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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Analytica Environmental Laboratories, Inc.

v.

Lumina Decision Systems, Inc.

Cancellation No. 26,851

Harold R. Bruno, III of Smith McCullough, P.C. for Analytica Environmental Laboratories, Inc.

Robert H. Sloss of General Counsel Associates LLP for Lumina Decision Systems, Inc.

Before Hanak, Hohein and Rogers, Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Analytica Environmental Laboratories, Inc. ("petitioner") has petitioned to cancel the registration owned by Lumina Decision Systems, Inc. ("respondent") for the mark ANALYTICA for goods identified as "computer software for decision analysis applications in the environmental, pharmaceutical, aerospace, power plant, financial, telecommunications, health care, computer,

manufacturing and retail fields and user manuals sold together as a unit therewith."<sup>1</sup>

In pertinent part, petitioner asserts in its pleading that it "has adopted and continuously used the trademark ANALYTICA and design, since at least as early as November 30, 1987 to the present, in connection with environmental testing and analysis laboratory services"; that it has obtained Registration No. 1,665,304 for the mark, for those services; that there is no issue as to priority of use because respondent filed its intent-to-use application in April 1995 and in its subsequently filed statement of use claimed September 9, 1996 as respondent's date of first use; that consumers are likely to consider respondent's goods as emanating from petitioner; and that there is a likelihood of consumer confusion or deception, as evidenced by an instance of actual confusion. Petitioner attached to its petition a plain copy of its registration, showing the mark set forth



below.

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<sup>1</sup> Registration no. 2,044,684, issued March 11, 1997, in international class 9, and listing a date of first use and first use in commerce of September 9, 1996.

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In its answer, respondent admitted petitioner's allegations relative to respondent's first use of respondent's mark ANALYTICA, but otherwise denied the allegations of the petition. In addition, in separate averments, respondent asserted that the petition is barred by laches and that petitioner is estopped to petition for cancellation of respondent's mark.<sup>2</sup>

The record includes the pleadings; the file of the challenged registration; a certified copy of petitioner's pleaded registration, introduced by petitioner's notice of reliance, showing that it is subsisting and owned by petitioner; the testimony and associated exhibits from the testimony deposition of Jeffrey Lyons, president of petitioner; the testimony and associated exhibits from the testimony deposition of Eric Weissman, president and CEO of Decisioneering, Inc., a former licensee of respondent; and the testimony and associated exhibits from the testimony deposition of Max Henrion, CEO of respondent.<sup>3</sup>

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<sup>2</sup> We view the allegation of estoppel solely as part of respondent's affirmative defense of laches.

<sup>3</sup> Respondent filed a notice of reliance on its involved registration file, which was unnecessary. This notice, as well as petitioner's notice of reliance, asserts that each party will rely on the testimony of the various witnesses. Again, it is unnecessary to file a notice of reliance on a testimony deposition transcript. The transcript of every testimony deposition taken in a Board case must be filed with the Board and, when filed, automatically constitutes part of the evidentiary record and may be cited to by any party. See discussion and authorities collected in TBMP §713.12.

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As a preliminary matter, we consider respondent's assertion that petitioner has abandoned the mark in its pleaded registration. During cross-examination of Mr. Lyons, respondent's counsel pursued the question of the precise mark that is covered by petitioner's registration:

**Q.** Is there a registration for a trademark for Analytica Environmental Laboratories, Incorporated?

**A.** Yes.

**Q.** Is that any different than the mark that's depicted in Exhibit 14 [petitioner's pleaded registration]?

**A.** It currently is because we have submitted the documentation to the trademark office, which I understand has been accepted, with the current logo and the name of Analytica.<sup>4</sup>

Lyons' Deposition, 32:19 to 33:2.

