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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Scientific Holdings, Inc.

Serial Nos. 76/214,473 and 76/214,474

William J. Lehane of Drinker Biddle & Reath LLP for  
Scientific Holdings, Inc.

Michael P. Keating, Trademark Examining Attorney, Law  
Office 107 (Thomas S. Lamone, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Scientific Holdings, Inc. ("applicant"), has appealed  
from the final refusals of the Trademark Examining Attorney  
to register on the Principal Register the mark shown below:



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as well as the typed mark VWR BIOMARKE, both applications sought to be registered for "publications, namely, a magazine, in the field of life sciences for use by professionals," and for "on-line store and catalog sale services all featuring products for use in life science laboratories."<sup>1</sup> In both cases, the Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d). Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested. Because these cases involve similar issues, we shall decide them in one opinion.

The Examining Attorney argues that applicant's marks should be refused registration because of likelihood of confusion with the following registered marks, all issued on the Principal Register: BIOMARK CONSULTING FOR THE LIFE SCIENCES ("CONSULTING FOR THE LIFE SCIENCES" disclaimed) (Registration No. 2,221,730, issued February 2, 1999); the mark



**BioMark**

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<sup>1</sup>Application Serial Nos. 76/214,473 and 76/214,474, both filed February 23, 2001, claiming use and use in commerce since December 31, 1999. In the first application, applicant submitted a disclaimer of the words "The Market Source for Life Science" upon request of the Examining Attorney.

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(Registration No. 2,216,525, issued January 5, 1999); and the mark BIOMARK (Registration No. 2,213,106, issued December 22, 1998), all issued to the same registrant, Biomark, Incorporated, and all for the same services-- "consulting services in the field of life sciences; namely, developing strategic plans, strategic product development and marketing for small life science businesses, such as livestock breeders and manufacturers of animal foods." The Examining Attorney withdrew one of the cited registrations (Registration No. 2,216,525, for the mark BIOMARK and design shown above) as a bar to registration of applicant's mark in Serial No. 76/214,473.<sup>2</sup>

The Examining Attorney argues that applicant's mark either consists entirely of or is dominated by "VWR BIOMARKE"; that the term "BIOMARKE" in applicant's marks is spelled nearly identically to the term "BIOMARK" in the registered marks; and that applicant's marks and the registered marks are similar in sound and commercial impression. Also, the Examining Attorney maintains that confusion is not avoided by the addition of the apparent house mark "VWR," and that the other matter in applicant's

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<sup>2</sup>The current Examining Attorney indicated, brief, 3, that he believed the previous Examining Attorney was in error in withdrawing this cited registration. The record is silent as to why the previous Examining Attorney withdrew this registration as a bar in one case but not the other.

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first application--the descriptive and disclaimed wording shown in much smaller and less prominent lettering and the design element--do not serve to avoid likelihood of confusion. In this regard, the Examining Attorney contends that the feature "VWR BIOMARKE" is more significant in creating a commercial impression in applicant's composite mark, because words generally dominate in creating a commercial impression.

With respect to applicant's goods and applicant's and registrant's services, it is the Examining Attorney's position that these goods and services are or will be offered to the same consumers--entities in the life sciences field. Because there is no limitation in applicant's identification of services, the Examining Attorney contends that applicant's on-line and catalog sale services featuring products for use in life science laboratories are broad enough to encompass registrant's more specifically limited consulting services in the field of life sciences. Further, relying upon several third-party registrations in other fields (international business, policy development and promotion for business, computer hardware and software),<sup>3</sup> the Examining Attorney

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<sup>3</sup>We note that one of the third-party registrations relied upon by the Examining Attorney, in the field of coffee and tea, was not based upon use in commerce but rather was issued pursuant to Section 44 of the

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argues that entities which offer publications may also offer consulting services and retail services in that field. The Examining Attorney contends that even sophisticated or knowledgeable customers are not necessarily immune from confusion as to source. It is the Examining Attorney's position, therefore, that consumers are likely to conclude that applicant's magazines and on-line store and catalog sale services in the field of life sciences originate from the same source that offers registrant's consulting services in the same field, in view of the similarities of the marks. Finally, the Examining Attorney asks us to resolve any doubt in favor of the registrant.

