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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/591138

**APPLICANT:** Opt It, Inc.

**CORRESPONDENT ADDRESS:**

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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**MARK:** OPT IT

**CORRESPONDENT'S REFERENCE/DOCKET NO:** 05,123

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
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4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Opt It, Inc., (hereinafter referred to as “applicant”) has appealed the trademark examining attorney’s final refusal to register the proposed mark, OPT IT and design, under Section 2(d) of the Trademark Act of 1946. The trademark examining attorney respectfully requests that this refusal be affirmed.

## **FACTS**

On March 20, 2005, the applicant filed an application to register the mark, OPT IT and design, for the amended recitation of services of “Computer Software, namely, computer software for text messaging” in international class 9 on the Principal Register.

On October, 19, 2005, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 2101964 as to be likely to cause confusion, to cause mistake, or to deceive. The registered mark is OPT! for “computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details.” On March 30, 2006, Applicant filed a response to the Examining Attorney’s office action; on April 21, 2006, the Examining Attorney issued a final action. On October 19, 2006, Applicant filed a Notice of Appeal.

## ARGUMENTS

THE APPLICANT'S PROPOSED MARK, OPT IT AND DESIGN, IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT'S MARK, OPT!.

### A. Relevant Law Generally

Section 2(d) of the Trademark Act of 1946 [as amended] states:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. . .

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in

appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); TMEP §§1207.01 *et seq.*

The applicant applied to register OPT IT and design for "computer software, namely, computer software for text messaging."

The registered mark is OPT! for "computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details."

**B. The Mark OPT! is Confusingly Similar to Applicant's Proposed Mark,  
OPT IT and design**

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Despite applicant's arguments, the marks are highly similar in that both marks contain the dominant word OPT. The marks are compared in their entireties under a Section 2(d) analysis. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); TMEP §1207.01(b)(viii). OPT is clearly the dominant element in both marks. In the proposed mark, the word IT simply modifies the word OPT.

Applicant states that “OPT is not the dominant portion of Appellant’s mark because the design portion of the composite mark OPT IT and design forms a distinct commercial impression by itself” and “consumers with a fallible memory and a general impression are likely to remember the Appellant’s mark design features and not be confused.”

However, concerning applicant’s reference to the design elements in applicant’s mark, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Thus, the word portion, and not the design portion of the mark(s) will be most likely impressed upon purchasers memory and used by purchasers in calling for the goods.

Applicant argues, “there is not likelihood of confusion because the Appellant’s [mark] and registrant’s are different in sound, appearance and connotation.” Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). 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. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000). 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 (TTAB 1979); TMEP §1207.01(b).

Applicant states “there is no likelihood of confusion because the Appellant’s and registrant’s mark have been used for years in commerce without any action confusion.” The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. *See Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. *See also In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984), wherein the 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 registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case).

Applicant argues “there is no likelihood of confusion between the Appellant’s composite mark and registrant’s mark because the U.S. Trademark Office has already allowed registration of the word portion of the mark, OPT IT, to the Appellant” and “[a]ppellant is also the owner of U.S. Registration No. 3,068,068 for the word mark, OPT IT, for advertising services, namely, providing special offers, promotions and updates for others

via text messaging.” Applicant fails to note that U.S. Registration No. 3,068,068 is for different services than the proposed mark. U.S. Registration No. 3,068,068 is for advertising **services** while applicant’s **goods** are “computer software, namely, computer software for text messaging.” Moreover, prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973) .

**C. The Goods in the Registered Mark and the Proposed Mark are Related.**

Both of the marks are used to identify computer programs/software for text messaging or sending/receiving emails. Please see the previously attached X-Search evidence, which illustrates that the same marks identify both text messaging or emailing telecommunication services. Please also see the previously attached Nexis® evidence which illustrates that the same software provides both text messaging and emailing.

Applicant asserts “the Appellant’s mark identifies goods including computer software, namely computer software for text messaging” and “E-mail is not identified in the Appellant’s description of goods.” Examining Attorney agrees with Applicant’s statement. However, the Applicant should note that the goods and/or services of the

parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

Applicant should note that the attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the services listed therein which are provided by Applicant's goods, namely text messaging and emailing telecommunication services, are of a kind that may emanate from a single source. *See In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

Applicant correctly states "[t]he case law clearly states the likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration." In fact, despite applicant's assertion that the channels of trade are different, it is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as

they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Since the identification of the registrant's and applicant's goods is very broad and does not limit the channels of trade, it is presumed that the registration and the application encompasses all goods of the type described and that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Despite applicant's argument that the purchasers are sophisticated, 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. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

The same consumers will be exposed to the goods identified with both of the marks. The similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); TMEP §§1207.01(d)(i).

For the foregoing reasons, the refusal of registration pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is believed proper and it is respectfully requested that it be upheld by the Board.

Respectfully submitted,

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