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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77722665

MARK: IOBIT

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, Chengdu AOBI Information Technology Co., Ltd. ("Applicant"), has appealed the final refusal to register the proposed mark IOBIT for "Computer utility program recorded on data media; optical discs; computer operating program recorded on data media; computer software for performing computer maintenance work recorded on data media; magnetic data storage media; disc drivers for computers; downloadable computer program for performing computer maintenance work" in International Class 9.

Registration is refused pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that the applied-for mark is likely to be confused with the registered mark IOBYTE, U.S. Registration No. 2557070, for "Computer software design for others; Technical consultation in the field of computer software" in International Class 42.

It is respectfully requested that this refusal be affirmed.

II. STATEMENT OF FACTS

On March 20, 2009, Applicant filed a use-based application for "Recorded computer program; optical discs; recorded computer operating program; recorded computer software; magnetic data storage media; disc drivers for computers; downloadable electronic publications; downloadable computer program" in International Class 9.

On July 27, 2009, the undersigned examining attorney ("Examining Attorney") refused registration under Trademark Act Section 2(d) on the ground that the applied-for mark was confusingly similar to the mark in U.S. Registration No. 2557070. Registration was also refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark was merely descriptive. Applicant was also required to amend its identification of goods.

On January 20, 2010, Applicant provided arguments against the Section 2(d) and Section 2(e)(1) refusals. Applicant also submitted an amended identification of goods.

On February 27, 2010, the Examining Attorney issued final refusals under Sections 2(d) and 2(e)(1). The requirement for a proper identification of goods was also made final.

On August 27, 2010, Applicant filed the present appeal with the Trademark Trial and Appeal Board ("Board"), and concurrently submitted a request for reconsideration of the final refusals and requirement. In the request for reconsideration, Applicant provided additional arguments against the Section 2(d) refusal and amended the present application

to seek registration on the Supplemental Register in response to the Section 2(e)(1) refusal. Applicant also submitted a properly amended identification of goods.

On September 1, 2010, the Examining Attorney withdrew the Section 2(e)(1) refusal and the requirement for a properly amended identification of goods. The Examining Attorney denied the request for reconsideration in connection with the Section 2(d) refusal based on the fact that the marks were confusingly similar and the goods and services were closely related.

III. ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of Applicant's goods and the registrant's services. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the similarity of the marks and the similarity of the goods and services are the most relevant factors in the analysis. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP

§§1207.01 *et seq.* Applicant's arguments regarding the sophistication of the purchasers, the fame of the marks, the weakness of the marks, and the absence of actual confusion are unpersuasive.

A. The applied-for mark is confusingly similar to the registered mark.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In the present case, registrant's mark IOBYTE is almost identical in appearance to Applicant's applied-for mark IOBIT, with the only differences being that Applicant has replaced the "Y" with an "I" and has deleted the final "E."

In addition to the similarity in appearance, both marks are three-syllable, one-word marks that begin with "IOB" and have a hard "T" sound at the end. Applicant argues that the marks would be pronounced differently. Applicant's Appeal Br. at unnumbered 4. However, there is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983). The marks in question could be pronounced the same; such similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart,*

Inc., 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); TMEP §1207.01(b)(iv). In any event, the slight differences in the sound that may be created by the use of "I" instead of "Y" in the applied-for mark will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983).

Applicant also argues that the final syllable in each word ("BIT" in the applied-for mark, "BYTE" in the registered mark) "differ[] greatly … in meaning." Applicant's Appeal Br. at unnumbered 4. However, "bit" and "byte" refer to units of computer information. *See, e.g.*, The American Heritage® Dictionary of the English Language (4th ed. 2000) (from the 09/01/2010 Office action):

- http://www.thefreedictionary.com/bit (defining "bit" as "a fundamental unit of information having just two possible values, as either of the binary digits 0 or 1");
- http://www.thefreedictionary.com/byte (defining "byte" as "a sequence of adjacent bits, usually eight, operated on as a unit by a computer").

As these definitions show, a "byte" is a group of "bits," and, as such, the marks as a whole create similar commercial impressions, namely, units of computer information relating to input/output. *See, e.g.*, *id.* at http://www.thefreedictionary.com/I%2fO (defining "I/O" as abbreviation of "input/output"). Consumer confusion has been held likely for marks that do not physically sound or look alike but that convey the same idea, stimulate the same mental reaction, or may have the same overall meaning. *Proctor & Gamble Co. v. Conway*, 419 F.2d 1332, 1336, 164 USPQ 301, 304 (C.C.P.A. 1970) (holding MISTER STAIN likely to be confused with MR. CLEAN on competing cleaning products); *see Ralston Purina Co. v. Old Ranchers Canning Co.*, 199 USPQ 125 (TTAB 1978) (holding TUNA O' THE FARM for canned chicken likely to be confused

with CHICKEN OF THE SEA for canned tuna); *Downtowner Corp. v. Uptowner Inns, Inc.*, 178 USPQ 105 (TTAB 1973) (holding UPTOWNER for motor inn and restaurant services likely to be confused with DOWNTOWNER for the same services); TMEP §1207.01(b).

