TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Chengdu AOBI Information Technology Co.,Ltd

Serial Number: 77722665

Filing Date of Application: April 27, 2009

Mark: IOBIT

APPEAL BRIEF

Applicant respectfully requests that the mark IOBIT be approved for registration as Applicant believes the mark is valid and does not cause a possible likelihood of confusion with any other registered or pending mark.

The examining attorney has refused registration of this mark due to a possible likelihood of confusion between this mark and the mark IOBYTE found in U.S. Registration Number 2557070 (registry's extract included). The Applicant does not feel that there is a likelihood of confusion as the applicant has used the mark IOBIT for over five years now with no actual confusion regarding the source of the goods

In considering what factors are relevant to a determination of likelihood of confusion, it is helpful to turn to In re E. I. du Pont de Nemours & Co., 476 F. 1357, 177 USPQ 563 (C.C.P.A. 1973). The Court of Customs and Patent Appeals discussed likelihood of confusion and the decisional process involved, as follows:

09-21-2010

The phrase 'on account of its nature' in Sec. 2 clearly applies to the "resembles' element of Sec. 2(d). But 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.' The only relevant application is made in the marketplace. The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.

The Decisional Process

The ultimate question of the likelihood of consumer confusion has been termed a question of fact (citation omitted). If labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence. As so often said, each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.

In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).

6. The number and nature of similar marks in use on similar goods.

7. The nature and extent of any actual confusion.

8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

9. The variety of goods on which a mark is or is not used (house mark, 'family'mark, product mark).

10. The market interface between applicant and the owner of a prior mark:

    a. a mere 'consent' to register or use.

    b. Agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.

    c. Assignment of mark, application, registration and goodwill of the related business.

    d. Laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

11. The extent to which applicant has a right to exclude others from use of its mark on its goods.

12. The extent of potential confusion, i.e. whether de minimis or substantial.

13. Any other established fact probative of the effect of use.

The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one

factor alone may be sufficient to support a holding that the marks are confusingly similar. In re Lamson Oil Co., 6 USPQ2d 1041, 1042 n. 4 (TTAB 1987).

The similarity or dissi milarity of the marks in t heir entireti es as to appearance, sound, connotation and commercial impr ession and th e similarity o r dissimila rity and nature of the goods or servic es as described in an ap plication or registration or in connection with which a prior ma rk is in use.

These marks are clearly different from each other. The registered mark is for IOBYTE whereas applicant's mark is for IOBIT. While both marks start with the letters "IO", the final syllable of each word differs greatly – both in pronunciation and in meaning. As the examining attorney stated:

- Merriam-Webster Online Dictionary (2010):
  - http://www.merriam-webster.com/dictionary/bit (defining "bit" as "a unit of computer information equivalent to the result of a choice between two alternatives");
  - http://www.merriam-webster.com/dictionary/byte ("a unit of computer information or data-storage capacity that consists of a group of eight bits and that is used especially to represent an alphanumeric character");

While both are computer terms, they define very different things which would be immediately apparent to the sophisticated users of these goods.

They are different phonetically and in meaning. While it is often true that there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark, the last syllable of each of these marks consist of terms that are common and whose pronunciation is quite likely to be predicted.

"The terms bit and byte are common in computer networking."

http://compnetworking.about.com/cs/basicnetworking/f/bitsandbytes.htm

Furthermore, "bit" is pronounced \'bit\ whereas "byte" is pronounced \'bīt\, which is also something that would be immediately known and apparent to the sophisticated users of the goods associated with the marks. These marks are very different in both pronunciation and meaning.

The two marks are not phonetically similar. They do not sound alike. They do not have the same appearance.

The conditions under w hich and buyers to who m sales a re made, i.e. 'impulse' vs. ca reful, sophisticated purchasin g.

Applicant's mark is associated with high technology products, geared toward consumers who are demanding and passionate regarding the products. The goods are geared to individuals with very specific needs and desires regarding the products they are purchasing.

The fame of the prior mark (sales, advertising, length of use).

Applicant has been using this mark in business extensively since at least as early as May 25, 2005. This mark has become distinctive to the goods and services offered by the applicant.

The number and nature of similar marks in use on similar goods.

There are currently 132 live pending applications/registered marks in International Class 009 containing the word "bit", 57 live pending applications/registered marks in International Class 009 containing the word "byte", and 45 live pending applications/registered marks in International Class containing "IO" as a major portion of the mark. These are common terms.

The nature and e xtent of any actual con fusion.

Applicant has been using this mark in business worldwide, in association with these goods, for over five years now with no actual confusion regarding the source of the goods.

Conclusion

For all of the above reasons, Applicant respectfully requests that the mark IOBIT, Serial Number 77722665, be allowed and published for opposition.

Respectfully submitted,

Jeffrey M. Furr

Attorney for Applicant

2622 Debolt Road

Utica, Ohio 43080

740-892-2118 (telephone)

740-892-3860 (fax)

CERTIFICATE OF MAILING

I hereby certify that this Notice of Appeal is being deposited with the United States Postal Service as first class mail with postage prepaid in an envelope address to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 on the 17h day of September, 2010.

Jeffrey M. Furr

Attorney for Applicant

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This page was generated by the TARR system on 2010-09-17 08:47:23 ET

Serial Number: 76007972 Assignment Information Trademark Document Retrieval

Registration Number: 2557070

Mark (words only): IOBYTE

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-04-02

Filing Date: 2000-03-23

Transformed into a National Application: No

Registration Date: 2002-04-02

Register: Principal

Law Office Assigned: LAW OFFICE 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-04-18

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Lubart, Marc Daniel

Address:
Lubart, Marc Daniel
50 Palmer Lane
Thornwood, NY 10594
United States
Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 042
Class Status: Active
Computer software design for others; Technical consultation in the field of computer software
Basis: 1(a)
First Use Date: 2000-11-00
First Use in Commerce Date: 2000-11-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-04-18 - Post Registration action mailed Section 8 & 15

2008-04-08 - Assigned To Paralegal

2008-03-27 - TEAS Section 8 & 15 Received

2007-05-15 - Case File In TICRS

2002-04-02 - Registered - Principal Register

2001-12-18 - Allowed for Registration - Principal Register (SOU accepted)

2001-12-10 - Assigned To Examiner

2001-12-06 - Statement Of Use Processing Complete

2001-11-21 - Use Amendment Filed

2001-05-22 - NOA Mailed - SOU Required From Applicant

2001-02-27 - Published for opposition

2001-01-26 - Notice of publication

2000-12-14 - Approved For Pub - Principal Register

2000-12-13 - Assigned To Examiner

2000-12-11 - Examiner's amendment mailed

2000-10-02 - Non-final action mailed

2000-09-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent
MARC DANIEL LUBART
50 PALMER LANE
THORNWOOD, NY 10594