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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Hearing:
June 19, 2001

Paper No. 19
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Newport Electronics, Inc.

v.

Newport Scientific Pty. Ltd.

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Opposition No. 115,002
to application Serial No. 75/299,671
filed on May 28, 1997

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Robert Curcio of Delio & Peterson, LLC for
Newport Electronics, Inc.

Jeffrey D. Shewchuk of Kinney & Lange, P.A.
for Newport Scientific Pty. Ltd.

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Before Quinn, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Newport Scientific Pty. Ltd has filed an application to register the mark NEWPORT SCIENTIFIC and design, as shown below, for "food analysers for assessing and determining viscosity properties of foodstuffs, including milk and dairy products, cereals, grains, and derivative

products thereof such as cooked starch, bread, and flour."[1]

Newport Electronics, Inc. has filed an opposition to registration of the mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In the notice of opposition, opposer alleges the manufacture, distribution and sale by it of a wide variety of equipment for industrial applications including analyzers and flowmeters since 1968; the use of the mark NEWPORT for its products since 1968; the ownership of several registrations for the mark NEWPORT for industrial and scientific equipment including analyzers and flowmeters;[2] and the likelihood of confusion

[1] Serial No. 75/299,671, filed May 28, 1997, claiming a first use date of February 24, 1986 and a first use in foreign commerce between the United States and Australia date of March 11, 1987. A disclaimer has been made of the word SCIENTIFIC.

[2] Opposer alleges ownership of Registration Nos. 1,656,111; 1,794,794; 2,263,919; 2,106,737 and Application Serial No. 75/387,724 (later issued as Registration No. 2,337,118). These registrations in their entireties cover the mark NEWPORT for a wide variety of industrial and scientific equipment. We note the following portions of certain of these registrations:

> Registration No. 1,794,794, issued September 28, 1993, for "meters and multimeters; namely, temperature meters

with applicant's use of the mark NEWPORT SCIENTIFIC in connection with its analyzers for industrial applications, namely analyzing the viscous properties of foodstuffs.

Applicant, in its answer, denied the majority of the allegations in the notice of opposition, although admitting opposer's ownership of the pleaded registrations.

The Record

The record consists of the pleadings; the file of the involved application; opposer's testimony deposition, and accompanying exhibits, of Michael Buskirk, opposer's

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... pressure meters... flow meters";
Registration No. 2,263,919, issued July 27, 1999, for "industrial and scientific equipment for measuring, controlling, and/or regulating temperature, humidity, pressure, strain, force, flow, level, pH, ... and acquisition, display and retrieval of data regarding temperature, humidity, pressure, strain, force, flow, level, pH...namely, analyzers, namely, signal analyzers, voltage analyzers, process loop analyzers; ... flowmeters, namely, conductive fluid flowmeters, DC pulse style flowmeters, electromagnetic flowmeters, analog input flowmeters, high viscosity flowmeters, vortex flowmeters, magnetic flowmeters, liquid flowmeter, high pressure flowmeter, mechanical flowmeter, paddlewheel flowmeter, position displacement flowmeters";
Registration No. 2,106,737, issued October 21, 1997, for "catalogs, technical and scientific handbooks, textbooks, and technical reference textbooks about measuring, controlling and/or regulating temperature, humidity, pressure, strain, force, flow, level ... and acquisition, display and retrieval of data regarding temperature, humidity, pressure, strain, force, flow, level ... ."

Marketing Project Manager; copies of six registrations owned by opposer[3] and certain printed publications made of record by opposer's notice of reliance; applicant's testimony depositions, and accompanying exhibits, of Dick T. Metzger, Product Manager of Foss North America and Rodney Booth, Managing Director of applicant; copies of third-party registrations and web pages made of record by applicant's notice of reliance;[4] and opposer's rebuttal evidence of copies of official records introduced by means of a notice of reliance. Both parties have filed briefs and both participated in an oral hearing of the case.

