

<p>This Opinion is not a Precedent of the TTAB</p>
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Appgraft LLC

Serial No. 85843178

Arnold S. Weintraub of The Weintraub Group, P.L.C.,
for Appgraft LLC

Timothy Schimpf, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Bucher, Wellington, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Appgraft LLC seeks registration on the Principal Register of the mark OBSERVANT OWL for “computer software for digital video monitoring and recording for use with video surveillance systems” in International Class 9.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of a likelihood of confusion with the mark OBSERVANT for goods and services

¹ Application Serial No. 85843178 was filed on February 7, 2013, based on Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

including, in most relevant part, “computer software, namely, fully downloadable software for wireless sensing, remote sensing, monitoring, measuring, recording, reporting, data processing, data transmission, management and control” in International Class 9.²

After the Trademark Examining Attorney made the refusal final, Applicant appealed. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to

² Registration No. 4398801, issued September 10, 2013 from an application filed August 28, 2012. In full, the registration identifies “electronic devices for monitoring, measuring and recording data; electronic devices for performing computations on recorded data, reporting on recorded data and communicating recorded data to other electronic devices through wireless and wired transmission means; electronic devices for management and control of other apparatus; computer software, namely, fully downloadable software for wireless sensing, remote sensing, monitoring, measuring, recording, reporting, data processing, data transmission, management and control; Computer software, namely, fully downloadable software, for the storage, retrieval, display, manipulation and processing of data stored either locally or remotely” in International Class 9 and “software as a service (SAAS) services, namely, hosting software for use by others for remote storage, processing, accessing, displaying and reporting of data; computer services, namely, remote management of software applications for others; customizing computer software for others” in International Class 42.

the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

We first address the second *du Pont* factor, the similarity of the goods. We must look to the goods and services as identified in the involved application and cited registration, not to extrinsic evidence of actual use. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).³

We find that Registrant’s identified “computer software, namely, fully downloadable software for wireless sensing, remote sensing, monitoring, measuring, recording, reporting, data processing, data transmission, management and control” is broad enough to encompass Applicant’s identified “computer software for digital video monitoring and recording for use with video surveillance systems.” The second *du Pont* factor thus weighs in favor of a finding that confusion is likely.

We turn next to the first *du Pont* likelihood of confusion factor, which focuses on “the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach*

³ For that reason, our decision does not rest on the printouts from Registrant’s website submitted by Applicant during prosecution and also attached to Applicant’s appeal brief. See June 16, 2014 Response to Office Action at 2-13; 4 TTABVue 7-18.

Servs. Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Because the similarity or dissimilarity of the marks is determined on the marks in their entireties, our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). On the other hand, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data*, 224 USPQ at 751.

The cited mark is OBSERVANT and Applicant’s mark is OBSERVANT OWL, both in standard characters. The initial term in Applicant’s mark constitutes the entirety of the cited mark OBSERVANT, an adjective meaning “noticing everything that happens.”⁴ However, we find that the additional term OWL in Applicant’s mark significantly distinguishes the meaning and overall commercial impression of Applicant’s mark from that of the cited mark. Although the Examining Attorney introduced Internet evidence that owls have excellent vision – particularly night vision – and are characterized in one source as “sometimes hav[ing] a watchful,

⁴ July 3, 2014 Final Office Action at 2, from MacmillanDictionary.com (American English definition).

thoughtful look,”⁵ Applicant’s mark as a whole clearly invokes a specific type of bird commonly associated with wisdom rather than observation, while the cited mark connotes only the adjective “observant.” The shared term “observant,” moreover, is highly suggestive of computer software for monitoring and recording. On the record before us, there is no reason to believe that the word OWL would be viewed as designating a variation of software goods from the same source as the cited mark OBSERVANT.

Each case must be decided on its own merits. *See In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Here, the fact that both marks contain the term OBSERVANT is not a sufficient basis for us to conclude that the marks are confusingly similar. Rather, we find that when these respective marks are considered in their entirety, their differences in connotation and overall commercial impression outweigh their similarity. Considering the specific marks and goods before us, under the first *du Pont* factor, we find the meaning and overall commercial impression made by the mark OBSERVANT OWL to be sufficiently dissimilar from the cited mark OBSERVANT to render confusion unlikely even though the goods are overlapping. In this case, the dissimilarity of the marks is determinative. *See Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The refusal to register Applicant’s mark OBSERVANT OWL is reversed.

⁵ *See id.* at 3-10.

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Opinion by Wellington, Administrative Trademark Judge, dissenting:

I respectfully dissent from the majority decision because I do not view the marks OBSERVANT and OBSERVANT OWL as creating significantly different commercial impressions. Although the registered mark, OBSERVANT, is a word that suggests a purpose or quality of monitoring and recording software, Applicant's addition of the word OWL does not necessarily negate this suggestive element for the same goods. That is, OBSERVANT, as the primary element in Applicant's mark and despite being used as an adjective for OWL, still connotes a quality or purpose of Applicant's monitoring and recording software.

I believe the marks are sufficiently similar that, when used on the same goods being offered for sale through the same trade channels to the same consumers, there is a likelihood of confusion. I would therefore affirm the refusal.