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Hearing
March 19, 1997

Paper No. 24
RLS/TF

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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Antek Instruments, Inc.
v.
Sievers Instruments, Inc.

Cancellation No. 23,856

Rose A. Hagan and Carla C. Calcagno of Arnold, White & Durkee for Antek Instruments, Inc.

Glenn K. Beaton of Davis, Graham & Stubbs, LLC for Sievers Instruments, Inc

Before Rice, Simms and Hohein, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge.

Antek Instruments, Inc. (petitioner), a Texas corporation, seeks cancellation of a registration owned by Sievers Instruments, Inc. (respondent), a Colorado corporation. That registration, Registration No 1,788,003, which issued August 17, 1993, is for the mark SCD for "instruments; namely, sulfur chemiluminescence detectors for the detection of sulfur and non-sulfur compounds." As more fully indicated below, petitioner essentially argues that the registered mark should be canceled because it is a

generic initialism for respondent's goods. Both parties have submitted evidence, filed briefs and appeared at the oral hearing held in connection with this case.

The Pleadings

In its petition for cancellation, petitioner asserts that respondent is in the chemical instrumentation industry or, more particularly, the manufacturing and selling of devices for chemical detection, including sulfur chemiluminescence detectors. Petitioner asserts that it is a common practice in this industry to describe the instruments or processes by two- or three-letter acronyms, which are comprised of the initial letter of each word. For example, in the pleading petitioner asserts that flame ionization detection is referred to as "FID," and a flame photometric detector, a type of instrument used in several brands of chemical detectors, is known as a "FPD." According to petitioner, given this industry practice, the expected acronym for sulfur chemiluminescence detectors would be "SCD." Therefore, petitioner alleges that respondent's asserted mark is "the common descriptive name" for respondent's goods and has become the generic term of all such goods produced and sold by competitors. This registration, according to petitioner, impairs its right to use these letters because petitioner has been involved in the manufacture and sale of sulfur chemiluminescence

detectors. Petitioner also alleges that respondent's registration was obtained fraudulently because, in a telephone call with the Examining Attorney handling respondent's application, respondent's attorney indicated that the asserted mark was "coined or contrived" and that it "has no meaning [or] significance within the relevant trade or industry." According to petitioner, this statement was false and made with the intent to induce this Office to grant the registration.

In its answer, respondent has denied the essential allegations of the petition for cancellation, and has asserted that the petition is barred by laches, acquiescence, estoppel and unclean hands. Although the pleadings present more issues, the parties tried and briefed only the issue of genericness, and that is the only issue before us.

The Record

Pursuant to agreement, the parties have submitted affidavits in lieu of depositions and portions of depositions from a patent case in which the parties were involved. In addition to the affidavit of petitioner's chief operating officer, petitioner has also relied upon

¹ Moreover, the defenses asserted by respondent are inapplicable to the claims of genericness and/or fraud. See *TBC Corp v Grand Prix Ltd*, 12 USPQ2d 1311, 1313 (TTAB 1989), *Care Corp v. Nursecare International, Inc*, 216 USPQ 993, 995 (TTAB 1982), *American Speech-Language-Hearing Assn V National Hearing Aid*

discovery responses of respondent as well as numerous printed publications.²

According to this record, petitioner is in the business of designing, assembling, manufacturing, promoting, selling and servicing scientific instruments for chemical detection. Petitioner's affidavit of its chief operating officer, Randy Wreyford, sets forth the following facts. Mr. Wreyford has been involved in the chemical detector industry since 1972, with his duties and responsibilities including oversight of the assembly, serving, testing and selling of most products offered by petitioner, including gas chromatographs (GCs) and nitrogen and sulfur analyzers. He states:

2. In my experience, it is a common practice in the chemical instrumentation industry to describe the instruments or processes by two- or three- letter acronyms, which are comprised of the initial letter of each word or term. For example, flame ionization detection, a type of process used in several brands of chemical detectors, is known as "FID." Gas chromatography, a process used to determine the fixed gas and organic component composition of natural gas, is known as "GC." Other commonly used and accepted industry acronyms are TCD (thermal conductivity detector), FPD (flame photometric detector), HID (helium ionization detector), PID (photometric ionization detector), NPD (nitrogen phosphorous detector), DID (discharge ionization detector) and others. Given this industry practice, the expected

Society, 224 USPQ 798, 804 at n. 4 (TTAB 1984) and cases cited therein

² Respondent's objection raised in its brief to petitioner's notice of reliance on the printed publications is overruled. The only issue in this case is the genericness of the letters SCD and we believe that the general relevance of the printed publications is obvious

acronym for sulfur chemiluminescence detectors would be "SCD."

