

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

SERIAL No.: 77396813 :
 FILED: 14 Feb. 2008 :
 MARK: DITTO PRO : ESTTA 350394
 ATTORNEY: John J. Okuley :
 APPLICANT: Asist, Inc. :

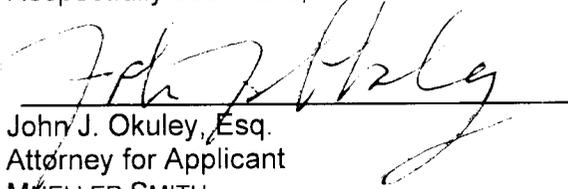
To: Trademark Trial and Appeal Board
 U.S. Patent and Trademark Office
 P.O. Box 1451
 Alexandria, VA 22313-1451

APPLICANT'S TRANSMITTAL OF APPEAL BRIEF

To the Trademark Trial and Appeal Board:

Applicant herewith submits its Appeal Brief.

Respectfully submitted,



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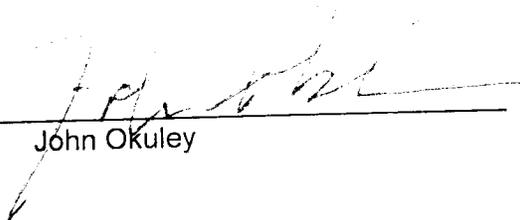


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Applicant appeals the trademark examining attorney's refusal to register the trademark DITTO PRO on the ground that the mark is confusingly similar to the registered mark DITTOCAM (Serial No. 78461063) under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

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Argument

I. The Board should reverse the Examining Attorney's § 2(d) refusal to register Applicant's mark.

The Examining Attorney has refused to register Applicant's mark on the ground that it so resembles Registrant's mark that it is likely that potential consumers will be confused or mistaken or deceived as to the source of the parties' services. The Examiner cited the similarity of the marks, similarity of the services, and the similarity of the trade channels as the relevant and controlling du Pont factors in his analysis.

Applicant respectfully requests this Board to review the Examiner's analysis of the du Pont factors, which relied heavily upon an incorrect characterization of the relatedness of the parties' services and corresponding trade channels. As this Board well knows, a mischaracterization of one factor can have a magnified effect on the overall analysis, because any one factor can influence the consideration of other factors. See, Perfumebay.com v. eBay Inc., 506 F.3d 1165, 1174 (9th Cir. 2007). Here, the Examiner erred when concluding that the services are closely related because "registrant's services encompass the applicant's video teleconferencing services," and because certain third party registrations "suggest that the...services listed therein are of a kind that may emanate from a single source."

Such an error requires this Board's intervention. The mischaracterization resulted in the Examiner concluding that the related factors of trade channels, customer sophistication, and conditions of sale weighed in favor of a finding that

a likelihood of confusion existed between the marks – a conclusion that was without evidentiary support. It also resulted in the Examiner affording more evidentiary weight than necessary to the similarities between the marks at issue.

A. Applicant's services are not closely related to Registrant's services, nor are they of a character that indicates a likelihood of consumer confusion.

Generally, the likelihood of consumer confusion regarding the source of two parties' services is influenced by the relationship of those services in the mind of the consumer. Team Tires Plus, Ltd. V. Tires Plus, Inc., 394 F.3d 831, 834 (10th Cir. 2005). The more closely the services are related, the more likely it becomes that consumer confusion as to their source will occur. Id. The issue under this factor is not necessarily whether the services are *in fact* related to each other, but whether consumers would associate the services and expect them to come from the same source. In re Total Quality Group, Inc., 51 U.S.P.Q.2d 1474, 1476 (T.T.A.B. 1999).

Neither the plain language found in both Applicant's and Registrant's identifications of their respective services, nor the third party registrations cited by the Examiner demonstrate that the parties' services are related in a manner that indicates a likelihood of consumer confusion as to their source.

1. The plain wording of both Applicant's and Registrant's identification of their services demonstrates that the services are not identical or overlapping.

