

This Opinion is Not a
Precedent of the TTAB

Mailed: July 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Ucorp Pty Ltd.

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Serial No. 90349154

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John Alunit of Alunit IP for Ucorp Pty Ltd.

Christina L. Martin, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

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Before Cataldo, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Ucorp Pty Ltd. (“Applicant”) seeks registration on the Principal Register of the mark shown below for services ultimately identified as “Software as a service (SAAS) services featuring software for authoring safety data sheet documents” in International Class 42:



CHEMWATCH¹

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¹ Application Serial No. 90349154 was filed on November 30, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark at least as early as July 23, 1993 and first use of the mark in commerce at least as early as

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the mark shown below



registered on the Principal Register for, among other things, “Providing online non-downloadable cloud software for professional learning in the field of regulation of chemicals and the management of chemical risks” and “providing an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in International Class 42,² as to be likely, when used in connection with the services identified in the application, to cause confusion, to cause mistake, or to deceive.

January 4, 2003. Applicant describes the mark as follows: “The mark consists of the wording ‘CHEMWATCH’ in the colors gold and light gold appearing within a black rectangle with a gold and light gold border. The gold in the mark fades from gold on the left and right to light gold in the middle.” The colors black, gold, and light gold are claimed as a feature of the mark.

² The cited Registration No. 6032374 issued on April 14, 2020. It covers additional goods and services that are not cited by the Examining Attorney in support of the refusal to register. The registrant has disclaimed the exclusive right to use “Chemical” apart from the mark as shown. The registrant describes the mark as follows: “The mark consists of a stylized iris symbol on the left and the word ‘Chemical’ above the word ‘Watch’ to the right, with the first letter of each word (‘C’ and ‘W’) capitalized and the remainder of each word in lower case.” Color is not claimed as a feature of the mark.

When the Examining Attorney made the refusal final, Applicant requested reconsideration, which was denied, and then appealed. Applicant and the Examining Attorney have filed briefs.³ We affirm the refusal to register.

I. Record on Appeal⁴

The record on appeal includes Applicant's specimen, which consists of Applicant's login page and pages from its website;⁵ USPTO electronic records regarding the cited registration;⁶ dictionary definitions of "chem" and "authoring;"⁷ third-party webpages regarding the authoring of safety data sheets;⁸ Wikipedia entries captioned "Safety data sheet" and "Occupational safety and health;"⁹ and third-party webpages offering the involved services.¹⁰

³ Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). 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. Applicant's brief appears at 4 TTABVUE and the Examining Attorney's brief appears at 6 TTABVUE.

⁴ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the Trademark Status and Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO"). The Examining Attorney initially cited a second registration for different services as a bar to registration under Section 2(d), but withdrew that citation prior to appeal. November 17, 2021 Final Office Action at TSDR 1. We will not summarize record evidence directed to the withdrawn refusal except to the extent that it is probative of the issues before us on appeal.

⁵ November 30, 2020 Specimen at TSDR 2-5.

⁶ March 26, 2021 Office Action at TSDR 4-6.

⁷ *Id.* at TSDR 7; July 8, 2021 Response to Office Action at TSDR 12-16.

⁸ July 8, 2021 Response to Office Action at TSDR 2-11.

⁹ *Id.* at TSDR 17-25; September 25, 2021 Request for Reconsideration at TSDR 11-62.

¹⁰ August 23, 2021 Final Office Action at TSDR 30-51; November 17, 2021 Denial of Request for Reconsideration at TSDR 2-28.

II. Analysis of Likelihood of Confusion Refusal

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, 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.” Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

“In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). Applicant confines its arguments to these two key factors, concluding that “[w]hen Applicant’s and Registrant’s marks are considered in their entirety, confusion is not likely” and that there is “insufficient evidence to establish

relatedness of Applicant's services with the relevant services of Registrant." 4 TTABVUE 9.¹¹

A. Similarity or Dissimilarity of the Marks

"Under the first *DuPont* factor, we consider 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *Id.* (quoting *In re Inn at St. John's*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd*, 777 Fed. App'x 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1801, 1812 (TTAB 2014)).

"The proper test regarding similarity is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Id.* (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (internal quotation omitted)).

"The proper perspective on which the analysis must focus is on the recollection of the

¹¹ As noted above, we consider those *DuPont* factors for which there is argument and evidence. Applicant offered neither on any *DuPont* factor other than the first two, including on the conditions of purchase and the sophistication of the purchasers.

average customer, who retains a general rather than a specific impression of marks.”¹² *Id.* (quoting *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018)).

For ease of reference in following our discussion, we display the involved marks again below:



Applicant argues that “while it is often true that the word portion of a mark is more likely to be impressed upon a purchaser’s memory, that is not the case in every situation.” 4 TTABVUE 4. According to Applicant, the involved marks “are Composite Marks whose design features form a significant part of the mark, and which must be considered along with the wording.” *Id.* at 5.

