THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: January 10, 2023 Mailed: January 19, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re OptConnect Management, LLC

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Application Serial No. 88458583
Application Serial No. 88458653
Application Serial No. 88458681

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Glenn A. Gundersen and Gayle Denman of Dechert LLP,
for OptConnect Management, LLC.

Patrick Carr, Trademark Examining Attorney, Law Office 125,
Heather Biddulph, Managing Attorney.

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Before Bergsman, Shaw, and Allard,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

OptConnect Management, LLC ("Applicant") seeks registration on the Principal Register of the marks OPTCONNECT EMA (in standard characters), OPTCONNECT (in standard characters), and OPTCONNECT MANAGED WIRELESS SOLUTIONS and design, reproduced below, for specialized connectivity hardware, software, and transmission, management and monitoring services to facilitate machine-to-machine communications in connection with remote unattended automated teller machines, cash automation systems, commercial laundry

equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment, in International Classes 9, 38, and 42.

The application includes the following description of the mark:

> The mark consists of the term OPTCONNECT with the wording MANAGED WIRELESS SOLUTIONS in smaller type immediately below, all to the right of an abstract design consisting of interlocking shapes.
>
> Color is not claimed as a feature of the mark.

Applicant disclaims the exclusive right to use "Managed Wireless Solutions."

The specific descriptions of goods and services for the applications at issue are set forth below:

- Application Serial No. 88458583 for the mark OPTCONNECT EMA for the following goods and services:[1]

> Cellular modems designed for use in design, development, management, monitoring and repair of platforms facilitating machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-

[1] Filed June 4, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of its mark anywhere and in commerce as of May 2019 for the goods and services in both classes.

> service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet, in International Class 9; and
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> Providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet; providing on-line non-downloadable software designed for providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet, in International Class 42.

- Application Serial No. 88458653 for the mark OPTCONNECT and Application Serial No. 88458681 for the mark OPTCONNECT MANAGED WIRELESS SOLUTIONS and design both for the goods and services set forth below:[2]

> Machine-to-machine (M2M) device networking products, namely, modems, network routers, computer network adaptors, network power controllers, antennae, and amplifiers designed to facilitate machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; computer hardware for running firmware or software designed to facilitate machine-to-machine (M2M) communications and interfaces with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; microcontrollers

[2] Applicant filed both applications on June 4, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use its marks anywhere and in commerce as of October 2009 for the goods and services in all three classes.

and remote control transmitters designed for internet of things (IoT) enabled remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for connecting, operating and managing machine to machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment, in International Class 9;

Providing machine-to-machine (M2M) connectivity over long distances and remote locations with unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing electronic transmission of data and information to wirelessly connected machine-to-machine (M2M), network-connected, and Internet connected remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment comprising the Internet of things (IOT); technical consulting in the field of electronic and digital data transmission and communication via machine to machine (m2m) technology, remote device management and the internet of things (IoT) related to unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment, in International Class 38; and

Providing on-line non-downloadable software designed for connecting, operating and managing machine to machine (m2m) services for remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing a web portal featuring technological information and technology to monitor and manage connectivity, usage, management, and provisioning of machine-to-machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending

> machines, self-service retail point-of-sale devices, and agricultural equipment, and to provide reporting data and diagnostics and monitor the location of such devices; providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet, in International Class 42.

The Examining Attorney refused to register Applicant's marks under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's marks so resemble the registered mark OPCONNECT (in standard characters) for "interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging," in Class 9, as to be likely to cause confusion.[3]

The Board consolidated the appeals in Serial Nos. 88458653 and 88458681 in an order dated May 18, 2021.[4] On October 20, 2021, Applicant filed a request to consolidate the appeals in Applicant's three applications listed in the caption.[5] On February 3, 2022, the Examining Attorney filed a motion to consolidate the three applications.[6] Because the three appeals share common issues of fact and law, the Board grants the request/motion to consolidate the appeals. We refer to the record in application Serial No. 88458583 unless otherwise indicated.