Applicant, on the other hand, emphasizes that the letters "VWR" in its marks cannot be ignored; nor can the assertedly differentiating disclaimed matter and the graphic element in applicant's composite mark. Concerning the goods and services of applicant and registrant, applicant argues that registrant offers only consulting services while applicant sells only general laboratory products and supplies and a magazine that seeks to show readers how best to use applicant's products. According to

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Trademark Act. We have not considered this third-party registration. We also agree with applicant that the existence of the other registrations in completely different fields has little or no bearing on purchaser perception in this case.

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applicant, registrant's consulting services are offered to a small group of presumably sophisticated persons "well-versed" in the field, and that applicant's goods and services do not compete or overlap with registrant's services. Finally, applicant maintains that the Examining Attorney, by making of record registrations of other companies in other fields of endeavor who may offer consulting services in addition to producing a publication and making retail sales, is attempting to create a pattern of conduct where none exists. According to applicant, these registrations do not reflect "business reality" in its field of endeavor.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood-of-confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

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Turning first to the marks, it is important to realize that the proper test for determining confusing similarity is not whether the respective marks are distinguishable on the basis of a side-by-side comparison. The reason is that such a comparison is not ordinarily the way that customers will be exposed to these marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the relevant purchasers of the respective goods and services, who may normally retain a general rather than a specific impression of marks, even if those purchasers may be somewhat sophisticated or knowledgeable. See *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In this case, applicant's mark VMR BIOMARKE as well as its design mark which includes "VWRbioMarke" and registrant's mark BIOMARK have similarities in pronunciation in that the "BIOMARKE" or "bioMarke" portion of applicant's marks would be pronounced identically to registrant's mark BIOMARK. They also are similar in

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appearance because applicant's marks, as actually used, show the "bio" and "Marke" portions as a separate components of the composite mark, while registrant's mark, at least as shown in the design mark  , also depicts "Bio" and "Mark" as separate components of the mark.

We also note that one of applicant's marks and one of registrant's marks use the term "Life Science" in the respective phrases "The Market Source for Life Science" and "CONSULTING FOR THE LIFE SCIENCES." While this term is a generic one, it is nevertheless another reason why the two marks are similar in sound, appearance and commercial impression. Compare, for example, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985)(finding likelihood of confusion between CASH MANAGEMENT ACCOUNT for certain financial services and THE CASH MANAGEMENT EXCHANGE for computerized cash management services, where the only similarity between the marks were highly descriptive or generic words). In any event, both phrases have similar descriptive meanings, one indicating that the mark's owner is the "market source" for life science and the other that it is the source for consulting for the life sciences.

Moreover, even if potential purchasers should note the specific differences in the marks, especially that applicant's mark includes the apparent house mark "VMR,"

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those purchasers may well think that these letters represent a subsidiary or licensee of registrant, authorized to use the registered mark in connection with magazines and on-line and catalog services.

In this connection, we also observe that letters may be more difficult to remember than other parts of a mark, in this case, the word mark "BIOMARKE." For example, in finding likelihood of confusion between the letter marks TMM and TMS, the U.S. Court of Appeals for the Federal Circuit observed that "It is more difficult to remember a series of arbitrarily arranged letters than it is to remember figures... [Citations omitted]." *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (1990). In this case, we believe that the letters "VWR" are not particularly memorable and would be more difficult to recall than the word "BIOMARKE" (or "bioMarke").

Further, the descriptive and design elements of the respective marks have little source-indicating ability. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) ("Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion"); and *In re Dixie Restaurants*, 105

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F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(Court holding that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion). Moreover, if both words and a design comprise a mark, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by them to request the goods and/or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). We conclude that the respective marks are sufficiently similar that confusion would be caused if they were use on commercially related goods and services.

We also note that there is no evidence of the use or registration of similar marks.

Turning then to the goods and services of applicant and registrant, our analysis of the relatedness of those goods and services, their channels of trade and classes of consumers is governed not by what the record shows but, rather, by the respective identifications in registrant's registrations and applicant's applications. See *In re Dixie Restaurants, supra*, 41 USPQ2d at 1534 (Fed. Cir. 1997)("Indeed, the second DuPont factor expressly mandates

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consideration of the similarity or dissimilarity of the services as described in an application or registration"); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"); and *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

When comparing the respective goods and services, it is not necessary that the respective goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from

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or are in some way associated with the same source, or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Based on this record, we find that the types of goods and services involved here are similar and are marketed in the same or similar trade channels, facts which support a finding of likelihood of confusion.

