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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Scientific Solutions, Inc.
v.
Scientific Solutions, LLC

Cancellation No. 92051031

Scientific Solutions, Inc., pro se.

Jacques Catafago of The Catafago Law Firm PC for Scientific Solutions, LLC.

Before Seeherman, Holtzman and Kuhlke, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Petitioner, Scientific Solutions, Inc., filed a petition to cancel a registration owned by Scientific Solutions, LLC (respondent) for the mark shown below on the Principal Register for "dietary and nutritional supplements" in Class 5.¹ The

¹ Registration No. 3564203; issued January 20, 2009 from an application filed on June 10, 2008. "The color(s) blue, green, black, and grey is/are claimed as a feature of the mark."

wording SCIENTIFIC SOLUTIONS is disclaimed.²



As its ground for cancellation, petitioner asserts likelihood of confusion under Section 2(d) of the Trademark Act.³ Petitioner alleges that respondent's mark when applied to respondent's goods so resembles petitioner's previously used and registered marks consisting of or including the term SCIENTIFIC SOLUTIONS as to be likely to cause confusion. Petitioner has pleaded ownership of Registration No. 2406359 for the mark SCIENTIFIC SOLUTIONS and Registration No. 2406360 for the mark SCIENTIFIC SOLUTIONS (and design), both for the following goods in Class 9:

Computer hardware and software for use in the fields of industrial automation and scientific and engineering data acquisition, control and analysis and for controlling, monitoring and emulating scientific and engineering instruments and instrumentation systems, and for performing instrumentation functions, and instruction manuals sold therewith.

Respondent filed an answer denying the salient allegations in the petition.

² The disclaimer was included in respondent's original application.

³ Petitioner's pleaded claim of dilution was neither tried nor argued, and it will be given no further consideration.

The record includes the pleadings and the file of the involved registration. In addition, petitioner submitted the testimony, with exhibits, of Ellen E. Reardon, petitioner's sales account manager and Dean B. Cawthon, petitioner's president. The exhibits consist of printouts of petitioner's pleaded registrations obtained from the USPTO's TESS electronic database and the affidavits of each witness attesting to purported instances of actual confusion.⁴

Respondent did not attend the deposition of petitioner's witnesses; nor did respondent introduce any testimony or other evidence in its own behalf. Only petitioner filed a brief.

Standing and Priority

Petitioner has shown through the TESS printouts made of record that petitioner is the owner of its pleaded registrations and that the registrations are valid and subsisting. Registration No. 2406359⁵ is for the typed mark SCIENTIFIC SOLUTIONS and Registration No. 2406360⁶ is for the mark shown below.



⁴ The witnesses testified as to the truth and accuracy of the statements made in their affidavits and, accordingly, the affidavits are properly of record.

⁵ Issued November 21, 2000; renewed.

⁶ Issued November 21, 2000; renewed. "The lining is a feature of the mark and does not indicate color."

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Both marks are registered for "computer hardware and software for use in the fields of industrial automation and scientific and engineering data acquisition, control and analysis and for controlling, monitoring and emulating scientific and engineering instruments and instrumentation systems, and for performing instrumentation functions, and instruction manuals sold therewith," in Class 9.

The word SCIENTIFIC is disclaimed in Registration No. 2406360 only.

Because petitioner's registrations are of record, petitioner has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

In a cancellation proceeding, where both parties own registrations, petitioner must prove priority of use. See *Brewski Beer Co. v. Brewski Brothers, Inc.*, 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. Because petitioner's registrations are of record, petitioner may rely on the registrations as proof that the mark was in use as of the filing date of the underlying applications. See *J. C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965).

Both of petitioner's registrations issued from applications filed on January 10, 2000. This date is long prior to the June

10, 2008 filing date of respondent's underlying application, which is the earliest date on which respondent is entitled to rely given the absence of any evidence of earlier use. Thus, petitioner has established its priority.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

In our analysis we will focus on petitioner's mark which can be considered closest to the mark in the subject registration, namely Registration No. 2406359 for the typed mark SCIENTIFIC SOLUTIONS.