Respondent argues in its brief that the mark in petitioner's pleaded registration has not been used since April 1995, when petitioner changed its name. Notwithstanding the evidence of record which could be characterized as supporting respondent's assertion that petitioner has abandoned its registered mark<sup>5</sup>, we note that

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Also, while petitioner's notice of reliance asserts that petitioner will rely on the transcript of a discovery deposition of respondent's CEO, Mr. Henrion, no such deposition appears to have been taken. In any event, if a discovery deposition was taken, its transcript was not submitted with petitioner's notice of reliance and is not, therefore, part of the record.

<sup>4</sup> While Mr. Lyons apparently believes that the mark in petitioner's registration has been changed in Patent and Trademark Office records, the certified copy of its registration clearly reveals the contrary.

<sup>5</sup> See, in addition to testimony quoted above, Lyons' deposition 36:19 through 37:20.

respondent is precluded from pursuing a collateral attack on petitioner's pleaded registration. Respondent did not include a counterclaim for cancellation in its answer and has not moved to amend the answer to assert such a counterclaim. Moreover, we do not view the evidence of abandonment as so clear and unmistakable that petitioner should be unable to rely on the presumptions of validity, ownership and exclusive right to use accorded to the owner of a registration. Accordingly, we will not further consider the assertion of abandonment. See Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048, 1050 n.4 (TTAB 1982); see also, Penguin Books Ltd. v. Eberhard, 48 USPQ2d 1280, 1286-87 (TTAB 1998). In view thereof, we also need not consider petitioner's argument that it has not abandoned its mark because the specimens of use submitted with its Section 8 and 15 affidavit (Petitioner's exh. 18) show a mark not substantially different from the mark originally registered.<sup>6</sup>

We turn, next, to the record. Petitioner and its related companies provide their customers with environmental

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<sup>6</sup> We note that both petitioner's pleading and its brief rely only on the mark in the pleaded registration, not use of the word ANALYTICA alone as an element of the trade name of petitioner and the related "Analytica Group" companies, or on any mark revealed in exhibit 18. Thus, in our analysis of likelihood of confusion we have limited our comparison of the marks to petitioner's and respondent's respective registered marks. We have given no weight to evidence relating to other uses of the term ANALYTICA, or marks incorporating that term, by petitioner or "Analytica Group" companies other than petitioner.

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testing and analysis laboratory services. Each of the related companies specializes in testing and analyzing samples, such as water, air, soil, or building materials, for particular substances. Lyons' Dep. 7:24-9:8 and 12:9-12:16. The results, including both raw data and conclusions, are reported to customers in hard copy reports and in electronic form, such as by e-mail via the Internet or by diskette. Customers can utilize the electronic form results to manipulate and use the data and reports in assessing environmental risks. Id. 11:5-11:15, 52:4-52:25.

Petitioner's customers include "a wide array of companies or individuals. It can be city, state, local municipalities, federal government agencies, state government agencies, commercial and industrial businesses, environmental consulting firms, environmental engineers, petroleum engineers..., [and] universities [and] school districts." Id. 19:14-19:24. The services cost from "a few hundred dollars to several hundred thousand dollars." Id. 81:15-81:16. Petitioner promotes its services via its web page on the Internet, in trade journals, at trade shows, by telemarketing, and in brochures and flyers used for direct mail. Id. 20:25-22:20.

Respondent is in the business of developing software that aids the decision-making process. Henrion Dep. 8:2-8:5. The particular program covered by respondent's

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registration is used "for creating, analyzing and communicating quantitative models. [It is] a high-end spreadsheet [with] a more graphical visible interface [and] allows quantities to be represented as uncertain using probability distributions..." Id. 9:10-9:18; see also, id, 13:3-13:9 and Weissman Dep. 17:7-17:12. The vast majority of the copies of respondent's program that have been sold, approximately 1,000, have been sold by respondent's licensee, with a retail price of nearly \$800 per copy; since marketing by the licensee ceased and respondent has been marketing the program directly, it has been selling for nearly \$500 per copy. Henrion Dep. 73:8, 34:2-34:5; Weissman Dep. 35:14.

