

THIS DISPOSITION IS
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OF THE TTAB

Mailed: July 11, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Liebert Corporation
v.
Digitronics Inventioneering Corporation¹

Opposition No. 91153525
to application Serial No. 76081580
filed on June 30, 2000

Robert J. McAughan, Jr. and Scott J. Garber of Howrey Simon
Arnold & White, LLP for Liebert Corporation.

Arlen L. Olsen and Jack P. Friedman of Schmeiser, Olsen &
Watts, LLP for Digitronics Inventioneering Corporation.

Before Chapman, Holtzman and Walsh, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Digitronics Inventioneering Corporation (a New York
corporation) filed on June 30, 2000, an application to

¹ The record indicates that applicant is now known as "Sixnet" and the records of the Assignment Branch of the USPTO indicate a security interest recorded as to the involved application granted from Sixnet, LLC to American Capital Financial Services, Inc. However, there is no transfer of interest document from applicant to Sixnet, LLC recorded with the USPTO. See Section 10 of the Trademark Act, 15 U.S.C. §1060. The defendant portion of the caption of this proceeding remains "Digitronics Inventioneering Corporation."

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register on the Principal Register the mark SITETRAK for goods ultimately identified as follows:

“industrial monitoring devices, namely, remote terminal units, remote terminal industrial controllers, electronic devices placed at remote locations to perform monitoring and/or control functions, used for reporting real-time conditions by telephone, modem or other electronic means, providing alarms, and collecting and storing data” in International Class 9.

Applicant’s application was filed based on applicant’s assertion of a bona fide intention to use the mark in commerce. Applicant later filed an amendment to allege use, claiming a date of first use and first use in commerce of February 23, 2001, which was accepted by the USPTO.

As grounds for opposition, opposer alleges that it owns three registrations -- (i) Registration No. 1394704 for the mark SITESCAN for “computer based facilities management system comprising computer programs and electronic monitors and controllers for use in monitoring and controlling power protection, environmental control, fire and water detection, security protection and computer support equipment” in International Class 9, of which opposer alleges continuous use since 1984; (ii) Registration No. 1278765 for the mark SITEMASTER for “monitors for providing readout and analysis of electrical power supplies” in International Class 9, of which opposer alleges continuous use since July 1982; and (iii) Registration No. 1933970 for the mark SITENET for

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"computer programs and circuit modules for monitoring uninterruptible power supplies" in International Class 9, of which opposer alleges continuous use since March 1995. Opposer also alleges ownership of application Serial Nos. 76194376 for the mark SITELINK for "uninterruptible power supplies" and 75484645 for the mark SITENET ENERGY MANAGER for "software for controlling power consumption during electrical line power outages when and [sic] uninterruptible power supply supplies power."

Opposer specifically alleges as follows:

7. [Opposer] has expended considerable effort and expense in promoting the SITESCAN, SITEMASTER and SITENET marks and the products offered under those marks with the result that the purchasing public has come to know, rely upon, and recognize the products of Liebert by such marks. Liebert has established valuable goodwill in its SITESCAN, SITEMASTER and SITENET marks. As a result of Liebert's long usage and promotion of its SITESCAN and SITEMASTER marks, those marks are now famous.

Opposer concludes and alleges that applicant's mark, when used in connection with its goods, so resembles opposer's previously used and registered SITESCAN, SITEMASTER and SITENET marks, as to be likely to cause confusion, mistake, or deception in contravention of Section 2(d) of the Trademark Act.

In its answer, applicant admits that opposer is the owner of Registration Nos. 1394704, 1278765 and 1933970; and

that opposer is the owner of application Serial Nos. 76194376² and 75484645. Applicant denies the remaining salient allegations of the notice of opposition.

Both parties filed briefs on the case.³ Neither party requested an oral hearing.

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance under Trademark Rule 2.120(j) on applicant's responses and additional responses to certain of opposer's interrogatories;⁴ the testimony, with exhibits, of David Saliaris, director of opposer's Liebert Monitoring Group;⁵ and the testimony, with exhibits, of Steve A. Schoenberg, applicant's president.⁶

² In its answer, applicant states that opposer did not file a statement of use in this application and the application was abandoned as of May 14, 2002.