3. On many occasions, I have heard people in the industry refer to all sulfur chemiluminescence detectors by the acronym "SCD ". It has been my experience that "SCD" is the acronym used by the industry generally to refer to sulfur chemiluminescence detectors.
4. Besides registrant Sievers Instruments, Inc., other companies in the industry use the acronym "SCD" to refer generically to sulfur chemiluminescence detectors. One such company is Fluid Data. Attached as Exhibit 1 to this Affidavit is a true and correct copy of a Fluid Data brochure from 1993. The third page of that brochure states "This system of sulfur detection is known as a Sulfur Chemiluminescence Detector (SCD) The SCD developed by Fluid Data is virtually unaffected by hydrocarbon or carbon dioxide quenching."
5. Attached as Exhibit 2 to this Affidavit is a true and correct copy of a Fluid Data brochure from 1994. The fourth page of the brochure states. "Detector Capability: Up to three FID, TCD, FPD, ICD, SCD or DIT, in any combination." It is my understanding that these acronyms refer to the various chemical detectors, and that "SCD" stands for sulfur chemiluminescence detector

Mr. Wreyford also refers to a document (the ASTM³ Committee D-2 Report) of the proposed industry standard test method for the determination of sulfur compounds in petroleum gases and light liquids by gas chromatography and selective chemiluminescence detection. This document uses SCD to refer to sulfur chemiluminescence detectors.

4.3 *Sulfur Chemiluminescence Detection.* As sulfur compounds elute from the gas chromatographic column they are combusted in a flame ionization detector (FID). These combustion products are collected and transferred to a sulfur chemiluminescence detector (SCD). This detection

technique provides a highly sensitive, selective, and linear response to volatile sulfur compounds and may be used while simultaneously acquiring the usual fixed gas and hydrocarbon determinations. The SCD demonstrates greater than 10^5 linearity, part-per-billion (low picogram) sensitivity, and greater than 10^6 selectivity for sulfur compounds over hydrocarbons. The detector is not subject to quenching of sulfur compound response or interference from co-eluting compounds at the usual GC sampling volumes.

Elsewhere in this report, the following statements can be found:

6.1.5 *Detector* - Both a flame ionization detector (FID) and a sulfur chemiluminescence detector (SCD) are used

The detector design must be such to allow the insertion of the SCD sampling probe into the flame without interrupting the detection of the hydrocarbon response.

6.1.5.2 *SCD* - The sulfur chemiluminescence detector shall meet or exceed the following specifications

These combustion products are collected and removed from the flame using a ceramic sampling tube (probe) interface and transferred through a flexible tube to the reaction chamber of the sulfur chemiluminescence detector (SCD)

The column will also demonstrate a sufficiently low liquid phase bleed at high temperature such that no loss of the SCD sulfur response is encountered while operating the column at 300° Centigrade

A dual channel system is useful for simultaneous presentation of both the FID and SCD signals.

8. Preparation of Apparatus

8.2 *SCD*-Place in service in accordance with the manufacturer's instructions. With the FID flame ignited, put the probe assembly in place.

The Fluid Data brochure states:

This system of sulfur detection is known as a Sulfur Chemiluminescence Detector (SCD). The response from the reaction is linear over at least five orders of magnitude. It also demonstrates a selectivity to sulfur over carbon of 10^6 to 10^8 to one. The SCD developed by Fluid Data is virtually unaffected by hydrocarbon or carbon dioxide quenching.

Combustion of the sample in the dual-flame of the SCD serves to breakdown the large carbohydron molecules to maximize the sensitivity and selectivity of the detector.

