ESTTA Tracking number: **ESTTA125133**
Filing date: **02/15/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78591138
Applicant	Opt It, Inc.
Applied for Mark	OPT IT
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Submission	Reply Brief
Attachments	appeal reply brief.pdf (17 pages)(158375 bytes)
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Signature	/Stephen Lesavich/
Date	02/15/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Application of: Opt It, Inc. 191 N. Wacker Drive, Suite 2350 Chicago, IL 60606 An Illinois Corporation	)	Law Office: 104 Trademark Examining Attorney: Carol Spils
Serial No. 78/591,138	)	ESTTA Tracking Number ESTTA105138
Filed: March 20, 2005	)	
MARK: OPT IT and Design	)	

Mail Stop: TTAB NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Electronic Transmission Transmittal Letter

(17 Total Pages including this Transmittal Letter)

1. We are transmitting electronically herewith:

☒ APPELLANT REPLY BRIEF UNDER 37 C.F.R. §2.142 (16 pages)

2. GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES: No fees are required. Should this assumption be incorrect, please charge any additional fees or credit overpayment to Deposit Account No. 50-2281 for Lesavich High-Tech Law Group, P.C. (32097)

3. CERTIFICATE OF TRANSMISSION UNDER 37 CFR § 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1, are being electronically transmitted to the U.S. Patent and Trademark Office via the USPTO web-site estta.uspto.gov the February 15, 2007.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C. (32097)

Stephen Lesavich

Dated: February 15, 2007

Stephen Lesavich

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Application of:	)	
Opt It, Inc.	)	Law Office:
191 N. Wacker Drive, Suite 2350	)	**104**
Chicago, IL 60606	)	Trademark Examining Attorney:
An Illinois Corporation	)	**Carol Spils**
	)	
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	)	**ESTTA105138**
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APPELLANT'S REPLY BRIEF
TO EXAMINING ATTORNEY'S APPEAL BRIEF
UNDER 37 C.F.R. §2.142

In re Opt It, Inc.

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Date: February 15, 2007

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APPELLANT'S INDEX OF CASES

The full Index of Cases is incorporated herein by reference from the Appellant's Appeal Brief filed on December 15, 2006.

No new cases were cited in this reply brief.

DESCRIPTION OF RECORD

The full Description of the Record is incorporated herein by reference from the Appellant's Appeal Brief filed on December 15, 2006.

This Reply Brief to the Examining Attorney's Appeal Brief e-mailed February 9, 2007 was timely filed within twenty (20) days pursuant to 37 C.F.R. §2.142(b)(i) on February 15, 2007.

STATEMENT OF ISSUES

Appellant hereby appeals to the Trademark Trial and Appeal Board from the final decision of the Examining Attorney dated April 21, 2006, which refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that the mark when used on the identified goods and services so resembles Reg. No. 2,101,964 as to be likely to cause confusion, mistake, or to deceive.

Recitation of Facts

The full Recitation of Facts is incorporated herein by reference from the Appellant's Appeal Brief filed on December 15, 2006.

SUMMARY OF ARGUMENTS

The Appellant replies to the following arguments has raised by the Examining Attorney:

1) Relevant Law Generally

2) The Registrant's mark OPT! is not Confusingly Similar to Applicant's Mark, OPT IT and Design.

3) The Goods in the Registered Mark and the Proposed Mark are not related.

The Appellant traverse all of the assertions by the Examining Attorney. The Appellant is responding only to certain assertions, but intends to traverse all of the assertions made by the Examining Attorney.

ARGUMENTS

1) Relevant Law Generally

The Appellant, very respectfully submits that the Examining Attorney's Reply Brief does not meet the requirements outlined in 37 C.F.R. 2.142.

The Examining Attorney did not include the required portions of the brief including an Index of Cited Cases.

The Board will see, after examining all the evidence and the case law relevant to composite marks and the evidence for the current matter, that there is simply no likelihood of confusion or actual confusion between the source of goods for the Appellant's composite mark

and the registrant's word mark, OPT!

2) The Registrant's mark OPT! is not Confusingly Similar to Applicant's Mark, OPT IT and Design .

The Examining Attorney asserts "The overriding concern is to prevent buyer confusion as to the source of the goods and/or services."

The Appellant's composite mark is used with software for text messaging. An advertiser must first set-up a mobile domain name. A user subscribes to the advertiser's mobile domain name via their mobile phone to received advertising via text messaging. See pages 14-16 and Figures 1-3, Appeal Brief. The goods and services provided by the Appellant are unique and are identified in part by the Appellant's colorful composite mark.

No consumer would confuse the Appellant's composite mark used with the Appellant's software and the associated sign-up process required to use the Appellant's text message software to receive text messaging advertising with the software used on a desktop computer for organizing business contacts under the registrant's mark.

There is clearly no confusion as the source of the Appellant's and registrant's goods and services.

The Examining Attorney asserts "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."*

However, what the Examining Attorney does not say, or want the Board to note is that the word mark, OPT IT, was not registered for different services. This word mark was registered by the Appellant for services via text messaging: "advertising services, namely, providing special offers, promotions and updates for others via text messaging."

In addition, the Examining Attorney does not want the Board to know that another Examining Attorney in the same Law Office 104 as her did not find any likelihood of confusion between the word portion of the Appellant's composite mark and the registrant's mark and also did not inappropriately try to extend the description of goods or services to include things that were never intended to be there in the first place.

Based on all of the arguments made by the Appellant in previous papers and herein, the Appellant has clearly demonstrated that there is that the mark are not confusingly similar and that no confusion as to the source of its goods and those of the registrant. Thus, the Appellant's mark is not likely to cause confusion, to cause mistake, or to deceive when used in association with the Appellant's goods in a marketplace including the registrant's goods.

