2021

Mailed: March 31, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Combe Incorporated,

v.

Marke Enterprises, LLC

Opposition Nos. 91214779 (parent) and 91215509

Douglas A. Rettew, Anna B. Naydonov and Sydney N. English of Finnegan
Henderson Farabow Garrett & Dunner LLP for Combe Incorporated.

Brian J. Jacobs of Brian J. Jacobs Attorney at Law for Marke Enterprises, LLC.

Before Kuhlke, Kuczma and Larkin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Marke Enterprises, LLC (Applicant), filed intent-to-use applications to register
the marks VAGISERT (standard character mark) Serial No. 86038104,¹ and

¹ Application Serial No. 86038104 was filed on August 14, 2013, under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b).



(VAGISERT & Design) Serial No. 86038137,² for vaginal antifungal

preparations in International Class 5.

Combe Incorporated (“Opposer”) opposes the registration of Applicant’s marks on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its ownership of the following registered marks³:

Mark	Reg. No. Issue Date	Goods First Use/Use in Commerce
VAGISIL	1104172 11/17/1978	Pharmaceutical preparations, namely, medicated cremes, Class 5 First use/Use in commerce: 9/13/1973
VAGISIL	1424503 1/13/1987	Cosmetics, namely, powders for feminine use in Class 3 First use/Use in commerce: 2/22/1985
VAGISIL	2971826 7/19/2005	Pharmaceuticals, namely, medicated premoistened towelettes for feminine use in Class 5 First use/Use in commerce: 2/4/2005
VAGISIL	4073832 12/20/2011	Non-medicated feminine washes in Class 3 First use/Use in commerce: 12/14/09
VAGISIL	4205458 9/11/2012	Moisturizers for the skin at the external vaginal area in Class 3 First use/Use in commerce: 7/24/1995

²Application Serial No. 86038137 was filed on August 14, 2013, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). According to Applicant, the mark consists of the word “VAGISERT” in a stylized font with the ‘I’ in ‘VAGISERT’ dotted with a heart and the ‘G’ in ‘VAGISERT’ curving into a heart with the wording ‘VAGINAL APPLICATORS’ below the letters ‘ISERT’ of the term ‘VAGISERT.’” “VAGINAL APPLICATORS” is disclaimed.

³ Testimony Declaration of Stacey Feldman ¶¶ 11-12, Exhibit B (57 TTABVUE 4-5, 63-672). Although not initially pleaded, as noted below, Applicant stipulated to the admissibility and assertion of the VAGISTAT mark and registrations. (80 TTABVUE 5).

	4343995 5/28/2013	Nonmedicated products for feminine use, namely, feminine soothing creams for the skin, moisturizers for the skin at the external vaginal area, feminine deodorant powders, and nonmedicated feminine hygiene washes Class 3; Medicated products for feminine use, namely, feminine anti-itch creams, and premoistened feminine wipes Class 5 First use/Use in Commerce: 1/22/2013
VAGISTAT	1290700 8/21/1984	Pharmaceutical Preparation for the Treatment of Fungus Infections of the Female Reproductive Tract in Class 5 First use/Use in Commerce:8/5/1983
VAGISTAT-3	3174689 11/21/2006	Pharmaceutical Preparation for the Treatment of Fungus Infections of the Female Reproductive Tract in Class 5 First use/Use in Commerce: 12/31/2002

Applicant's Answers to the Notices of Opposition deny the allegations except for its admissions of the following allegations:

- Copies of Opposer's Trademark Registration Nos. 1104172, 1424503, 2971826, 3285997, 3696951, 4073832, 4205458 and 4343995 with corresponding printouts from the Trademark Status & Document Retrieval (TSDR) showing the title and status of the Registrations alleged in the Complaint (see Answers in both Oppositions, ¶¶ 3, 5, 7, 9, 11, 13, 15, 17 (Opposition No. 91214779, 8 TTABVUE 12-13) (Opposition No. 91215509, 7 TTABVUE 12-13)⁴;
- Applicant's applications and non-use of Applicant's marks on the goods identified in its application (see Answers in both Oppositions, ¶¶ 19-24 (Opposition No. 91214779, 8 TTABVUE 13-14) (Opposition No. 91215509, 7 TTABVUE 13-14));
- Applicant's goods set forth in its applications would be offered through the same or similar trade channels and used by the same classes of purchasers

⁴ Opposer's Registration Nos. 3285997 and 3696951 pleaded in the Notices of Opposition have since expired and have been cancelled, and are not considered.

as Opposer's goods (see Answers in both Oppositions, ¶ 28 (Opposition No. 91214779, 8 TTABVUE 14) (Opposition No. 91215509, 7 TTABVUE 14)).

Additionally, Applicant asserted, but did not pursue, a number of "affirmative defenses." Because Applicant did not pursue its pleaded affirmative defenses by motion or at trial, they are deemed waived. *See, e.g., Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014); *Alcatraz Media v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd mem.*, 565 Fed. App'x 900 (Fed. Cir. 2014).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file histories for Applicant's application Serial Nos. 86038104, and 86038137 which are the subject of this proceeding.

The record also includes the following evidence submitted by Opposer:

1. Opposer's Notice of Reliance No. 1 (56 TTABVUE):
 - Exhibit A: TSDR records for Opposer's U.S. Trademark Registration Nos. 1104172, 1424503, 2971826, 4073832, 4205458, 4343995, 1290700 and 3174689.⁵
2. Testimony Declaration of Stacey Feldman, Senior Vice President and General Manager, OTC Brands, North America at Opposer, with Exhibits A-H, J-Z, AA-EE, GG-HH (57 TTABVUE):

⁵ Opposer notes that it first disclosed Registration Nos. 1290700 and 3174689 for VAGISTAT and VAGISTAT-3, respectively, in its May 10, 2019 supplemented pretrial disclosures and produced discovery regarding its use of those marks. Copies of the Registrations were subsequently submitted with its Notice of Reliance No. 1 (56 TTABVUE 2-3, 89-102). Applicant subsequently consented to the admissibility and assertion of Opposer's VAGISTAT marks and registrations as properly pleaded (80 TTABVUE 5) and Opposer's pleading is considered amended to include these Registrations pursuant to Federal Rule of Civil Procedure 15(b)(2).