³ All briefs on the case have been filed by the parties under seal as confidential. It is clear that most of the information contained therein is not confidential. The parties are ordered to submit redacted copies of their briefs on the case for inclusion in the public record. See Trademark Rule 2.27.

⁴ One of the exhibits to one of applicant's interrogatory answers in this notice of reliance was filed by opposer under seal as confidential.

⁵ A small portion of opposer's testimony and the related exhibits were filed separately under seal as confidential. However, the entire deposition transcript was marked "Confidential" at the top of each page. The transcript was not so filed and the deposition clearly has many non-confidential portions. Thus, the Board has treated as confidential only those portions of the Saliaris deposition (with related exhibits) which were filed separately under seal.

⁶ Opposer noted in its brief on the case that while applicant took the Schoenberg deposition, applicant had not filed the transcript of the deposition (brief, pp 1 and 3). Shortly after the filing of opposer's brief, applicant filed the Schoenberg deposition transcript, with exhibits. Applicant's notice of filing this testimony does not include proof of service thereof on

We will first address some preliminary matters. Applicant argues in its brief that opposer did not plead a family of "SITE" marks or common law rights in any marks; and that because opposer pleaded harm only as to its SITESCAN mark, opposer cannot rely on any of its other pleaded "SITE" marks.

It is true that opposer specifically pleaded (paragraph 11) that registration of applicant's SITETRAK mark would damage opposer in view of opposer's prior use and registration of its SITESCAN mark. However, it is also true that in paragraph 10 opposer pleaded generally that registration of applicant's SITETRAK mark would damage opposer.

In view of the rules of notice pleading, (see e.g., Trademark Rule 2.104(a), and Fed. R. Civ. P. 8(a), (e)(1) and (f)), we find that the general pleading of damage in paragraph 10 of opposer's notice of opposition sufficiently

opposer's attorney as required by Trademark Rules 2.125(c) and 2.119(a). It is presumed that opposer received a copy of applicant's filing. Further, pursuant to Trademark Rule 2.123(h), all trial testimony depositions taken in a proceeding, must be filed with the Board.

Applicant's notice of the filing of the Schoenberg transcript includes a statement that the transcript is filed under seal as confidential, but there is nothing to indicate that it was actually so filed by applicant. Moreover, it is clear that much of the deposition and exhibits are not sensitive business information, which require handling as confidential material. The Board will use discretion in discussing any confidential material submitted by either party in this case.

pleads damage as to each of opposer's five specifically recited registered and applied-for "SITE" marks.

Even if we construe the notice of opposition liberally, we agree with applicant that there is no pleading of a family of marks. Nonetheless, the record is clear that this issue was tried by implied consent of applicant. (See e.g., Saliaris dep., pp. 31, 62, 63, 81, 87.) Applicant did not object thereto at any time. See *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451 (TTAB 1998).

Accordingly, we hold that the notice of opposition is considered amended under Fed. R. Civ. P. 15(b) to conform to the evidence, specifically, to include opposer's claim of a "family" of marks. See TBMP §507.03(b) (2d ed. rev. 2004).

With regard to opposer's arguments as to its common law rights in the other marks, SITEGATE, SITELINK, SITEI/O and SITETRAP, the notice of opposition does not include a claim to common law rights in those marks. However, it is again clear from the record that common law rights were asserted during trial without objection by applicant, and, in fact, applicant cross-examined thereon. (See e.g., Saliaris dep., pp. 31-33, 37-46.)

Accordingly, we hold that the notice of opposition is considered amended under Fed. R. Civ. P. 15(b) to conform to the evidence, specifically, to include opposer's claim of

common law rights in the marks SITEGATE, SITELINK, SITETRAP and SITEI/O.

Opposer first used the mark SITESCAN in October 1984⁷ and the mark has been in continuous use since that time for the goods identified as "computer based facilities management system comprising computer programs and electronic monitors and controllers for use in monitoring and controlling power protection, environmental control, fire and water detection, security protection and computer support equipment."

Liebert Corporation's witness, Mr. Saliaris, describes the relevant portion of opposer's business as follows (dep., pp. 12, 14-15):

Liebert's Site line of products is made up of hardware modules and software components to an overwrapping system known as SiteScan. So there are hardware modules that pick up points of interest from analog to digital components, multiplex them in a hardware module of various types, brings them together up to components within the SiteScan system that ultimately gets to a server to provide information to a customer.