Ultimately, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Because the marks are confusingly similar in appearance, sound, and commercial impression, confusion as to the source of Applicant's goods and the registrant's services is likely under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

B. Applicant's goods are closely related to the registrant's services.

If the goods and services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and

services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

In this case, Applicant's goods and the registrant's services are closely related in that Applicant offers computer software and the registrant offers computer software design. Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion). This conclusion is supported by third-party registrations and Internet evidence submitted by

the Examining Attorney demonstrating that a single entity could offer both computer software goods and computer software design services. *See, e.g.*:

- From the 02/27/2010 Office action:
  - 21st Century Technologies:
    - http://www.21stsoft.com/software-development-web-development-products-free/ (computer software);
    - http://www.21stsoft.com/software-development-services/ (software design);
  - ATK Solutions, Inc.:
    - http://www.atksolutions.com/products.html (computer software);
    - http://www.atksolutions.com/softdes.html (software design);
- From the 09/01/2010 Office action:
  - Emagenit:
    - http://www.emagenit.com/microsoft-excel-add-ins.htm (computer software);
    - http://www.emagenit.com/mosoftdsgn.htm (computer software design);
  - Ideal Universe:
    - http://idealuniverse.com/download.html (computer software);
    - http://idealuniverse.com/ (computer software design);
  - The Integrated Solution Group:
    - http://www.intsolgrp.com/Products/index.htm (computer software);
    - http://www.intsolgrp.com/Solutions/software-design.htm (computer software design).

Indeed, Applicant itself is seeking registration of IOBIT in connection with "computer software design." *See* Trademark Application Serial No. 77723547 (attached with

07/27/2009 Office action). This evidence reinforces the conclusion that consumers are likely to confuse the source of Applicant's goods and the registrant's services.

Because Applicant offers computer software and the registrant offers software design, and because third-parties regularly offer both under the same mark, confusion as to the source of Applicant's goods and the registrant's services is likely under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

C. Alleged sophistication of purchasers not persuasive.

Applicant alleges that the potential consumers of its goods are "demanding and passionate." Applicant's Appeal Br. at unnumbered 5. However, Applicant has provided no evidence that this is the case.

In any event, the fact that purchasers are sophisticated or knowledgeable in the computer software field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). At any rate, Applicant has not placed any limitations on the types of consumers to whom its goods are offered, so it is presumed that the relevant consumer is the general public. When the relevant consumer includes the general public, the standard of care for purchasing the goods is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

D. Fame of the marks a neutral factor in an ex parte proceeding.

Applicant argues that it "has been using [the applied-for] mark in business extensively" for over five years, and that the applied-for mark "has become distinctive."

Applicant's Appeal Br. at unnumbered 5. In an ex parte proceeding, however, the "fame of the mark" factor is normally treated as neutral. *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006); *see* TMEP §1207.01(d)(x). At any rate, Applicant has not provided any evidence that its mark is famous or that the registrant's mark is not. Applicant only states that it has been using its mark "extensively" for five years; however, registrant's mark has been registered for ten, so years of use alone would not be enough to establish fame in this case.

E. Alleged weakness of the marks not persuasive.

Applicant has argued that a number of currently registered marks contain the same elements as the marks at issue here, and therefore these elements are "common." Applicant's Appeal Br. at unnumbered 5. However, Applicant has not attached any of the cited registrations. As Applicant was informed in the September 1, 2010, Office action, to make third-party registrations part of the record, Applicant had to submit copies of the registrations from the USPTO records. *See, e.g.*, *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03. Because these registrations were not attached, they are not part of the record and were not considered by the Examining Attorney. The Examining Attorney again objects to Applicant's reference to these registrations and applications, especially since it cannot be determined how the words "bit," "byte," or "IO" are being used within the marks.

Even if the marks at issue in this case were to be considered "weak," both the Court of Appeals for the Federal Circuit and the Board have recognized that marks deemed "weak" are still entitled to protection against the registration by a subsequent

user of a similar mark for closely related goods and services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). Because the marks in this case are similar, and because the goods and services are closely related, the registered mark is still entitled to protection against the confusingly similar applied-for mark even if it is determined to be "weak."

F. Absence of actual confusion not dispositive.

Applicant argues that there has been no evidence of actual confusion in the five years it has been using its applied-for mark. Applicant's Appeal Br. at unnumbered 6. The test under Trademark Act Section 2(d), however, is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. TMEP §1207.01(d)(ii); *e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). The Board has stated as follows:

> [A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

IV. CONCLUSION

Applicant's applied-for mark and the registrant's mark are likely to be confused by potential consumers. Confusion is likely because the applied-for mark and the registered mark are confusingly similar in appearance, sound, and commercial

impression, and because Applicant's goods and the registrant's services are closely related. Therefore, because confusion as to the source of the goods and services is likely, the applied-for mark must be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Any doubt regarding this likelihood of confusion determination must be resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

For the foregoing reasons, the Examining Attorney respectfully requests that the refusal to registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), be affirmed.

Respectfully submitted,

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