- Exhibit A: representative current and past VAGISIL products and packaging (57 TTABVUE 3-4, 31-62);
- Exhibit B: Printouts from TESS/TSDR of Opposer's trademark Registrations for VAGISIL mark (57 TTABVUE 5, 63-672);
- Exhibit C: report of sales under VAGISIL mark since 1991 by product category (57 TTABVUE 5-8, 673-675);
- Exhibit D: report of intimate health category using IRI data from June 2017-June 2018 (57 TTABVUE 9-10, 676-712); VAGISIL occupies the top rankings in its core product segments
- Exhibit E: IRI report listing stores and outlets where Opposer's VAGISIL-branded products are offered and sold (57 TTABVUE 10, 713-716);
- Exhibit F: Summary of event and summary of results of Opposer's email survey at 2018 The American Congress of Obstetricians and Gynecologists convention (57 TTABVUE 11, 717-732);
- Exhibit G: summary of Opposer's #BlogHer18 Health event in New York on January 30-31, 2018 and Opposer's email survey (57 TTABVUE 11-12, 733-763);
- Exhibit H: Opposer's media spend report based on Nielsen data compilation (57 TTABVUE 12-13, 764-818);
- Exhibit I: Intentionally left blank (57 TTABVUE 819);
- Exhibit J: chart summarizing over 90 representative TV ads for the VAGISIL brand from the 1980's, 1990's, 2000's, and 2010's until 2018 (57 TTABVUE 13-14, 820-984);
- Exhibit K: copies of story boards for Opposer's VAGISIL TV ads from the 1980's (57 TTABVUE 14, 985-989);
- Exhibit L: copies of story boards for Opposer's VAGISIL TV ads from the 1990's (57 TTABVUE 15, 990-1001);
- Exhibit M: copies of story boards for Opposer's VAGISIL TV ads from the 2000's (57 TTABVUE 15, 1002-1050);

- Exhibit N: copies of story boards for Opposer's VAGISIL TV ads from 2010 to 2018 (57 TTABVUE 16, 58 TTABVUE 2-94);
- Exhibit O: copy of a summary of Opposer's 2018 campaign for the VAGISIL Preventeza emergency contraception launch (57 TTABVUE 16, 58 TTABVUE 95-96);
- Exhibit P: copy of a summary of Opposer's *Making Valentine's Day Special* media tour with Dr. Chavez for VAGISIL-branded wipes, powders, and ProHydrate and mailers promoting VAGISIL products to many outlets and magazines, including *BuzzFeed*, *Cosmo*, drugstores, and grocery businesses (57 TTABVUE 16-17, 58 TTABVUE 97-100);
- Exhibit Q: copies of weekly updates Opposer receives from its PR agency of VAGISIL media placements from January 2018-July 2018 (57 TTABVUE 17, 58 TTABVUE 101-103);
- Exhibit R: copies of representative letters and scripts for VAGISIL ads which Opposer has provided to radio networks over the years (57 TTABVUE 17, 58 TTABVUE 104-133);
- Exhibit S: chart summarizing over 160 representative print ads for the VAGISIL brand from the 1970's, 1980's, 1990's, and 2000's to 2017 and copies of print ads, and support therefor, included in chart (57 TTABVUE 18-21, 58 TTABVUE 134-491, 59 TTABVUE 2-180);
- Exhibit T: copies of representative wholesaler promotions that Opposer sent to retailers to advertise the VAGISIL brand (57 TTABVUE 21-22, 59 TTABVUE 181-216);
- Exhibit U: copy of a report of Opposer's daily impressions from Facebook advertising for the VAGISIL brand from June 2016 to May 2018 compiled by Opposer's VP of Integrated Media (57 TTABVUE 22, 59 TTABVUE, 59 TTABVUE 217-239);
- Exhibit V: copy of a visitor statistics report for the vagisil.com domain compiled and kept by Opposer's marketing department in the ordinary course of business (57 TTABVUE 23, 59 TTABVUE 240-242);

- Exhibit W: copies of representative VAGISIL in-store displays and shelf-talker ads, including in *Walmart*, *Sam's Club*, and *Target* (57 TTABVUE 23, 59 TTABVUE 243-255);
- Exhibit X: copies of representative nationally circulated coupons for VAGISIL products from 2001 to 2019 (57 TTABVUE 24, 59 TTABVUE 256-313);
- Exhibit Y: copies of representative online ads for VAGISIL products (57 TTABVUE 24-25, 59 TTABVUE 314-409);
- Exhibit Z: chart summarizing representative *YouTube* blogger videos (both solicited and unsolicited) for the VAGISIL brand (57 TTABVUE 25, 59 TTABVUE 410-426);
- Exhibit AA: copies of representative VAGISIL promotions, including free samples and educational brochures (57 TTABVUE 26, 59 TTABVUE 427-437);
- Exhibit BB: copy of a transcript of the December 5, 2009 *Saturday Night Live* show, which dedicated an entire skit to a VAGISIL-branded bowling alley (57 TTABVUE 27, 60 TTABVUE 2-5);
- Exhibit CC: copy of a Wikipedia article summarizing the "Poor and Stupid" *South Park* episode, where VAGISIL was a sponsor at a NASCAR event (57 TTABVUE 27, 60 TTABVUE 6-10);
- Exhibit DD: copy of a transcript of *The Big Bang Theory* episode mentioning VAGISIL (57 TTABVUE 27, 60 TTABVUE 11-22 [most pages illegible]);
- Exhibit EE: chart summarizing media articles mentioning the VAGISIL brand dated 2000 to 2018 (57 TTABVUE 27-28, 60 TTABVUE 23-904);
- Exhibit FF: Intentionally left blank (60 TTABVUE 905);
- Exhibit GG: copies of examples of VAGISTAT by VAGISIL packaging offered and sold by Opposer (57 TTABVUE 28, 61 TTABVUE 2-4);
- Exhibit HH: copies of representative VAGISIL promotions, including free samples and educational brochures (57 TTABVUE 26, 61 TTABVUE 5-77).

3. Opposer's Notice of Reliance No. 2: unsolicited media articles discussing Opposer's VAGISIL brand (62 TTABVUE). The articles submitted through this Notice are attached as Exhibits EE and EE-1 to the Feldman Declaration, which authenticates them (see 57 TTABVUE 27-28, 60 TTABVUE 23-904).
4. Opposer's Notice of Reliance No. 3: January 2018 Expert Report of Hal Poret: Survey to Assess Whether the VAGILSIL Mark is Famous, January 2018 (63 TTABVUE).

Evidence submitted by Applicant:

1. Applicant's Notice of Reliance (64 TTABVUE):
 - Printout from TSDR for Registration No. 401202 for VAGISERT, issued on April 27, 1943 to Chicago Pharmacal Company, showing status as expired (64 TTABVUE 4-7).

Opposer submitted a trial brief. Applicant subsequently filed its Response to Opposer's Evidentiary Objections to Applicant's Notice of Reliance to which Opposer submitted its Reply Brief. Two days before the oral hearing was originally scheduled, Applicant discovered that its trial brief, which was filed with its Evidentiary Objections, was not received by the Board. Applicant promptly filed a Stipulated Motion to Reopen Briefing and Extend Time for Hearing, which was granted. Applicant submitted its trial brief and Opposer submitted a responding Reply Brief. The case was re-set for oral argument, which was held on February 10, 2021.