What you do with [opposer's SITESCAN product] is you take hardware modules and interconnect them to industrial products, like chillers and diesel generators, picking up I/O [input/output] points of interest from that, digital contacts, analog

⁷ In 1984 opposer "was an air-conditioning company that sold monitoring products in connection with the air-conditioning company." (Saliaris dep., p. 95.)

information that are in those areas of the environment, bring it back into a system, cache the data into the hardware modules, and bring that up into a gateway that passes it to a front-end system. That front-end system provides event management, trending capability, provides alarm functioning out. So it is an over-arching system that provides information out to those end-users, end clients.

Opposer's Exhibit No. 6 (a SITESCAN product description document) includes the following statements:

Product Description

If you want to keep small problems from becoming big disasters, you need SiteScan Centralized Monitoring System.

...

SiteScan is a perfect solution for:

- Computer rooms
- Telecommunications centers
- Industrial process control facilities
- Any operation that needs to be managed efficiently and effectively

Opposer first used the mark SITEMASTER in 1982 for "monitors for providing readout and analysis of electrical power supplies."⁸ Opposer first used the mark SITENET for "computer programs and circuit modules for monitoring uninterruptible power supplies" in March 1995 and opposer's use thereof has been continuous. According to Mr. Saliaris, SITENET "is a family of products that are hardware modules and software components that wrap up a complete family of products underneath that name." (Saliaris dep., p. 28.)

⁸ There is no testimony or other evidence of opposer's continuous use of its mark SITEMASTER. (See Saliaris dep., pp. 23-24.)

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Opposer has established common law rights in four additional marks. Opposer uses the mark SITELINK for a control module that interfaces with industrial gear. Opposer uses the mark SITEI/O for an input/output module which collects inputs (digital or analog) and provides digital output. This product can work with the overall SITESCAN product or it has a stand-alone capability. Opposer uses the mark SITEGATE for a central collection point product that collects the data provided by the SITELINK and the SITEI/O products. Opposer's use of these three common law marks (SITELINK, SITEI/O and SITEGATE) has been continuous since 1995. Opposer has continuously used the mark SITETRAP since 1999 for a software product that converts the SITESCAN information into a form that can be passed to a network management system.

Opposer targets its products to three main areas, specifically, to industrial (e.g., manufacturing facilities), telecom and data center markets. It sells through independent sales representatives, reseller channels and the internet to, for example, facility managers, plant managers, data center managers. Opposer distributes product brochures through its independent sales representatives and it also markets its involved goods through press releases and exhibiting at trade shows.

Total sales figures and advertising expenses for the SITESCAN product line under the SITE name have been significant.⁹ These figures could not be broken down by product.

Opposer has sold its SITESCAN line of monitoring products to thousands of companies. Exclusive of applicant's use of the mark SITETRAK, opposer is not aware of any third-party use of a "SITE" mark in connection with goods similar to opposer's goods. Opposer is not aware of any instances of actual confusion.

Mr. Steve Schoenberg, applicant's president, describes applicant's SITETRAK product as "a monitoring device that's used in a remote location generally placed there by a third party and its functionality is substantially to record data and events and transmit them to a remote site, off-site positions. So it's used in an unattended manner."

(Schoenberg dep., pp. 5-6.)

According to Mr. Schoenberg, applicant's product is not a computer and is not computer software, but rather it is "a small, embedded remote device ... it's not programmable...", "a piece of hardware for monitoring industrial type applications." (Schoenberg dep., pp. 10, 44.) That is, applicant's SITETRAK product is a component, not the system.

⁹ Opposer's sales figures and advertising expenses are "confidential" and cannot be set forth herein.

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Applicant "invites people to combine our products with unrelated products from other vendors." (Schoenberg dep., p. 49.) It must be combined with third-party software. Purchasers/users can take applicant's product and combine it with other items and create applications.

Applicant has continuously used the mark SITETRAK on its identified industrial monitoring devices since February 2001.