First, we note that there are limitations in both applicant's applications and registrant's registrations: all indicate that the respective goods and services are in the field of life sciences, that applicant's magazines are distributed to "professionals," that applicant's on-line and catalog services feature products for life science laboratories, and that registrant's services are for small life science businesses. The words "such as" in registrant's identification of services do not impose a limitation or restriction on the channels of trade of registrant's services. Rather, these words indicate that what follows are illustrative of the type of small businesses to which registrant renders its services.

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Registrant's consulting services may be rendered to any "small life science business."

"Life science" is defined by one dictionary as "Any of several branches of science, such as biology, medicine, anthropology, or ecology, that deal with living organisms and their organization, life processes, and relationships to each other and their environment. Also called *bioscience*."<sup>4</sup> Accordingly, these small businesses could include, in addition to the ones listed in registrant's identification, such small business as medical labs that analyze tissue and blood, or any small environmental businesses or labs.

Applicant's magazine and on-line and catalog services reveal, according to the specimens of record, that "The VMR bioMarke Life Science Program is your comprehensive market source for life science chemicals/reagents, equipment and supplies. No matter what type or size of lab, the VMR bioMarke program can meet your needs." The magazine indicates that applicant sells such goods as beakers, biohazard bags, gloves, pipets, safety glasses, timers and tubes, as well as goods for such life science fields as

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<sup>4</sup> The American Heritage Dictionary of the English Language (Fourth Edition 2000). We may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

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"Cell Culture," "Chromatography," "Electrochemistry,"  
"Imaging," "Immunology" and "Microbiology." In addition,  
according to applicant's magazine, applicant has a support  
program for its customers:

**VMR bioMarke Support**

VWR's team of Life Science Specialists supports the VWR bioMarke Program. They're available to meet all your needs: product sourcing, applications assistance, on-site product demos, technical support and much more.

That's not all: with the VMR bioMarke Program you get access to VMR's Managed Services to help you cut procurement costs, streamline your business and increase profitability. Managed Services addresses customer procurement, delivery/transportation, inventory management, e-commerce, on-site and equipment maintenance needs.

As can be seen, these services (technical support, streamlining a business, inventory management, equipment maintenance, etc.) rendered under the mark sought to be registered (but apparently not reflected in the identification of services in its applications) are related to registrant's product development and marketing services for small businesses. The specimens themselves, therefore, offer some evidence that a company which renders services related to registrant's consulting services also distributes a magazine and offers on-line and catalog sales services.

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While it is true that the Examining Attorney has not offered any specific evidence to show the relatedness of applicant's life science magazines and its on-line and catalog services rendered to life science laboratories to registrant's life science consulting services (and it is not clear to us where, in this ex parte context, such specific evidence could have been located), it is important not to diminish the importance of the respective identifications of goods and services in the applications and registrations. See, for example, *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002), where the Court criticized the Board for failing to give appropriate weight to those identifications:

Because [opposer] did not present evidence of relatedness beyond the descriptions in the application and registration, the Board refused to find the goods and services sufficiently related. While additional evidence, such as whether a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis, the Board did not consider the important evidence already before it, namely the ITU application and [opposer's] registrations. Because it must consider each DuPont factor for which it has evidence of record, the Board erred when it declined to compare the services described in [applicant's] application with the goods and services described in [opposer's] registrations. [Citation omitted.]

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Considering these identifications of goods and services and the possible common customers of applicant and registrant, we believe that confusion is likely if registrant's services and applicant's goods and services are offered under the respective marks. For example, a small biotech company or a small testing lab which analyzes body fluids such as blood and which uses goods shown in applicant's VMR BIOMARKE magazine or acquired through applicant's VMR BIOMARKE on-line or catalog services, which then should need registrant's BIOMARK product development or marketing services for its own products may well believe that registrant's BIOMARK services emanate from or are licensed or sponsored by the same source that distributes applicant's magazine or offers applicant's on-line or catalog services. Also, a small manufacturer of animal feed which used registrant's BIOMARK consulting services and which then needs equipment for its lab and sees it in applicant's VMR BIOMARKE magazine or orders it on-line or by catalog from applicant may believe that these goods and services all come from the same source. And, even if those small business purchasers are considered more knowledgeable or careful in their purchasing decisions than the ordinary consumer, nevertheless they are not immune to confusion, as the Examining Attorney has pointed out. *See In re Total*