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[3] Registration No. 3914101 registered February 1, 2011; renewed.

[4] 43 TTABVUE (Serial No. 88458653).

[5] 47 TTABVUE (Serial No. 88458583); 52 TTABVUE (Serial No. 88458653).

[6] 48 TTABVUE (Serial No. 88458583).

When we cite the prosecution history record, we refer to the Trademark Status and Document Retrieval (TSDR) system by page number in the downloadable .pdf version of the documents.

When we cite to the briefs, we refer to TTABVUE, the Board's electronic docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

I. Preliminary Issues

Before proceeding to the merits of the refusal, we address a briefing issue and an evidentiary issue.

A. Applicant's Reply Brief

Applicant's Reply Brief (56 TTABVUE) is single-spaced, contrary to the spacing requirements of Trademark Rule 2.126(b)(1), 37 C.F.R. § 2.126(b)(1) ("A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet.").[7] Nevertheless, because it appears that the Reply Brief would fall within the applicable page limit if it had been double-spaced, we exercise our discretion to consider the Reply Brief. *See In re Univ. of Miami,* 123 USPQ2d 1075, 1077 n.2 (TTAB 2017) (Board exercised its discretion to consider applicant's

[7] A brief filed in an ex part appeal must conform to the requirements of Trademark Rule 2.126(b). Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2).

appeal brief and reply that were not double-spaced because it appeared that they would fall within the applicable page limits had they been double-spaced).

B. Applicant's submission of unidentified third-party use

In its February 16, 2021 Request for Reconsideration, Applicant submits what it refers to as "other uses … for CONNECT-formative marks for vehicle charging kiosks and services. Exhibit D."[8] The exhibits showing use of the third-party marks appear to be associated with the third-party registrations because they display the same marks and owner.[9] For example, Applicant submitted a TSDR printout of Serial No. 88733198 for the mark WE CONNECT filed by Volkswagen Aktiengesellschaft accompanied by a screen shot of the Volkswagen We Connect ID app that purportedly "can view the range of your Volkswagen ID, vehicle, pre-set your preferred temperature, finding charging stations and much more!"[10] However, Applicant did not include the URLs for the screenshots, indicate whether the screenshots were specimens from the applications or registrations, or otherwise identify the screenshots.

To make Internet material properly of record, the offering party must provide the full address (URL) for the web page, and the date it was accessed or printed, either by the information displayed on the web page itself, or by providing this information in an Office action or an applicant's response. *In re I-Coat Co.*, 126 USPQ2d 1730,

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[8] February 16, 2021 Request for Reconsideration (TSDR 16).

[9] *Id.* at TSDR 155-206.

[10] *Id.* at TSDR 158-61.

1733 (TTAB 2018) ("We will no longer consider Internet evidence filed by an applicant in an *ex parte* proceeding to be properly of record unless the URL and access or print date has been identified, either directly on the webpage itself, or by providing this information in a response."); *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1593 (TTAB 2018) ("Internet printouts must include a date and source/URL applies equally to evidence submitted by Examining Attorneys in ex parte cases as it does to parties involved in inter partes cases, and is important because it ensures that an applicant can verify the information presented in the case.").

Nevertheless, in the subsequent Office Action, the Examining Attorney did not object to the non-complying Internet evidence and advise Applicant how to properly make the Internet evidence of record.[11] In fact, the Examining Attorney acknowledged the evidence and found it unpersuasive.[12] Therefore, the Examining Attorney waived any objection to the third-party use evidence. *See In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018) (by failing to object to Internet excerpts submitted by the examining attorney that did not include URLs and access dates, applicant waived its objections to the submission of those websites); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1208.03

[11] February 25, 2021 Denial of Request for Reconsideration.