II. Entitlement to a Statutory Cause of Action⁶

Opposer's entitlement to a statutory cause of action is a requirement that must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies*

⁶ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in

Pty. Ltd. v. Naked TM, LLC, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Opposer has made of record its Registration Nos. 1104172, 1424503, 2971826, 4073832, 4205458 and 4343995 for the mark VAGISIL for medicated cremes; powders and medicated pre-moistened towelettes for feminine use; non-medicated feminine washes; moisturizers for the skin at the external vaginal area; feminine soothing creams for the skin, moisturizers for the skin at the external vaginal area, feminine deodorant powders, and feminine anti-itch creams, and premoistened feminine wipes in International Classes 3 and 5; and Registration Nos. 1290700 for the mark VAGISTAT and 3174689 for the mark VAGISTAT-3 (hereafter jointly referred to as “VAGISTAT” unless specifically distinguished) for pharmaceutical preparations for the treatment of fungus infections of the female reproductive tract in International Class 5.

nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable as the tests “share a similar purpose and application.” *Corcamore*, 2020 USPQ2d 11277, at *7, *see also Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Applicant's applied-for mark VAGISERT begins with the same five letters as Opposer's marks and is for vaginal antifungal preparations in International Class 5, which goods are identical to some of Opposer's goods. Therefore, Opposer has shown that its interest in opposing registration is within the zone of interests protected by the statute and it has a reasonable belief of damage that is proximately caused by registration of the mark. In view thereof, Opposer has proven its entitlement to assert a statutory cause of action in this opposition.

III. Grounds for Opposition

To prevail on the ground of likelihood of confusion under § 2(d) of the Trademark Act, it is Opposer's burden to prove by a preponderance of the evidence both priority of use and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

A. Priority

Because Opposer's Registrations are of record, and Applicant has not counterclaimed for cancellation of the Registrations, priority is not at issue in this proceeding with respect to the goods identified in Opposer's Registrations. *See King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Thus, Opposer has priority due to its registration of the marks VAGISIL and VAGISTAT, which Applicant does not dispute.

B. Likelihood of Confusion

In determining the likelihood of confusion, we must analyze all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (*DuPont* “articulated thirteen factors to consider when determining likelihood of confusion”). We consider each *DuPont* factor for which there is evidence and argument. See *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). However, “each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973).

Two key considerations are the similarities between the marks and the similarities between the goods. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.* 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We have also considered other *DuPont* factors for which the parties have submitted evidence and/or argument namely, the similarity of trade channels and classes of purchasers, purchaser sophistication and the strength of Opposer’s marks. *DuPont*, 177 USPQ at 567.

1. Similarity of the Goods, Trade Channels and Class(es) of Customers

We turn first to the second *DuPont* factor which involves consideration of the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Applicant concedes that the parties’ goods are similar, as well as their trade channels and consumers.⁷ As addressed below, there is no dispute regarding these matters.

Applicant’s goods are vaginal antifungal preparations in International Class 5; Opposer’s VAGISTAT goods are legally identical to Applicant’s goods, namely, pharmaceutical preparations for the treatment of fungus infections of the female reproductive tract in International Class 5. As explained in Encyclopaedia Britannica:

The Female Reproductive System

The female gonads, or sexual glands, are the ovaries; they are the source of ova (eggs) and of the female sex hormones estrogens and progestogens. The fallopian, or uterine, tubes conduct ova to the uterus, which lies within the lesser or true pelvis. The uterus connects through the cervical canal with the vagina. The vagina opens into the vestibule about which lie the external genitalia, collectively known as the vulva.

<https://www.britannica.com/science/human-reproductive-system/The-female-reproductive-system>

⁷ Applicant’s Brief p. 4 (82 TTABVUE 11).

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Inasmuch as the vagina is a part of the female reproductive tract⁸, Opposer's registered VAGISTAT mark for pharmaceutical preparations for the treatment of fungus infections of the female reproductive tract is inclusive of Applicant's vaginal antifungal preparations.

Opposer's VAGISIL mark is also registered for related goods including medicated cremes, medicated pre-moistened towelettes for feminine use, feminine anti-itch creams, and premoistened feminine wipes, in International Class 5; and powders for feminine use; non-medicated feminine washes and feminine hygiene washes; moisturizers for the skin at the external vaginal area; feminine soothing creams for the skin, moisturizers for the skin at the external vaginal area, and feminine deodorant powders, in International Class 3. Inasmuch as Opposer's VAGISIL goods, and Applicant's VAGISERT vaginal antifungal preparations, are both utilized as feminine hygiene goods, they are related.

Next, we consider the *DuPont* factor concerning the trade channels and classes of purchasers. This factor relates to whether Opposer's and Applicant's identified or presumptive trade channels and customers would result in a likelihood that

⁸ Definition of "tract": 2. A system of body parts or organs that act together to perform some function. Merriam-Webster, [merriam-webster.com/dictionary/tract](https://www.merriam-webster.com/dictionary/tract), © 2021 Merriam-Webster, Incorporated, March 29, 2021.

The Board may sua sponte take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including definitions in online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

customers would consider the parties' identified goods and services as "emanat[ing] from the same source." *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356-1357 (Fed. Cir. 2004). Because there are no limitations as to trade channels or classes of customers set forth in Applicant's goods and the identical and closely related goods identified in Opposer's Registrations, other than that both parties' goods are intended for use by female customers, we must presume that both Applicant's and Registrant's goods move in the same normal channels of trade and are available to the same classes of ordinary customers. *See Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1162 (application with no restriction on trade channels cannot be narrowed by testimony that applicant's use is restricted to a particular class of purchasers); *Cunningham v. Laser Golf*, 55 USPQ2d at 1846 (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods"); *Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

Accordingly, we find that Applicant's goods and Opposer's goods are identical in-part and otherwise closely related, travel in the same channels of trade, and are

offered to the same classes of customers, strongly weighing in favor of a finding of likely confusion under the second and third *DuPont* factors.

2. The Conditions Under which and Buyers to Whom Sales are Made

The fourth *DuPont* factor considers “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” *DuPont*, 177 USPQ at 567. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005)).

Opposer contends that its and Applicant’s in-part identical goods are relatively inexpensive and subject to an impulsive purchase noting that its VAGISIL products are sold over the counter for as little as \$3-7.⁹

⁹ Feldman Testimony Declaration ¶ 28 (57 TTABVUE 11).

Additionally, Opposer argues:

Confusion is also exacerbated given people’s embarrassment over the parties’ products and the conditions they treat (vaginal itch, dryness, and irritation). As a result, consumers often purchase these ‘shy-to-buy/grab-and-go’ feminine-care products hastily without spending much time at the shelf to examine them. *See Am. Home Prods. Corp. v. Morton-Norwich Prods., Inc.*, No. 78 Civ. 1493, 1978 WL 21535, at *3 (S.D.N.Y. Oct. 6, 1978) (finding likelihood of confusion between OVRAL prescription birth control and ENCARE OVAL off-the-shelf vaginal suppository contraceptive; recognizing that ‘[c]ontraceptive products are used by women of all education and care levels,’ including those who ‘may desire to complete the purchase as quickly as possible [and] [s]he will not carefully canvass and compare names but probably will take the first product that sounds familiar’) (internal quotations omitted).

