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

Proceeding	85775410
Applicant	Solis Tek, Inc.
Applied for Mark	SOLIS TEK DIGITAL LIGHTING
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I. INTRODUCTION

COMES NOW the Applicant Solis Tek Inc. (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant’s contention that the instant mark should be permitted to register.

II. STATEMENT OF THE CASE

Applicant applied to register the instant mark on November 9, 2012. The application was based upon Section 1(a) of the Act and was filed in connection with “Electric luminaries; Lamp reflectors; Lamps; Light reflectors; Luminaries” in International Class 11 with a date of first use on or about October 1, 2012.

On or about March 13, 2013 the Office conducted its initial review of the application at issue. On that date the Examining Attorney refused registration of the instant mark on the grounds that, if registered, the application would create a likelihood of confusion with the mark found in U.S. Reg. No. 3539121.

U.S. Reg. No. 3539121 is for the mark SOLIS used on in connection with “LED (light emitting diode) electric lamps and LED (light emitting diode) electric luminaries” in International Class 11. Of note, the mark is registered on the Supplemental Register. (*Emphasis Added*).

Applicant responded to the Examining Attorney’s refusal to register the mark on September 12, 2013. Deeming the response unpersuasive, the Examining Attorney went final on the refusal to register the mark on October 7, 2013. The instant appeal now timely follows.

III. ARGUMENT IN SUPPORT OF REGISTRATION

The Examining Attorney refused registration of the mark on the basis that, if registered, the Applicant's mark would create a likelihood of confusion with the mark SOLIS as used by Solid State Solutions, LLC, as more fully identified in U.S. Registration Number 3,539,121 (hereinafter referred to as "Solid State Solutions, LLC mark") which exists on the Supplemental Register for the U.S. Patent and Trademark Office.

Applicant respectfully disagrees with the Examining Attorney's decision as more fully set forth below.

The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *DuPont* factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

See id.

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor*

Sales, U.S.A., Inc., 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods with which the marks are used, the nature and scope of a party’s goods must be determined on the basis of the goods recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston ComputergoodsInc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811

F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).

If the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Moreover the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's mark is entitled to register despite the existence of the cited mark.

A. Similarity of Goods, Marketing and Trade Channels

At the onset it is noted that the goods of the parties are highly similar if not identical in part. As such, and in the absence of any limitations on the marketing or trade channels in the cited registration, it is presumed that both the goods of the Applicant as well as the goods of the registrant will travel in the same or similar channels of trade and be marketed in a similar manner. As such, Applicant must respectfully concede these *du Pont* factors.

B. The Cited Registration is Entitled to a Narrow Scope of Protection

However, based upon the weakness of the cited registration in conjunction with the narrow scope of protection to be afforded to the same, Applicant submits that there is still no likelihood of confusion should its mark be entitled to register.

The Applicant applied to register the mark SOLIS TEK DIGITAL LIGHTING. The cited mark is SOLIS (U.S. Reg. No. 3,539,121). Copies of the applications for Applicant's mark and for the blocking mark were previously made of record as Exhibits 1 – 2 to Applicant's April 1, 2014 Request to Reconsider (hereinafter "Request to Reconsider"). See Request to Reconsider, Exhibits 1 - 2.

Of note, the cited mark is only registered on the Supplemental Register. The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984).

With respect to marks registered on the Supplemental Register, the Board stated the following in *In re Hunke & Jochheim*:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as “weak” marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

185 USPQ 188, 189 (TTAB 1975) (citation omitted).

In that regard, it is submitted that the instant cited mark, SOLIS, which exists only on the Supplemental Register, should be afforded a very narrow scope of protection and, pursuant to *Hunke & Jochheim*, only block the registration of another mark that is “substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.” *Id.* In the instant case, the similarity as between the marks with the sole overlapping term being that of the descriptive SOLIS is simply not sufficient to maintain the instant refusal.

The only overlapping feature of the marks is the term SOLIS. This feature of the cited registration is, under the law cited above, entitled to an extremely narrow scope of protection as it is admittedly descriptive of the cited registrant’s goods. Within that context, the Applicant has not merely applied for the term SOLIS in connection with similar goods. Rather, Applicant has applied for SOLIS TEK DIGITAL LIGHTING in connection with its goods.

Although both marks share the common element SOLIS, under the cited law the registrant is entitled to a narrow scope of protection and the addition of the inherently distinctive term TEK in conjunction with additional descriptive or generic terminology DIGITAL LIGHTING must be sufficient to satisfy the requirements of the *Hunke & Jochheim* court. If not, marks such as Coca-Cola and Pepsi Cola could not co-exist due to the overlap of the admittedly descriptive term COLA.

As such, it is submitted that these differences in the appearance of the applied-for mark and the cited mark referenced herein create a separate and distinct commercial impression especially in light of the narrow scope of protection that should be afforded to the registered mark by virtue of its Supplemental Register status.

C. The Absence of Evidence of Actual Confusion and the Duration of Time the Marks have Co-Existed with the Absence of such Actual Confusion

But the instant argument is not submitted in a vacuum. In the instant matter, the Applicant and Registrant have co-existed in the marketplace for nearly two (2) years. During this time, Applicant is unaware of any instances of actual confusion as between the goods offered in connection with its mark and the goods offered under the registered mark. Moreover, as set forth in Applicant's Affidavit previously made of record with the Request for Reconsideration, given the length of time during which Applicant has used its mark in connection with its goods and has co-existed with the other registered mark without confusion such again suggests that confusion is not likely as between the marks should Applicant's mark be permitted to register. As such, it is submitted that this *du Pont* factor also favors registration of the Applicant's mark especially as evidence in support that given the weakness of the cited registration consumers are simply not actually confused as between the source of the goods and, accordingly, this evidence should be weighed heavily in favor of the registration of the instant application.

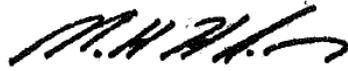
CONCLUSION

In conclusion, based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's mark.

WHEREFORE it is respectfully requested that the Board reverse the instant refusal to register this application and approve the instant application for publication upon the Principal Register.

Respectfully submitted this 8th day of August, 2014

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