In identifying applicant's customers, Mr. Schoenberg explained that applicant has several categories of customers, including vendor-managed inventory (i.e., suppliers of commodities such as liquid or gaseous material kept in tanks monitoring the level in the tank for purposes of reordering), unattended monitoring of HVAC systems in buildings, and power demand and power usage by utilities. Applicant's product data sheet (applicant's Exhibit No. 102) for its identified goods in its involved application includes the following statements:

SiteTRAK™ Remote Site Manager
The plant floor interface for real-time
database systems

- Real-time Internet Databases
(E-business distributed databases)
- Vendor Managed Inventory
(Detect shortages and track usage)
- Remote Process Monitoring
(Alarm reporting and datalogging)
- HVAC and Energy Management
(Demand factor and usage analysis)
- Environmental Monitoring
(Data collection and reporting)

- Low cost OEM applications
(Data enable industrial products)

...
SiteTRAK puts an end to manual data recording and costly site visits.

...
SiteTRAK is the plant floor "front-end" that brings real-time data from distributed industrial locations into your central information server. Site TRAK is an innovative combination of RTU (Remote Terminal Unit), datalogger, real-time database client, and telemetry interface in a compact installation-ready package.

Applicant's sales have been limited in both dollar volume and number of units sold. Some of applicant's customers are engineers, and technical people influence the purchasing decisions involving applicant's product.

Without doubt, opposer's three registrations¹⁰ and the testimony about its activities establish that opposer has standing to bring this opposition. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

In view of opposer's ownership of valid and subsisting registrations for its pleaded registered marks, SITESCAN,¹¹ SITEMASTER¹² and SITENET,¹³ the issue of priority does not

¹⁰ Opposer's three pleaded registrations were introduced during the testimony of David Saliaris, who testified to opposer's current ownership thereof and to the current live status thereof. See opposer's Exhibit Nos. 1, 15 and 21. (Applicant admitted that opposer owned each of the three registrations in its answer to the notice of opposition.)

¹¹ Registration No. 1394704, issued May 27, 1986, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

¹² Registration No. 1278765, issued May 22, 1984, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

¹³ Registration No. 1933970, issued November 7, 1995, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

arise in this opposition proceeding. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1133 (TTAB 1995). Moreover, opposer's first use of each of its registered marks, SITESCAN (1984), SITEMASTER (1982) and SITENET (1995), and each of its common law marks SITELINK (1995), SITEGATE (1995), SITEI/O (1995) and SITETRAP (1999) predates applicant's filing date of June 30, 2000 and applicant's actual first use in February 2001.

We turn now to consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. 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 of the marks and the similarities of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative

effect of differences in the essential characteristics of the goods [and services] and differences in the marks.”)

Turning first to the marks, the Board must consider the similarity or dissimilarity of the marks in sound, appearance, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

We initially address opposer’s claim of a family of “SITE” marks. In its brief (pp. 13-14), opposer contends that it “owns a family of similar marks, all sharing a common prefix combined with a dissimilar suffix, and all used for the same type of products.” The marks in this asserted “family” are SITESCAN, SITEMASTER, SITENET, SITELINK, SITEGATE, SITEI/O and SITETRAP.

The “family” of marks doctrine has applicability in those situations where, prior to a defendant’s first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant’s subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff’s will cause the relevant purchasing public to assume that defendant’s mark is yet another member of plaintiff’s family. See *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992); and *Econo-Travel Motor Hotel Corp.*

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v. Econ-O-Tel of America, Inc., 199 USPQ 307, 311-312 (TTAB 1978).

It is well settled that mere adoption, use and registration of a number of marks having a common feature (e.g., SITE) for similar or related goods or services does not in and of itself establish a family of marks. Rather, in order to establish a family of marks, it must be demonstrated that the marks asserted to comprise the family, or a number of them, have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 403, 164 USPQ 43 (CCPA 1969); and Hester Industries Inc. v. Tyson Foods Inc., 2 USPQ2d 1646 (TTAB 1987).