The purchasing public, which includes women of all ages and socio-economic backgrounds, exercises varying degrees of care when purchasing Opposer's VAGISIL products, from taking time to conduct research before purchasing products, to hastily purchasing products because women are embarrassed by the products and the conditions they treat, including vaginal odor, dryness and itch. Consequently, embarrassed purchasers do not want to spend a lot of time when in the store to make a purchase, and will quickly select the product and place it in their shopping cart, covering it with other products they are purchasing in order to make a discreet purchase.¹⁰

The relatively low cost at which Opposer's goods, and presumably those of Applicant, are offered for sale to the purchasing public, together with the

Opposer's Brief p. 38 (67 TTABVUE 47). However, Opposer's citation to a case decided more than 42 years ago involving different goods than the goods involved here, offers little perspective on the goods in this case.

¹⁰ Feldman Testimony Declaration ¶¶ 27, 29 (57 TTABVUE 11). Opposer conducted one study at the 2018 The American Congress of Obstetricians and Gynecologists convention showing that consumers are embarrassed by the conditions that VAGISIL products treat. Eighty percent of the over 160 doctors surveyed indicated that their patients sometimes feel embarrassed or ashamed about seeking advice regarding various vaginal health issues, e.g., odor, itching, etc. (57 TTABVUE 11). *See* summary of the study's results at 57 TTABVUE 717-732.

Another survey taken in connection with Opposer's #BlogHer18 Health event held in New York on January 30-31, 2018 also shows that consumers are embarrassed by the conditions that VAGISIL products treat. This event attracts numerous celebrities, social media influencers, entrepreneurs, and brands with the goal of empowerment of women. Prior to the event, Opposer conducted an email survey, which showed that 45% of the participants (a total of 553 women) were too embarrassed or ashamed to discuss vaginal issues even with their doctors. Feldman Testimony Declaration ¶ 31 (57 TTABVUE 11-12, 734-740, summary of survey at 57 TTABVUE 746).

embarrassment of purchasing such goods, support that the purchasers of such goods employ nothing more than ordinary care in their purchasing decisions.¹¹

3. Strength of Opposer's Marks

To determine the scope of protection accorded to Opposer's VAGISIL mark, we consider its strength. In determining strength, we evaluate both inherent strength, based on the nature of the mark, and commercial strength or recognition. *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (a mark's strength is measured both by its conceptual strength and its marketplace strength). "The fifth *DuPont* factor enables Opposer to expand the scope of protection afforded its pleaded mark by adducing evidence of '[t]he fame of the prior mark (sales, advertising, length of use);' the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of '[t]he number and nature of similar marks in use on similar goods.'" *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, *8 (TTAB 2020); *DuPont*, 177 USPQ at 567.

¹¹ Opposer also argues "there's a strong public interest in avoiding any likely confusion between medical products, like the ones at issue here. *See Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharm. Co.*, 290 F.3d 578, 597, 62 USPQ2d 1757, 1769 (3d Cir. 2002) (public interest in being free from confusion 'particularly strong where over-the-counter drugs are concerned'); *Upjohn Co. v. Am. Home Prods. Corp.*, 598 F. Supp. 550, 557, 225 USPQ 109, 115 (S.D.N.Y. 1984) (public interest in avoiding confusion especially high in a case involving over-the-counter pain relief medication)." Opposer's Brief p. 39 (67 TTABVUE 48). The cases cited by Opposer involve over-the-counter drugs and pain relief medications, which differ in nature from the goods in this case, which are not ingested by their users.

Turning first to inherent strength, Applicant contends that the “VAGI-” prefix is generic because “the wealth of ‘VAGI-’ prefix marks for products relating to female intimate health establishes that the prefix is what it purports to be: the name of a human anatomic structure.”¹²

Opposer argues that its VAGISIL mark, like its VAGISTAT mark, “is a made-up word that, at most, is suggestive of [Opposer’s] feminine care products.” According to Opposer, neither mark, nor the “VAGI-” prefix, is the usual or normal manner in which feminine care products would be described.¹³ As Opposer notes, “‘VAGI’ is not a word people use to generically identify any particular type of product, let alone a body part,” citing *USPTO v. Booking.com B.V.*, ___ U.S. ___, 140 S. Ct. 2298, 2020 USPQ2d 10729, *5, *7 (2020) (whether a compound term is generic turns on whether “the term’s meaning as a whole, not its parts in isolation” is “perceive[d] [by consumers] . . . as the name of a class or, instead, as a term capable of distinguishing among members of the class”); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) (“Evidence of the public’s understanding of the term [for a genericness analysis] may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications”); *see also In re*

¹² Applicant’s Brief p. 17-18 (82 TTABVUE 24-25).

¹³ Opposer’s Brief pp. 26-27 (67 TTABVUE 35-36); Feldman Testimony Declaration ¶ 7 (57 TTABVUE 3).

Northland Aluminum Prods., Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).¹⁴

Applicant's unsupported argument is incorrect. "Vagina," not "vagi-," is the name of the intimate female anatomic structure, i.e., "a canal in a female mammal that leads from the uterus to the external orifice of the genital canal."¹⁵ Applicant has not provided any evidence showing that "vagi-" is a generic term meaning vagina. Even if it were, it is not a generic term for the goods involved in this case. Opposer's mark VAGISIL "merely 'connotes' the vaginal area of a woman's body; a consumer must exercise some degree of 'imagination to connect it with the goods,' namely feminine care and hygiene products." *Combe Inc. v. Dr. August Wolff GmbH & Co. KG Arzneimittel*, 382 F. Supp. 3d 429, 447 (E.D. Va. 2019) citing *Sara Lee Corp. v. Kayser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996). See also *Syntex Labs., Inc. v. Norwich Pharmacal Co.*, 315 F. Supp. 45, 166 USPQ 312, 316 (S.D.N.Y. 1970), *aff'd*, 437 F.2d 566 (2d Cir. 1971) (holding that the strong suggestiveness of the prefix "vagi- " is attenuated when joined with the suffix "-trol" to form the word "Vagitrol").

In support of its argument that Opposer's marks are weak, Applicant also introduces evidence of a single third-party registration, Registration No. 401,202 for the mark VAGISERT, the same mark as Applicant now seeks to register, for "vaginal suppositories" in Class 5 which issued on April 27, 1943 to Chicago Pharmacal

¹⁴ Opposer's Reply Brief p. 11 (83 TTABVUE 17).

¹⁵ Definition of "vagina" from Merriam-Webster, [merriam-webster.com/dictionary/vagina](https://www.merriam-webster.com/dictionary/vagina), © 2021 Merriam-Webster, Incorporated, March 29, 2021.