Applicant further argues that

Applicant’s mark features what appears to be a black metal plate with gold, shiny borders containing the single word CHEMWATCH in the center. On the other hand, registrant’s mark, according to its description, consists of “a stylized iris symbol.” The commercial impressions conveyed by these two features are different because there is no connection between a black metal plate with gold borders and an iris. Applicant’s mark contains the single wording “CHEMWATCH,” while registrant’s consists of two words “CHEMICAL WATCH,” making registrant’s

¹² The record indicates that the average customer of Applicant’s services is a company that deals with chemicals or chemical-containing products and thus must prepare the safety data sheets discussed below that are required under U.S. law and regulations.

mark appear and sound longer. This also leaves prospective consumers with the impression that registrant's mark contains two words, and not one. The fonts are also different. The differences in appearance of the wording, the resulting differences in sound based on the length of the wording, and the different design features, all work together to minimize confusion.

Id.

Applicant criticizes the Examining Attorney for failing to consider the marks in their entireties and instead “focus[ing] only on the fact that ‘CHEM’ is an abbreviation for ‘CHEMICAL,’ and the same word is combined with the word ‘WATCH.’” *Id.* at 6.

The Examining Attorney responds that the “marks share the nearly identical wording ‘CHEMWATCH’/‘CHEMICAL WATCH,’ and applicant merely abbreviates the wording ‘CHEMICAL’ in registrant’s mark to ‘CHEM’ and omits the space between the wording ‘CHEM’ and ‘WATCH’ in the applied-for mark,” 6 TTABVUE 6, and that “applicant’s and registrant’s marks convey a highly similar overall commercial impression, namely, that applicant’s and registrant’s services involve some form of oversight with regard to chemicals.” *Id.* at 7.

With respect to the design elements of the marks, the Examining Attorney argues that the words dominate the marks, and that “[b]ecause the word portion of the marks is nearly identical, in that the applied-for mark merely appears to be a shortened version of registrant’s mark, potential consumers are likely to focus on this wording in the mark and believe that applicant’s and registrant’s services emanate from the same source.” *Id.* She further argues “that the applied-for mark centers the wording in large font and the design element included is merely a carrier,” while “the wording

in the registrant's mark is the dominant feature of the mark and the wording in registrant's mark is also presented in a large font, next to a design element that fills less space than the wording." *Id.* at 8.

As noted above, Applicant stops short of arguing that the design elements of the involved marks are their dominant portions, claiming only that the "design features form a significant part of the mark[s] . . . which must be considered along with the wording," 4 TTABVUE 5, and we agree with the Examining Attorney that the words CHEMWATCH and Chemical Watch dominate the respective marks. "In marks 'consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.'" *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021) (quoting *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). "The verbal portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Id.* (quoting *Viterra*, 101 USPQ2d at 1911). *See also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015) ("We have also explained that when a mark consists of both 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.'" (citation omitted).

This general principle applies to both composite marks. As noted by the Examining Attorney, the background rectangular design in Applicant's mark is a mere carrier for the word CHEMWATCH and has no separate source-identifying significance. *See, e.g., In re Benetton Grp., S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998) ("common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the [services] to which they are applied absent evidence of distinctiveness of the background design alone."). The word "Chemwatch" is "likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the [services]." *Sabhnani*, 2021 USPQ2d 1241, at *31.¹³

In the cited mark, the peripheral design element is "likely to be 'viewed, not spoken'" when the mark is verbalized, *id.*, at *36 (quoting *In re Electrolyte Labs., Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990)), and the words "Chemical Watch" are similarly "likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the [services]." *Id.*, at *31.

We turn now to the required comparison of the marks in their entireties, giving greater weight in that comparison to the word CHEMWATCH in Applicant's mark, and the words "Chemical Watch" in the cited mark, than to the design elements of the marks.

¹³ Applicant's specimen of use, consisting of pages from its website, shows its composite mark on several pages, but in text Applicant refers to itself simply as "Chemwatch." November 30, 2020 Specimen at TSDR 2-5.

The dominant words CHEMWATCH and Chemical Watch in the marks are effectively identical in meaning. The Examining Attorney made of record a definition of “chem” as an abbreviation of, among other things, “chemical,”¹⁴ and Applicant acknowledges that “‘CHEM’ is an abbreviation for ‘CHEMICAL.’” 4 TTABVUE 6. The design elements of the marks contribute to some differences between the marks in appearance, and the presence of two distinct words in Applicant’s mark contributes to a slight difference in sound, but those differences are far outweighed by the near identity of the words CHEMWATCH and Chemical Watch in meaning. There is no evidence of record regarding whether consumers will recognize the design element in the registered mark as a stylized iris. Thus, there is no evidence that the design will contribute to the meaning of the registered mark. We agree with the Examining Attorney that both marks have the same connotation and commercial impression, namely, that “[A]pplicant’s and registrant’s services involve some form of oversight with regard to chemicals.” 6 TTABVUE 7. The near identity of the marks in connotation and commercial impression is “sufficient to find the marks confusingly similar.” *Sabhnani*, 2021 USPQ2d 1241, at *26 (quotation omitted). The marks are also quite similar in sound and somewhat similar in appearance, taking into account that consumers retain “a general rather than a specific impression of marks,” *Embiid*, 2021 USPQ2d 577, at *11, and the first *DuPont* factor strongly supports a finding of a likelihood of confusion.