Opposer was incorporated in 1965 and began using its NEWPORT mark in the 1960's. Opposer's business is signal conditioning and electronic instrumentation, with its main manufacture being digital instrumentation. Opposer

[3] Only three of these registrations are pleaded registrations. Copies were not made of record of either Registration Nos. 1,794,794 or newly issued 2,337,118. Copies were made of two registrations in which the mark covered is not NEWPORT in typed drawing form but rather N NEWPORT in a design format. Moreover, although opposer describes the copies made of record as being "status" copies, these are not status and title copies of the registrations as are prepared and issued by the Office. They are merely photocopies of the registrations or printouts obtained from the Office search system, which fail to show the current status and title of the registrations.

[4] Although applicant has not followed the proper procedure in making these web pages of record, see Raccioppi v. Apogee, Inc.,

sells its products to process industries in general, including the oil industry, the food processing industry, the chemical processing industry, the pharmaceutical industry, and others. Specific longstanding customers of opposer in the food processing industry to whom opposer has been selling goods since prior to 1986 include Ralston Purina, Miller Brewing, and Quaker Oats. The types of products sold to the food processing industry include temperature measurement products, flow and pressure measurement products, and calorimeters for pH measurement. Opposer manufactures products which have been used to control viscosity, such as its temperature and pressure products. Specifically, some printing customers control the viscosity of their ink by controlling the temperature and flow of the product.

Opposer has promoted its mark and products in the food processing industry by advertisements in trade journals, press releases and through trade shows. Opposer has been listed in equipment directories directed to the food processing industry since prior to 1986. Opposer sells its products to the food processing industry either directly, through authorized distributors, or through trade shows and has done so

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47 USPQ2d 1368 (TTAB 1998), opposer has not objected thereto.

since prior to 1986. By the introduction of annual reports from 1972-1989 opposer has demonstrated that opposer has produced instruments for the measurement of flow since at least 1972. In the 1979 report (Exhibit 5) the following description is given of opposer's products:

> Newport digital panel meters are used to measure and display electrical signals related to physical parameters such as temperature, pressure flow, speed and weight. Such parameters are measured by sensors that convert stimuli from physical phenomena to electrical signals.

Use of opposer's NEWPORT mark on instruments of this nature since at least 1972 has also been demonstrated.

Opposer has been selling products to the food processing industry, in particular instruments to measure flow, since at least 1972. One type of flow measurement instrument presently being sold is the paddlewheel flow sensor which is ideal for solutions having low viscosity and low suspended solid content. (Exhibit 23). These flow sensors sell for $200-$225. In general, opposer has more than 50 customers, and probably over 100, in the food processing industry.

Applicant was incorporated in 1985 in Australia for the purpose of developing a device to test for weather damage to wheat. The outcome of this project was

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Accordingly, the web pages are considered of record.

applicant's product, the Rapid Visco Analyser, prototypes of which were introduced to the market in 1985-1986 and first sold commercially in 1987. The basic concept of this instrument revolves around cooking a sample of ground wheat in water and measuring the viscosity of the resulting paste. Although originally developed to measure the activity of alpha-amylase in weather damaged wheat, uses of the instrument have expanded to measure the viscous properties of the starch that comprises the sample by means of the cooking process and has been applied to all grains containing starch or manufactured or modified starches, all of which is highly useful to the food industry. In operation, the sample in slurry form, is stirred with a paddle and the torque required to keep the paddle at a constant speed while the sample is heated and/or cooled is recorded. The torque is then equated to a number in centipoise which is a universal number used to indicate viscosity measurements. The instrument is used, inter alia, by grain traders, flour millers, bread, cake and biscuit bakers, starch refiners, plant breeders, seed companies, pet, snack and breakfast food extruders, breweries and maltsters. (Applicant's Exhibit 3).

In 1988 Foss Food Technology, later known as Foss North America (Foss), became applicant's exclusive distributor in the United States. Since that time applicant, through Foss, has sold about 300 units in the United States. There are various models, ranging in price from around $34,000 to $14,000. Sales are advanced by means of the Foss sales force, by advertisements in certain magazines such as Cereal Foods World and by participation in trade shows. A sale is typically made after direct contact of a Foss regional sales manager with someone in the food industry and following considerable interchange, and perhaps a demonstration of the product. The same type of selling process is used by applicant's two main competitors. Applicant's products are not available through retail locations or over the Internet. In general, purchasers of applicant's product are persons in corporations in research and development positions who typically have advanced technical degrees and very experienced work backgrounds. Another group of customers are academic scientists in universities or organizations who use the instrument for developing new genetic material or applications for cereal crops. In most instances, the sale involves a multi-person decision

making process. Most installations are performed by Foss employees.