Company. However, as shown by the USPTO reports which Applicant entered into evidence, that Registration expired in 1986 for lack of renewal.¹⁶ Applicant attempts to rely on this expired Registration to “show the descriptive or generic nature of the ‘VAGI-’ prefix in the VAGISIL mark,”¹⁷ but inasmuch as Registration No. 401,202 has been cancelled it is of no probative value. *Action Temporary Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”); *see also, Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) (recognizing that whatever benefits a federal registration confers are lost when that registration is cancelled).

¹⁶ Applicant’s Notice of Reliance, Exhibit A, Trademark Electronic Search System (TESS) and Trademark Status and Document Retrieval (TSDR) reports showing expired status of Registration No. 401,202 (64 TTABVUE 5-7).

¹⁷ Applicant’s Brief p. 11, n.7 (82 TTABVUE 18).

As set forth in Opposer’s Evidentiary Objections to Applicant’s Notice of Reliance Under 37 CFR § 2.122(e)(1) and TBMP § 704.03(b)(1)(B), Applicant submitted this evidence asserting that it “is relevant to show, at a minimum, that Applicant may assert the defenses of acquiescence, estoppel and laches.” (66 TTABVUE 2 quoting from 64 TTABVUE 2). In its response to the Evidentiary Objections, Applicant maintains that the expired Registration is being used to show the descriptive or generic nature of the “VAGI-” prefix in the VAGISIL mark, requesting that Opposer’s evidentiary objections be overruled. (70 TTABVUE).

While the exact nature of Applicant’s reference to the expired Registration in its trial brief is not clear, Applicant relies on the expired Registration in support of its argument that Opposer did not pursue a cancellation proceeding against Chicago Pharmacal Company’s registration during the almost eight years of overlapping ownership of Chicago Pharmacal’s registration and Opposer’s VAGISIL registration. (82 TTABVUE 17-18). While that is not relevant to Applicant’s defenses of acquiescence, estoppel and laches, which were deemed waived because Applicant did not pursue its pleaded defenses by motion or at trial, Applicant responded to Opposer’s objection saying that it used the expired Registration to support its argument that VAGISIL is a weak mark because the prefix “VAGI” is descriptive at best and generic at worst. (70 TTABVUE 3). Accordingly, although the expired Registration is of no probative value, we exercise our discretion and overrule Opposer’s objection.

Offering no direct evidence of active third-party registrations, Applicant relies on the federal registrations submitted into evidence in *Combe v. Dr. August Wolff*, the appeal of the TTAB's dismissal of Opposer's opposition to registration of the VAGISAN mark for "vaginal moisturizers, vaginal anti-fungal preparations, vaginal washes; sanitary preparations for medical use; diet pills, diet capsules, diet liquid medications" in International Class 5 and "soaps, perfumery, essential oils, cosmetics, hair lotions" in International Class 3. Reversing the TTAB's dismissal of Opposer's opposition, the District Court found that the applicant's VAGISAN mark was likely to cause confusion with Opposer's VAGISIL mark:

. . . application of the likelihood of confusion factors to the evidence submitted at trial convincingly supports a finding that the VAGISAN mark that defendant applied to register "so resembles a mark registered in the Patent and Trademark Office," to wit: plaintiff's VAGISIL mark, "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." See 15 U.S.C. § 1052(d).

382 F. Supp. 3d at 466-67. Thus, the District Court held that "the evidence compels the conclusion that defendant's VAGISAN mark is not registrable."

Applicant argues that the third-party registrations presented to the District Court in the VAGISAN case "weaken both the conceptual and commercial strength of VAGISIL" entitling Opposer's registered marks to only a narrow scope of protection which does not extend to Applicant's mark.¹⁸

¹⁸ Applicant's Brief pp. 13-14 (82 TTABVUE 20-21).

Opposer challenges Applicant's reliance on the third-party registrations from *Combe v. Dr. August Wolff* disclosed in Applicant's brief¹⁹ because they are not of record, and argues they should not be considered, citing *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (finding applicant did not show opposer's mark CHIRO-KLENZ was weakened by third-party uses of CHIRO- when it relied on a list of third-party marks downloaded from the UPSTO's website because while "the listing itself is of record, the registrations listed therein are not of record"); *Jansen Enters. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007) (determining "[r]espondent failed to properly introduce any third-party registrations for [petitioner's] marks" when he made reference to them in his brief because this did not suffice to make them of record and he should have submitted copies of the registrations).²⁰

Aside from the fact that Applicant offers no evidence of the current status of the then-live third-party registrations identified in *Combe v. Dr. August Wolff*, they are not of record as active third-party registrations in this case and therefore, are not considered.

Inasmuch as there is no evidence that the "vagi-" root in Opposer's VAGISIL and VAGISTAT marks describes something, or is so commonly used that the public will look to other elements to distinguish the source of the goods, Opposer's marks are not merely descriptive. However, there is little doubt that the "VAGI-" component of Opposer's marks is inherently somewhat weak as a source identifier since it is

¹⁹ Applicant's Brief p. 9 (82 TTABVUE 16).

²⁰ Opposer's Reply Brief pp. 6-7 (83 TTABVUE 12-13).

suggestive of Opposer's feminine personal care products for the vaginal area. *Combe v. Dr. August Wolff*, 382 F. Supp. 3d at 447; *see also DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (“a suggestive mark ‘requires imagination, thought and perception to reach a conclusion as to the nature of the goods,’ while a merely descriptive mark ‘forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods’”) (internal citations omitted); *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found suggestive because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread).

Additionally, inasmuch as Opposer's marks VAGISIL and VAGISTAT are registered, they must be accorded all of the presumptions that are to be accorded registered marks pursuant to Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

Turning to commercial strength, the testimony of Stacey Feldman, Opposer's Senior Vice President and General Manager, OTC Brands, North America, supports the fame of its VAGISIL mark. A famous mark has extensive public recognition and renown. Thus, fame of a prior mark plays a dominant role in likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). In the likelihood of confusion analysis, fame varies along a spectrum from very strong to very weak. *Jos. Phelps*

Vineyards, LLC v. Fairmont Holdings, LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). Because of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012); *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009).

Relevant factors supporting fame include volume of sales, advertising expenditures for goods travelling under the mark, and the length of time the indicia of commercial awareness have been evident, and may also include use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689-90 (Fed. Cir. 2018); *Recot v. M.C. Benton*, 54 USPQ2d at 1896-97; *see also Bose v. QSC Audio*, 63 USPQ2d at 1305 (“[O]ur cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.”).