¹⁴ May 26, 2021 Office Action at TSDR 7 (MERRIAM-WEBSTER DICTIONARY).

B. Similarity or Dissimilarity of the Services

The second *DuPont* factor “considers [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration’” *Embiid*, 2021 USPQ2d 577, at *29 (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d, 1047, 1051 (Fed. Cir. 2018)).

“The [services] need not be identical, but ‘need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.* (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012)).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant [services] are used together or used by the same purchasers; advertisements showing that the relevant [services] are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s [services] and the [services] listed in the cited registration.

Id., at *22-23 (quoting *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020)).

“We begin with the identifications of [the] services in the registration and application under consideration.” *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019). Both identifications contain some technical and vague language, and “[w]hen identifications are technical or vague and require clarification, it is appropriate to consider extrinsic evidence of use to determine the meaning of the identification[s].” *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1354 (TTAB 2015) (citing

Edwards Lifesciences Corp. v. VigiLanz Corp., 94 USPQ2d 1399, 1410 (TTAB 2010); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (considering extrinsic evidence to interpret vague terminology with special meaning in the industry)). Accordingly, we will first discuss the meaning of certain terms in the respective identifications.

1. Applicant's Services

The services identified in the application are “Software as a service (SAAS) services featuring software for authoring safety data sheet documents.” The identification contains two portions that we must interpret before we can assess the similarity of the identified services to the services identified in the cited registration: (1) “Software as a service (SAAS),” and (2) the field of use for the software, “authoring safety data sheet documents.”

“The Board may take judicial notice of dictionary definitions, including online dictionaries, definitions in technical dictionaries and translation dictionaries that exist in printed format.” *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *2 n.17 (TTAB 2019). We take judicial notice that “software as a service” (SAAS) means:

[t]he capability provided to the consumer for using the provider's applications running on a cloud infrastructure. The applications are accessible from various client devices through either a thin client interface, such as a web browser (e.g., web-based email), or a program interface. The consumer does not manage or control the underlying cloud infrastructure, including network, servers, operating systems, storage, or even individual application capabilities, with the possible exception of limited user-specific application configuration settings.

DICTIONARY OF COMPUTER AND INTERNET TERMS (1st ed. 2016). *See In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1124 (Fed. Cir. 2016) (discussing software as a service and cloud computing).¹⁵ Applicant's SAAS services are provided through its website at chemwatch.net.¹⁶

With respect to the field of use of Applicant's SAAS services, "authoring safety data sheet documents," the record shows that "authoring" is a term of art in the field of computers and that a "safety data sheet" is a term of art in the field of chemicals. Applicant made of record a page from Dictionary.com that defines "authoring," in the context of computers, as "the writing of an electronic document or software program, especially a hypertext or multimedia application."¹⁷ Applicant also made of record a Wikipedia entry captioned "Safety data sheet," which defines a "safety data sheet (SDS)" as "a document that lists information relating to occupational safety and health for the use of various substances and products,"¹⁸ and states that SDSs are "a widely used system for cataloguing information on chemicals, chemical compounds, and chemical mixtures" that "may include instructions for the safe use and potential hazards associated with a particular material or product, along with spill-handling procedures."¹⁹ The Wikipedia entry also states that in the United States, "the

¹⁵ We note with some consternation that neither the Examining Attorney nor Applicant introduced into the record during prosecution a definition of this term and another relevant term discussed below.

¹⁶ November 30, 2020 Specimen at TSDR 2-5.

¹⁷ July 8, 2021 Response to Office Action at TSDR 12.

¹⁸ *Id.* at TSDR 17.

¹⁹ *Id.* According to the entry, "the newer SDS format is internationally standardized," *id.*, and the "Global Harmonized System of Classification and Labelling of Chemicals contains a standard specification for safety data sheets" that has 16 sections dealing with matters such

Occupational Safety and Health Administration requires that SDSs be readily available to all employees for potentially harmful substances handled in the workplace under the Hazard Communication regulation,” as well as to local fire department and other government offices dealing with emergencies.²⁰

The Wikipedia entry contains a section captioned “SDS authoring,” which states that “[m]any companies offer the service of collecting, or writing and revising, data sheets to ensure that they are up to date and available for their subscribers or users.”²¹ Applicant appears to be one of those companies, as its specimen of use states that “we provide SDS management and SDS authoring to keep your chemical management systems up to date.”²²

Applicant also points to several websites made of record by the Examining Attorney as referring to Applicant’s SAAS services for “authoring safety data sheet documents.” 4 TTABVUE 7-8. These websites help to illustrate the nature of the services identified in the application, and we describe and display pages from several of them below.