Aside from the three registrations for opposer's SITESCAN, SITEMASTER and SITENET marks, opposer's evidence of a family of "SITE" marks essentially consists of (i) the testimony of Mr. Saliaris in general terms such as that since the beginning of opposer's entry into the monitoring business it has used the term "SITE" to represent the products in the family (Saliaris dep., p. 46) and the "SITE" family of marks is "extremely important" to opposer

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(Saliaris dep., p. 63); and (ii) a few uses by opposer of a few of its "SITE" marks in its sales brochures. (See e.g., Saliaris dep., p. 18, Exhibit No. 4 -- a brochure for opposer's SITESCAN SS2W for Windows system which shows on page 6 thereof the marks SITESCAN, SITEGATE and SITELINK identifying boxes in a flow chart configuration; Saliaris dep., p. 21, Exhibit No. 10 -- a brochure for opposer's Deluxe System/3 environmental control system which shows on pages 6 and 11 the marks SITESCAN and SITEMASTER; Saliaris dep., p. 37, Exhibit No. 30 -- a SITELINK sales brochure which shows the marks SITESCAN and SITELINK; and Saliaris dep., p. 37, Exhibit No. 31 -- an Installation Guide for a SITELINK product which shows the marks SITESCAN, SITELINK and SITEGATE identifying boxes in a flow chart configuration.)

In this case, the record contains insufficient evidence to establish that opposer has advertised and promoted its "SITE" marks together and in association with each other in such a manner that consumers would recognize common ownership thereof in opposer based on the common feature. There is no evidence of the seven "SITE" marks herein used together; rather, there is evidence of, at most, use of two or three "SITE" marks in the same sales brochure by opposer. Generally, opposer's evidence shows promotion of the marks individually and independent of opposer's other "SITE"

marks. Opposer's various sales brochures generally show a single mark prominently on the first page. Even those uses where there are two or three "SITE" marks, the uses are inside the brochure and are not prominent or easily noticeable to customers. All of these factors do not leave an impression of a family of marks. Viewing the totality of opposer's evidence regarding its asserted family of "SITE" marks, the record before the Board is not sufficient to prove that opposer has used and promoted its "SITE" marks in a manner resulting in public recognition of "SITE" as a family "surname" such that opposer's various "SITE" marks would be assumed to have a common origin. Cf. *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.* 6 USPQ2d 1215, 1219 (TTAB 1988).

Moreover, the family feature or "surname" must be distinctive as the concept of a family of marks is based on consumer recognition of the common feature as the distinguishing feature of each mark. The evidence before us (including, *inter alia*, the dictionary definition of "site" of which the Board takes judicial notice later in this decision) shows that the family feature ("SITE") is not distinctive.

Opposer has not proven by a preponderance of the evidence that it has a family of "SITE" marks.¹⁴

We turn next to a consideration of opposer's individual "SITE" marks, SITESCAN, SITEMASTER, SITENET, SITELINK, SITEGATE, SITEI/O and SITETRAP. Of these marks, we consider opposer's SITESCAN mark for a computer based facilities management system to be the closest of opposer's marks and goods to applicant's SITETRAK mark for its industrial monitoring devices. Therefore, we will focus our discussion of opposer's likelihood of confusion claim on opposer's SITESCAN mark and goods.

Looking first to the marks, SITESCAN and SITETRAK, it is obvious that they are not identical. However, both involved marks are constructed in a similar manner, both

¹⁴ In reaching this conclusion, the Board is not validating applicant's argument that because opposer did not obtain survey evidence, opposer is not entitled to a finding of a family of marks. Applicant cited Colony Foods Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984) as the basis for this argument. We do not read the Colony Foods case to require survey evidence in order to prove a family of marks. Rather, the Court explained that "Colony had failed to establish, for example by a survey," that the asserted family term is understood by the purchasing public in connection with restaurant services to identify Colony exclusively.

Surveys are not required in Board proceedings. As the Board has noted, "We appreciate the significant financial cost of surveys. Moreover, we obviously recognize the limited jurisdictional nature of Board proceedings, wherein only rights to registrability, not use, are determined." *Hilton Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1435-1436 (TTAB 1993). See also, *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995). As Professor McCarthy stated: "The Board will not draw a negative inference from a party's failure to offer survey evidence." 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §32:180 (4th ed. 2005).

beginning with the word "SITE" and both consisting of two syllables with no space between the two syllables comprising each mark. Specifically, both marks share the beginning suggestive term "SITE" followed by a second suggestive term relating to the involved product.¹⁵ The first part of a mark is often the part impressed upon the mind of the purchaser, and the most likely to be remembered. See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1981).