[12] *Id.* at TSDR 1 ("Applicant's amendments regarding the Section 2(d) refusal have been reviewed and found unpersuasive."); *id.* at TSDR 3 ("Applicant arguments regarding the differences between the marks and the weakness of the wording CONNECT ignores the maxim that when comparing marks, '[t]he 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 [consumers] who encounter the marks would be likely to assume a connection between the parties.'").

(2022) ("[T]he Board will not consider non-complying Internet evidence filed by an applicant if, in the first Office action following the response in which the non-complying material was submitted, the examining attorney objects and advises the applicant how to properly make the Internet evidence of record, and the examining attorney maintains the objection in their appeal brief. Otherwise, the Board may consider the objection to be waived."). We have considered the evidence for whatever probative value it may have.

II. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

> [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on an analysis of all of the 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) (setting forth factors to be considered, referred to as "*DuPont* factors"); *see also In re Majestic Distilling Co.,* 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). "Whether a likelihood of confusion exists between an applicant's mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors." *Omaha Steaks Int'l, Inc. v. Greater*

Omaha Packing Co., 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). "In discharging this duty, the thirteen *DuPont* factors 'must be considered' 'when [they] are of record.'" *In re Guild Mortg. Co.,* 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.,* 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont,* 177 USPQ at 567)). "Not all *DuPon*t factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.,* 41 USPQ2d at 1533).

"Each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). "Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the 'fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.'" *In re Embiid,* 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *See also In re i.am.symbolic, llc,* 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) ("The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but 'may focus … on dispositive factors, such as similarity of the marks and relatedness of the goods.'") (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d

1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. The strength of the registered mark

The strength of Registrant's mark affects the scope of protection to which it is entitled. Thus, we consider the inherent or conceptual strength of Registrant's mark based on the nature of the mark itself and its commercial strength based on marketplace recognition of the marks. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength."); *Bell's Brewery, Inc. v. Innovation Brewing,* 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. September 2022 update) ("The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

Because neither Applicant, nor the Examining Attorney, submitted any evidence regarding the commercial strength of Registrant's mark, our analysis is limited to the inherent strength of Registrant's mark.[13]

We begin by noting that OPCONNECT consists of the prefix syllable "Op" and the suffix word "Connect." The MERRIAM WEBSTER DICTIONARY (merriam-webster.com) (accessed January 5, 2023) defines "Connect," inter alia, as "to become joined" and "to establish a communications connection: connect to the Internet."[14] ROGET'S 21ST CENTURY THESAURUS (3rd ed. 2013) (accessed December 6, 2023) lists "plugs into" and "network with" as synonyms of "Connect."[15] Thus, the suffix word "Connect" in the mark OPCONNECT suggests a connection to a power source and to the Internet.

The MERRIAM WEBSTER DICTIONARY (merriam-webster.com) (accessed January 5, 2023) defines "Op," inter alia, as an abbreviation for "operation; operative; operator."

When OPCONNECT is used in connection with "interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer

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[13] Furthermore, the owner of the cited registration is not a party to this proceeding and thus cannot introduce evidence regarding its use of the mark protected thereby. *See In re Thomas*, 79 USPQ2d 1021, 1027, n.11 (TTAB 2006) ("Because this is an *ex parte* proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark"). As a result, the commercial strength of Registrant's mark simply is not at issue in this proceeding.

[14] The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

[15] The Board may take judicial notice of information in a thesaurus. *See In re Wells Fargo & Co.*, 231 USPQ 116, 117 (TTAB 1986); *see also Sprague Elec. Co. v. Elec. Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980) (standard reference works).

operating software, for use in digital advertising and electric vehicle charging," it suggests an operational or working connection with an electric source and the Internet. Thus, OPCONNECT is inherently distinctive.

At a minimum, OPCONNECT has been registered on the Principal Register without a claim of acquired distinctiveness and, therefore, it is entitled to the benefits accorded a registered mark under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (registration is prima facie evidence of the validity of the registration and registrant's exclusive right to use the mark in commerce).