The website at ul.com describes UL’s “Safety Data Sheet (SDS) Authoring and Labelling Services,” which enable users to “[c]reate, maintain and distribute

as “Identification of the substance/mixture and of the company/undertaking,” “Hazards information,” first aid and firefighting measures, and handling and storage. *Id.* at TSDR 18-19.

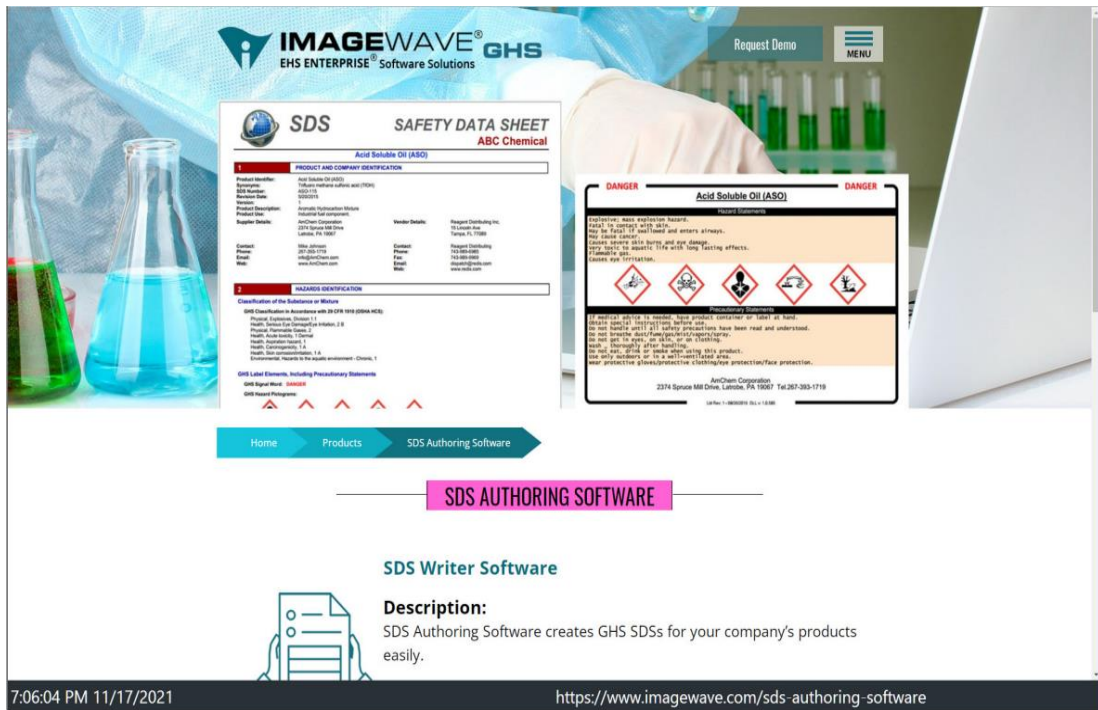
²⁰ *Id.* at TSDR 22.

²¹ *Id.*

²² November 3, 2020 Specimen at TSDR 4.

comprehensive SDSs and labels to meet your increasingly complex global compliance requirements” and to “[a]uthor safety data sheets & distribute them efficiently.”²³

The website at imagewave.com contains the pages displayed below, which discuss the Imagewave “SDS Authoring Software,” and displays an example of a Safety Data Sheet:



²³ *Id.* at TSDR 44.

²⁴ November 17, 2021 Denial of Request for Reconsideration at TSDR 8 (highlighting supplied by the Examining Attorney).

SDS AUTHORIZING SOFTWARE

SDS Writer Software



Description:
SDS Authoring Software creates GHS SDSs for your company's products easily.

Overview:
A scalable SDS Authoring system based on the GHS SDS standard. Customizable with many features. Add your company's logo and start creating your SDSs!

Features:

- ✔ **Generate GHS SDSs** – Integrated GHS Classifications, Signal Words, Precautionary Statements, and Pictograms.
- ✔ **Pre-loaded Chemical List** – With our included chemical database, you can build your SDS by selecting the chemical components from a simple picklist.
- ✔ **Your Logo and Color Scheme** – Easily add your company's logo and color scheme to your SDSs.
- ✔ **Custom Templates** – Create your own custom templates for product families or similar products.
- ✔ **Standard List Libraries** – Customizable list templates for all fields to enforce standard rules and assist in data entry.
- ✔ **Trademarks and Proprietary Information** – Keep your trademarks and proprietary information confidential via our special status fields.