The brochure also indicates as follows:

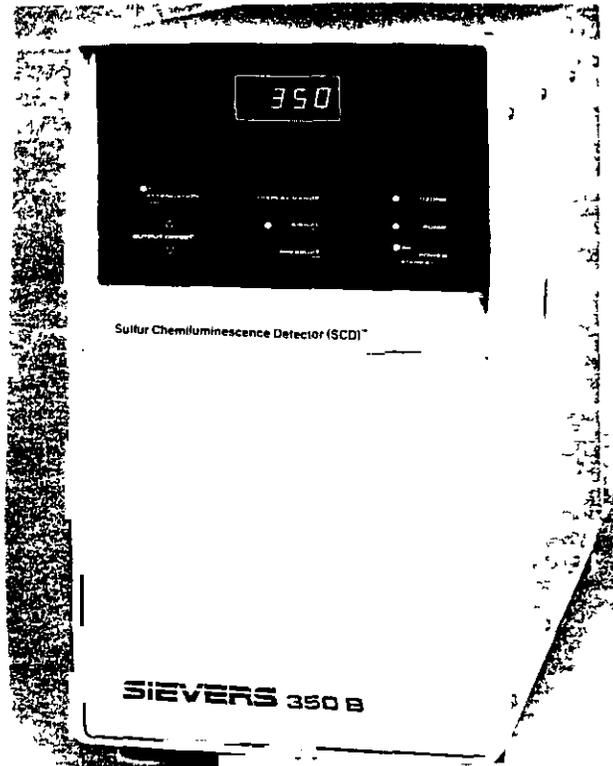
"Detector Capability. Up to three FID, TCD, FPD, ICD, SCD, or TID, in any combination. Simultaneous integration of all three signals."⁴

Mr. Wreyford also notes that respondent uses the initialism SCD to refer to "sulfur chemiluminescence detection." Respondent's product literature contains the following statement: "Gas chromatography with sulfur chemiluminescence detection (SCD®) provides a rapid means to identify and quantify various sulfur compounds that may be present in miscellaneous petroleum feeds and products, such as gasoline." Elsewhere in respondent's literature, respondent uses SCD in a more traditional trademark sense. For example, "Sievers Model 355 SCD®." Respondent also uses the initialism as follows: "Gas chromatography with a Model

⁴ Respondent has noted that this record contains no evidence that the Fluid Data brochure was distributed to potential customers or that there was commercial activity by this competitor. We have accorded relatively little weight to this brochure.

355 sulfur chemiluminescence detector (SCD®) was used to generate this chromatogram."

The mark appears as follows on respondent's goods:



The printed publications petitioner has made of record include dictionaries of acronyms and abbreviations, some of which do not include the letters "SCD" and one which does but specifically, points out that the inclusion of an entry is not a reflection of its status as a trademark. With respect to the scientific and trade journal articles, made of record by petitioner, selected excerpts follow:

Recently, two other selective detectors have become commercially available for the analysis of sulfur compounds, the atomic emission detector (AED) and the sulfur chemiluminescence detector (SCD). The performances of SCD and AED were recently compared.

The SCD was originally developed for the analysis of sulfur compounds in air.

The SCD demonstrates many advantages for the analysis of sulfur compounds in complex hydrocarbon matrices

Randy L. Shearer, Elizabeth B. Poole and Joe B. Nowalk, "Application of Gas Chromatography and Flameless Sulfur Chemiluminescence Detection to the Analysis of Petroleum Products," Journal of Chromatographic Science, March 1993

* * * * *

Sulfur Chemiluminescence Detection. As sulfur compounds elute from the gas chromatographic column they are combusted in a hydrogen-rich flame of a flame ionization detector (FID) producing numerous combustion products, one of which is sulfur monoxide (Reaction 1). These combustion products are collected and removed from the flame using a ceramic sampling tube (probe) interface and transferred through a flexible tube to the reaction chamber of the sulfur chemiluminescence detector (SCD)...

SCD - The sulfur chemiluminescence detector shall meet or exceed the following specifications

Neil G Johansen, Sievers Research, Inc., "Method for the Determination of Sulfur Compounds in Petroleum Gases and Light Liquids by Gas Chromatography and Selective Chemiluminescence Detection"

* * * * *

- A field evaluation of the sulfur chemiluminescence detector (SCD) as a real-time total atmospheric sulfur detector is presented. The SCD was installed in a monitoring trailer along with a flame photometric detector (FPD)

A commercial version of the SCD (Sievers Research, Inc ; SCD Model 350) has also been evaluated as a gas chromatographic (GC) detector

Richard Benner and Donald Stedman, "Field Evaluation of the Sulfur Chemiluminescence Detector," Environ Sci. Technol., Vol. 24,

No. 10, 1990

* * * * *

The sulfur chemiluminescence detector (SCD) is a sensitive, highly selective sulfur detection system based on reaction in hydrogen/air combustion followed by extraction and low-pressure chemiluminescence. This report documents investigations into the fundamental chemical processes occurring in the SCD.

