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

Proceeding	78629030
Applicant	iMo Corporation
Applied for Mark	IMO
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Appellant:	iMo Corporation 92 Hayden Avenue Lexington, Massachusetts 02421	
Serial No.:	78/629030	Attorney: R. Eisinger
Filed:	May 12, 2005	Law Office: 102
For:	**IMO**	Class: 35

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BRIEF FOR APPELLANT

INTRODUCTION

Appellant hereby appeals from the Examining Attorney's final refusal to register its mark "IMO" and respectfully requests the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision. This brief in support of appellant's appeal is submitted in triplicate.

APPELLANT'S TRADEMARK

Appellant seeks registration on the Principal Register for its mark "IMO" in connection with retail store services, online retail services, electronic catalog services and mail-order catalog services featuring wireless telephones, wireless telephone accessories and wireless telephone services of others.

THE REJECTION

In an Office Action mailed December 8, 2005, the Examining Attorney refused registration under Trademark Act Section 2(d) because he believes that the appellant's mark, when used on or in connection with the identified services, so resembles the EMO mark in U.S. Reg. No. 2,992,691 as to be likely to cause confusion, to cause mistake or to deceive. In addition, she requested amendment to the description of services, stating that the services were indefinite as filed.

In a second Office Action mailed August 14, 2006, the Examining Attorney maintained the Section 2(d) refusal and the objection to the description of services and made the rejections final.

THE ISSUE

The issue presented by this appeal is whether the appellant's trademark "IMO" is confusingly similar, under Section 2(d) of the Lanham Act, to the mark "EMO" that is the subject of U.S. Reg. No. 2,992,691.

ARGUMENTS

APPELLANT'S MARK IS NOT CONFUSINGLY SIMILAR TO THE EMO MARK COVERED BY U.S. REGISTRATION NO. 2,992,691 SO AS TO CAUSE CONFUSION, OR TO CAUSE MISTAKE, OR TO DECEIVE.

Appellant maintains that its mark is not confusingly similar to the mark that is the subject of U.S. Reg. No. 2,992,691 under Section 2(d) of the Lanham Act, as it does not look the same, sound the same, create the same commercial impression or have the same connotation as the cited mark.

The cited registration is for the mark "EMO," which covers "communication and telecommunication services, namely, electronic transmission of data, messages, games, images, sounds and documents via computer terminals, telephones and mobile telephones; the provision of telecommunications access and connections to a global computer network and mobile telephones; electronic mail services; multimedia messaging services including the transfer of audio and visual messages via telecommunications networks" in class 38. Appellant submits that the marks are so different in appearance, sound, meaning, commercial impression and connotation that there is no likelihood of confusion for purchasers and potential purchasers should applicant's mark be allowed to register.

The cited mark is EMO, while the appellant's mark is IMO. To support the rejection, the Examining Attorney initially stated that the marks could be pronounced the same and the services are identical or highly similar. Although the Examining Attorney cites case law for the proposition that there may be no correct pronunciation of a trademark, in this case, the owners of the trademarks do not pronounce the marks the same and it is likely that a potential purchaser

will not pronounce them the same. The registrant pronounces its mark "eemo" while the appellant pronounces its mark "eyemo." To a potential purchaser, each mark appears to be an acronym or abbreviation, and not a word, so each mark would likely be pronounced by calling off the letters. Using that approach, the registered mark looks different and would clearly sound different from the appellant's mark.

The registrant's mark is clearly an acronym or abbreviation, and the registrant uses that acronym or abbreviation to highlight its services. "EMO" is an acronym or abbreviation for "emotions," as can be seen from the page from www.acronymfinder.com, previously submitted with the responses on file. And the registrant's services are directly related to "emotions." The registrant has devised a character called "Emo" to be used as animated greetings to be sent to and from mobile phones via multimedia messaging. The registrant states on its website, www.moodmessaging.com, that "[Emos] are a powerful way to express how you are feeling with or without using words." These "emos" characters are discussed at a page from the registrant's website, also previously filed with this application, and in an article about the registrant from www.zdnet.com.au, also previously on file. Thus, it is clear that the registered mark is pronounced "Eemo."

The appellant's mark, in contradistinction, is "IMO." The mark is different from the registrant's mark, is pronounced differently by its owner (and would likely be pronounced differently by purchasers and potential purchasers if unfamiliar with the appellant and its services), and has nothing to do with emotions. IMO is an acronym or abbreviation for "independent mobile," as can be seen from the applicant's website, www.imo.com, previously submitted with the responses. The article from The Columbus Dispatch dated November 16, 2005, previously filed with the responses, shows that the mark is pronounced "EYE-mo." Thus,

the marks appear differently and are pronounced differently, and these differences will prevent any likelihood of confusion.

In the second Office Action, the Examining Attorney provided listings from Internet searches to show the various meanings that EMO and IMO may reference. For example, a *Wikipedia* listing shows that EMO could refer to a type of music, a wide range of fashion styles and attitudes affiliated with emo music, an Irish oil company, an album by Screeching Weasel, or could stand for Electronic Money Order, Emergency Measures Organization, Emergency Machine-Off operation, or Extra Man Opportunity. A *OneLook* reference provided by the Examining Attorney states that IMO stands for In Memory Of, In My Opinion, International Maritime Organization, International Money Order, I'm Moving On, Internet Mail Only and many more. The Examining Attorney argued that given the large number of possible meanings to both the acronyms or abbreviations for the terms "IMO" and "EMO," none of which immediately suggest the services of either the registrant or appellant, potential consumers would view the marks only as three letter terms both include the ending "-MO." She concludes that the points of similarity are of greater importance than the points of difference, and therefore finds the marks confusingly similar.