Applicant's witness Mr. Booth named four other "Newport" companies in the instrumentation field, namely, Newport Corporation, a supplier of optical equipment and instrumentation; Newport Components, a supplier of electrical equipment; Newport Glass, a supplier of special optical glass blanks; and a Newport Scientific company from Jessup, Maryland, a supplier of high-pressure pumps and hygrometers and hygrometric controls and recorders.

Applicant's witness Dick Metzger defined "viscosity" as
"the resistance to the flow of a liquid." (Deposition p.75). While he agreed that "flow" might be considered a parameter in the measurement of velocity, he was not aware of any flowmeter which could be used to measure viscosity. Mr. Booth described "flow measurements" as being used to "ascertain the quantity of fluid passing through a pipe," whereas the "viscosity" is a property of the liquid itself and the term "viscous properties" is used to describe "the performance of a material under different changes of temperature and shear rate." (Deposition p.77-78).

The Opposition

Considering first the issue of priority, we note that, as previously pointed out, the copies of its registrations which opposer has made of record by means of its notice of reliance do not qualify as status and title copies of the registrations. Although applicant has admitted in its answer that opposer is the owner of the registrations pleaded in the notice of opposition, applicant has made no admission as to the status of these registrations. Thus, the issue of priority cannot be determined on the basis of opposer's ownership of valid and subsisting registrations. Cf. King Candy Co., Inc., v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Nonetheless, we find the evidence of record sufficient to establish that opposer has marketed digital panel instrumentation under its NEWPORT mark, particular instruments for flow measurement, since at least 1972. Applicant has neither shown nor claimed use earlier than at least 1986. Opposer has clearly established priority and applicant has made no arguments to the contrary.

Turning to the issue of likelihood of confusion, we take under consideration all of the *du Pont* factors which

are relevant under the present circumstances and for which there is evidence of record. See E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We look first to the marks of the parties and the similarity or dissimilarity thereof. Opposer's mark as pleaded is the typed mark NEWPORT. Opposer has also made registrations of record in which the mark is N NEWPORT in the following design format:

Applicant's mark is NEWPORT SCIENTIFIC and design, as previously depicted.

Opposer contends that its marks and the mark of applicant are essentially identical, in that the word NEWPORT is identical and the latter portion of applicant's mark, the term SCIENTIFIC, is a generic term which "neither adds to nor detracts from" the commercial impression of the mark. Applicant, on the other hand, insists that the design portion and the SCIENTIFIC portion of its mark cannot be ignored. Applicant argues that the fanciful design element is just as prominent as the word portion of its mark and would have considerable source-indicating significance. Applicant also argues

that the additional word SCIENTIFIC serves to distinguish applicant's mark as a whole from opposer's marks.

Although the marks involved must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods and thus it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192 (TTAB 1994).

Applying these principles, we find the word NEWPORT to be the dominant portion of both opposer's and applicant's marks. The descriptive term SCIENTIFIC in

applicant's mark, and acknowledged as being descriptive by applicant by its disclaimer thereof, has little source-indicating significance. Moreover, even though the design feature of applicant's mark may be fanciful and perhaps eye-catching, it is the word portion, and particularly the word NEWPORT which will be remembered and relied upon by purchasers in calling for the goods. All in all, we find the marks, when considered in their entireties, highly similar in overall commercial impressions.

Considering next the respective goods, opposer takes the position that both opposer's and applicant's goods are electronic instruments for analyzing, measuring and controlling variable parameters and thus are functionally similar. Opposer argues that its goods are inclusive of devices capable of measuring time, temperature, torque, speed and more directly, flow and flow rate and that at least some of its products have been used collectively to measure and control viscosity, as in controlling the viscosity of ink or oil. Thus, argues opposer, the nature of applicant's food analyzers for determining the viscosity of foodstuffs, which makes independent measurements of time, torque and temperature to determine the viscosity, is consistent with the discrete parametric

measurements performed by a number of instruments produced and sold by opposer.

