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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Caliper Life Sciences, Inc.

Serial No. 78403120

Donald R. McKenna, Esq. of Caliper Life Sciences, Inc.

D. Beryl Gardner, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Hairston, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Caliper Life Sciences, Inc. has filed an application to register the standard character mark SCICLONE on the Principal Register for "automatic laboratory equipment, namely, a robotic workstation for transferring, dispensing and diluting liquids in drug screening applications," in International Class 9.[1]

[1] Serial No. 78403120, filed April 16, 2004, based on use of the mark in commerce, alleging first use and use in commerce as of November 1, 1996.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark CYCLONE previously registered for "laboratory instruments, namely, automated sorting devices for liquid-entrained[2] substances," in International Class 9,[3] that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201

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[2] We take judicial notice of the definition of "entrain" in *The American Heritage® Dictionary of the English Language* (4th ed. 2000) as "To pull or draw along after itself. *Chemistry.* To carry (suspended particles, for example) along in a current."

(Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The examining attorney contends that confusion is likely because the marks are phonetically identical and the cited mark is an arbitrary term for the identified goods and, thus, it is not weak. The examining attorney contends that the goods are "closely related because they are automated laboratory devices that sort liquids" (brief, unnumbered p. 8); and that "although the expense of the goods and the complexity of their function may yield a particular class of consumers, the consumers' knowledge in the dedicated function does not necessarily mean that they are immune from source confusion" (*id.*, unnumbered p. 5). While applicant's

[3] Registration No. 2113797 issued November 18, 1997, and owned by Dakocytomation Colorado, Inc. [Section 8 (six-year) and 15 affidavits accepted and acknowledged, respectively.]

product is limited in function to "drug screening applications," the examining attorney argues that "registrant has not limited the function of its goods and thus the registrant's goods may serve the same narrow function as the applicant's goods" (*Id.*, unnumbered p. 7). In support of her position that the goods are related, the examining attorney submitted copies of ten third-party registrations.

In arguing against a finding of likelihood of confusion, applicant contends that the goods are different; that, while both products may involve sorting liquid substances, applicant's products are limited in use to drug-screening applications; that the respective products are very expensive,[4] with applicant's product costing approximately $100,000 to $200,000; and that the products are purchased with great care by highly sophisticated laboratory personnel, biotechnical engineers in applicant's case, who are "well aware of what they purchase and generally purchase products based upon their function." (Response, p. 2, received May 18, 2005.)

[4] With its brief, applicant submitted a copy of its price list. The record must be complete prior to appeal and normally such a submission would not be considered. However, we have considered this price list to be part of the record. The examining attorney did not object and, in fact, referred to the amounts listed therein in the brief. Additionally, the price list merely supports applicant's statement, made during examination and not

Applicant describes its business in the following statement in its brief (p. 5):

> Applicant ... is in the business of combining microfluidics, liquid handling and laboratory automation principally for today's drug discovery and development industry and genomics and proteomics laboratories.

During examination, applicant submitted a copy of its brochure, which includes the following statements:

> The Sciclone workstation gives any lab a broad range of highly accurate and precise liquid handling functions in a versatile, open-design format that adapts to almost any protocol. Each Sciclone workstation is configured with your choice of liquid handling functionality and on-deck accessories, and is field-reconfigurable to adapt as your research progresses.
>
> . . .
>
> No other liquid handler can match the Sciclone for precision and flexibility in pipetting across 96.384 and 1536 microplate formats.
>
> . . .
>
> The Sciclone ALH 3000, your first step to fully integrated lab automation and enhanced productivity.
>
> The following is just a sampling of the many different applications that are being automated today on Sciclone workstations and Sciclone-based systems in labs throughout the world today:
>
> - Drug Screening Applications
> - Genomic applications
> - Proteomic Applications

Applicant admits that the marks are phonetically identical, but argues that they are visually different

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disputed by the examining attorney, that its products are very expensive. In this sense, it is not entirely new information.