Richard L. Benner and Donald H. Stedman, "Chemical Mechanism and Efficiency of the Sulfur Chemiluminescence Detector," Applied Spectroscopy, Vol. 48, No. 7, (1994)

* * * * *

The most widely used sulfur-selective detector for gas chromatography has been the flame photometric detector (FPD)

The atomic emission detector (AED) is a multi-element detector that can be used for sulfur compounds

The limitations of existing sulfur-selective detectors for gas chromatography led to the development by Benner and Stedman of a new sulfur-selective detector, the sulfur chemiluminescence detector (SCD)

Richard Hutte, "The sulfur chemiluminescence detector," Chromatography in the Petroleum Industry, 1995

* * * * *

A new chemiluminescence (CL) technique has recently been developed which reportedly showed a large enhancement in the detection limits for small sulfur-containing compounds. Reported by Benner and Stedman, the new technique called the sulfur chemiluminescence detector (SCD) showed a factor of 10 to 100 improvement in the detection limit for SO

"Chemiluminescence from Sulfur Compounds in Novel Flame and Discharge Systems Proof of Sulfur Dioxide as the Emitter in the New Sulfur Chemiluminescence Detector," Applied

Spectroscopy, Vol. 46, No. 6 (1992)

* * * * *

Detection schemes for the volatile tellurium gases include flame ionization (FID), flame photometric (FPD), and thermal conductivity detection (TCD)

Earlier work performed in our laboratory led to the development of a sulfur chemiluminescence detector (SCD) that detects the visible light generated in the gas phase reaction of an analyte with fluorine

Chasteen, Silver, Birks, Fall, "Fluorine-Induced Chemiluminescence Detection of Biologically Methylated Tellurium, Selenium, and Sulfur Compounds," Chromatographia (August 1990)

* * * * *

The most widely used sulfur-selective detector for gas chromatography is the Flame Photometric Detector (FPD)

An attractive alternative to the FPD is the Sulfur Chemiluminescence Detector (SCD)

The performance characteristics of the SCD for use as an atmospheric monitor

Hutte, Johansen, and Legier, "Column Selection and Optimization for Sulfur Compound Analyses by Gas Chromatography," Journal of High Resolution Chromatography, June 1990

* * * * *

As indicated, petitioner also made of record portions of the testimony depositions from the patent case, a civil action in the United States District Court for the Southern District of Texas. Part of the testimony of Mr Neil Johansen (at 20) is set forth below:

Q. While you were at Sievers, was "SCD" commonly used as an acronym for sulfur chemiluminescent device"?

A. Yes.

B. To your knowledge, is SCD a commonly accepted acronym for sulfur chemiluminescent device throughout the industry?

A. I'm not sure throughout the industry.

The following is found in the testimony of Dr. Stedman (at 81, 82).

Q I direct you to the first sentence which reads "The sulfur chemiluminescence detector (SCD) is based on the use of a hydrogen flame to convert sulfur species to SO."

My question to you, Dr. Stedman, is whether the Benner-Stedman device is a SCD?

A. Yes.

Q. Yes?

A. Yes. As defined here, SCD is sulfur chemiluminescence detector.

Q Who else makes SCDs?

A. I know of only two places where that term has been used and that's my laboratories and the instruments that Sievers Instruments builds.

Q. What is your understanding of the meaning of the term "SCD"?

A. That is a term mostly used by Sievers Instruments to describe their particular device. I don't know if it's a protected term or not.

Q. Has Sievers Instruments or anyone employed with Sievers Instruments criticized you for using the term "SCD" as in this article and not indicating that it is a trademark of Sievers?