Applicant argues that OPCONNECT is entitled to only a narrow scope of protection because of third-party use and registrations featuring a Connect-formative mark for vehicle charging kiosks and services.[16] Applicant submitted four third-party registrations owned by two entities, as listed below:

● Registration No. 4182151 for the mark SEMACONNECT and Registration No. 4327474 for the mark SEMACONNECT and design both for "electrical apparatus,

[16] February 16, 2021 Request for Reconsideration (TSDR 155-206). We do not consider Serial No. 88733198 for the mark WE CONNECT or Serial No. 79298524 for the mark CAR-CONNECT and design because they are pending applications, not registrations. *Id.* at TSDR 155 and 201. Pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks. *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366 n.7 (TTAB 2007).

We do not consider Registration No. 4951536 for the mark NISSANCONNECT because it has been cancelled effective November 18, 2022, for failure to file a Section 8 declaration of use. *Id.* at TSDR 176. A cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007). *See also Action Temp. Servs. Inc. v. Labor Force Inc.,* 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("A cancelled registration does not provide constructive notice of anything.").

namely, charging stations for charging electric vehicles" and both owned by SemaConnect, Inc.; and

● Registration No. 4759043 for the mark EVCONNECT and design for, inter alia, "software for administration of, operation of, interacting with, accessing, and paying for operation of electric vehicle charging stations" and "charging stations for charging electric vehicles" and Registration No. 4754786 for the same mark for "charging stations for charging electric vehicles" both owned by EV Connect, Inc.

Applicant submitted exhibits showing use of CONNECT-formative marks purportedly in connection with vehicle charging stations and services. The third-party uses are listed below:[17]

● Volkswagen We Connect ID posted on Google Play for connecting a Volkswagen vehicle to the Internet, including providing "range and current charge level" of the vehicle and "start and stop charging sessions";[18]

● SemaConnect webpage advertising "Smart Electric Vehicle Charging Solutions for Businesses, Fleets, and Multifamily."[19] SemaConnect advertises that it provides fleet management software and charging stations;

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[17] The Car-Connect screenshot is from a website <car-connect.cc> originating in the Cocos Islands, an Australian territory. The screenshot is associated with an application filed by CAR-Connect GmbH with an address in Germany. February 16, 2021 Request for Reconsideration (TSDR 201-206). The screenshot displays a portable 44KW high voltage charger. Because there is no evidence that this product is sold in the United States or that consumers in the U.S. encounter this product, we do not give this exhibit any consideration.

[18] February 16, 2021 Request for Reconsideration (TSDR 159-61).

[19] *Id.* at TSDR 168-75.

● The NissanConnect EV & Services app posted on Google Play is designed to manage an electric vehicle such as battery charging, adjusting climate control, and checking battery status;[20] and

● EvConnect is advertised as comprehensive electric vehicle charging management software to manage access, pricing, and performance of charging stations.[21]

Applicant's evidence reinforces our finding that the word "Connect" in the mark OPCONNECT suggests a connection to a power source or the Internet. There is no evidence that OPCONNECT suggests anything other than an operational or working connection with an electric source or the Internet.[22] Therefore, we find that Registrant's OPCONNECT mark is entitled to the normal scope of protection accorded to an inherently distinctive, although somewhat suggestive, mark.

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[20] *Id.* at TSDR 182-86.

[21] *Id.* at 196-200.

[22] Applicant submitted copies of three third-party registrations for OP for various computer related products and services. March 4, 2020 Response to Office Action (TSDR 77-92). However, those goods and services are not related to "interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging." *See Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus "on goods shown to be similar"); *i.am.symbolic,* 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *TAO Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields "have no bearing on the strength of the term in the context relevant to this case.").

Applicant also submitted an excerpt from the Abbreviations.com website indicating that "OP' may be the abbreviation of "Operation" or "Operations." October 2, 2020 Request for Reconsideration (TSDR 16).