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Features:

- ✔ **Generate GHS SDSs** – Integrated GHS Classifications, Signal Words, Precautionary Statements, and Pictograms.
- ✔ **Pre-loaded Chemical List** – With our included chemical database, you can build your SDS by selecting the chemical components from a simple picklist.
- ✔ **Your Logo and Color Scheme** – Easily add your company's logo and color scheme to your SDSs.
- ✔ **Custom Templates** – Create your own custom templates for product families or similar products.
- ✔ **Standard List Libraries** – Customizable list templates for all fields to enforce standard rules and assist in data entry.
- ✔ **Trademarks and Proprietary Information** – Keep your trademarks and proprietary information confidential via our special status fields.
- ✔ **Integration** – Seamlessly integrates with ImageWave's EHS Enterprise® Software Suite including SDSFinder® and the Advanced Environmental Reporter.
- ✔ **Flexible Output** – Output your SDSs to industry standard file formats such as PDF, HTML and Text.
- ✔ **Multi-lingual** –The multi-lingual option creates SDSs in up to 51 languages.
- ✔ **GHS Label Printing** – Print GHS container and shipping labels.
- ✔ **Multiple Brand SDSs** –Multiple Brands? No problem. Easily create SDSs using various brand logo profiles.
- ✔ **Don't see a feature you're looking for on this list? Contact our experienced sales staff for more details and a free demo!**

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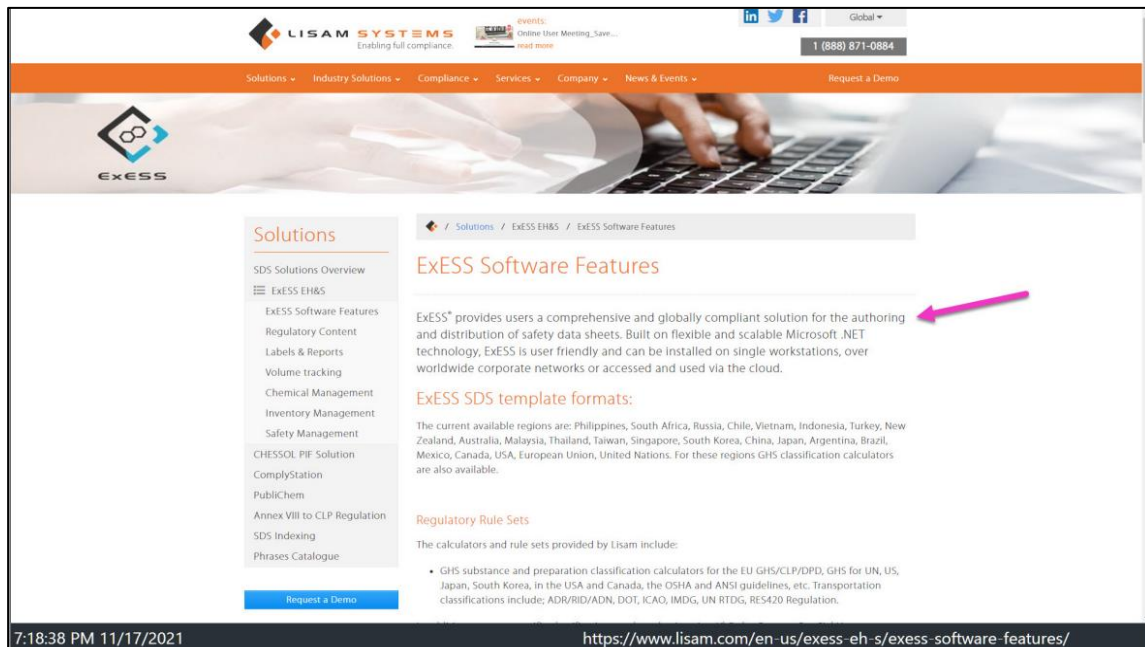
7:07:06 PM 11/17/2021<https://www.imagewave.com/sds-authoring-software>

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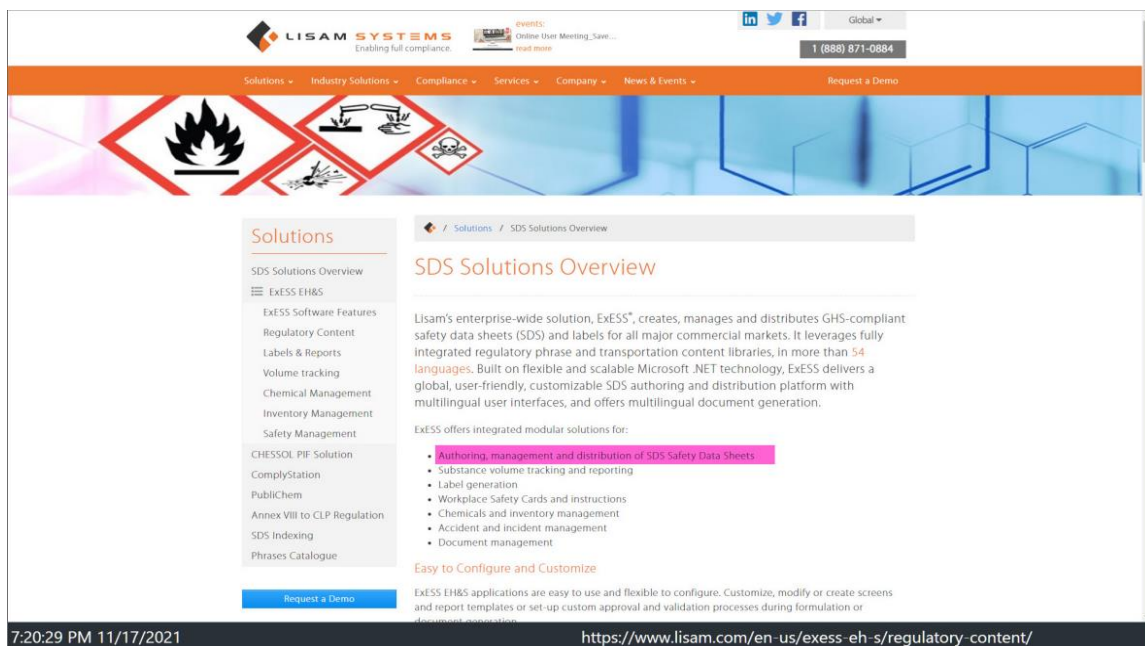
²⁵ *Id.* at TSDR 9.