Applicant contends that the goods of the parties are drastically different, applicant's food analysis equipment being totally separate from the electrical analysis equipment of opposer. Applicant argues that the purpose of opposer's paddlewheel flow sensors, which are "apparently the goods which [opposer] deems closest to the food analyzers," is to make a purely quantity measurement, namely, the quantity of material moving past a point in a pipeline. By contrast, applicant argues, its food analyzers determine the viscosity of foodstuffs at multiple points along the heating/cooking cycle or, as stated in the identification of goods, the "viscosity properties" of the material.

Applicant argues that the term "flow" as used in connection with a flowmeter has a much different meaning than when used in the definition of "viscosity" as "resistance to flow." A flowmeter measures a quantity of material moved or the speed at which it is moved, whereas "viscosity" is a parameter of the internal state of a fluid.

Applicant asserts that the mere fact that "flow" is one of the parameters which may be used to derive viscosity

should not be determinative. Time is a similar parameter; yet, applicant argues, a stopwatch is not similar to a flowmeter and neither a flowmeter nor a stopwatch is similar to applicant's food analyzers for determining viscosity properties.

Applicant further argues the cost differential in the goods of the parties as a distinguishing factor, applicant's food analyzers usually selling for over $20,000 whereas opposer's paddlewheel flow sensors sell for $200-$225. In addition, applicant asserts there is no cross-over of record between companies that market either food analyzers such as applicant's or viscometers of any type and flowmeters, pointing to testimony of Rodney Booth that to his knowledge there was no such cross-over. (Deposition pp. 74-76).

As for the analyzers upon which opposer is relying in its notice of opposition, applicant notes that none of opposer's registrations cover "analyzers" in general, but rather the two which contain references to analyzers specifically limit the same to "signal analyzers, voltage analyzers and process loop analyzers." All of these, applicant asserts, are not at all similar to food analyzers.

As a general principle, it is not necessary that the goods of the parties be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

From the basic definitions of "flow" and "viscosity," it is apparent that the flowmeters of opposer and the food analyzers for determining viscosity properties of applicant, sometimes referred to as "cooking viscometers," are not similar types of instrumentation used for similar purposes. Although flow may be considered as one of the parameters involved in the determination of viscosity, the complex measurement of the viscosity properties of a material over a range of temperatures and a period of time is a much different measurement from that of flow at a particular point in a system. Clearly the objectives for the use of

applicant's food analyzers are far different from the flowmeters of opposer. In a similar vein, the specific analyzers of opposer differ significantly in operation and purpose from the food analyzers of applicant.

Nonetheless, the question is not whether the goods of the parties are similar or even competitive, but rather whether a relationship of some type exists between the goods and/or whether they would be likely to be encountered by the same persons who might believe that emanate from the same source, if similar marks are used thereon. In this respect, we have little evidence of record to guide us in determining the exact points of use of opposer's various digital panel instruments. Opposer simply has produced evidence that its products have been marketed continually over the years to the food processing industry. We can only assume, from the nature of the measurements being made, particularly by the flowmeters on which opposer has placed its emphasis in this opposition, that these are instruments used in the food processing itself, or "on-line," to control or measure process parameters, rather than in any laboratory or scientific studies being conducted with respect to the foodstuffs involved. Such an assumption appears to be totally in line with opposer's testimony to the effect

that its products are sold to the process industry in general.

Applicant's food analyzers, on the other hand, have been shown to be used in the laboratory, whether commercial or academic, for the study of the viscous properties of various foodstuffs, normally starch-containing materials. This differentiation in area of use and purpose for use leads us to conclude that, regardless of the fact that opposer's instruments may measure some of the individual parameters which are involved in a viscosity measurement or may be used to control viscosity in an industrial process, the products of the parties are not sufficiently related that purchasers would be likely to assume a common source.

This leads us to a consideration of the channels of trade for the respective products. There is no question that the goods of both are marketed to the food processing industry in general. Opposer has named specific customers, including a cereal manufacturer and a brewery, which are similar to those of applicant. Opposer's products have been listed in equipment directories for the food processing industry. Applicant's product is by definition directed to use in the food industry.