A. We were not so criticized, no.

Q. Have you since been criticized?

A. No, we have not.

Q. Has anyone at Sievers asked you in future publications to indicate that the term SCD is a trademark of Sievers?

A. No, they have not.

Respondent's record includes six affidavits, some of which indicate that the letters SCD comprise a trademark used by respondent to identify its sulfur detectors and that

the affiants are not aware of use thereof by other manufacturers or sellers to describe their sulfur detectors. The affidavit of Randy Shearer, a member of the industry ASTM Committee, indicates that there were no other competitive devices on the market until late 1993 when petitioner introduced its product called a chemiluminescence sulfur detector (CLSD).⁵ (Respondent introduced its detector, Model 300 SCD, in 1987 or 1988.) Both Mr. Shearer and Dr. John Birks, a consultant and former director of respondent, indicate in their affidavits that the use of the term SCD in articles which they authored refers only to respondent's sulfur detectors and to no others.

According to the affidavit of Mr. Donald Stedman, the co-developer of respondent's detector and a current consultant of respondent's

- 2 [Richard Benner] and I developed the device now known as the Sulfur Chemiluminescence Detector (SCD) which we applied for and obtained patent rights upon and the rights for which were licensed to Sievers Instruments by the University of Denver. Throughout this time period Sievers Instruments has insisted to me that we use the letters SCD as a trademark to distinguish their commercial product. For instance on page 135 of Benner's 1981 PhD Thesis there appears a picture of the MODEL 350 SCD™ detector.
3. As I understand the use of trademarks, the trademark SCD is used by Sievers Instruments

⁵ The introduction of that device led to respondent's patent infringement suit against petitioner in federal court. In respondent's discovery responses, respondent states that there has been customer confusion between the mark SCD and petitioner's initialism CLSD.

Inc. to identify its goods and distinguish them from those manufactured or sold by others. I am unaware of the use of the trademark SCD by any manufacturer or seller other than Sievers to describe commercially available sulfur detectors. In the process of our research we have used SCD systems directly, and adapted them and made our similar units and may not have always used the TM superscript when describing those systems which we have used, but they were never commercially available systems, rather we have used the letters SCD to describe home-built instruments based upon the same design and technology which if [sic] sold on the commercial market.

4. The following publications authored by me or partly by me use the trademark SCD. The trademark as used therein refers either to devices manufactured by Sievers or to non-commercial devices manufactured by myself.

For rebuttal petitioner has relied upon portions of the testimony from the patent case (three depositions).⁶ In the deposition of Dr. Stedman, he testified as follows (upon examination by petitioner's attorney).

Q. My question to you, Dr. Stedman, is whether the Benner-Stedman device was a SCD?

A. Yes

Q. Yes?

A. Yes. As defined here, SCD is sulfur chemiluminescence detector.

Q. Who else makes SCDs?

⁶ For its rebuttal, petitioner moved to use this deposition testimony. The Board granted this motion as uncontested on August 15, 1996. Petitioner claims that this deposition testimony contradicts statements made in the affidavits of these witnesses submitted by respondent.

A. I know of only two places where that term has been used and that's my laboratories and the instruments that Sievers Instruments builds.

Q. What is your understanding of the meaning of the term "SCD"?

A. That is a term mostly used by Sievers Instruments to describe their particular device. I don't know if it's a protected term or not.

Q. Has Sievers Instruments or anyone employed with Sievers Instruments criticized you for using the term "SCD" as in this article and not indicating that it is a trademark of Sievers?

A. We were not so criticized, no.

Q. Have you since been criticized?

A. No, we have not.

Q. Has anyone at Sievers asked you in future publications to indicate that the term SCD is a trademark of Sievers?

Also, petitioner introduced excerpts from the testimony of Dr. Birks and Dr. Richard Hutte, a senior scientist with respondent, both taken on April 3, 1996, in the Texas patent litigation

Q. Do you see a reference to an Antek SCD?

A. Yes.

Q. Is that a proper way to describe the Antek 704?

A. Well, as a scientist, we often use acronyms, and so electron capture detector is an ECD no matter who makes it. I understand SCD might be a trademark. I don't know if it's a trademark or not of Sievers Instruments -

Q. But without specific knowledge that it is a trademark, it would have been your expectation that it was merely an acronym just like the ECD you told me about?