What is striking about the definitions the Examining Attorney has supplied for both terms "EMO" and "IMO" (as acronyms) is that there are no common meaning for the acronyms IMO and EMO. Therefore, if a consumer selects a possible definition for IMO, it will necessarily be completely different than any definition for EMO, and vice versa. A consumer viewing these two marks would not ever think they are related, because they are different. The marks are different in looks, especially since the initial portion or syllable of the mark is the part that is different. The Trademark Trial and Appeal Board has held that the first word, prefix, or syllable

in a mark is typically the dominant portion. Presto Products v. Nice-Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1988). "[I]t is often the first part of a mark which is most likely to be impressed upon the mind or a purchaser and remembered when making purchasing decisions involving the services of the applicant and registrant." The first syllables of the marks are different in the manner in which they are pronounced. And, it is clear that if a potential purchaser were to look for a meaning for each term, the terms are different in meaning.

Additionally, the marks create different connotations and commercial impressions. Despite the broad recitation of services for the registered mark, there is a meaning in connection with that mark, because the registrant's services are primarily related to sending "emotions" via communications or telecommunications services. The registrant has devised a character called "Emo" to be used as animated greetings to be sent to and from mobile phones via multimedia messaging. The registrant states on its website, www.moodmessaging.com, that "[Emos] are a powerful way to express how you are feeling with or without using words." And, contrary to the assertions of the Examining Attorney, there is a meaning in connection to the services recited by the appellant, as the appellant is called, "Independent Mobile."

Appellant also reiterates that the marks are not pronounced the same by the owners of the trademarks and most likely will not be pronounced the same by a potential purchaser. Thus, the registered mark looks differently and clearly sounds differently from the appellant's mark. It is clear that the Appellant's mark creates an entirely different impression from that created by the registered mark.

In the first Office Action, the Examining Attorney stated that since the appellant's recitation includes the wording "services," and those retail services involve wireless communications products, the services may be wireless communications services, which are

related to the registrant's communications and telecommunications services. In response to that first Office Action, appellant amended the recitation of services in its application to highlight the services it provides. The applicant provides highly individualized services to people seeking cell phones, helping its clients sort through various phones, calling plans and features so as to determine the ideal phone and plan to accomplish what the client wants to do with his or her phone. The appellant is not providing communications or telecommunications services.

In the second Office Action, the Examining Attorney maintained her objection to the services, stating that the description was in part indefinite and also possibly encompassing more than one class. Appellant submitted a response on October 19, 2006, amending the services in class 35 in response to the Examining Attorney's comments. Appellant did not adopt the proposed class 38 services as it does not provide class 38 wireless telephone telecommunications services. Appellant provides retail store services that feature wireless telephones, wireless telephone accessories and wireless telephone services of others.

These services are distinct from that of the registrant. The registrant provides electronic transmission of data, messages, games, images, sounds and documents via computer terminals, telephones and mobile telephones, telecommunications access and connections to a global computer network and mobile telephones, electronic mail services and multimedia messaging services including the transfer of audio and visual messages via telecommunications networks. From the listed services, the registrant appears to be a communications service provider, although the registrant's website appears to limit its services to the character "Emo" and the sale of the characters as an added feature on mobile phones. The appellant, on the other hand, provides retail services, with a store and printed and online catalogs, featuring wireless communication products, accessories and services, not Internet or telecommunications services.

The Examining Attorney, in the second Office Action, states that the services of the registrant and the appellant are highly related, because the appellant's recitation of service includes the sale of services offered by the registrant. In addition, the Examining Attorney claims that the appellant's services are within the reasonable zone of expansion of the registrant's trade. The differences in the marks themselves, however, as well as the manner in which the respective services are generally marketed and sold, would ensure that there is no confusion as to source if appellant's mark were to register.

The selection and purchase of the appellant's services would involve close, personal contact with the appellant's employees, and individual attention to the client. Appellant is providing highly individualized and personalized consulting, advice and sales to its customers in relation to mobile telephones, accessories and calling plans. The registrant too markets its services to its customers in an individualized manner. Whether the customer is selecting a telecommunications plan, or the right "EMO" to send, the registrant's customer will carefully scrutinize his or her options, because one must contract for a period of time, generally years with a service provider and will want to ensure that the provider's quality of service is optimal in the area in which the customer will use the services. Given the highly specialized nature of each of the services provided respectively by the registrant and appellant and the level of care and scrutiny of the person purchasing and using the services, there is no likelihood that confusion will result. With the level of scrutiny necessary for selecting any of these services, members of the relevant consuming public are not likely to be confused as to the source of the respective services sold under these very different marks. Potential purchasers confronting these very different marks would easily and quickly recognize the differences between them and would, therefore, never confuse them as indicators of source.

CONCLUSION

For the reasons set forth above, appellant requests that the citation to a prior registration be removed. The Board is respectfully requested to reverse the Trademark Attorney's decision refusing registration of appellant's mark.

Respectfully submitted,

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