The Marks

We turn first to a comparison of respondent's mark SCIENTIFIC SOLUTIONS (and design) with petitioner's mark SCIENTIFIC SOLUTIONS and a determination of the similarity or

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dissimilarity of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

While marks must be compared in their entireties, one feature of a mark may have more significance than another in creating a commercial impression, and in such a case there is nothing improper in giving greater weight to that more significant feature. In *re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The wording SCIENTIFIC SOLUTIONS is petitioner's entire mark and that same wording is the entire literal portion of respondent's mark. Thus, the marks are identical in sound. In terms of appearance, the marks differ to the extent that respondent's mark includes a design element which is not present in petitioner's mark. However, the wording SCIENTIFIC SOLUTIONS makes a strong visual impression apart from the design, and the design does not detract from that impression. It is also the wording itself, rather than the design, that is likely to have a greater impact on purchasers and be remembered by them. See *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"). The word portion of a composite word and design mark is generally accorded greater

weight because it would be used by purchasers to request the goods. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Furthermore, with or without the design, the two marks have the same meaning and create the same commercial impression. The design in respondent's mark may add to the commercial impression created by the words SCIENTIFIC SOLUTIONS, but it does not change the commercial impression in any significant way.

We also point out that although the wording is disclaimed in respondent's mark, it remains the most significant part of the mark. It is well settled that a disclaimer "has no legal effect on the issue of likelihood of confusion." *National Data*, 224 USPQ at 751. The disclaimed words "still form[] a part of the mark and cannot be ignored in determining likelihood of confusion." *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (finding GIANT to be the dominant portion of a mark consisting of the words GIANT HAMBURGERS with a large background design, even though the wording GIANT HAMBURGERS was disclaimed).

Because the literal portions of the marks are identical, the marks as a whole are very similar in sound, appearance, meaning and commercial impression.

The *du Pont* factor regarding the similarity of the marks favors petitioner.

Goods/Channels of Trade/Purchasers

The greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the goods on which they are used in order to support a finding of likelihood of confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); and *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

However, the goods must still be related in some viable manner such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Even if the marks are identical, if these conditions do not exist, we have held that confusion is not likely. See *In re Unilever Limited*, 222 USPQ 981 (TTAB 1984) and *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983).

Respondent's goods are "dietary and nutritional supplements." Petitioner's goods comprise computer hardware and software and they are identified as follows:

Computer hardware and software for use in the fields of industrial automation and scientific and engineering data acquisition, control and analysis and for controlling, monitoring and emulating scientific and engineering instruments and instrumentation systems, and for performing instrumentation functions, and instruction manuals sold therewith.

Respondent's dietary and nutritional supplements, which are ordinary consumer goods, and petitioner's computer goods with highly technical and specialized functions and purposes, are vastly different products. Furthermore, these goods appear wholly unrelated on their face, and petitioner has failed to show, or even explain, any commercial relationship between them.

In addition, these vastly different products, by their very nature, would be sold in completely different marketing channels. The customary channels of trade for nutritional supplements might include drug stores and grocery stores. These would not be the customary channels of trade for computer hardware and software used for controlling scientific instrumentation systems.

Petitioner, however, maintains that the channels of trade for the respective goods overlap in that both parties market their products over the Internet. There is no evidence of record showing how petitioner's goods are marketed or sold,⁷ and its evidence regarding respondent's trade channels is unpersuasive. Petitioner refers to respondent's specimen label which displays the product mark "Sports Oxysht"⁸ and includes a reference to the website "scientificolutions.com" as part of the company

⁷ Petitioner points in its brief to information contained in the file for its pleaded registration. Petitioner made the registration itself of record, but not the contents of the registration file, and therefore this evidence cannot be considered. The Board does not take judicial notice of registration files. See *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986).

⁸ Respondent's mark SCIENTIFIC SOLUTIONS (and design) appears as a house mark on the label.

address. While the label mentions a website, there is nothing to indicate that the product can be purchased at the website or even that the product is advertised on the website. In any event, "the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade."⁹ *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007). Nor would the common presence of the parties' marks on the Internet prove that the goods offered under the marks would be perceived as emanating from a common source.

The parties' goods would also be offered to different classes of purchasers. Respondent's nutritional supplements would be purchased by ordinary consumers. Petitioner's goods, in contrast, are sold to "end users, OEM's, universities, research labs, pharmaceutical companies, drug and nutritional companies." *Reardon Test.*, p. 3. The "end users" who would purchase petitioner's highly specialized computer products, for example, scientists and engineers, are not ordinary consumers. Nevertheless, petitioner maintains that both products are marketed "to nutritional consumers and marketplace."

⁹ Contrary to petitioner's contention, the mere fact that a media representative mistakenly contacted petitioner instead of respondent as a potential candidate for advertising in his publication is not evidence that the respective goods are commercially related or that they travel in the same trade channels. This evidence, along with petitioner's other asserted evidence of actual confusion will be addressed later in this opinion.