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*Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999) ("We recognize applicant's attorney's point that its software is expensive and that purchasers of it are likely to be sophisticated.. In any event, even careful purchasers are not immune from source confusion"). Confusion is likely since both sets of marks prominently include the term BIOMARK or BIOMARKE and, in one mark of both applicant and registrant, there is the additional phrase making reference to "Life Science(s)." Moreover, applicant's magazine is apparently distributed free of charge and some of the goods obtained from applicant's on-line or catalog service are relatively inexpensive (beakers, biohazard bags, gloves, safety glasses, timers, tubes, wash bottles, etc.). Therefore, even though the goods and services are specifically different, small business purchasers may nevertheless, in view of the similarities of the marks, believe that they all emanate from or are sponsored or endorsed by the same entity. See *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000)("[A]lthough the services are different, it is reasonable to believe that the general public would likely assume that the origin of the services are the same."); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)("[E]ven if the goods in

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question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." ).

Moreover, if there were any doubt about likelihood of confusion in this case, we would, in accordance with precedent, resolve such doubt in favor of registrant and against applicant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals of registration are affirmed.<sup>5</sup>

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<sup>5</sup> We believe the dissent's analysis of the scope of registrant's identifications of services is subject to the same criticism as the Court leveled at the Board in *Hewlett-Packard*, *supra*. Registrant's identifications should be broadly construed. That is, we must presume that the scope of the services in the registrations encompasses not only all services of the nature and type described, but that the identified services move in all channels of trade which would be normal for those services, and that they would be purchased by all potential buyers of those services. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). The dissent maintains that "registrant's customers cannot be considered to be any small company that deals with any aspect of life science." However, we believe that registrant's identification of services ("consulting services in the field of life sciences; namely, developing strategic plans, strategic product development and marketing for small life science businesses, such as livestock breeders and manufacturers of animal foods") should be construed to include those consulting services rendered to any small business in the life science field. Moreover, contrary to the dissent's suggestion that confusion is being found because "a common term can be found to generally describe the goods and/or services... or in this case the field for the goods and services" (i.e., "life sciences"), here both applicant's goods and services and registrant's services are specifically stated to

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Seeherman, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority's finding that the refusal of registration should be affirmed.

First, I do not believe that the Office has established that applicant's goods and services are sufficiently related to the registrant's services such that confusion is likely to result from the use of the respective marks. As the majority acknowledges, footnote 3, the third-party registrations submitted by the Examining Attorney for goods and services in completely different fields have little or no bearing on purchaser perception in this case. Thus, the majority has turned to the specimens in the application, and the identifications of goods and services.

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be offered in the life sciences field. This is not a term of our coinage. More importantly, the identifications of goods and services, when properly construed, demonstrate that applicant's goods and services and registrant's services could be offered to some of the same small businesses in the life science field. Further, contrary to the *EDS* case (*Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992)), relied upon by the dissent, which involved large corporate customers or "purchasing institutions" with different, specialized and independent corporate purchasing departments, such considerations are not likely to exist in the context of small business purchasers, which are unlikely to have different purchasing departments. Finally, we see no basis for the dissent's conclusion that the registered mark BIOMARK is suggestive. Of course, while the prefix "BIO" may be suggestive of goods or services in the field of life science or "bioscience," generally, suggestive marks are those that suggest something about the goods or services with which the marks are used. For example, the hypothetical mark BIOTEST might suggest that the goods with which the mark is used are designed to test a biological substance such as blood or tissue. Here, however, there is no such suggestion in the registered mark BIOMARK for consulting services rendered to small businesses in the field of life sciences.