Ms. Feldman testified that Opposer’s mark has been in use since 1973, selling over a billion dollars of VAGISIL products since 1991.²¹ Opposer’s share in the feminine anti-itch cream market has been between 55-60% since 1991, and was 57.6% in 2016

²¹ Feldman Testimony Declaration ¶¶ 13-16 (57 TTABVUE 5-7).

and 60.5% in 2017, between 55-60% in the feminine-powder category and was 67.5% and 69% in 2016 and 2017, respectively, and over 95% in the anti-itch wipes category since 2010.²²

Opposer's VAGISIL brand products are ranked first for the segments in which it competes. For example, Opposer's VAGISIL anti-itch maximum strength creme is ranked No. 1 in both dollars and units in the \$33.5 million anti-itch cream segment with over thirty SKU's. Opposer's VAGISIL anti-itch wipes are ranked No. 1 and No. 2 in both dollars and units in the \$11.6 million anti-itch wipe segment.²³ Opposer also dominates the intimate-wash segment with VAGISIL intimate-washes ranked No. 1 and No. 2 in dollars, and No. 1 and No. 3 in units in the \$128 million intimate-wash market segment with over thirty SKU's. In the intimate-powder segment, Opposer's VAGISIL powder is ranked No. 1 in both dollars and units in that \$5.9 million dollar segment. And its VAGISIL moisturizing lubricant ranked No. 3 in both dollars and units in the \$23 million intimate-moisturizing market segment.²⁴

Opposer's VAGISIL products are promoted and sold nationwide including on Opposer's website (vagisil.com), and in thousands of mass-merchandising stores, drug-store chains, pharmacies, grocery stores, dollar stores, military outlets, and electronic retailers, including Walmart, Target, Walgreen's, CVS, Rite-Aid, Albertson's, Kroger, Publix, Stop & Shop, Amazon, H-E-B, Family Dollar,

²² Feldman Testimony Declaration ¶¶ 16-18 (57 TTABVUE 7-8).

²³ The ANTI-ITCH TRMT-WIPES market only had 4 product entries, 2 VAGISIL products and 2 LUVENA products.

²⁴ Feldman Testimony Declaration ¶¶ 19-24 (57 TTABVUE 9-10, 677, 702, 704-705, 710-711).

Drugstore.com, Nationwide Campus Corp., Dollar Tree Merchandising, Discount Drug Mart, Jet.com, Food Lion, Harris Teeter, and K-Mart.²⁵

Opposer uses in-store merchandising as a form of marketing to promote its VAGISIL brand and products, including in-store displays and shelf-talker ads, which for example, have appeared in Walmart, Sam's Club, and Target. To promote its VAGISIL brand and products, Opposer distributes coupons in gyms, with products, and in newspapers and on in-store displays that feature its VAGISIL mark.²⁶

Opposer has spent millions of dollars annually for decades on advertising and promotion of its VAGISIL mark and products to the general public nationally through various types of media including printed publications, television, radio, and the Internet. Since 1993 through around March 2018, Opposer's media spend for its VAGISIL brand was \$350 million in the U.S. Its media spend for its VAGISIL brand has been "on par with the other major brands in the category and, for most years, has exceeded the spend of its main competitors REPLENS and SUMMER'S EVE."²⁷ Opposer has also invested in other forms of marketing for its VAGISIL brand, including trade promotions, coupons, sampling, events, and in-store displays. Its

²⁵ Feldman Testimony Declaration ¶¶ 25-26 (57 TTABVUE 10; 713-716).

²⁶ Feldman Testimony Declaration ¶¶ 61-64 (57 TTABVUE 23-24). Opposer provided a representative selection of its in-store displays and coupons (59 TTABVUE 243-255, 256-313).

²⁷ Feldman Testimony Declaration ¶¶ 32-35 (57 TTABVUE 12-13, 765-766). While the graph included in ¶ 34 of the Feldman Testimony Declaration shows a considerable amount in excess of \$350 million dollars spent on media spend, Ms. Feldman's testimony was that "from 1993 to around March 2018 (as reported in June 2018), the media spend for the VAGISIL brand was \$350 million in the U.S."

expenditures for these other forms of marketing totaled \$75 million from 2008 to June 2018.²⁸

Since the 1980's, Opposer has advertised its VAGISIL goods on major television "stations including ABC, NBC, Fox, CBS, A&E, Bravo, Oxygen, BET, VH1, and MTV."²⁹ It has also promoted its VAGISIL brand, products and product launches through various public relations campaigns. In 2018, Opposer launched its campaign for the VAGISIL Preventeza emergency contraception which had over 64 million viewers and 267 placements. As part of this campaign, Opposer's CEO Keech Combe Shetty, and Dr. Logan Levkoff, a famous sexual therapist, went on a satellite media tour, which included at least ten television segments.³⁰ Opposer also sponsored a *Making Valentine's Day Special* media tour with Dr. Chavez for VAGISIL-branded wipes, powders, and ProHydrate on Yahoo, CBS, and Fox, which had over 755 million viewer and/or listener impressions.³¹ In addition to the *Making Valentine's Day Special* media tour, Opposer also sent out mailers promoting VAGISIL products to many outlets and magazines, including *BuzzFeed*, *Cosmopolitan*, drugstores, and

²⁸ Feldman Testimony Declaration ¶ 36 (57 TTABVUE 13).

²⁹ Feldman Testimony Declaration ¶¶ 37-43 (57 TTABVUE 13-15). See chart summarizing over 90 representative television ads from the 1980's through the present (57 TTABVUE 820-823); and screenshots and storyboards from television ads for VAGISIL brand goods (57 TTABVUE 824-1050, 58 TTABVUE 2-94).

³⁰ Feldman Testimony Declaration ¶ 45 (57 TTABVUE 16, 58 TTABVUE 95-96).

³¹ Feldman Testimony Declaration ¶ 46 (57 TTABVUE 16-17, 58 TTABVUE 97-99).

grocery businesses.³² From January 2018 through July 16, 2018, VAGISIL products received over 1300 media placements.³³

Online advertising is another form of promotion Opposer uses to promote its VAGISIL brand and products. Opposer's online banner ads have appeared on many third-party websites, including Web MD, People.com, Vogue.com, Facebook, Instagram, Yahoo and YouTube.³⁴

Opposer also spends significant resources for advertising and promoting its VAGISIL brand and products on social media, including Facebook, Twitter, Instagram, and YouTube, by social-media influencers and bloggers. Its total daily impressions for VAGISIL Facebook advertising has exceeded 124 million. This number reflects each time any content from or about the VAGISIL Facebook page entered a user's screen, including by way of posts, check-ins, ads, and VAGISIL page interactions. In addition to paid Facebook advertising, the VAGISIL Facebook page has received 1.3 million organic, non-paid impressions. An additional tool for promoting the VAGISIL brand is through Opposer's website, vagisil.com. Since 2015, vagisil.com has had over 7.2 million pageviews.³⁵

³² Feldman Testimony Declaration ¶ 47 (57 TTABVUE 17, 58 TTABVUE 98, 100).

³³ Feldman Testimony Declaration ¶ 48 (57 TTABVUE 17, 58 TTABVUE 101-103).

³⁴ Feldman Testimony Declaration ¶¶ 65-66 (57 TTABVUE 24-25, 59 TTABVUE 314-409).

³⁵ Feldman Testimony Declaration ¶¶ 56-60 (57 TTABVUE 22-23). Opposer provides a report of its daily impressions from Facebook advertising for the VAGISIL brand from June 2016 to May 2018. This report was compiled by Opposer's VP of Integrated Media. (59 TTABVUE 217-239). The next report is a visitor statistics report compiled and maintained by Opposer's marketing department in the ordinary course of business for the vagisil.com domain. (59 TTABVUE 240-242).

