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Subject: U.S. TRADEMARK APPLICATION NO. 85775410 - SOLIS TEK DIGITAL LIGHTING - N/A - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

<b>U.S. APPLICATION SERIAL NO.</b> 85775410  <b>MARK:</b> SOLIS TEK DIGITAL LIGHTING	
<b>CORRESPONDENT ADDRESS:</b> MATTHEW H SWYERS  THE TRADEMARK COMPANY  344 MAPLE AVE W STE 151  VIENNA, VA 22180-5612	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> Solis Tek, Inc.	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  N/A  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  mswyers@thetrademarkcompany.com	

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the examining attorney's final refusal to register the mark SOLIS TEK DIGITAL LIGHTNING for "Electric luminaries; Lamp reflectors; Lamps; Light reflectors; Luminaries." The application is refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), because it so

resembles the mark SOLIS in U.S. Registration No. 3539121 for “LED (light emitting diode) electric lamps and LED (light emitting diode) electric luminaries” as to be likely to cause confusion, to cause mistake or to deceive.

### **FACTS**

On November 9, 2012, Applicant applied to register the mark SOLIS TEK DIGITAL LIGHTING, in standard character form, for “Electric luminaries; Lamp reflectors; Lamps; Light reflectors; Luminaries” in International Class 11 under Section 1(a) of the Trademark Act. The initial application included a voluntary disclaimer of “DIGITAL LIGHTING.” The first Office action refused registration under Section 2(d) based on U.S. Registration No. 3539121. Applicant was also requested to claim ownership of a similar prior registration.

Applicant submitted arguments against the refusal and complied with the procedural requirement. Applicant’s arguments were considered unpersuasive; therefore a final refusal issued on October 7, 2013. A request for reconsideration was also denied on June 5, 2014. On August 15, 2014 Applicant’s appeal brief was filed.

### **ISSUE ON APPEAL**

The sole issue on appeal is whether applicant’s mark, SOLIS TEK DIGITAL LIGHTING, so resembles the registered mark SOLIS, when used in connection with their respective identified goods, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

## ARGUMENT

### I. A LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARK

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.* The examining attorney will also address applicant's arguments concerning the weakness of the marks and the absence of any actual confusion.

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *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)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Further, it has been held that a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark . . . .”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). Finally, when comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under applicant’s and registrant’s marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546,

1551 (TTAB 2012); TMEP §1207.01(b). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The marks at issue in this case are SOLIS TEK DIGITAL LIGHTING, in standard character form, and SOLIS, also in standard character form. Following the guidance outlined above concerning the comparison of marks, the examining attorney maintains that the marks of the parties are highly similar since “SOLIS” forms the dominant commercial impression in each mark. As a result, consumers are likely to believe that “SOLIS TEK DIGITAL LIGHTING” and “SOLIS” emanate from the same company. The examining attorney attached evidence to the first two Office actions (first Office action and final refusal) to prove that consumers are likely to consider “SOLIS” the dominant source indicator in each mark.

It has been held that matter that is descriptive of or generic for an applicant’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). The final Office action attached several third-party websites and news articles to demonstrate that “digital lighting” is merely a particular category of lighting products.

For example, the website at [www.lithonia.com](http://www.lithonia.com) describes an “LED Wraparound” as “[a]n affordable digital lighting platform designed to deliver general ambient lighting for recessed-ceiling application in schools, offices and hospitals.” An article in the New York Times, dated April 24, 2013, discusses the use of new technologies for light sources. It discusses “digital lighting based on light-emitting diodes – LEDs” as one innovation. It states that “[s]ome companies are selling the new digital lighting in forms that will fit in the prerevolutionary world, with its sockets and streetlamps – including familiar bulb shapes.” Finally, an article in the MIT Technology Review is entitled “Already Efficient, LED

Lights Get Smarter / Digital convergence is rapidly coming to lighting as component makers pave the way for customizable, networked lamps.” It discusses the manufacture of LED light engines with sensors that allow the consumer to control a light fixture wirelessly. It states: “Right now, it’s businesses that stand to benefit most from digital lighting because they can fine-tune schedules or use sensors to lower their energy use.” An article entitled “The Future of Lighting” from [www.forbes.com](http://www.forbes.com) describes an “LED” as a “solid-state semiconductor device that converts electricity into light.”

The above articles demonstrate that “digital lighting” is merely a particular type of light. It refers to lighting based on semiconductors (light emitting diodes or LEDs), or, LED lighting that contains digital controls. Therefore, the wording “DIGITAL LIGHTING” is highly descriptive and will not be focused upon by consumers as a means of differentiating source. Applicant’s “electric luminaries,” “lamps,” and “luminaries” likely feature digital lighting technology. Indeed, Applicant has apparently recognized the descriptiveness of the term by offering a voluntary disclaimer in the initial application. It has been held that disclaimed matter that is descriptive of or generic for an applicant’s goods and/or services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752 ; TMEP §1207.01(b)(viii), (c)(ii).