While it is possible that the scientists and engineers who may purchase or use petitioner's goods would also purchase dietary and nutritional supplements, the likelihood for any kind of confusion as to the source or sponsorship of the parties' goods is de minimis. See, e.g., *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392-93 ("[O]pposer urges that persons who use opposer's data processing and telecommunications services at work and who buy batteries at retail stores would be confused as to source.... [T]he potential for confusion appears a mere possibility not a probability").

Furthermore, to the extent that the purchasers for the respective goods overlap, this group of purchasers would be highly sophisticated and knowledgeable in their purchasing decisions. Considering the highly technical and specialized nature of petitioner's goods, it is very unlikely that such purchasers would believe, upon seeing respondent's nutritional supplements, that they were in any way connected with the computer products of petitioner. See *Electronic Design & Sales*, 21 USPQ2d at 1392 ("sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care.").

We find that the *du Pont* factor regarding the similarity or dissimilarity of the goods weighs heavily in favor of respondent,

and that the factors regarding the trade channels and purchasers for the goods weigh in favor of respondent as well.

Actual Confusion

Petitioner argues that actual confusion has already occurred between petitioner's and respondent's marks. In support of this contention, petitioner points to four misdirected phone calls which it received between 2008 and 2009, the period during which both parties were using their marks. Two of the misdirected calls were received by Ms. Reardon, and she recounts her conversations with those callers:

- I received a telephone call from a rather embarrassed gentleman looking to purchase our male enhancement product. When I indicated that we do not have this product, he wanted to know if he had reached Scientific Solutions, which I indicated he had. He then asked if it was a different department or division of the company that distributed our medical products.

- I received a telephone call from a woman wanting to purchase vitamins from us. Again, I had to explain that she did not have the correct company. The woman then asked how to get in contact with the Scientific Solutions that sold vitamins.

The two other calls were received by Mr. Cawthon. He describes those conversations as follows:

- This individual was angry about his order and subsequent credit card charges by Scientific Solutions and wanted the charges reversed. ... Only after a prolonged conversation did I determine the individual was confused regarding the source of the goods he had purchased. The individual indicated he had purchased a male enhancement pill called Viraplex. When I informed the individual that we did not sell that product nor charge his card, he became even more angry and thought I was trying to deceive him. He then asked to talk to someone else who

worked in the division of the company that sold the pills. ... [Ultimately] he said he would contact his credit card company and we would have to deal with them and then ended the call.

•["a National Account Executive of Bluff media"] called us...and indicated they had done research on Scientific Solutions and thought we would be good candidates for advertising in their publication. As I was not familiar with Bluff media, I asked the executive to send me information, advertising rates and closing dates. ... The executive followed up with a number of calls emails [sic] to which I indicated I would have to review the information after the first of the year. Only after further discussions, and after the executive had mentioned the OxyShot product, did I become aware that the executive had confused Petitioner with the Applicant [sic] regarding the source of goods.

We find this evidence of no probative value on the question of confusion as to the source of respondent's nutritional supplements. These individuals were clearly confused, but the nature of that confusion is entirely unclear from the testimony. Mr. Cawthon's judgments regarding the callers' confusion "as to source" are his own assessment and they are unsupported by any underlying facts or details. Indeed, petitioner has offered no testimony as to what caused these individuals to contact petitioner instead of respondent. There could be any number of reasons for the mistake other than confusion as to source for respondent's and petitioner's goods. They may have mistaken one mark for the other, which would account for their misdirected calls, but there is no indication that mistake occurred because of any belief that respondent's nutritional supplements came from the same source as petitioner's computer goods. In fact, it is

not even clear that the callers were aware of petitioner's goods. We simply cannot infer from the vague and limited information provided by the witnesses that these individuals were prompted to call petitioner as a result of any confusion due to the source of the parties' goods, particularly considering the complete lack of similarity between the goods.¹⁰

Because we find that petitioner's evidence of actual confusion is not entitled to any probative value, this *du Pont* factor is neutral.

Conclusion

Notwithstanding the close similarity of the parties' marks, when we consider the respective goods of the parties, which are so fundamentally dissimilar and sold in different trade channels to different classes of purchasers, we find that a likelihood of confusion does not exist.

Decision: The petition to cancel is denied.

¹⁰ We also point out that the media executive who mistakenly tried to sell petitioner advertising space in his publication is not a potential purchaser for either party's goods, and any confusion on the part of this individual is irrelevant.