Importantly, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the involved marks in sound, appearance, meaning and commercial impression. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). The difference in the marks (the second word) does not serve to distinguish the marks here in issue. That is, purchasers are unlikely to remember the specific difference between the marks due to the recollection of the average purchaser, who normally retains a general, rather

¹⁵ Applicant offers industrial monitoring devices which perform a monitoring (and/or control) function and report real-time conditions, that is, they track information. We find "trak" to be the equivalent of "track." Opposer offers a computer based facilities management system with electronic monitors, thus they scan the information.

than a specific, impression of the many trademarks encountered. The marks are similar in sound and appearance.

The connotations of the marks SITESCAN and SITETRAK are also similar. The Board takes judicial notice of Webster's Third New International Dictionary (1993) definitions of the following words:¹⁶

(1) **site** n ...2b a space of ground occupied or to be occupied by a building..

(2) **scan** vb ...3a(2): to check ... for recorded data by means of a mechanical or electronic device.

(3) **track** vb 1a: to follow the tracks or traces of ... 3a to ascertain and follow up through vestiges: trace...

Relevant purchasers may note the difference in the last syllable of these marks, but they would still think these goods come from or are associated with the same source because of the parallel construction of the marks, specifically "SITE" followed by a term relating to tracking or scanning information. That is, purchasers familiar with opposer's computer based facilities management system sold under the registered mark SITESCAN, upon seeing applicant's mark SITETRAK on industrial monitoring devices, would assume

¹⁶ The Board may take judicial notice of dictionary definitions. See *The 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). See also, TBMP §704.12 (2d ed. rev. 2004).

that applicant's goods come from the same source as opposer's goods.

It is the impression created by each of the involved marks, each considered as a whole, that is important. See *In re Dixie Restaurants Inc.*, supra; *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). These marks do not create separate and distinct commercial impressions.

We find that the marks, SITESCAN and SITETRAK, considered in their entirety, are similar in sound, appearance, connotation and commercial impression.

Turning next to a consideration of the goods involved in this case, we start with the well-settled principle that the question of likelihood of confusion in Board proceedings regarding the registrability of marks, must be determined based on an analysis of the goods or services identified in applicant's application vis-a-vis the goods or services recited in the registration(s). See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Further, it is also well settled that goods or services need not be identical or even competitive to support a finding of likelihood of confusion. Rather, it is

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enough that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they emanate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Opposer's identified goods are "computer based facilities management system comprising computer programs and electronic monitors and controllers for use in monitoring and controlling power protection, environmental control, fire and water detection, security protection and computer support equipment." Applicant's identified goods are "industrial monitoring devices, namely, remote terminal units, remote terminal industrial controllers, electronic devices placed at remote locations to perform monitoring and/or control functions, used for reporting real-time conditions by telephone, modem or other electronic means, providing alarms, and collecting and storing data."

David Saliaris testified regarding the goods as follows (dep., pp. 17, 42-43):

Q. And how would you compare the goods listed under the SITETRAK mark on Exhibit 2 to the goods

that you described earlier sold under the SITESCAN mark by Liebert?

A. By this definition, this is exactly what we do with the SITESCAN product set.

Q. Just to make clear for the SITELINK, SITEI/O and SITEGATE products, have any of the functions of those products changed since the time when they were initially introduced?

A. The central core functions of those products have not changed. There have been enhancements made on the products over time that increase the features, the benefits of each of those products.

Q. But as compared to the description of goods on Plaintiff's Exhibit 2 [the Official Gazette page showing applicant's mark and goods], has that function changed?

A. No. What's described in Exhibit 2 is the central part of the SITESCAN monitoring product family.

In this case, even though the involved goods are specifically different, we find that they are complementary, related goods. The issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

The respective identifications of goods indicate that applicant's industrial monitoring devices, including electronic devices, are used to monitor and/or control functions, report real-time conditions, provide alarms and collect and store data; and that opposer's computer based system (consisting of hardware and software), includes electronic monitors, and the system is used to control power protection, environmental control, fire and water detection,

security protection and computer support equipment. It is clear from the identifications that there is overlap in the uses and functions of these two separate products. The product brochures for applicant's SITETRAK goods and opposer's SITESCAN goods both indicate use for real-time conditions, for providing alarms, for collecting and storing data.