and, when considered in connection with the respective goods, each has a different connotation. Applicant also contends that "the marks are somewhat weak in that each play[s] upon the fact that [it] deal[s] with areas of science in which biological species are manipulated." (*Id.*) In this regard, applicant states the following (brief, p. 5):

> [E]ach mark ends with the suffix "clone," which would be recognized as having the described genetic engineering relationship. Applicant's mark is the joining of the suffix "clone" with the prefix "sci" connoting science or scientific. By comparison, "CYCLONE" connotes "any of various devices using centrifugal force to separate materials." Dictionary.com.[5]

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective

[5] While we do not ordinarily take judicial notice of dictionary definitions submitted in the brief that are from Internet websites, we take judicial notice of the fact that this definition is the same as the definition found in *The American Heritage® Dictionary of the English Language* (4th ed. 2000), which exists in print format.

marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant has admitted that the marks are phonetically identical. We are not convinced by applicant's contention that the marks have different connotations. While one connotation of applicant's mark to relevant purchasers may be "scientific cloning," it is equally likely that the connotation to these purchasers will be the term "cyclone," which is its phonetic equivalent and which has an equally relevant meaning in relation to applicant's goods. The marks differ visually only in their first several letters, as both of them end in the letters "clone." It is true that the commercial impressions of the two marks are not the same, we find that, overall, the commercial impressions of these two marks are similar and, thus, this *du Pont* factor weighs against applicant.

Turning to consider the goods or services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's

application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

The only evidence submitted by the examining attorney regarding the goods is ten third-party registrations and these registrations are of limited probative value. We note that seven of these

registrations are owned by three parties; one of the registrations is owned by the cited registrant; and one of the registrations is not based on use in commerce. These registrations do not show, as argued by the examining attorney, that a number of different entities offer the goods involved in this case under the same mark. Further, each of the third-party registrations includes in its identification of goods a wide range of laboratory equipment, some including devices that dispense and dilute liquids, as does applicant's product. None of the registrations included devices that specifically "sort" liquids, as does registrant's product. Although several of the registrations include devices that "mixed," measured," or "extracted" liquids or matter from liquids, there is insufficient evidence from which to draw a conclusion that these devices are the same as, or similar to, the product in the cited registration. Therefore, we find that the examining attorney has not adequately established a sufficient relationship between the goods for this *du Pont* factor to weigh against applicant in our analysis.

We find the *du Pont* factors of channels of trade and class of purchasers to be of particular significance in determining the issue of likelihood of confusion herein. It is clear that applicant's product

is a very expensive and technically sophisticated device that will be used by equally sophisticated scientists and purchased by, or at the behest of, these scientists only after very careful consideration. While we have no specific information about the cited registrant and the nature and use of its goods, such is not necessary in this ex parte proceeding. Based entirely on the identification of goods in the cited registration, it is clear that such goods are used in a scientific laboratory and it is likely that they are not inexpensive and are likely purchased by knowledgeable scientists after careful consideration. Thus, we find that these *du Pont* factors weigh heavily in applicant's favor.

Therefore, in view of the above analysis, despite the substantial similarity in the commercial impressions of applicant's mark, SCICLONE, and registrant's mark, CYCLONE, there is insufficient evidence regarding any relationship between the identified goods for us to conclude that the contemporaneous use of the identified marks, particularly in view of the expensive and highly technical nature of the goods and their careful purchase by or for knowledgeable scientists, is likely

to cause confusion as to the source or sponsorship of such goods.

In reaching our decision, we did not consider applicant's request that any existing doubt be resolved in applicant's favor. We note that precedent requires us to resolve any doubt against applicant. *See Century 21 Real Estate Corp. v. Century Life of America,* 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *Ava Enterprises Inc. v. Audio Boss USA Inc.,* 77 USPQ2d 1783 (TTAB 2006); *Baseball America Inc. v. Powerplay Sports Ltd.,* 71 USPQ2d 1844 (TTAB 2004). Similarly, regarding applicant's contention that it is aware of no actual confusion, we note that, while a factor to be considered, the absence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. *See, In re Kangaroos U.S.A.,* 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

Decision: The refusal under Section 2(d) of the Act is reversed.