3) The Goods in the Registered Mark and the Proposed Mark are <u>not</u> related.

The Examining Attorney repeats her assertion "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."

The Examining Attorney repeats her assertion that the "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."

With respect to the first assertion, the Board should note that this is an incorrect assertion by the Examining Attorney. The registrant's mark <u>does not</u> include text messaging in the description of goods. The Appellant's mark <u>does not</u> include e-mail in the description of goods. They never did.

The Appellant presented conclusive evidence that the registrant's mark likely did not include text messaging in the description of goods because text messaging was NOT a service that was commercially available at the time (1995) the registrant's application was filed or registered in (1997). See Appendixes D-H of Appellant's Brief.

In addition, the registrant did not amend their description of good to include text messaging when the registrant filed a Section 8 and Section 15 affidavit in 2003. Presumably, if the registrant was using the mark for text messaging the description of goods would have been amended at that time since text messaging was a commercially viable product in 2003.

Moreover, the Appellant 's attorney has a PhD in computer science and formerly worked as a professional software engineer filed the trademark application and the appeal brief. The Appellant's attorney did not include e-mail (or any other technology types) in the description of the goods for the application because the Appellant's software is based on text messaging and NOT e-mail. Enough said.

In addition, the Appellant's attorney filed a second trademark application for the mark, OPT IT, that registered as U.S. Trademark Registration Number 3,068,068 for services including "advertising services, namely, providing special offers, promotions and updates for others via text messaging." The Board should note that e-mail was NOT included in this description of services for this mark for the same Appellant.

In addition, the Appellant's attorney filed a third trademark application for the mark, ": AT YOUR FINGERTIPS," for the same Appellant that registered as U.S. Trademark Registration Number 3,070,861 for services including "advertising services, namely, providing special offers, promotions and updates for others via text messaging." The Board should note that e-mail was NOT included in this description of services for this mark for the same Appellant.

As with all legal matters, including this trademark matter, there must be a reasonable nexus to the matter for any evidence to be relevant and applicable or probative. There is no such reasonable nexus here.

The Board should note that the Examining Attorney did not find, and did not assert, any registered marks that included both e-mail text messaging in the description of goods or services from the 1995-1997 time period when the registrant's application was filed or registered. The year 2000 was the earliest dated paper the Examining Attorney found in her

Nexus and X-search. Further proof that of the Appellant's position that there is simply no reasonable nexus to apply the alleged evidence cited by the Examining Attorney simply because some other document on the Internet or trademark registrations happen to include the words text messaging and e-mails. There is also a saying in the computer science world, which applies to the Examining Attorney's search assertions, "garbage in, garbage out."

With respect to the second assertion, the search results are not even probative because there is clear evidence to the contrary and no reasonable nexus to the current matter. As was discussed above the Appellant explained the Appellant's good and services are not done via e-mail, and the registrant's goods could not include text messaging since the technology to do so was not commercially available at the time the registrant's application was filed or when it registered and was not amended to include text messaging when the Sec. 8 and 15 affidavit was filed.

The Trademark Examining Attorney asserted that both Applicant's and registrant's description of services are very broad, so they will it is presumed that the registration and the application encompass all of the type described.

The Board should note first, there is no basis in law or fact provided by Examining Attorney that either the registrant's or Appellant's description of goods are very broad. The Appellant clearly explained why they description of goods of both parties are not broad but instead very limited as described. See Appellant's Brief (pages 21-22).

The Examining Attorney asserts that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticate or knowledgeable in the field of trademarks or immune from source confusion."

However, the Board knows and the Examining Attorney ignores and does not appear to understand that that the Federal Circuit has clearly stated that sophistication in degree in care of purchasing, purchase price, different and likely to continue channels of trade and absence of actual confusion are all factors that must be considered in a likelihood of confusion analysis. When a number of these factors are present and based on the evidence as a group are favorable to the Appellant, they tip the balance away from likelihood of confusion. This is why the Federal Circuit decided such cases. See Appeal Brief pages 17-18 for cited cases.

Based on all of the arguments made by the Appellant in previous papers and herein, the Appellant has clearly demonstrated that there is that Appellant's goods are not related to those of the registrant. Thus, the Appellant's mark is not likely to cause confusion, to cause mistake, or to deceive when used in association with the Appellant's goods in a marketplace including the registrant's goods.

CONCLUSION

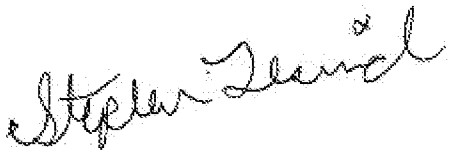
The Board is urged not to let this Examining Attorney mechanically make a likelihood of confusion rejection when the evidence does not support such a rejection. The Board is also urged not the let the Examining Attorney, *sua sponte*, just decide to add items to a description of goods, to make a rejection when the item (i.e., text messaging) was not clearly not included by the registrant and not commercially available at the time registrant filed a trademark application. That is why an applicant is required to include a description of goods or services in a trademark application in the first place. Such actions violate trademark rules and trademark law, are inequitable, and would make the U.S. Trademark system unusable as any Examining Attorney could unfairly manipulate registration of a given mark on a whim.

For the reasons set forth above, Appellant submits that there is no likelihood of confusion, mistake, or deception between Appellant's mark and the prior cited registration based on the sources of the goods. Accordingly, Appellant's mark is clearly entitled to registration. The Board is therefore respectfully requested to reverse the Examining Attorney's decision refusing registration of Appellant's mark and request the Examining Attorney immediately pass the mark to publication for registration.

Sincerely,

ATTORNEY FOR THE APPELLANT

Lesavich High-Tech Law Group, P.C.



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Date: February 15, 2007