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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Vaisala Oyj

Serial No. 78533852

D. Peter Hochberg of D. Peter Hochberg Co., L.P.A. for
Vaisala Oyj.

Michael Webster, Trademark Examining Attorney, Law Office
102 (Karen Strzyz, Managing Attorney).

Before Zervas, Walsh and Wellington, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Vaisala Oyj ("applicant") filed, on December 16, 2004,
an application to register on the Principal Register the
mark VAISALA METCAST for "meteorological measurement
apparatus, namely, electronic signal transmitters and
electronic signal receivers, computer hardware, computer
operational software programs, microprocessor based
automatic meteorological weather station and computer link
therefor, all for use in sending, receiving and

interpreting weather data information from and between meteorological and environmental observations systems" in International Class 9. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark METACAST (in standard character form) for "computer software for presenting meteorological information" in International Class 9; and "scientific and industrial products research and development; computer programming for others; rental of computer programs; licensing of intellectual property; meteorological forecasting; consultancy in the field of engineering" in International Class 42.¹

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is affirmed.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence

¹ Registration No. 2310174, issued January 25, 2000. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarity and dissimilarity of the marks. Our focus is on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Applicant's mark is a combination of the terms METCAST and VAISALA, and applicant maintains that VAISALA is its house mark. See p. 8, response to first Office action. Of course, there are significant similarities between the second term in applicant's mark, i.e., METCAST, and the only term in registrant's mark, i.e., METACAST. Except for the letter "A" in the middle of registrant's mark, the

terms are spelled identically. These terms are hence similar in sound and appearance.

On the question of meaning, the examining attorney maintains at p. 5 of his brief that METCAST and METACAST may be viewed as a combination of "meteorology" and "forecast," both of which have relevance in the context of applicant's and registrant's goods. "Met." is an abbreviation for, inter alia, "meteorological," "meteorology," and "metropolitan." See definition of "met." in *Webster's Third New International Dictionary Unabridged* (Merriam-Webster 2002). "Cast" is defined in the same dictionary as, inter alia, "a forecast or conjecture concerning future events or conditions." We take judicial notice of these definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The combination METCAST hence could be perceived by purchasers as meaning "meteorological forecast" or "metropolitan forecast."

There is no definition in the record or in *Webster's Third New International Dictionary* of "meta" as a word or an abbreviation. The examining attorney points out that both "met-" and "meta-", as prefixes, appear in an English language dictionary. "Met-" is identified in the *Merriam-*

Webster Online Dictionary entry made of record with applicant's request for reconsideration as a variant of meta-; and both hence are defined in relevant part as "1 a: occurring later than or in succession to: after ... [;] b: situated behind or beyond ... [;] c: later or more highly organized or specialized form of ... [;] 2: change : transformation ... [;] 3 ... more comprehensive: transcending." Thus, if MET and META are considered as prefixes, neither METCAST nor METACAST have any particular meaning in the context of applicant's and registrant's goods and services, even if CAST is defined as "forecast."

If purchasers view METCAST as a combination of "metropolitan" or "meteorological" or "meteorology" and the English word "cast," the question arises as to whether METCAST is a descriptive or highly suggestive term in connection with applicant's goods and services. This question is important in considering the registrability of applicant's VAISALA METCAST mark because there is a line of cases holding that the addition of other matter, such as a house mark, primary mark or other material, to one of two otherwise similar marks, will not necessarily be sufficient to distinguish the marks as a whole. See, generally, *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988); *In re Champion Oil Company*, 1 USPQ2d 1920

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(TTAB 1986); *In re Christian Dior, S.A.*, 225 USPQ 533 (TTAB 1985); *In re C. F. Hathaway Company*, 190 USPQ 343 (TTAB 1976). The additional matter has been found sufficient to distinguish the marks under circumstances where the appropriated matter is highly suggestive or merely descriptive or has been frequently used or registered by others in the field for the same or related goods or services. See, e.g., *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS for ladies' sportswear not confusingly similar to ESSENTIALS for women's clothing because ESSENTIALS is a highly suggestive term for articles of clothing); *In re Merchandising Motivation, Inc.*, 184 USPQ 364 (TTAB 1974) (MEN'S WEAR for a semi-monthly magazine not confusingly similar to MMI MENSWEAR for fashion consulting for men because "MENSWEAR" is merely descriptive of such services).

