

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Sciton, Inc.

Serial Nos. 88781133 and 88781493

Jonathan O. Owens of Haverstock & Owens LLP
for Sciton, Inc.

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Before Adlin, Coggins and English, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Sciton, Inc. seeks registration of SCITON, in standard characters and as a stylized composite mark with a design, for: “medical services, namely, cosmetic skin treatments utilizing energy devices, namely, tunable skin resurfacing, phototherapy, hybrid fractional laser and body contouring, and minimally invasive medical and aesthetic treatment services, namely, laser-assisted lipolysis and procedures for improvement of body contours, cellulite and skin,” in International

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Class 44.¹ The Examining Attorney refused registration of both forms of the mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant’s specimens do not “show a direct association between the applied-for mark and the services in the application.” After the refusals became final, Applicant appealed, and requested and was granted remands to introduce additional evidence. The Examining Attorney found the new evidence unpersuasive, maintained the refusals and the appeals are now fully briefed.

I. Appeals Consolidated

These appeals involve common questions of law and fact and the records are essentially identical. Accordingly, we consolidate and decide both appeals in this single decision.² *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1214 (2022).

¹ Application Serial Nos. 88781133 (the “133 Application”) and 88781493 (the “493 Application”), respectively, both filed January 31, 2020 under Section 1(a) of the Trademark Act, based on claimed first use dates of February 28, 2001. The ’493 Application includes this

description of the composite mark  : “The mark consists of an oval design with two extensions dividing the oval coming to points in the middle of the oval, next to the stylized word ‘SCITON’.” Both applications include Applicant’s claim of ownership of renewed Registration No. 2547021.

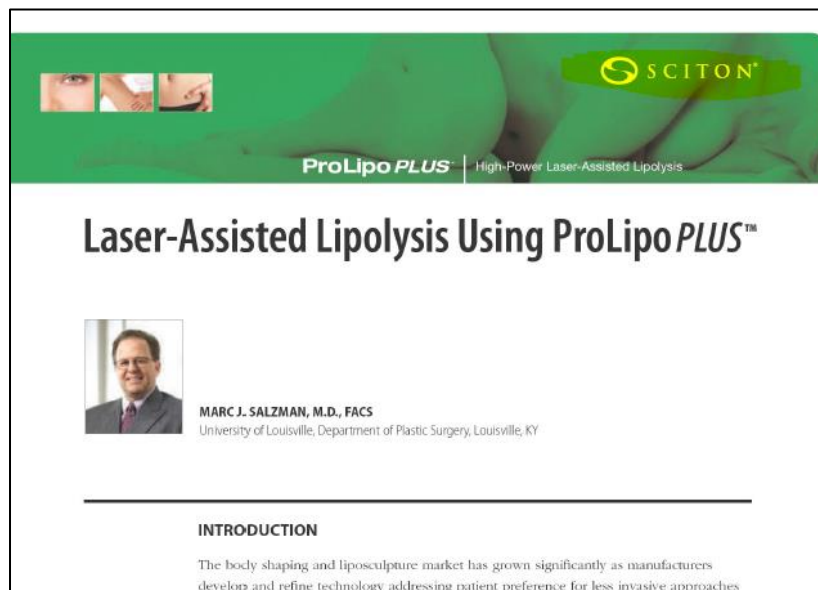
² Citations are to the record in the ’133 Application. Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format. Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

II. Specimens and Related Evidence

Applicant filed two specimens with each of its applications: (1) its “White Paper” entitled “Laser-Assisted Lipolysis Using ProLipo *PLUS*™,” by plastic surgeon Marc J. Salzman; and (2) a printout from the “Treatments” section of its website accessible at “sciton.com.” Applicant and the Examining Attorney also introduced related evidence.

A. Specimen 1 – White Paper

This specimen displays the SCITON mark on its first and last pages, as shown below:



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and includes the word mark in the footers of the first six pages, as shown by this example from the first page: **1 | SCITON White Paper**. The White Paper discusses the benefits of Laser-Assisted Lipolysis (“LAL”) generally, LAL using the “ProLipo *PLUS*™ laser (Sciton, Inc., Palo Alto, Calif.)” specifically, and includes case studies.

B. Specimen 2 – Applicant’s Website

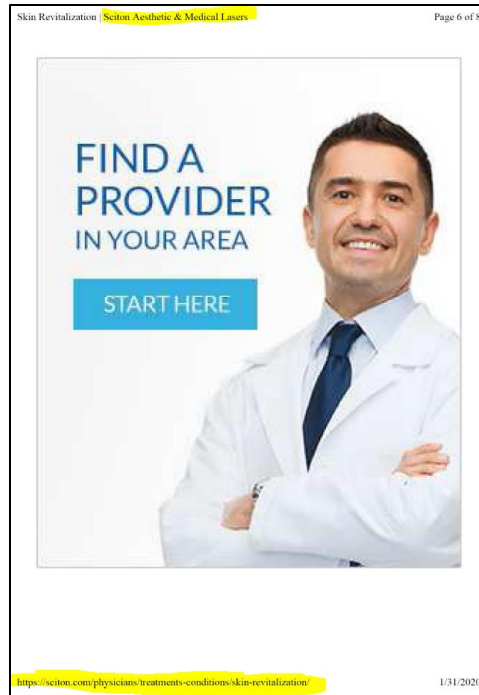
The “Treatments” section of Applicant’s website displays the SCITON composite mark at the top, and includes information on “Skin Revitalization,” as well as “Indications” and “Product Solutions” therefor, as shown below:

The screenshot shows the SCITON website interface. At the top is the SCITON logo with the tagline "BECAUSE RESULTS MATTER". Below the logo are navigation links: "FIND A PROVIDER (/FIND-PROVIDER)", "CONTACT US (/CONTACT-US/)", and a shopping cart icon. A secondary navigation bar includes "ABOUT SCITON", "PRODUCTS", "TREATMENTS", "BEFORE & AFTER (HTTPS://SCITON.COM/PHYSICIANS/BEFORE-AFTER-RESULTS/)", and "PHYSICIAN RESOURCES". A third navigation bar includes "SUCCESS BUILDER" and "PATIENTS (/PATIENTS/?TYPE-PATIENT)".

The main content area is titled "TREATMENTS" and features a section for "Skin Revitalization". The text in this section states: "Cosmetic procedures have increased by 39% over the past five years (from 2011) with surgical procedures up 17% and nonsurgical procedures up 44%.*" Below this is a quote: "Aging can bring unwanted changes to the skin – in the form of wrinkles, fine lines, enlarged pores, rough texture or a dull tone. As a result, many people are striving to restore their youthful glow, looking as good on the outside as they feel on the inside."

To the right of the main content is a sidebar titled "Skin Revitalization | Sciton Aesthetic & Medical Lasers" with "Page 2 of" in the top right corner. This sidebar contains two sections: "Indications" with a bulleted list: "Mild – Severe Rhytids", "Poor Texture", "Enlarged Pores", and "Dullness"; and "Product Solutions" with a bulleted list: "HALO™ (/physicians/halo/)", "Contour TRL™ (/physicians/contour-trl/)", "ProFractional™ (/physicians/profractional/)", and "ClearSilk™ (/physicians/clearsilk/)". At the bottom of the sidebar is a footnote: "*Resource: ASAPS, working with an independent research firm, compiled the 19-year national data for procedures performed from 1997-2015."

This section of the site also includes before and after photographs of treatments featuring one of the specific “Product Solutions” listed, and links to other sections of Applicant’s website covering specific skin conditions. The site includes a “Find a Provider” search tool, as displayed below:



C. Other Evidence

The Examining Attorney introduced evidence that the “Find a Provider” search tool on Applicant’s website links to information about “independent physicians who provide treatments using applicant’s goods.” February 22, 2021 Office Action TSDR 2, 4. She also introduced an additional printout from Applicant’s website stating that Applicant “was created to provide advanced lasers and light sources to the aesthetic medical markets,” but providing no indication that Applicant provides medical or cosmetic services. *Id.* at 5. Rather, Applicant’s website makes clear that Applicant focuses on providing “systems,” and that it also offers its customers, i.e. medical professionals, “comprehensive clinical training and practice marketing programs.” *Id.* Applicant refers to itself as a “medical device company” and a “laser company.” *Id.* at 6, 7.

With its Request for Remand, Applicant introduced the Declaration of Daniel K. Negus, its Co-Founder/President (“Negus Dec.”). 4 TTABVue 7-9. He testifies that Applicant “manufactures medical and aesthetic laser and light devices.” *Id.* at 7 (Negus Dec. ¶ 1). He goes on to explain that Applicant uses “trusted health expert[s]” and “influencers” known as “Key Opinion Leaders (KOLs),” who exchange “advice and recommendations” with Applicant. *Id.* (Negus Dec. ¶ 3). KOLs are Applicant’s “partners,” and “[t]ogether, we strive to maintain and improve the quality of products and services provided under” the involved mark, “and to ensure that ongoing medical standards are met.” *Id.*

Dr. Negus further explains that the “Find a Provider” feature on Applicant’s website identifies “doctors who use [Applicant’s] products and are approved by [Applicant] to do so.” *Id.* at 7-8 (Negus Dec. ¶ 4). Applicant trains these doctors/providers. *Id.* at 8 (Negus Dec. ¶¶ 5-6).

Dr. Peter Castillo, one of these providers who is also a KOL, “directs an on-site clinic at the location of [Applicant’s] corporate headquarters,” where he provides cosmetic skin treatment services. *Id.* (Negus Dec. ¶¶ 7, 9). “While performing procedures at the on-site clinic, Dr. Castillo uses [Applicant’s] products bearing the SCITON mark. Before, during, and after these procedures, patients are exposed to the SCITON mark on brochures, release forms, and Sciton products.” *Id.* (Negus Dec. ¶ 10).