It is well settled that a likelihood of confusion between marks in a § 2(d) analysis should be determined on the services as they are set forth and identified in the application and registration at issue. In re Total Quality, 51 U.S.P.Q.2d at

1474 (citing Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490 (Fed. Cir. 1987); In re Elbaum, 211 U.S.P.Q. 639 (T.T.A.B. 1981)). Here, Applicant has applied to register the mark DITTO PRO for "video teleconferencing." The mark cited against Applicant is DITTOCAM for "radio *broadcasting* services; telecommunications services, namely, *broadcasting* of real time images via the global computer network."

Applicant first requests this Board to take judicial notice of the following dictionary definitions, taken from Webster's Encyclopedic Unabridged Dictionary of the English Language (1996 ed.). Such evidence is proper subject matter for judicial notice. In re Total Quality, 51 U.S.P.Q.2d at 1475 (citing Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372 (Fed. Cir. 1983)).

The services identified in Registrant's registration both utilize the term *broadcasting* in their description. Webster's defines broadcasting in verb form as: (1) to transmit (programs) from a radio or television station; (2) to speak, perform, sponsor, or present on a radio or television program; (3) to cast or scatter abroad over an area, as seed in sowing; (4) *to spread or disseminate widely*; (5) to divulge or indicate unwittingly to one's opponent (one's next offensive move); (6) to transmit programs or signals from a radio or television station; (7) *to scatter or disseminate something widely*; and (8) to speak, perform, sponsor, or present all or part of a radio or television program. It is evident from these definitions that registrant's services primarily involve disseminating information to a wide audience. Thus, Registrant's services are defined

principally through the provision of one-to-many communication methods, which is expected of radio program-related technology services.

Applicant's identification of its services, on the other hand, indicates that the mark will be used in conjunction with video teleconferencing services. The Merriam-Webster Online Dictionary, containing the print version of Merriam-Webster's Collegiate Dictionary, Eleventh Edition, defines teleconferencing as "the holding of a conference among people remote from one another by means of telecommunication devices (as telephones or computer terminals)." Therefore, Applicant's services are rendered to facilitate communications between multiple parties – two-way communication services.

When both parties' services are defined correctly, it is easy to see that a conclusion that equates the services is akin to equating direct mail letters to classified newspaper advertisements. Both direct mail letters and classified ads utilize similar distribution *technology*, namely, the physical deliveries of paper documents, but are completely different methods of communication. This is precisely the incorrect target of the Examiner's focus – the provision of both parties' services involves the transmission of real time images via the Internet. By reading Registrant's identification of its services to encompass *any* transmission of real time images, the Examiner failed to take note that those services are limited to the *broadcasting* or real time images. Registrant broadcasts; Applicant does not.

This interpretation of the parties' services as identified also is supported by the parties' actual respective services. While such evidence is admittedly not

admissible to prove what the parties' services actually are, In re Total Quality, 51 U.S.P.Q.2d at 1474, Applicant offers them as supporting evidence for its interpretation of the services as identified. Applicant utilizes its mark in conjunction with video conferencing software and services and related multi-language translation services, in order to facilitate conversational, constructive communication between relatively small groups of people. Registrant, on the other hand, utilizes its mark in conjunction with radio broadcasting services for radio shows, such as the Rush Limbaugh show, and incidental Internet video broadcasts – streaming one-way video – of the radio show.

As previously mentioned, the relatedness of two parties' services is dependent upon whether consumers would associate the services and expect them to come from the same source. In re Total Quality, 51 U.S.P.Q.2d at 1476. In his rejection, the Examiner did not discuss how consumers would associate the services, merely concluding that the services were rendered "to the same type of customers." As shown above, however, the services at issue here *are* distinct, although they utilize similar technology to effect satisfactory service – namely, the transmission of real time images over the Internet. While some case law arguably supports an assertion that services available on the Internet are more likely to be found related merely because of their relationship with the Internet, more recent decisions rightfully place confidence in the sophistication of modern Internet users and their ability to differentiate between services provided on the Internet. Instant Media, Inc. v. Microsoft Corp., No. 07 Civ. 2639, 2007 U.S. Dist. LEXIS 61443, at *25-28 (N.D. Cal.); but cf. GoTo.com, Inc. v. Walt

Disney Co., 202 F.3d 1199, 1206-1207 (N.D. Cal. 2000) and Jupiter Hosting Inc. v. Jupitermedia Corp., 76 U.S.P.Q.2d 1042, 1044-1045 (N.D. Cal. 2004).