Moreover, the record clearly shows that the device sold by applicant must be connected to a system, and that it could be connected to opposer's SITESCAN system. (See e.g., Schoenberg dep., p. 48; applicant's Exhibit No. 102 -- applicant's product data brochure; and opposer's Exhibit No. 3, a SITESCAN product brochure which states therein that "You can connect virtually any piece of remote equipment to SiteScan.") That is, applicant's product could be used as a component of opposer's SITESCAN monitoring system.

We find that applicant's identified goods and opposer's identified goods in its registration for the mark SITESCAN are complementary, related goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). That is, there is a commercially significant relationship between opposer's goods offered under its SITESCAN mark and applicant's goods offered under its SITETRAK mark. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir.

2002)("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services"); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)("even if the goods in 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.").

Regarding the trade channels of these products, there are no restrictions thereto in either party's identification of goods. Moreover, the record establishes that applicant markets and sells its products sold under its SITETRAK mark "through independent sales representatives and distributors, and through the Internet" (applicant's answers to opposer's interrogatory Nos. 10 and 21), and opposer sells its products sold under its SITESCAN mark through, inter alia, independent sales representatives, and through the Internet (opposer's answer to applicant's interrogatory No. 20). Thus, the channels of trade are the same or at least overlapping.

There is very little evidence in this record relating to the sophistication of the purchasers or the nature of and the care taken in the purchasing process. In fact,

applicant's testimony regarding the purchasers of its products is vague and ambiguous. (See e.g., Schoenberg dep., p. 51.) Nonetheless, clearly the goods involved herein are not general consumer goods. Assuming the sophistication of the purchasers of the involved goods, "even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). See also, Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); In re Decombe, 9 USPQ2d 1812 (TTAB 1988); and OPTOmechanisms, Inc. v. Optoelectronics, Inc., 175 USPQ 246 (TTAB 1972). That is, even relatively sophisticated purchasers of these goods are likely to believe that the respective goods emanate from or are affiliated with the same source, if offered under these similar marks. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990); and Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Regarding the du Pont factor of the number and nature of similar marks in use on similar goods, applicant argues that it "has demonstrated that there exists a substantial number of similar marks in [sic] goods similar to the goods of Opposer." (Brief, p. 44.) In support thereof, applicant

refers to third-party registrations that it made of record.¹⁷

The third-party application carries no weight as it is evidence only that the application was filed on a particular date. The 30 third-party registrations are likewise totally devoid of evidentiary value with regard to this du Pont factor because third-party registrations do not establish that the marks shown therein are in use, or that the public is familiar with them. Thus, we cannot assume that the public will (presumably) come to distinguish between them. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). There is no evidence before us of any use by any third party of any mark including the word "SITE" for the same or related goods.

Looking next at the du Pont factor of the fame of opposer's mark, opposer argues that its SITESCAN mark is "strong" (brief, p. 21) on the basis that it has used the mark for about 20 years; that its "SITE" marks have been

¹⁷ Applicant introduced one third-party application and approximately 30 third-party registrations during its cross-examination of opposer's witness, David Saliaris. (A few of the third-party registrations were duplicates of the same registrations.) Applicant re-introduced the same third-party application (applicant's Exhibit Nos. 3 and 113) and approximately 25 of the same 30 third-party registrations during the direct examination of its witness, Steve Schoenberg.

"significantly advertised"; and that sales under its "SITE" marks have been "extensive."

While the figures are large, they are not persuasive because they cover many years of sales and neither the sales figures nor the advertising figures are broken down by mark. The record herein does not support a finding that opposer's SITESCAN mark is strong for its computer based facilities management system.

Applicant argues that opposer's SITE marks are not strong, but are weak "because of the large number of existing SITE marks not owned by Opposer including many SITE marks in the same field/market as Opposer's field/market." (Brief, p. 42.)