The typical purchaser of respondent's program is more sophisticated than the average purchaser of software. Weissman Dep. 39:18-39:19. See also, id, 30:20-31:1, and Henrion Dep. 31:23-32:10.<sup>7</sup> The program has not been sold at retail. Henrion Dep. 34:17-34:22. It has been marketed through direct sales calls, direct mail, the Internet, and at trade shows. Weissman Dep. 11:22-14:17; Henrion Dep. 34:13-34:16.

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<sup>7</sup> Q. ...[A]s the principal developer of this product, did you have an expectation that the user would have to have a certain level of experience in a particular area?

A. Yes.

Q. What type of experience did you--

A. Typically, at least a graduate degree in a quantitative discipline.

Henrion Dep. 32:3-32:10.

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We begin our analysis of petitioner's claim by noting that petitioner prevails on the issue of priority, because petitioner has introduced a certified copy of its pleaded registration, establishing that it is subsisting and owned by petitioner, and respondent, in its answer, admitted that it did not use its mark until a date long after the filing date of the application which gave rise to petitioner's registration. See Brewski Beer Co. v. Brewski Brothers Inc., 47 USPQ2d 1281, 1284 (TTAB 1998) and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423, 1428-29 n.13 (TTAB 1993).

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all the *du Pont* factors which are relevant under the present circumstances and for which there is evidence of record. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarity or dissimilarity of the goods or services and the similarity or dissimilarity of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); In re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209, 1210 (TTAB 1999).

We consider, first, the similarity or dissimilarity of the marks. Respondent argues that the marks are dissimilar



because petitioner's mark incorporates a stylized letter A design, presents the term ANAYLYTICA with larger letters on either end, and includes I-N-C-O-R-P-O-R-A-T-E-D. In terms of the visual similarity of the marks, we agree that the use of the stylized letter A and the particular display of "incorporated" result in a mark that looks different than respondent's mark. In contrast, we disagree with respondent's contention that petitioner's particular display of the term ANALYTICA, i.e., with the "A" on either end slightly larger than the other letters, contributes to visual dissimilarity. Respondent's mark ANALYTICA is registered in typed form, so we must consider the possibility of it being presented in various forms of display, including the form in which petitioner displays that term. Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971); Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992).

While we find the marks to have both similarities and dissimilarities in appearance<sup>8</sup>, we find the connotation or meaning created by the marks to be similar. Petitioner's registration includes a disclaimer of the term

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<sup>8</sup> To the extent the parties' respective marks would be spoken, there would be both similarities and dissimilarities in pronunciation, with the latter attributable to petitioner's use of the letter A and the term "incorporated" in its mark. We find it unlikely, however, that many of petitioner's customers would articulate the letter A and the term "incorporated" in petitioner's mark, and would be more likely to speak it simply as ANALYTICA.

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"incorporated," and disclaimed matter typically is less significant than other components in a mark. Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976). In addition, we find that the stylized letter A design would be perceived as an initial and would tend to reinforce the dominant term in petitioner's mark, i.e., ANALYTICA. In sum, we find the marks create the same basic commercial impression.

Notwithstanding the basic identity of commercial impression created by the involved marks, we agree with respondent that the term ANALYTICA, though not found in the dictionary, is highly suggestive of the involved goods and services. The term is evocative of "analysis" and "analytical," both of which are terms used by petitioner to describe its services. Likewise, respondent's software is a "decision analysis" program. Moreover, the record, including non-party registrations, Internet evidence and phone directory listings, reveals that ANALYTICA has appealed to others as a trademark or trade name element, for laboratories and laboratory equipment, and in the computer field, among others. While this evidence does not establish the extent of use of these other marks or names, or the degree to which consumers have been exposed to them, it does demonstrate that ANALYTICA may not be particularly distinctive. See Bost Bakery Inc. v. Roland Industries,

Inc., 216 USPQ 799, 801 n.6 (TTAB 1982). In addition, petitioner has provided no support for its claim that its mark has achieved a degree of fame in the "niche" field of environmental testing. Thus, we conclude that the scope of protection to which petitioner's mark is entitled is limited.