The Instant Media case is useful to the issue here. In that case, the plaintiff Instant Media sued Microsoft for trademark infringement of its registered mark, used in conjunction with its high definition video player software that it used to broadcast promotional campaigns for retailing services. Id. at *2-3. Microsoft used a similar mark in connection with its instant messaging services with voice and video capabilities. Id. at *6-8. The Instant Media court reasoned that “in 2007, where iPods and instant messaging are household concepts, this Court cannot say that, as a matter of law, ‘it is irrelevant whether the parties’ Internet related services are different.’” Id. at *28. Deciding that no likelihood of confusion existed, the court held that the parties’ goods “superficially overlap with regard to video capability,” citing that fact that Microsoft’s software did not enable users to *broadcast* video or audio programs. Id. at *32.

The instant case runs parallel to the Instant Media case in that the parties’ software enabled two very different types of communication via the same general technological channels. Just as in that case, Applicant’s identified services do not enable the broadcasting of video to Internet users all over the world. Conversely, Registrant’s identified services do not encompass – or even involve – video teleconferencing. Therefore, an analysis of the plain language of the parties’ services as identified in their respective writings demonstrates that the Examiner’s conclusion that the more specific services identified by Applicant are encompassed within Registrant’s broad identification is based on a

misinterpretation of those identifications. Furthermore, the Examiner's later arguments supporting a finding that Applicant's services are within the field of likely expansion of Registrant's services belie the conclusion that the parties' services are overlapping. One cannot exist in a space while simultaneously expanding into that same space.

2. The third party registrations cited by the Examining Attorney do not demonstrate that Applicant's services exist as a subset of Registrant's services.

The Examining Attorney cited fifteen trademark registrations as evidence "that the respective services commonly emanate from a single source and are within the normal field of expansion of either party." Other than the conclusory statements that the third party registrations demonstrate a common source for the services, the Examiner failed to discuss or point out which registrations were particularly probative or relevant of the issue. For example, the Examiner submitted Serial No. 3,254,144 as support. However, that registration applies to "providing telecommunications, namely, audio and video teleconferencing of *seminars and workshops* to a global computer network" and does not clearly demonstrate that both Applicant's and Registrant's services here are offered under one mark.

The Examiner also concluded – without explanation – that the cited registrations demonstrated a likelihood of confusion, while failing to address the ultimate issue: whether consumers, when seeing the marks used with the respective services, would be likely to attribute common source or origin. In re 1st USA Realty Prof'ls, Inc., 84 U.S.P.Q.2d 1581, 1584 (T.T.A.B. 2007). Several

points must be made with regard to these third party registrations. First, the fact that several entities have obtained registrations for marks used in conjunction with both the services of the Applicant and services of the Registrant significantly weakens the Examiner's prior assertion that "registrant's services encompass the applicant's video teleconferencing services." If that were truly the case, there would be no reason for third parties to list the specific identification of a service that is encompassed within a broader service that also is identified.

Furthermore, the Examiner cites the third party registrations as evidence that the parties' respective services "are within the normal field of expansion of either party." This is logically incompatible with the Examiner's aforementioned conclusion that Applicant's services are encompassed by Registrant's services, as one cannot possibly offer a particular service and simultaneously expand to offer that very same service.

Here, many of the registrations cited by the Examiner are for marks used in connection with goods and services that run the gamut of the telecommunications class (e.g., Reg. Nos. 2,845,269, 2,995,724, 3,391,868, 3,428,277). Marks used in conjunction with "Internet telephony services," "DSL services," "long distance telephone communication services," and "electronic transmission of voice, data information and images" (Reg. No. 2,995,724) should be viewed distinctly from marks used in conjunction with individual, specialized telecommunication services, such as Applicant's and Registrant's identified services. Telecommunications companies that provide the infrastructure and connectivity required for accessing the Internet will necessarily be involved in

almost *all* types of communication services. This is common, and even unsophisticated consumers would surely differentiate those marks utilized with such broad types of services from companies that offer specific types of communications and related services.