As mentioned previously herein, applicant introduced a total of about 30 third-party registrations, all of which include the word SITE in the mark. Interestingly, applicant asked both parties' witnesses questions about the third-party registrations. Specifically, applicant asked opposer's witness, David Saliaris, a series of questions as to each of the approximately 30 third-party registrations, including whether he recalled seeing the mark during the course of his "watchdog function"; whether the goods and/or services were within or outside the scope of opposer's field; and if outside, explain why. Thus, this record contains direct evidence from opposer as to why each of

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these third-party registered marks did not or would not cause opposer to take action against them. (For example, these third-party registrations range from applicant's Exhibit No. 9, Registration No. 2584255 for the mark SITEMASTER for "electric roadway lighting fixtures" clearly outside the scope of the goods involved herein, to applicant's Exhibit No. 30, Registration No. 2515656 for the mark SITENET for goods and services in International Classes 9, 35 and 37, and about which Mr. Saliaris testified that he had not seen it before but expressed some concern about the Class 37 identified services. Most of the third-party registrations fall in a middle range, such as Registration Nos. 2572117 and 2188034 (applicant's Exhibits Nos. 10 and 24, Saliaris dep. pp. 87-88 and 105-106), with clear explanations from opposer as to why these would not be within the scope of the goods opposer would protect through its "SITE" marks.)

Applicant also asked its witness, Mr. Steve Schoenberg, questions regarding whether he believed a customer of opposer's various "SITE" products would be a likely customer for the goods in about 25 of these third-party registrations. Not surprisingly, Mr. Schoenberg testified as to each one essentially yes, and he frequently stated that the identified goods in the third-party registrations involve computer software.

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Due to the reasons given by opposer as to why these marks are not a concern (with only the one exception of a registered mark and goods/services opposer was not previously familiar with), we cannot find that these third-party registrations establish that opposer's SITESCAN mark is weak.

Because we have found that the record does not support a finding that opposer's SITESCAN mark is strong, and it does not support a finding that it is a weak mark, we therefore accord opposer's SITESCAN mark the normal scope of protection otherwise afforded to registered marks. We specifically note that opposer's SITESCAN mark is registered on the Principal Register with no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b) of the Trademark Act.

Regarding the du Pont factor of "the nature and extent of any actual confusion," applicant argues in its brief that there is no evidence of actual confusion despite the fact that there has been simultaneous use of the parties' respective marks for about three years. Opposer argues that the nature of applicant's sales (generally to distributors) and the limited number of applicant's sales over a three-year period indicates that there has been no real opportunity for actual confusion to arise. On this record,

we agree with opposer that there has not yet been meaningful opportunity for actual confusion by customers or potential customers regarding opposer's mark SITESCAN and applicant's mark SITETRAK for their respective goods. See Carl Karcher Enterprises Inc. v. Stars Restaurant Corp., supra. Thus, we find that this factor is neutral. Moreover, the test is not actual confusion, but likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992).

Although applicant argues that the extent of potential confusion is "negligible" (brief, p. 46), and opposer argued that the potential for confusion is "extremely substantial" (brief, p. 25), we find that the evidence of record does not establish this factor either way. This duPont factor is neutral.

On balance, and considering all of the evidence on the relevant du Pont factors, and giving each such factor its appropriate weight in the circumstances of this case, we find that purchasers familiar with opposer's mark SITESCAN used for its computer based facilities management system would be confused when applicant uses SITETRAK as a mark for industrial monitoring devices.

To the extent we have doubt as to the presence of likelihood of confusion, we resolve that doubt against the newcomer (applicant) and in favor of the prior user and

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registrant (opposer). See *In re Pneumatiques, Caoutchouc Manufacture*, 487 F.2d 918, 179 USPQ 729 (CCPA 1973) (“If there be doubt on the issue of likelihood of confusion, the familiar rule in trademark cases, which this court has consistently applied since its creation in 1929, is that it must be resolved against the newcomer or in favor of the prior user or registrant.”) See also, *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997); and *In re Hyper Shoppes*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

We have found that there is a likelihood of confusion between opposer’s SITESCAN mark and applicant’s SITETRAK mark, when used on the parties’ respective identified goods. In the interest of thoroughness of this decision, we will also determine the issue of likelihood of confusion as to opposer’s six other marks, SITEMASTER, SITENET, SITELINK, SITEGATE, SITEI/O and SITETRAP. Simply put, on careful consideration of the record relating to each of those marks and opposer’s goods sold under each of those marks, we find that opposer has not proven by a preponderance of evidence its claim of likelihood of confusion with regard to any of these other six marks, which carry different connotations and cover different goods.

Decision: The opposition is sustained based on opposer’s SITESCAN mark.