On the record before us, we do not find METCAST to be merely descriptive or even highly descriptive of applicant's goods. There is no evidence regarding use of the term by purchasers in the meteorological field or that the term would have any significance to purchasers. Applicant has not argued that the term is descriptive or highly suggestive. Also, applicant has submitted many

registrations with its request for reconsideration for marks similar in construction to applicant's mark such as KITECAST, SKICAST, DRIVECAST, CLIMATECAST and WAVECAST for weather-related goods and services, and these registrations are on the Principal Register. We therefore find that applicant may not avail itself of cases such as *Knight Textile, supra*.

Also, to the extent that METCAST and METACAST have any meaning to purchasers, we find that their meaning is similar.

As for the commercial impression of METCAST and METACAST, as noted earlier, the examining attorney points out that both "met-" and "meta-", as prefixes, appear in an English language dictionary; and that "met-" is a variant of "meta-." Because "met-" as a prefix is a variant of "meta-" and does not impart a different meaning to registrant's mark, we find that purchasers will not give the "A" much weight and will find the commercial impressions of the marks are the same.

Applicant has argued at p. 10 of its brief that "the words MET, META and CAST are in widespread use alone or in combination with other words and/or design elements (or with each other) for a high number of marks ... which cover various goods and services in the meteorology industry.

This common use of 'MET,' 'META' and 'CAST' reduces the likelihood of confusion with other marks employing those terms." In this regard, applicant cites "at least eighty-five different registrations" for marks containing MET and/or CAST which cover various goods and services in the meteorology industry" and which were made of record with applicant's request for reconsideration.

The Board has held in the past that "[e]vidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field." *In re Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996).

The problem with applicant's evidence and hence its argument is that third-party registrations, by themselves, are not entitled to much weight in determining whether confusion is likely. *See In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace or that the public is so familiar with the use of such marks that the other elements are emphasized in order to allow purchasers to distinguish among such marks. *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB

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1975). Also, only two registrations include both MET and CAST as part of the marks. These two registrations (Registration Nos. 2525133 and 2770005) both contain the term METROCAST, which has a different connotation than either applicant's or registrant's marks due to their inclusion of the English word METRO. Applicant's argument is thus not supported by substantial evidence and is not persuasive. Moreover, if applicant's mark should be treated as a relatively weak mark, we note that even weak marks registered on the Principal Register are entitled to the statutory presumptions of Section 7(b) of the Act, and hence should be protected against the registration by a subsequent user of a highly similar mark for closely related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Much of the foregoing discussion has involved the second term in applicant's mark. Applicant's mark also contains the initial term VAISALA, which is applicant's house mark, part of applicant's corporate name and the subject of Registration No. 1124655, a copy of which applicant submitted with its request for reconsideration.

It has frequently been held that the addition of a trade name or house mark or other such matter to one of two otherwise similar marks will not serve to avoid a

likelihood of confusion. See *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d at 1632; *Envirotech Corp. v. National Service Industries, Inc.*, 197 USPQ 292 (TTAB 1977). Indeed, it has been held in this regard that "[w]here the marks are otherwise virtually the same, the addition of a house mark or ... a surname ... is more likely to add to the likelihood of confusion than to aid to distinguish the mark" at issue. *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168, 170 (TTAB 1982). Because VAISALA is applicant's house mark, its addition to METCAST, a term which has not been shown to be descriptive or highly suggestive, does not serve to avoid a likelihood of confusion.

In view of the foregoing, we find that the marks, when considered as a whole, are similar in appearance, meaning, sound and commercial impression, and we resolve the *du Pont* factor regarding the similarity of the marks against applicant.