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With respect to the specimens, the majority has pointed to language in applicant's magazine that applicant helps customers with procurement, inventory management, equipment maintenance and other needs. To the extent that these activities can even be considered a separate service under trademark law, this service is not the subject of the subject applications. Nor is this "service" clearly related, as the majority states, to the "strategic product development and marketing" services identified in the cited registrations. Even assuming, however, that these impediments did not exist, and accepting, arguendo, that applicant's identified goods and services are related to its so-called "Managed Services," and its "Managed Services" are related to the registrant's identified product development and marketing services, this does not show that applicant's identified goods and services are related to the registrant's identified services. Although, in the language of geometry, if  $A=B$  and  $B=C$ , then  $A=C$ , the same principle does not obtain if the elements are not equal. Thus, even if A is related to B, and B is related to C, this does not mean that A is related to C. Moreover, applicant's "Managed Services" have not even been shown to be related to applicant's magazine; the fact that applicant itself uses its marks for a magazine and also offers its

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"Managed Services" does not establish that this item and the services of inventory management, equipment maintenance needs, etc. are related.

As for the identification of services, I agree with the majority that the registrant's identification of developing strategic plans, strategic product development and marketing for small life science businesses, such as livestock breeders and manufacturers of animal foods, does not limit the registrant's customers to livestock breeders and manufacturers of animal foods. However, the fact that these businesses are listed in the identification cannot be ignored; the listing clearly indicates the type of customers to which the registrant's services are directed. As a result, I think that the registrant's customers cannot be considered to be any small company that deals with any aspect of life science, including, as the majority asserts, medical labs that analyze tissue and blood, and small environmental businesses or labs. Thus, I do not think it evident, on the record before us, that the customers for applicant's services and registrant's services would be the same.

However, even assuming that the registrant's customers could have laboratory operations as part of their businesses, such that they would have a need to purchase

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products such as test tubes by utilizing applicant's on-line store and catalog sale services, I do not find a basis for concluding that there is an opportunity for confusion. The mere fact that the same company may purchase laboratory products from an on-line store or a catalog and may retain consulting services to develop strategic plans, etc., does not mean that the relevant persons within that company will be exposed to the marks under which these services are offered. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992) ("it is error to deny registration simply because 'applicant sells some of its goods in some of the *same fields* in which opposer provides its services,' without determining who are the 'relevant persons' within each corporate customer," internal citation omitted.)

There is no evidence that the persons in a life science business who would be involved in obtaining consulting services in the nature of developing strategic plans and product development and marketing would also be ordering laboratory products such as test tubes from an on-line service or a catalog.

Further, it must be remembered that applicant has applied to register its marks for a service (on-line store and catalog sale services featuring products for use in

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life science laboratories), not for laboratory products themselves. This service is a step removed from the products, and applicant's sales services would include the sale of various companies' goods. It is not clear to me why someone ordering equipment from an on-line service or catalog would assume that a company which offers this kind of sales service would also offer consulting services as identified in the cited registrations, even if there were some similarities in the marks. Certainly there is no evidence that businesses which offer on-line and catalog sales services also do consulting.

As for the applicant's magazines, even assuming that there is an overlap in relevant customers, and that the professionals to whom the magazines are directed would also be involved in obtaining the registrant's consulting services, I do not see why a professional who reads applicant's magazine and sees goods advertised or featured in it, and even orders such goods from the on-line store or catalog which is the same source as the magazine, would assume that there is a connection between the source of the magazine and the source of the consulting service identified in the cited registrations.

It appears to me that the only basis for considering applicant's goods and services related to the registrant's

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services is that they are all in the field of life science. However, the cases are legion that simply because a common term can be found to generally describe the goods and/or services, or in this case the field for the goods and services, is not a sufficient basis for finding that goods and services are related. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, supra; *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co. Ltd.*, 188 USPQ 517 (TTAB 1975); *In re Cotter and Company*, 179 USPQ 828 (TTAB 1973).

The majority has cited *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000), (which involved the question of whether FIDO LAY for dog treats was likely to cause confusion with FRITO LAY for snack foods) for the statement that even if the goods in question are different from one another in kind, they can be related in the mind of the consuming public as to the origin of the goods. However, there was evidence in that case that several large companies produce and sell both pet and human food, evidence that the Court of Appeals for the Federal Circuit found was extremely pertinent to the question of the relatedness of the goods. There was also evidence of Recot's co-merchandising scheme in which FRITO-LAY-branded products were sold with images of puppies on product bags

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and display racks. In the present case, there is no analogous evidence, for example, evidence that companies offer the same goods and services as those identified in the applications and cited registrations.