B. The conditions surrounding the sale of Applicant's and Registrant's services, the trade channels through which they are delivered, and the respective customer bases and characteristics demonstrate that the services are not related.

Having established that the parties' services are not overlapping and are not significantly related, Applicant points to evidence from the remaining du Pont factors that supports such a finding. The factor that weighs most heavily in favor of Applicant in this context is the condition under which sales are made and the buyers to whom the sales are made. In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Registrant's relevant consumer groups are those seeking "the broadcasting of real time images via the global computer networks." The plain language of Registrant's identification of its services leads one to the conclusion that no more than two types of consumers must exist with respect to these services: consumers seeking to broadcast real time images over the Internet, and consumers wishing to receive a broadcast of real time images over the Internet. Applicant's services, on the other hand, are identified as "video teleconferencing" services, and would generally be marketed to and consumed by two groups of consumers: consumers that wish to communicate by dialogue with other parties, and non-participatory third parties that benefit from the use of

the service (*i.e.*, corporations that employ video teleconferencing for logistical and productivity purposes).

Clearly, these groups of consumers have wildly divergent needs and consequentially, the conditions surrounding the marketing, purchase, and rendering of the services are distinctly different. The consumers to which services of a nature similar to Applicant's are marketed would seek out firms that advertised two-way communication abilities, video teleconferencing, and other related services, such as the ability to project documents alongside the image of the person speaking. A consumer wishing to use video teleconferencing services would also need to enter into service with at least one *other* consumer for the service to work, and those multiple consumers must have some communication need with each other for them to seek the service out. When broadcasting video as Registrant does, however, each consumer need only have the desire to watch the relevant video feed, even though many other consumers may be simultaneously receiving the signal.

The coordinated communication efforts that are required by Applicant's services necessarily have a higher cost to the party providing the service than would the provision of simple broadcasting of real time images. This observation is reflected in the actual practices of the parties, as expected. Applicant's communication services cost the average user \$x,xxx, whereas the end users of Registrant's services are offered the service as a perk incident to a subscription to a radio show club. The vastly divergent prices of the services at issue

therefore demonstrate that consumers are not likely to confuse the origin of the parties' services.

C. Applicant's mark is not similar enough in sight, sound and meaning to Registrant's mark to support a finding that a likelihood of confusion exists between the marks.

The mark in question is not visually identical to the cited mark. The mark as a whole must be viewed since that is what consumers (here, different classes of consumers) confront. The marks at issue, then, are "DITTOCAM" and "DITTO PRO". All distinctions are relevant when determining the likelihood of confusion since all known circumstances surrounding the use of a mark must be examined. du Pont, 177 U.S.P.Q. at 567. According to du Pont, the question of confusion is related not to the nature of the mark, but to its effect "when applied to the goods of the applicant." Id. This is especially true when distinct services are supplied to different customers for different uses.

The DITTOCAM mark indicates that the products or services of the Registrant involve a camera, which indeed they do. Applicant's DITTO PRO mark is used on an entirely different set of services, as discussed above – services that overlap with Registrant's only to the extent that they incidentally utilize similar technological channels. DITTO, in the context of Applicant's services, is an acronym for "Digital Interpreting, Translation, and Transliteration Online." The customer base of the distinctly different associated services are themselves clearly distinct, greatly reducing the impact of the Examiner's observation that "the applicant's mark is similar to the registered mark in sound, appearance, and connotation because of the shared dominant term DITTO."

Given the distinctions discussed above regarding the parties' trade channels, relatedness of services, and customer bases, the fact that the marks share the term "DITTO" is not enough to create consumer confusion.

Conclusion

For the foregoing reasons, Applicant respectfully moves this Board to reverse the final decision of the Examining Attorney refusing to register based on § 2(d) of the Trademark Act, 15 U.S.C. 1052(d), and order the mark to be registered.

Respectfully Submitted,

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Date: 07 September 2010

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