²⁶ *Id.* at TSDR 10.

According to Applicant, the website at lisam.com “refers to a software feature for SDS authoring,” 4 TTABVUE 9, and we display below pages from that website:



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²⁷ *Id.* at TSDR 11 (arrow supplied by the Examining Attorney).

²⁸ *Id.* at TSDR 13 (emphasis supplied by the Examining Attorney).

The website at era-environmental.com discusses the company's "SDS Authoring" software as follows:

SDS AUTHORIZING



SDS AUTHORIZING

Ensure Your GHS Compliance with This Comprehensive SDS Authoring Offering

ERA's SDS Authoring solution is the perfect option for businesses that need to both streamline and ensure complete accuracy with their SDS production.

ERA's SDS authoring software will allow your business to produce fully-GHS compliant SDSs, ensuring that all regulations and chemical classifications are completely up to date. This approach helps ensure your company is always acting in total regulatory compliance.

This solution allows you to:

- Accurately author or re-author any type of data sheet you need with complete confidence, including SDS, CPDS, TDS and Department of Transport (DoT) shipping labels.
- Maintain a comprehensive SDS library of all product revisions and changes.
- Access and utilize fully up-to-date Volatile Organic Chemicals (VOC) and Hazardous Air Pollutant (HAP) content as you author.
- Tiered access gives your employees the ability to review, modify, and edit based on your

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- Access and utilize fully up-to-date Volatile Organic Chemicals (VOC) and Hazardous Air Pollutant (HAP) content as you author.
- Tiered access gives your employees the ability to review, modify, and edit based on your custom permissions.
- Take into account all regulations, both federal and state, while producing your GHS compliant SDSs.

This authoring solution can update your Material Safety Data sheets (MSDS) into fully compliant GHS SDS documents in a rapid and fully automated manner. Your newly produced SDSs are fully GHS compliant and fully in line with OSHA regulations.

ERA actively supports your SDS creation by giving you full access to our dedicated team of EH&S professionals, who will walk you through the best way to carry out your SDS writing. This team is standing by to assist you with the best possible application of this capable software.

With a comprehensive and fully-curated master chemical list informing your SDS management, your business will be able to produce fully accurate and formatted SDSs in minutes. This production facilitates full proprietary control across your reporting.

Look what our clients say about us.



With more than 500 unique products to manage, we needed an efficient and effective solution for creating compliant domestic and international SDSs and labels. ERA has been a valuable partner, helping us to save time and providing peace of mind knowing we comply with the most current regulations. They offer the flexibility we require to handle our evolving product range, and we appreciated being able to trial the SDS On Demand system before purchasing the full license. The ERA team has supported us throughout the training and implementation process.

- **Mak Joshi, Ph.D.** | Vice President, R&D
Hawk Research Laboratories, LLC

The Only SDS Authoring Software that Provides Material Data Directly from Your Vendors

ERA's SDS Authoring software is the only system that can automatically utilize the very latest information from your vendors, directly feeding this information into your SDS production.

This means that you no longer must carry out the task of updating product and chemical information to accurately reflect the latest classifications. These changes are instead noted by your vendor, and are automatically worked into your calculations.

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²⁹ August 23, 2021 Office Action at TSDR 8.

³⁰ *Id.* at TSDR 9.

These websites, and the other evidence of record, establish that the “Software as a service (SAAS) services featuring software for authoring safety data sheet documents” identified in the application enable users to use non-downloadable software to create SDSs that comply with applicable legal and regulatory standards and requirements regarding chemicals.

2. The Services Identified in the Cited Registration

The involved services identified in the cited registration are “Providing online non-downloadable cloud software for professional learning in the field of regulation of chemicals and the management of chemical risks” and “providing an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks.”³¹ We take judicial notice that in the context of the identified services, the term “cloud” refers to “cloud computing,” which is “anything that involves delivering hosted services over the Internet,” including “Software-as-a-Service (SaaS).” *DICTIONARY OF COMPUTER AND INTERNET TERMS* (1st ed. 2016). Accordingly, the services identified in the cited registration, like the SAAS services in Applicant’s application, which Applicant’s specimen describes as “cloud-based software tools and professional services,”³² are rendered through the “cloud.”