Since the 1970's Opposer has advertised its VAGISIL mark and products in a variety of nationally-circulated magazines and newspapers, including *People, People en Español, Reader's Digest, TV Guide, Cosmopolitan, Good Housekeeping, Working Mother, Ladies' Home Journal, True Story, McCall's, Glamour, Parade, Family Circle, Woman's World,* and *Woman's Day* and has also advertised its VAGISIL products in leading trade publications.³⁶ Opposer has also sent wholesale promotions to retailers for VAGISIL products since the 1970's.³⁷

Opposer's VAGISIL brand and products have been advertised on the radio beginning in the 1970's. In the 1980's, VAGISIL products were advertised on over 100 radio stations, many of which were the No. 1 top-rated stations in their markets, including ABC, NBC, and CBS satellite radio. Opposer has used radio advertising to keep the VAGISIL brand top-of-mind for its consumers with repeated exposure.³⁸

Opposer's VAGISIL brand and products have also appeared on blogger-created YouTube videos where bloggers review Opposer's products. For solicited videos, Opposer sends its VAGISIL products to the bloggers for their use and comment.

³⁶ Feldman Testimony Declaration ¶¶ 51-53 (57 TTABVUE 17-21, 58 TTABVUE 134-141, 142-491, 59 TTABVUE 2-180). Opposer's exhibits include over 160 representative print ads for the VAGISIL brand from the 1970's to the present, although there appears to be a gap in ads from later 2009 until 2014, and then from 2014 to 2017.

³⁷ Feldman Testimony Declaration ¶¶ 54-55 (57 TTABVUE 21-22, 59 TTABVUE 181-216). The exhibits submitted were limited to the years 1975, 1976, 1979, 1980 and 1984.

³⁸ Feldman Testimony Declaration ¶¶ 49-50 (57 TTABVUE 17, 58 TTABVUE 104-133). The exhibits include copies of representative letters and scripts for VAGISIL ads dated in 1999, 2004 and 2006.

Additionally, many bloggers post unsolicited user-review videos regarding Opposer's VAGISIL products.³⁹

Opposer promotes its VAGISIL brand and products at doctor's offices via educational brochures, with free samples, and at OBGYN conventions, including the ACOG convention.⁴⁰

Opposer's VAGISIL trademark has been recognized in popular culture. For example, VAGISIL has been mentioned in numerous comedy skits and television shows, *The Big Bang Theory*, *South Park*, and *Saturday Night Live*. On December 5, 2009, *Saturday Night Live* show dedicated an entire skit to a VAGISIL-branded bowling alley mentioning VAGISIL more than thirty times, and exposing millions of consumers to the brand. In the episode "Poor and Stupid" on *South Park*, Vagisil was a sponsor at a NASCAR event. On an episode of *The Big Bang Theory*, VAGISIL was mentioned. VAGISIL has also been the subject of widespread media attention in books and media articles in leading national publications, including *The Washington Post*, *The Boston Globe*, *Advertising Age*, *The Chicago Tribune*, *The Wall Street Journal*, *The New York Times*, *The Miami Herald*, and many others.⁴¹

In further support of the fame of its VAGISIL mark, Opposer submits the Expert Report of Hal Poret entitled "Survey to Assess Whether the VAGISIL Mark is

³⁹ Feldman Testimony Declaration ¶¶ 67-68 (57 TTABVUE 25, 59 TTABVUE 410-426).

⁴⁰ Feldman Testimony Declaration ¶¶ 69-71 (57 TTABVUE 26, 59 TTABVUE 427-437, 61 TTABVUE 5-77).

⁴¹ Feldman Testimony Declaration ¶¶ 72-77 (57 TTABVUE 26-28, 60 TTABVUE 2-5, 6-10, 11 [12-22 are not legible], 23-904).

Famous.”⁴² Based on the survey results, 38.7% of the 300 respondents named VAGISIL when asked, unaided, to list all brands of vaginal care products they have ever seen or heard of. Mr. Poret finds that the 38.7% unaided result for VAGISIL is very high and provides an initial indication that VAGISIL is a strong and well-known mark, as it was top of mind for many respondents and the most mentioned mark on an unaided basis.⁴³ When shown the VAGISIL word mark, 90.0% (270 out of all 300 respondents) answered that they have seen or heard of VAGISIL in connection with vaginal care products.⁴⁴

The Report also shows that VAGISIL has an extremely high unaided awareness result among females (52.3%) and even has a strong unaided awareness level (24.1%) among males.⁴⁵ Therefore, according to Mr. Poret, VAGISIL has a very high rate of awareness among both males and females, establishing that it is not only famous among the overall consuming public but is even famous among males.⁴⁶ Based on the survey results, Opposer’s survey expert concludes that “it is my opinion that the VAGISIL mark is famous.”⁴⁷

⁴² Expert Report of Hal Poret dated January 2018 (63 TTABVUE 5-92). We find Mr. Poret to be qualified to testify as an expert witness on the survey and its results.

⁴³ Expert Report p. 24 (63 TTABVUE 28). Summer’s Eve (26%) and Monistat (17.3%) were the next most frequently identified brands. Expert Report p. 23 (63 TTABVUE 27).

⁴⁴ Expert Report p. 25 (63 TTABVUE 29). The next most frequently recognized marks were MONISTAT (79.7%) and SUMMER’S EVE (78.0%).

⁴⁵ Expert Report p. 27 (63 TTABVUE 31).

⁴⁶ Expert Report p. 28 (63 TTABVUE 32).

⁴⁷ Expert Report p. 30 (63 TTABVUE 34).

According to Applicant, to claim, as Opposer does, that “VAGISIL is both ‘famous’ and ‘strong’ (see, 67 TTABVUE 35-40) is to prejudice the analysis against Applicant by seeming to ascribe to the prior mark superiority in two separate likelihood of confusion criteria where *DuPont* only allows for one.”⁴⁸ Applicant argues that in an opposition proceeding, “it is not competent for the opposer to seek to prove that its mark is ‘famous.’”⁴⁹ Thus, Applicant contends that Opposer’s “fame” survey should be disregarded and the analysis limited to the conceptual and commercial strength of VAGISIL and VAGISTAT as compared to VAGISERT.⁵⁰

Applicant misunderstands the use of “fame” as a likelihood of confusion factor. While fame for dilution is an “either/or proposition”—it either exists or does not — fame for likelihood of confusion “varies along a spectrum from very strong to very weak.” *Jos. Phelps Vineyards v. Fairmont*, 122 USPQ2d at 1734, citing *Palm Bay v. Veuve Clicquot*, 73 USPQ2d at 1694.⁵¹ In *DuPont*, the predecessor court to the Federal Circuit set forth “the fame of the prior mark (sales, advertising, length of use)” as one of the factors to be considered “in testing for likelihood of confusion under Sec. 2(d).” *DuPont*, 177 USPQ at 567. Thus, under the fifth *DuPont* factor, we are required to consider evidence of the fame of Opposer’s mark and to give it great weight if it exists.