We next consider the similarity and dissimilarity of applicant's and registrant's goods, and applicant's goods and registrant's services. It is well settled that goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services 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 or are in some way associated with the same producer or that there is an association between the producers of the goods or services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Both applicant and registrant's goods are in the meteorological field, and both applicant and registrant list computer software in their identifications of goods. Applicant's apparatus takes meteorological measurements and registrant's software presents the meteorological information. The goods are complimentary in that one is used to obtain information and the other is used to present the same information. The same individual or entity would likely use both goods. Also, in view of the similarity between the marks, those purchasers of applicant's goods who require replacement software or even software in the nature of upgrades for their meteorological measurement apparatus would likely consider applicant as the source of registrant's software in that registrant also provides

software in the meteorological field. Applicant's goods also are related to registrant's services in that registrant's services include "meteorological forecasting," and applicant's goods would be used - by the same individual or entity - in such forecasting. For the foregoing reasons, we find that applicant's and registrant's goods, and applicant's goods and registrant's services, are related and resolve the *du Pont* factor regarding the similarity of the goods and services against applicant.

With respect to the similarity or dissimilarity of trade channels, the identifications of goods and the identification of services do not contain trade channel limitations within the meteorological field. Because our determination of the issue of likelihood of confusion between the applied-for and registered marks must be made on the basis of the goods and services as they are identified in the involved application and registration, and because there are no trade channel limitations in the identifications, we presume that the registration encompasses all goods and services of the nature and type described, and that the identified goods and services move in all channels of trade that would be normal for such goods and services, and that they are available to all

classes of purchasers for the described goods and services. *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Thus, because the same user may use applicant's goods to first obtain meteorological information and then registrant's goods to present that information, and because registrant's meteorological forecasting services are without limitation, we conclude that the trade channels for applicant's goods and registrant's goods and services overlap.

We next consider the conditions under which and buyers to whom sales are made. Applicant maintains that applicant's and registrant's goods are "high-end and expensive meteorological measurement apparatus" whose "consumers are typically sophisticated and savvy" and "who would be quite familiar with the Appellant's house mark and trade name VAISALA, as well as the cited mark METACAST." Brief at p. 12. Applicant further contends that a reasonably prudent purchaser in the meteorology industry would not buy such goods casually, but rather only after careful consideration. Applicant also argues that purchasers of such goods would "undoubtedly be familiar with the Appellant's house mark VAISALA and that the

standard should be elevated to a discriminating purchaser standard due to the nature of the goods.”² Brief at p. 14.

There is no evidence in the record regarding the cost of applicant's goods. Thus, we are unable to gage just how “expensive” applicant's goods are or just how discriminating applicant's purchasers are. Also, even if we accept applicant's attorney's arguments as true, we find that the similarity of the marks and goods outweighs any purchaser sophistication. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Moreover, the fact that purchasers are sophisticated in a particular field does not necessarily mean that they are knowledgeable in the field of trademarks or immune from source confusion. *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); *In re Hester Industries, Inc.*, 231 USPQ 881 (TTAB 1986) (“While we do not doubt that these institutional purchasing agents are for the most part sophisticated buyers, even sophisticated purchasers are not immune from confusion as to source where, as here,

² The evidence of record does not support applicant's assertion that VAISALA is a “strong and well-known” mark. If true, however, the renown of VAISALA would foster the likelihood of reverse confusion. The Federal Circuit, our primary reviewing court, has recognized that reverse confusion is also prohibited by Section 2(d). See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

substantially identical marks are applied to related products").

The *du Pont* factor regarding the conditions under which and buyers to whom sales are made is neutral.

We have also considered applicant's additional arguments in support of registration of its mark, but have not found them to be persuasive. The additional *du Pont* factors referred to in applicant's summary in its brief and not specifically discussed in our decision do not persuade us that there is no likelihood of confusion between applicant's and registrant's marks.

In conclusion, because of the similarity in the marks and the goods and services, as well as the similarity in the trade channels, and because we are not persuaded that confusion is not likely in view of any purchaser sophistication, we find that purchasers familiar with registrant's goods and services offered under the mark METACAST would be likely to believe, upon encountering applicant's mark VAISALA METCAST for the goods recited in its application that they originate with or are somehow associated with the same entity.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.