³¹ A showing that the services identified in the application are related to either of the involved services identified in the cited registration is sufficient to support the Section 2(d) refusal. *Cf. Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

³² November 30, 2020 Specimen at TSDR 5.

3. Analysis of Similarity or Dissimilarity of the Services

The Examining Attorney cites multiple Internet websites that she claims show that “the same entity commonly provides the relevant services and markets the relevant services under the same mark.” 6 TTABVUE 11. Applicant does not dispute that the SAAS services identified in the application, and the “non-downloadable cloud software” services identified in the cited registration, both allow purchasers of those services to access software remotely, or that the services of “providing an online non-downloadable cloud database” allow purchasers of those services to access a database remotely. Applicant’s argument is that the services are not related because the respective fields of use of the non-downloadable software, “authoring safety data sheet documents” in the application, and “professional learning in the field of regulation of chemicals and the management of chemical risks” in the cited registration, do not overlap, and because “authoring safety data sheet documents” does not overlap with the “database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” services in the cited registration. To that end, Applicant critiques each of the websites on which the Examining Attorney relies, and concludes that the evidence is insufficient to show that the services are related. 4 TTABVUE 6-9.

The Examining Attorney responds that the Internet evidence of record shows that the same mark has been used for both SAAS services regarding software for authoring SDSs and an online downloadable cloud database of regulatory documents in the field of regulation of chemicals and the management of chemical risks. 6 TTABVUE 10-11.

As discussed above, Applicant's SAAS services involve the authoring of SDSs that must comply with a welter of changing federal and state laws, regulations, and standards regarding chemicals, including, among other things, "instructions for the safe use and potential hazards associated with a particular material or product, along with spill-handling procedures."³³ Databases regarding such laws, regulations, and standards are an obvious, indeed perhaps inevitable, source of information for use in the preparation of compliant SDSs. Applicant's own website urges its customers to "[k]eep-up-to-date with Chemwatch," and states that its "cloud-based software tools and professional services access the world's largest Chemicals database containing over 30 million Vendor SDSs with 'active SDS data' covering 93 countries and 47 languages," and that its "regulatory library contains over 5000 regulatory databases from 89 countries, with regulatory context being updated daily."³⁴

The services in the cited registration are directed to educating users regarding the regulation of chemicals and the management of chemical risks. It would be a natural and logical line extension from providing software for SDS authoring into providing users access to "online non-downloadable cloud software for professional learning in the field of regulation of chemicals and the management of chemical risks" and "an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks," or vice versa. Applicant's and the registrant's services are thus inherently complementary,

³³ July 8, 2021 Response to Office Action at TSDR 17.

³⁴ November 30, 2020 Specimen at TSDR 5.

and “[w]e find that the identifications in the application and registration themselves support finding the . . . services are related.” *Country Oven*, 2019 USPQ2d 443903, at *6. *See also Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002) (finding goods and services to be related based on the respective identifications without resort to evidence).

Our determination is bolstered by the Examining Attorney’s Internet evidence, which shows that providers of SDS authoring services in fact make educational software and databases in the field of regulation of chemicals and the management of chemical risks available to their SDS authoring customers. The Era Environmental website shown above offers “SDS authoring software” that allows users to “[a]ccess and utilize fully up-to-date Volatile Organic Chemicals (VOC) and Hazardous Air Pollutant (HAP) content as you author,”³⁵ and to “[t]ake into account all regulations, both federal and state, while producing your GHS compliant SDSs.”³⁶ The specific VOC and HAP content identified on the site as an adjunct to SDS authoring, and the referenced “regulations, both federal and state,” involve databases that are encompassed within the broad identification of the registrant’s services of “providing an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks.”³⁷

³⁵ August 23, 2021 Final Office Action at TSDR 8.

³⁶ *Id.* at TSDR 9.

³⁷ We reject Applicant’s sweeping assertion that on this website, “[t]here is no reference to anything remotely resembling” the services identified in the cited registration. 4 TTABVUE 7.

The Verisk 3E website at verisk3e.com offers SDS Authoring Software,³⁸ touts its “Single source compliance support,” through which “users enjoy the unique benefits of having the software, data services and support from a single source,” and states that it is “the only vendor to offer a powerful combination of integrated and optimized world class regulatory content, sophisticated authoring data management tools, language support and comprehensive outsourced services to support product and workplace safety and stewardship,”³⁹ and that it can “[s]treamline authoring and distribution” in “conformance with complex and changing regulations in multiple jurisdictions and languages worldwide.”⁴⁰ The website further states that users can “[a]ccess integrated regulatory data,” and that its SDS software “is much more than software” because it is “fueled by world class Verisk 3E content, which is considered the highest quality, most comprehensive collection of regulatory information by many of the world’s top chemical manufacturers.”⁴¹

The CloudSDS website at cloudsds.com offers “SDS Authoring,”⁴² as well as other services involving searching of SDSs,⁴³ “MSDS data in languages of your choice using

³⁸ *Id.* at TSDR 20. Applicant argues that because this website “was cited in support of a refusal based on registration no. 3274455,” which has been withdrawn, “this evidence is not relevant.” 4 TTABVUE 6. We disagree. The website evidence is in the record, and it is probative of the relatedness of the services identified in the cited registration and in the application.