The distinctions come in the means by which sales are carried out. Applicant has shown that its sales are advanced by direct contact between a sales representative of applicant's exclusive distributor Foss and the potential customer, who usually is a person with an advanced technical degree and an experienced work background. The sales process involves considerable interchange and a multi-level decision making process. The product is installed by Foss employees. Applicant has introduced testimony that applicant's products are not sold through any retail locations and cannot be purchased over the Internet.

Opposer, on the other hand, has made no evidence of record of any such personalized sales operation or of the nature of its customers. Applicant has introduced a portion of opposer's website showing that opposer's products such as the paddlewheel flow sensors can be purchased over the Internet.

Moreover, although two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. The likelihood of confusion must be shown to exist not in

a purchasing institution, but in a customer or purchaser. Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388,1391 (Fed. Cir. 1992), citing Astra Pharmaceuticals Prods. v. Beckman Instruments, 718 F.2d 1201, 220 USPQ 786, 790 (1st Cir. 1983). Here we have evidence that applicant's food analyzers are purchased by highly experienced persons with advanced technical degrees and that the actual purchase goes through a multi-level chain of approval. The purchases are obviously directed toward use of the food analyzers in a laboratory setting.

There is no evidence of record, however, as to the particular purchasers of opposer's products or the selling process involved. From the very differences in the nature and the costs of the goods of the parties, we can only assume that opposer's products are purchased by other than laboratory personnel and are intended for use in the food processing areas per se. Thus, although the goods of the parties may both be purchased by the same companies in the food processing industry, we are led to conclude that there is little likelihood that the actual purchasers of these goods would be the same.

Here the channels of trade factor is closely intertwined with the *du Pont* factor directed to the

conditions under which the purchases are made and the sophistication of the purchasers making these purchases. Opposer argues that, even though applicant's customers may be sophisticated, this is not a conclusive factor against likelihood of confusion in this case, given the wide variety of electronic products for industrial and scientific use marketed by opposer.

We cannot ignore, however, the expense involved in the purchase of applicant's food analyzers, running from $14,000-$34,000 or the level of expertise of those involved in the purchase of these analyzers. By contrast, the only evidence of record with respect to opposer's goods shows products ranging from $200-$225. The level of expertise or nature of the purchasers of opposer's products is unknown. As stated in Electronic Design & Sales, again citing Astra, "there is always less likelihood of confusion where the goods are expensive and purchased after careful consideration." Id. at 21 USPQ 1392. We find the nature of the goods, the individualization of the sales and the level of expertise of the purchasers to be strong factors in applicant's favor.

Applicant has also introduced evidence with respect to the use of similar Newport marks by third-parties for

similar goods. Although applicant argues that there are a large number of Newport marks being used in the United States, the testimony of Mr. Booth was limited to the use by four other companies of Newport marks in the instrumentation field. The use or registration of Newport marks for non-similar goods or services is irrelevant and applicant's evidence to this effect has been given no consideration. Opposer argues, however, that it has sought to enforce its mark and has made of record evidence of the consent decree whereby one of the four companies named by applicant, Newport Components and related companies, is enjoined from using the word "Newport" and of the infringement action which it is taking against another of the companies, Newport Corporation. (Exhibits 40 and 41). The evidence is clearly insufficient to establish that NEWPORT is a commonly used mark in the instrumentation field or that opposer's mark is entitled to less than the normal scope of protection.

Finally, applicant has raised the factor of the absence of any evidence of actual confusion, despite the

concurrent use of the marks since at least 1987. This factor also inures to applicant's benefit.[5]

Accordingly, on the basis of the cumulative differences in the nature of the goods, the differences in the actual purchasers of the goods, the nature of the process involved in the purchase of applicant's goods, and the sophistication of the purchasers involved in the selection of applicant's food analyzers, we find no likelihood of confusion, despite the similarity of the marks. As stated in Electronic Design & Sales, 21 USPQ2d at 1391, citing Witco Chem. Co. v. Whitfeld Chem. Co., 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969), aff'g. 153 USPQ 412 (TTAB 1967):

> We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Decision: The opposition is dismissed.

[5] Opposer's argument that the advertising by Foss often fails to show use in a clear and complete fashion of applicant's mark in connection with the goods is irrelevant to the issue of likelihood of confusion, the only issue before us.