The second case cited by the majority on this point, *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000), is also distinguishable. In particular, in that case, there was evidence that Internet connection services and Internet content publications were available from a single source.

The majority makes the point that, in an ex parte context, it would have been difficult for the Examining Attorney to have found specific evidence to show the relatedness of applicant's identified goods and services and the registrant's services. Although this Board and our principal reviewing court have recognized the limited facilities of the U.S. Patent and Trademark Office to acquire evidence, it is still the burden of the Office to establish likelihood of confusion. We cannot substitute speculation and assumptions for such evidence.

I also disagree with the majority on the degree of weight to be accorded the sophistication of the consumers for the involved goods and services. The majority points out that some of the goods obtained from applicant's on-

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line or catalog services are relatively inexpensive. However, it is applicant's on-line and catalog sales services that are at issue, not the individual items sold through this service. A customer requiring laboratory products for his business would presumably require prompt service in shipping the products, a sufficient inventory on the part of the supplier, etc., and would exercise care in choosing that supplier. Similarly, even if applicant's magazine is distributed free of charge, the magazine is, as shown by the identification, used by professionals. Such consumers are more knowledgeable and careful than the general public. And clearly a company hiring consulting services would also exercise care and discrimination.

Although even careful purchasers are not necessarily immune from source confusion, in this case the differences in the marks will be noted by purchasers, as a result of which confusion is not likely. The majority, of course, has focused on the similarity of the marks, and particularly on the similarities between the BIOMARK/BIOMARKE portions. However, I do not believe it has given sufficient weight to the presence of the letters VWR in applicant's mark. These letters appear first in the mark, and are visually set off from the rest of the mark. In the special form drawing, VWR is depicted in all capital

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letters, and therefore appears in a larger size than the other words. It also appears on a clear background, which makes it stand out. Even in the typed drawing, VWR is separated from the second element BIOMARKE. The majority has observed that letters may be more difficult to remember than other parts of a mark. However, the case cited by the majority in support of this view involved two marks consisting of a series of arbitrarily arranged letters, TMM v. TMS. In the present case, of course, the letters appear only in applicant's mark and, for the reasons I have indicated, are a distinguishing feature.

Further, BIOMARK has a suggestive significance, such that the cited registrations are not entitled to a broad scope of protection. "Bio" has an obvious meaning when used in connection with services dealing with the life science field. As the dictionary definition quoted in the majority opinion shows, "life science" is also called "bioscience." The element "mark," as used in the cited marks, has the connotation of "trademark." Thus, consumers are not likely to assume that all marks containing the element "biomark," (or, in the case of applicant's marks, "biomarke") which are used in connection with any goods or services in the life science field, indicate a single source. In saying this, I recognize that in applicant's

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marks the term is spelled with an additional letter "E"—BIOMARKE. To the extent that consumers note this additional letter, and ascribe a different connotation to it, this only serves as a further distinguishing feature of applicant's marks.

The majority makes the point that consumers may think that the letters VWR in applicant's marks represent a subsidiary or licensee of registrant which is authorized to use the registered mark in connection with magazines and on-line and catalog services. I am not aware that it is a general practice of trademark owners to allow their marks to be used as a subsidiary mark with a licensee's house mark;<sup>6</sup> certainly there is no evidence that this is the case in the life science field. As a result, I do not believe that the consumers for the applicant's and registrant's goods and services would assume a licensee relationship between the two companies. Rather, I believe that consumers would recognize, because of the presence of VWR in applicant's marks, that these marks identify the source of applicant's identified goods and services as separate from the source of the registrant's services.

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<sup>6</sup> Although applicant's name is Scientific Holdings, Inc. and not VWR, for purposes of this discussion I accept the majority's characterization of VWR as applicant's apparent house mark.

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As a minor point, although I do not believe that the additional phrase THE MARKET SOURCE FOR LIFE SCIENCES in one of applicant's marks and the phrase CONSULTING FOR THE LIFE SCIENCES in one of the registrant's marks would be sufficient to distinguish the marks, nonetheless I do not agree with the majority that these phrases, with their common use of the term LIFE SCIENCE/LIFE SCIENCES, adds to the similarity of the marks. See *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (Overall, BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not confusingly similar).

In conclusion, I think that this record does not support a finding of likelihood of confusion. Therefore, I would reverse the refusal of registration with respect to both applications.