⁴⁸ Applicant’s Brief p. 8 (82 TTABVUE 15).

⁴⁹ Applicant’s Brief p. 7 (82 TTABVUE 14).

⁵⁰ Applicant’s Brief pp. 2, 8 (82 TTABVUE 9, 15).

⁵¹ Of course, if a mark is shown to be “famous” for purposes of dilution, it is a fortiori extremely strong on the continuum for purposes of likelihood of confusion.

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See Bose v. QSC Audio, 63 USPQ2d at 1305; *Recot v. Becton*, 54 USPQ2d at 1897; *Kenner Parker v. Rose Art*, 22 USPQ2d at 1457-58.

Although the “VAGI-” component in Opposer’s marks is somewhat conceptually weak due to its suggestiveness, the record does not show commercial weakness based on third-party use (or registration) of the “VAGI-” component, nor does it show that consumers are conditioned to distinguish among marks including VAGISIL, VAGISTAT and VAGISERT based on minute differences. Accordingly, we find that Opposer clearly proved, through evidence of long and substantial use, widespread national sales, advertising, promotions, media coverage, and survey evidence, that its VAGISIL mark is on the “very strong” end of the likelihood of confusion fame “spectrum from very strong to very weak.” *Jos. Phelps Vineyards v. Fairmont*, 122 USPQ2d at 1734. Thus, the fame of Opposer’s VAGISIL mark entitles it to a broad scope of protection against confusingly similar marks, therefore increasing the likelihood of confusion with Applicant’s mark. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

4. Similarity of the Marks in Sound, Appearance, Meaning and Overall Commercial Impression

We next consider the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be sufficient to find the marks to be similar. *See Cai v. Diamond Hong*, 127 USPQ2d at 1800.

Opposer's marks VAGISIL and VAGISTAT, and Applicant's mark VAGISERT, are all three-syllable marks beginning with the identical first term "VAGI-" followed by a one-syllable second term starting with the letter "S-," i.e., "-SIL," or "-STAT" in Opposer's marks, and "-SERT" in Applicant's mark. Additionally, Opposer's VAGISTAT mark and Applicant's VAGISERT mark have a two-letter difference in their literal elements, i.e., "-TA-" and "-ER-," with those two letters being tucked in the middle of the respective marks both beginning with "VAGIS-" and ending with a "T." The one-syllable second terms beginning with the letter "S" are not particularly distinctive and serve to convey analogous themes when the marks are viewed as a whole. Given the lack of differentiation in the remaining portions of Opposer's and Applicant's marks, i.e., the additional terms "-SIL," "-STAT" and "-SERT," do not result in marks having different overall connotations sufficient to distinguish them.

Applicant argues that its VAGISERT mark is not similar to Opposer's seven letter VAGISIL mark because VAGISERT has eight letters and "ends in 'rt,' which is phonologically a different form of phoneme than 'l'" in Opposer's mark. In support, Applicant proposes a comparison of the following word pairs to better appreciate the difference between the "-SIL" and "-SERT" in Opposer's and Applicant's marks:

DILL	DIRT
GILL	GIRT
HILL	HURT
KILL	CURT

According to Applicant, no one would confuse the first word in any of the foregoing pairs with the second word.⁵²

Applicant's word pairs do not support its claim that Opposer's VAGISIL and Applicant's VAGISERT marks are not likely to be confused. The "-SIL" and "-SERT" portions of the marks do not appear as standalone terms or as the first syllable in each mark. Appearing as the third syllable, their impression and connotation is affected by the first two syllables of the marks, which are identical. Additionally, while Applicant contends that "descriptive or generic elements can never be the dominant portion of a trademark"⁵³ there has been no showing that the first part of the parties' marks, i.e., "vagi-" is descriptive or generic. Rather, it is suggestive.

In determining the commercial impressions created by the marks we must also consider the marks in relation to the parties' identified goods. *See e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010), *aff'd*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012); *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013). Inasmuch as Applicant's proposed marks

VAGISERT and  are to be used on vaginal antifungal preparations, they connote the same meaning or commercial impression as that of Opposer's VAGISTAT and VAGISIL marks, which are registered for a pharmaceutical preparation for the treatment of fungus infections of the female reproductive tract, and powders,

⁵² Applicant's Brief pp. 18-19 (82 TTABVUE 25-26).

⁵³ Applicant's Brief p. 19 (82 TTABVUE 26).

premoistened wipes, washes, anti-itch creams and moisturizers, for feminine use. Thus, Opposer's and Applicant's marks have the same or similar overall commercial impression when used on Applicant's and Opposer's identical and related goods.

That Applicant's stylized VAGISERT mark, i.e., , includes design elements incorporated into the "g" and "i" portions of the mark does not detract from the similarity between its mark and Opposer's marks, as the design elements do not change the overall impression of its mark.⁵⁴ In composite marks comprising words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed. *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1134 citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983). Thus, the design elements do not serve to distinguish Applicant's stylized mark from Opposer's marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, 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 that the ultimate conclusion rests on consideration of the marks in their entireties."); *In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB finding that DELTA was the dominant feature of the mark THE DELTA CAFE

⁵⁴ Applicant's  mark also includes the wording "Vaginal Applicators" in smaller font located underneath the term "Vagisert." Inasmuch as this disclaimed wording relates to both Applicant's and Opposer's goods given their similarity, it does not distinguish the overall commercial impression of Applicant's mark.

and design, and that the design element and generic word “CAFÉ” were insufficient to overcome likelihood of confusion with the registered mark DELTA). Moreover, Opposer’s registered marks are standard character marks that make no claim to font style, size, or color. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Thus, Opposer’s marks could be presented in the same font as Applicant’s stylized mark in Serial No. 86038137.

When the marks are viewed in their entireties, they are similar. Thus, this *DuPont* factor favors a finding of a likelihood of confusion.

IV. Conclusion

The fame of Opposer’s mark VAGISIL plays a dominant role in the process of balancing the *DuPont* factors here because famous marks enjoy a wide latitude of legal protection. *Bridgestone Americas Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1063 (Fed. Cir. 2012) citing *Recot v. Becton*, 54 USPQ2d at 1897. Therefore, the fame of Opposer’s VAGISIL mark and the similarities between Opposer’s VAGISIL and VAGISTAT marks, and Applicant’s VAGISERT and



marks, together with the similarity of the parties’ goods and trade channels, is likely to result in confusion.

Decision: The Oppositions to registration of the marks VAGISERT and



shown in Serial Nos. 86038104 and 86038137, respectively, under § 2(d)

Opposition Nos. 91214779 and 91215509

of the Trademark Act are sustained. Accordingly, registration of the marks shown in Serial Nos. 86038104 and 86038137 is refused.