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Subject: U.S. TRADEMARK APPLICATION NO. 77723547 - IOBIT - N/A - Request  
for Reconsideration Denied - Return to TTAB - Message 1 of 6

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Files: evidence01-1.jpg, evidence01-2.jpg, evidence01-3.jpg, 77723547.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77723547

**MARK:** IOBIT



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

**APPLICANT:** Chengdu AOBI Information  
Technology Co., ETC.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 9/1/2010**

Applicant is requesting reconsideration of a final refusal issued/mailed 02/27/2010.

Applicant has amended the present application to seek registration on the Supplemental Register. As such, the refusal of the applied-for mark as merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), is hereby WITHDRAWN.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the likelihood of confusion and specimen refusals issued in the final action.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2557070. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

In this case, the following factors are the most relevant: similarity of the marks, similarity of the services, and similarity of trade channels of the services. *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.* Based on these factors, the examining attorney maintains that there is a likelihood of confusion between applicant's applied-for mark IOBIT for "Computer programming; Computer software design; Conversion of data or documents from physical to electronic media; Data conversion of computer programs and data, not physical conversion; Duplication of computer programs; Hosting of web sites; Installation of computer software; Maintenance of computer software; Research and development for new products for others; Research and development of computer software; Updating and maintenance of computer software" in International Class 42, and registrant's mark:

- IOBYTE (Reg. No. 2557070) for "Computer software design for others; Technical consultation in the field of computer software" in International Class 42.

Applicant's arguments to the contrary have been considered and found unpersuasive for the reasons set forth below.

### COMPARISON OF THE MARKS

In the present case, registrant's mark IOBYTE is almost identical to applicant's applied-for mark IOBIT, with the only differences being that applicant has replaced the "Y" with an "T" and has deleted the final "E." Other than this, both marks are three-syllable, one-word marks that begin with "IOB" and have a hard "T" sound at the end. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomm. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983).

Applicant argues that the marks would be pronounced differently. 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).

Moreover, both "BIT" and "BYTE" refer to units of computer information. *See, e.g.*, The American Heritage® Dictionary of the English Language (4th ed. 2000):

- <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 overall commercial impressions, namely, units of computer

information relating to input/output. *See, e.g.*, The American Heritage® Dictionary of the English Language (4th ed. 2000), <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. TMEP §1207.01(b).

## COMPARISON OF THE SERVICES

If the 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 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 and registrant offer identical “computer software design” services.

Moreover, evidence submitted in the previous Office actions (incorporated by reference herein) demonstrated that a single entity could offer both applicant’s and registrant’s services. *See also* the following additional evidence demonstrating the relatedness of applicant’s and registrant’s services:

- Applied Concepts, LLC, <http://www.appliedconceptsllc.com/services.htm> (offering technical consulting in the field of software, computer programming, software maintenance);
- Frontier Solutions:
  - [http://www.frontiersolutions.com/serv\\_technology\\_consulting.htm](http://www.frontiersolutions.com/serv_technology_consulting.htm) (technical consultation in the field of software);
  - [http://www.frontiersolutions.com/serv\\_software\\_design.htm](http://www.frontiersolutions.com/serv_software_design.htm) (software design);
  - [http://www.frontiersolutions.com/serv\\_web\\_design.htm](http://www.frontiersolutions.com/serv_web_design.htm) (hosting of web sites);
- Gara Systems:
  - <http://www.gara.com/services/consulting> (technical consultation in the field of software);
  - <http://www.gara.com/services/software#maint> (software maintenance);
  - <http://www.gara.com/services/hosting> (hosting of web sites);
  - <http://www.gara.com/services/network> (software installation);
- Systo:
  - <http://www.systo.com/about.shtml> (technical consulting in the field of software);
  - <http://www.systo.com/install.shtml> (software installation);
  - <http://www.systo.com/maintain.shtml> (software maintenance);
- Treehouse Software Incorporated, <http://www.treehouse.com/ConsultingTSI.shtml> (offering consultation in the field of software, updating and maintenance of computer software, software installation).

Ultimately, the services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant argues that the potential consumers of its and registrant's services are sophisticated. However, no evidence has been submitted to support this claim. In any event, the fact that purchasers are sophisticated or knowledgeable in a particular 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).

Moreover, no limitation has been placed on the consumers to whom the services are offered, so it is presumed that the relevant consumer includes the general public. When the relevant consumer includes both professionals and the general public, the standard of care for purchasing the services is that of the least sophisticated purchaser. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

### **FAME OF THE MARKS NEUTRAL FACTOR IN ANALYSIS**

In an ex parte proceeding, 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). In any event, 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 enough to establish fame in this case.

### **ALLEGED WEAKNESS OF MARKS NOT PERSUASIVE**

Applicant has argued that a number of currently registered marks contain the same elements of the marks at issue here, and therefore these elements are "common." However, applicant has not attached any of the cited registrations. To make third party registrations part of the record, an applicant must submit copies of registrations from USPTO records only. 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 have not been attached, they are not part of the record and therefore have not been considered by the examining attorney.

Moreover, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal 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 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).

In any event, prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Int’l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

### **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. 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 Trademark Trial and Appeal Board 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).

### **CONCLUSION**

Because applicant’s applied-for mark and registrant’s mark are nearly identical in appearance, sound, and commercial impression, because applicant’s and registrant’s services are closely related if not identical, and because the trade channels of the services overlap, the applied-for mark must be refused registration based on a likelihood of confusion. Any doubt regarding this likelihood of confusion determination is 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).

SPECIMEN REFUSED – DOES NOT SHOW USE OF MARK WITH LISTED SERVICES

The substitute specimen is not acceptable because it does not show the applied-for mark used in connection with any of the services specified in the application. An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

To be a service, an activity must be primarily for the benefit of someone other than the applicant. TMEP §1301.01(a)(ii). In this case, the 08/27/2010 substitute specimen does not clearly state that applicant is offering services for third parties. At the top of the specimen, applicant's products are discussed, and then the specimen goes on to state (in the "What We Do" section) that applicant "deliver[s] innovative system utilities" and "provide[s] first-class free software and online service." Nothing from this specimen shows that applicant provides the services listed in the application on behalf of third parties. If applicant is merely designing its own software, then these services are simply ancillary to applicant's primary purpose of offering software goods. See TMEP §1301.01(a)(iii). As such, applicant primarily benefits from these services, and therefore the specimen does not show that applicant is using the applied-for mark with any of the listed services.

Because applicant's specimens of use do not show use of the applied-for mark with any of the services listed in the application, registration must be refused. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

CASE TO BE RETURNED TO TTAB FOR FURTHER ACTION

Applicant has not persuaded the examining attorney that confusion is unlikely between the applied-for mark and the mark in U.S. Registration No. 2557070. Moreover, applicant has failed to provide a specimen that shows use of the applied-for mark with the services listed in the application. Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. §2.64(b); TMEP §715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

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**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.