Following remand, the Examining Attorney introduced evidence about Dr. Castillo showing that he practices at Swan Medical, and uses “Swan Medical” as a

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service mark/trade name that identifies the source of a variety of skincare services he provides. The Swan Medical website discusses a number of SCITON devices, but does not show that the SCITON mark is used to identify any services. November 18, 2021 Denial of Request for Reconsideration TSDR 9-17.

III. Analysis

“To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source via a ‘direct association.’” *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) (“[I]n a case such as this, the critical inquiry is whether the asserted mark would be perceived as a source indicator”). “A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.” *DSM Pharm.*, 87 USPQ2d at 1624. Moreover, “[i]t is not enough that the mark and a reference to the services both appear in the same specimen. In order to create the required ‘direct association,’ the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source.” *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

Here, while Applicant’s specimens display both forms of the SCITON mark for which Applicant seeks registration, they do not associate either form of the SCITON mark with the medical/cosmetic services identified in the involved applications. Indeed, neither specimen indicates that Applicant provides any medical or cosmetic services itself. Rather, the specimens make clear that Applicant is primarily a

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medical device company which provides its devices to medical and cosmetic service providers such as Dr. Castillo. While the record reveals that Applicant provides “comprehensive clinical training and practice marketing programs,” February 22, 2021 Office Action TSDR 5, those are not the services for which Applicant seeks registration.

For example, although both forms of the SCITON mark appear on the White Paper specimen describing LAL using Applicant’s ProLipo *PLUS*TM device, the White Paper does not indicate that Applicant or any other specific source provides any of the identified medical/cosmetic services. Rather, the White Paper associates the mark with the device, referred to as “[t]his Sciton laser” and “[t]he ProLipo *PLUS*TM laser (Sciton, Inc., Palo Alto, Calif).” *See In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) (“The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.”).

Similarly, although Applicant’s website specimen displays the SCITON mark, including in connection with basic facts about skin “treatments” and “skin revitalization,” there is no indication on the website that Applicant (or any other specific source) provides medical/cosmetic services. To the contrary, the site focuses on skin treatment facts generally. “Such vague references to services are insufficient to show use of [SCITON] for the services identified in applicant’s application.” *In re Chengdu AOBI Info. Tech. Co., Ltd.*, 111 USPQ2d 2080, 2082 (TTAB 2011). The site also lists “Product Solutions” (as opposed to services) offered by Applicant.

Rather than promoting services Applicant or another specific source provides, the site includes a tool allowing users to “Find a Provider.” Presumably, if Applicant provided the identified medical/cosmetic services, it would be offering or promoting its services on its site, or elsewhere, rather than encouraging users to find an independent provider of those services who, as Dr. Negus testified, “use Sciton products and are approved by Sciton to do so.” 4 TTABVUE 7-8 (Negus Dec. ¶ 4). In order for advertisement specimens “to create the required ‘direct association,’ the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source.” *Osmotica Holdings*, 95 USPQ2d at 1668.

That is not the case here. Here, “[t]he clear import of the mark as used in the specimens is to identify the [device(s)] used in the performance of the services.” *In re Walker Research, Inc.*, 228 USPQ 691, 692 (TTAB 1986). There is nothing on any specimen that refers to, or even suggests, that there is a SCITON medical/cosmetic service.


Applicant did not provide a specimen of use from Dr. Castillo’s “on-site clinic” at Applicant’s headquarters. Standing alone, Dr. Negus’s testimony about that clinic does not overcome the refusals to register Applicant’s mark for the identified medical/cosmetic services. In fact, not only is there no specimen directly associating either form of the SCITON mark with the identified services and identifying their source, but Dr. Negus does not even indicate that the services Dr. Castillo provides

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are identified by SCITON as opposed to SWAN MEDICAL or some other mark or name.

Dr. Negus's testimony that consumers are exposed to the SCITON mark in connection with Dr. Castillo's services is indefinite at best. Indeed, there is no testimony or other evidence, much less a specimen, showing that the "brochures" and "release forms" bearing the SCITON mark relate to the services identified in the involved applications, nor is there evidence that the SCITON mark identifies the identified services or their source. Consumer exposure to the mark on Applicant's devices "[b]efore, during and after" unspecified "procedures" is not enough to establish that the SCITON mark identifies the services for which Applicant seeks registration, or their source. It is likely that consumers of Applicant's identified services would view the SCITON mark on Applicant's products used by Dr. Castillo or others "as simply a trademark for" those products. *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994). There is no evidence that the "brochures," "release forms" and "products" about which Dr. Negus testifies make any "reference, not even an indirect one, to the service[s]" identified in the involved application, and "we have no evidence that the mark sought to be registered is used in advertising" the identified services. *Id. See also In re Adair*, 45 USPQ2d 1211, 1214 (TTAB 1997). As we pointed out in *DSM Pharm.*, in discussing *Walker Research*, it is "irrelevant" that Applicant's devices are used in performing the identified services. *DSM Pharm.*, 87 USPQ2d at 1626.

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Decision: The refusals to register SCITON and  because the specimens do not show a direct association between either form of the mark and the services identified in the application are affirmed.