Applicant’s addition of the word “TEK” also does not obviate the likelihood of confusion. Evidence in the form of third-party registrations was attached to the first Office action to show that “TEK” is widely used in marks associated with lamps and lighting fixtures. See, for example:

OASISTEK, U.S. Registration No. 4177852, for, inter alia, “light bulbs; “table lamps.”

TEK PRO, U.S. Registration No. 3262675, for “fluorescent lighting fixture used in commercial, industrial, workplace, school or horticulture applications.”

TEK TORCH, U.S. Registration No. 3200295, for “hand held lighting products, namely, flashlights and LED hand held lights.”

EYE CERA TEK, U.S. Registration No. 3938977, for “ceramic metal halide lamps.”

POWR-TEK, U.S. Registration No. 2654973, for “Fluorescent lighting tubes.”

Given the widespread use of the word “TEK,” it is maintained that “SOLIS” is rendered more significant or dominant in creating a commercial impression. Greater weight, therefore, should be placed on the commonality of “SOLIS” in both parties’ marks. *See In re Nat’l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751. Indeed, it is noted in the specimen of record that applicant’s packaging also uses the term “SOLISMAX66” wherein the term “SOLIS” is highlighted. Applicant therefore appears to consider the term “SOLIS” as a type of house mark, or, at a minimum, the main source indicator for its brand.

Regardless, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

In addition, it has been held that adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556,

557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii).

In the appeal brief, applicant has argued that since the cited mark is registered on the Supplemental Register it should be entitled to a narrow scope of protection. However, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or 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). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). Applicant has argued that since the term “SOLIS” should have a narrow scope of protection that the addition of “TEK” in conjunction with “additional descriptive or generic terminology DIGITAL LIGHTING” is sufficient to differentiate the marks. Otherwise, applicant argues “marks such as Coca-Cola and Pepsi Cola could not co-exist due to the overlap of the admittedly descriptive term COLA.” See Applicant’s Brief at page 10. However, applicant has not shown how “SOLIS” is descriptive. No evidence has been proffered concerning the meaning of the term or its relation to lighting products. Without such supplementary evidence, it is submitted that the mere fact that the cited registration is on the Supplemental Register should not be a strong factor in determining a likelihood of confusion in this case.

B. The similarity and nature of the goods or services as described in the application and registration.

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

In this case, applicant’s goods have been identified as “Electric luminaries; Lamp reflectors; Lamps; Light reflectors; Luminaries.” Registrant provides “(light emitting diode) electric lamps and LED (light emitting diode) electric luminaries.” Applicant has indicated in the Appeal Brief at page 9 that “the goods of the parties are highly similar if not identical in part” and that it concedes this factor in the likelihood of confusion analysis. Nevertheless, the evidence and arguments of record support the relatedness of the goods.

Both parties have identified electric luminaries and types of lamps. Since applicant has not specified particular types of electric luminaries or lamps, it must be presumed that the identification comprises the specific types of lamps and luminaries identified by registrant, namely, those featuring LEDs. The question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713,

1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). In addition, absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Applicant also appears to concede this point on page 9 of its brief.

The evidence of record also supports the close relationship between light/lamp reflectors and other lighting products, such as lamps or lighting fixtures. Therefore, applicant’s “lamp reflectors” and “light reflectors” should also be refused registration. The first Office action attached third-party registrations showing use of marks in connection with reflectors and lamps and/or luminaries. This evidence shows that the goods and/or services listed therein are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Several third-party websites were also attached to the final Office action to support the fact that reflectors and lamps or other lighting fixtures are complementary or are sold in the same channels of trade. For example, the website at [www.superbrightleds.com](http://www.superbrightleds.com) advertises high bay and low bay LED lighting fixtures and directly below, shows reflectors that are “designed for our LED High Bay and Low Bay Light Fixtures.” Similarly, a search for “high bay” at [www.daybrite.com](http://www.daybrite.com) shows various luminaires, overhead lights, as well as reflectors. This evidence establishes that the relevant goods and/or services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and that lighting

fixtures and reflectors are used and designed together; that is, they are complementary. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

C. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Applicant indicates that the parties have co-existed for two years. It also states that applicant is unaware of any instances of actual confusion. It therefore concludes that confusion is not likely to occur.

The examining attorney repeats the conclusions of the Board in *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984), wherein it stated:

[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).

The fact that applicant has had no notice of any actual confusion does not indicate that confusion has not occurred or is not likely to occur. For example, registrant may have received letters or other communications meant for applicant. Regardless, it is unnecessary to show actual confusion in establishing a 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. Finally, 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); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

### **CONCLUSION**

Based on the arguments and evidence submitted, the refusal to register on the basis on Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) should be affirmed. The arguments and evidence presented support a finding of a likelihood of confusion with the registered mark based on the similarities between the marks and the high degree of relationship between the respective goods and trade channels.

Respectfully submitted,

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