Turning to the involved goods and services, they clearly are not competitive, notwithstanding petitioner's arguments to the contrary<sup>9</sup>, and are only theoretically complementary. Respondent's CEO admitted during cross-examination that it would be possible for a user of respondent's software to utilize data obtained from petitioner's laboratory. Nonetheless, the witness also testified that the composition of an environmental sample, i.e., the results of the type of analysis conducted in petitioner's laboratory, would "be one among, you know, many, many inputs." Henrion Dep. 33:24-33:25. Moreover, there is no evidence that any common customer of petitioner and respondent has used the results of petitioner's analysis services in a decision analysis assessment using respondent's software.

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<sup>9</sup> Petitioner argues that "both companies provide tools by which environmental data is analyzed" and "the end result" of its services and use of respondent's program "are charts, bars and graphs of environmental data." The argument suffers from unwarranted generalities that do not accurately reflect the respective goods and services.

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The question of the relatedness of the goods and services in this case is similar to the circumstances considered by this Board in the *Information Resources* case. In that case, no likelihood of confusion was found despite simultaneous use of EXPRESS in connection with computer software and services relating to the analysis of information, including financial information, and X\*PRESS for transmitting news and a variety of general information and data to home and business computers via satellite and cable television lines. Information Resources Inc. v. X\*Press Information Services, 6 USPQ2d 1034 (TTAB 1988).

In regard to classes of consumers for the goods and services, we note that the only evidence that the parties even have common customers consists of testimony from petitioner's president that petitioner has done business with some of the same large companies and governmental agencies that are listed as customers of respondent's former licensee. There is no evidence, however, that the same individuals, or even the same departments within these institutional purchasers, would be responsible for purchasing both petitioner's services and respondent's goods. The mere fact that respondent's software and the end products resulting from a purchase of petitioner's services could end up in the hands of the same institutional consumer do not dictate a finding of likelihood of confusion. See

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 USPQ2d 1388 (Fed. Cir. 1992); see also, SBS Products Inc. v. Sterling Plastic & Rubber Products, Inc., 8 USPQ2d 1147, 1150 (TTAB 1988) (all products used in industrial plants are not, per se, related). Moreover, it is clear from the record that the particular individuals who would seek petitioner's services or respondent's goods, would be sophisticated and unlikely to rely solely on the parties' marks in making their purchasing decisions.

We note petitioner's argument that the involved goods and services have been marketed at some of the same trade shows. Petitioner has not, however, presented evidence that any attendees inquired about a possible relationship of the parties. We find the evidence of promotion at common trade shows no more probative on the question of likelihood of confusion than the evidence that the goods and services are also marketed through the common trade channel of the Internet. That is to say, this evidence is not probative of a likelihood of confusion. See *SBS Products, supra*, at 1150 (mere marketing of goods in same publications did not warrant finding that products were related or that readers would believe different goods originated in same source).

We note petitioner's allegation that there has been a single instance of actual confusion. We agree, however, with respondent's argument that the letter sent to

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petitioner, but intended for respondent's licensee, was misdirected through carelessness, not as the result of any actual confusion. The letter-writer was seeking to sell services, and was not seeking to purchase respondent's software program. We agree with the characterization of the letter by Mr. Weissmann, i.e., as a "junk mail" solicitation. Weissmann Dep. 43:22-43:25.

Finally, we find unpersuasive petitioner's argument that respondent adopted its mark in bad faith and with an intent to trade on petitioner's reputation. The record does not support the argument. Though respondent at some point became aware of petitioner's registration, it was not until after respondent had chosen its mark and concluded that the parties could co-exist because they are not competitors.

In sum, despite the virtually identical impressions created by the marks, we find no likelihood of confusion because the marks are suggestive and entitled only to a limited scope of protection; the goods are not competitive, and only marginally complementary; there is no evidence that the goods and services have common purchasers, even though they may have been marketed to some of the same institutional customers; and the prospective purchasers are highly sophisticated.

Decision: The petition to cancel is dismissed.