A. Right.

Q. And that's why you refer to the Antek device as an SCD?

A. Yes.

(Dr. John Birks)

* * * * *

A. SCD, in my nomenclature, refers to the chromatography detector. 357 is not a chromatography detector.

Q. And does the SCD refer only to Sievers chromatography detectors?

A. SCD is a registered trademark of Sievers Instruments.

Q. I'm aware of that. I'm asking you whether the term SCD, a trademark or not, refers only to Sievers Instruments or other instruments, in your nomenclature

A. In my nomenclature, it refers to the Sievers products.

Q. And does SCD mean sulfur chemiluminescent detector?

A. SCD is just a trademark.

Q. Is SCD an acronym for those three words, sir?

A. Historically, yes, that's where it came from, but

(Dr. Richard Hutte)

Arguments

Essentially, it is petitioner's position that the parties are competitors in the manufacturing and selling of sulfur chemiluminescence detectors, and that the initials SCD are generic for sulfur chemiluminescence detectors. As evidence of its genericness, petitioner points to the product literature of Fluid Data, the scientific journals which have used the letters SCD to refer to sulfur chemiluminescence detectors in the same manner that they have used other acronyms and initialisms, the ASTM standard test methods article as well as respondent's own occasional use of the letters to refer to the process of sulfur

chemiluminescence detection. According to petitioner, both "sulfur chemiluminescence detector" and the abbreviation "SCD" are generic and to allow respondent the exclusive right to use these initials prevents the trade and the public from using the common, expected abbreviation for "sulfur chemiluminescence detector." Also, petitioner relies upon the fact that the chemical instrumentation industry frequently uses two- and three-letter acronyms for various instruments and processes. According to petitioner, SCD has fallen into the lexicon of the chemical-testing field and designates a particular class of sulfur detection equipment rather than one specific sulfur chemiluminescence detector.

Respondent, on the other hand, argues that petitioner has not proven that its registered mark is generic. Respondent's attorney admits that respondent's scientists have sometimes used the letters SCD as "the 'wrong' part of speech." Respondent's brief, 8. However, respondent argues that it has never used the letters SCD to refer to anything other than its own sulfur chemiluminescence detector, and that its product literature shows the use of the TM symbol before the letters were registered and use of the registration symbol after the asserted mark was registered. Respondent also points out that the chairman of the committee that promulgated the industry standard received a

letter from respondent that the letters SCD were a registered trademark. Thereafter, these letters were removed from the ASTM standard. Concerning the scientific articles of record, respondent argues that the letters SCD therein refer to its device or specifically mention that respondent is the source of the detector. Respondent also argues that there is no evidence that others use the letters SCD as a trademark for their detectors or that consumers associate these letters with anything other than respondent's product

Discussion

Upon careful consideration of this record, we believe that petitioner has established that the letters SCD are used and understood in the trade (by analytic chemists and others) as the generic shorthand name for a sulfur chemiluminescence detector. It is clear that initials cannot be considered descriptive or generic unless they are so generally understood as representing descriptive or generic words as to be accepted as substantially synonymous therewith. *Modern Optics, Inc. v. The Univis Lens Co.*, 110 USPQ 293, 295 (CCPA 1956); *Intel Corp. v. Radiation Inc.*, 184 USPQ 54, 57 (TTAB 1974), and *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, § 12:37 (4th ed. 1996). We believe that petitioner has clearly demonstrated that the practice in the trade is to use

acronyms and initialisms in place of somewhat unwieldy names. Aside from the use of the letters SCD in the ASTM standards, the use of these letters in the scientific journal articles demonstrates this practice. These letters are clearly used as an abbreviation to refer to a type of product on the market -- a sulfur chemiluminescence detector. This use is similar to use of other initialisms, as petitioner has argued. While it may be that respondent was, at one time, the only manufacturer or seller of such a device, these letters are nevertheless understood as a generic identifier and not as a trademark indicating source or origin of the product. Respondent's placing of the TM symbol or the registration symbol next to these letters has not prevented these letters from being or becoming the generic identifier for a sulfur chemiluminescence detector. In this regard, we also note the rather unusual way in which respondent has chosen to display its asserted trademark. This use, in parentheses after the admittedly generic name "Sulfur Chemiluminescence Detector," tends to reinforce the generic significance of the letters SCD. Because we believe that petitioner has shown, on this record, that the letters SCD are or have become the generic identifier for a type of product---a sulfur chemiluminescence detector---the registration must be canceled.

Cancellation No. 23,856

Decision: The petition to cancel is granted and respondent's Registration No. 1,788,003 will be canceled in due course.


J. E. Rice


R. L. Simms


G. D. Hoheln

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

09 APR 1998