³⁹ *Id.* at TSDR 21.

⁴⁰ *Id.* at TSDR 22.

⁴¹ *Id.* at TSDR 23.

⁴² *Id.* at TSDR 33.

⁴³ *Id.* at TSDR 34.

multiple search types,”⁴⁴ “information regarding overall GHS status of sites [and] cabinets,” which “helps [in] achieving GHS compliance,”⁴⁵ and “our glossary section from millions of terms that are used by you.”⁴⁶ It is clear from the description of what may be searched through the website that the website maintains one or more databases that fall within the broad identification of “an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in the cited registration.⁴⁷

The ImageWave website shown above offers software for SDS authoring,⁴⁸ as well as customer access to a “Central SDS Database,”⁴⁹ which falls within the broad identification of an “online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in the cited registration. The website states that “[w]ith our included chemical database, you can build your SDS by selecting the chemical components from a simple picklist.”⁵⁰

⁴⁴ *Id.* at TSDR 35.

⁴⁵ *Id.*

⁴⁶ *Id.* at 36.

⁴⁷ Applicant argues that on this website, “there is no reference (or pink arrow) to registrant’s services for ‘online non-downloadable cloud software for professional learning in the field of regulation of chemicals and the management of chemical risks’ or ‘providing an online nondownloadable cloud database of regulatory documents and news sources . . .’” 4 TTABVUE 7. The website need not recite the formulaic language of the identification of services in the cited registration to be probative of the relatedness of those services to SDS authoring services.

⁴⁸ November 17, 2021 Denial of Request for Reconsideration at TSDR 8-10.

⁴⁹ *Id.* at TSDR 5.

⁵⁰ *Id.* at TSDR 10. Applicant acknowledges that the reference on this website to “our Central SDS Database” “suggests a database of regulatory documents,” 4 TTABVUE 8, but speculates

The Lisam Systems website shown above offers software for authoring SDSs,⁵¹ as well as what the website describes as “Regulatory Content,” including Lisam’s “OEL lists, EU GHS and REACH Libraries, and US State/Federal Lists.”⁵² According to the website, a customer “can benefit from simply using Lisam’s regulatory lists and phrase libraries, or may choose to license additional, fully integrated third party libraries.”⁵³ We find that the referenced lists and libraries reflect one or more databases that fall within the broad identification of an “online nondownloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in the cited registration, and we reject Applicant’s argument that “[w]hile the buzzwords ‘Regulatory Content’ is [sic] there, there is no clear reference to the services of ‘providing an online nondownloadable cloud *database* of regulatory documents” 4 TTABVUE 8 (emphasis supplied by Applicant).

The website of Material Inventory Report System (“MIRS”) at mirsinfo.com offers “Software for SDS Authoring, Management and OSHA Compliance,”⁵⁴ and a “Chemical List Extension” (“CLE”) add-on module, which “greatly expands the

that “for all we know, the Central SDS Database could contain only software tools for building SDS databases, and not regulatory documents.” *Id.* The reference to a “picklist” of chemical components available through “our included chemical database” suggests that the referenced database falls within the broad identification of “an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in the cited registration.

⁵¹ *Id.* at TSDR 11.

⁵² *Id.* at TSDR 12.

⁵³ *Id.*

⁵⁴ *Id.* at TSDR 14.

standard chemical database for identifying and cross-checking multiple agency lists.”⁵⁵ The website makes it clear that it provides both a “standard chemical database” and enhanced databases, both of which fall within the broad identification of an “online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” in the cited registration.

The identified services are inherently related, and the record shows that the same entity has offered both sets of the services under the same mark. The second *DuPont* factor thus supports a finding of a likelihood of confusion.

C. Summary

The marks are quite similar, and the services are inherently related and have been offered together under the same mark. We find, on the basis of the record as a whole, that consumers with a general rather than specific recollection of the cited mark for the services of “Providing online non-downloadable cloud software for professional learning in the field of regulation of chemicals and the management of chemical risks” and “providing an online non-downloadable cloud database of regulatory documents and news sources in the field of regulation of chemicals and the management of chemical risks” who are exposed to Applicant’s similar mark for “Software as a service (SAAS) services featuring software for authoring safety data sheet documents” are likely to believe mistakenly that the respective services have a common source.

⁵⁵ *Id.* at TSDR 16.

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Decision: The refusal to register is affirmed.