B. The similarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont,* 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

In comparing the marks, we are mindful that "[t]he 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." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.,* 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

We keep in mind that "[s]imilarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register OPTCONNECT EMA (and OPTCONNECT, both in standard characters, and OPTCONNECT MANAGED WIRELESS SOLUTIONS and design, reproduced below:

The Examining Attorney cited OPCONNECT (in standard characters) as a bar to registration.

1. OPTCONNECT

Applicant's mark OPTCONNECT and the registered mark OPCONNECT are similar, albeit not identical, in appearance and sound. The only difference between the two marks is Applicant's inclusion of the letter "T" after "Op" and before "Connect."

Where, as here, OPCONNECT and OPTCONNECT are not common words, there is no correct way for them to be pronounced. *Eveready Battery Co. v. Green Planet Inc.,* 91 USPQ2d 1511, 1518 (TTAB 2009); *Central Indus. v. Spartan Chem. Co. Inc.,* 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE likely to be confused with ICE SHINE); *In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003) (it is not possible to control how consumers will vocalize marks). Nevertheless, some consumers are likely to pronounce OPCONNECT as "ÄP KUH NEKT" and OPTCONNECT as "ÄPT KUH

NEKT" which are similar. Others may simply omit the letter "T" and pronounce the marks the same.

"Exact identity is not necessary to generate confusion as to source of similarly-marked goods." *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012). The public does not scrutinize marks. *See B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ 1719, 1721 (Fed. Cir. 1988) ("The purchasing public, we believe, does not indulge in such recognitional contortions but sees things as they are."); *In re Johnson Prods. Co., Inc.*, 22 USPQ 539, 540 (TTAB 1983) ("It is undeniable that if the mark is carefully examined, the two overlapping 'S's can be discerned. What is more significant, however, is that this sort of studied analysis of the mark is unlikely to occur in the marketplace where these products are sold.").

Slight differences in appearance and sound as we have here do not normally create dissimilar marks. *See Alfacell v. Anticancer Inc.,* 71 USPQ2d 1301, 1305 (TTAB 2004) (ONCASE v. ONCONASE: "As seen and spoken, this middle portion may be missed by many of the relevant purchasers."); *Glenwood Labs., Inc. v. Am. Home Prods. Corp.,* 455 F.2d 1384, 173 USPQ 19 (CCPA 1972) (MYOCHOLINE for a medicinal preparation for treatment of dysphagia, abdominal distention, gastric retention, and urinary retention is similar to MYSOLINE for an anti-convulsant drug); *Mag Instr. Inc. v. Brinkmann Corp.,* 96 USPQ2d 1701, 1714-15 (TTAB 2010) (difference of a single letter does not suffice to distinguish MAG STAR from MAXSTAR); *In re Great Lakes Canning, Inc.,* 227 USPQ 483, 485 (TTAB 1985) ("Moreover, although there are

certain differences between the [marks CAYNA and CANA] appearance, namely, the inclusion of the letter 'Y' and the design feature in applicant's mark, there are also obvious similarities between them. Considering the similarities between the marks in sound and appearance, and taking into account the normal fallibility of human memory over a period of time (a factor that becomes important if a purchaser encounters one of these products and some weeks, months, or even years later comes across the other), we believe that the marks create substantially similar commercial impressions.").

As to the meaning and commercial impression engendered by the marks, as we discussed above Opposer's mark OPCONNECT suggests a working connection with a power source or the Internet. Applicant contends, in its brief, that "in the context of [Applicant's] products … [OPT] suggests either 'optimal' or 'option.'"[23] Thus, Applicant's OPTCONNECT mark means and engenders the commercial impression of an efficacious connection. The meanings and commercial impressions engendered by the marks are similar, albeit, not identical.

Applicant also contends that because the "Connect" suffix is a weak term, consumers will focus on the OP or OPT prefix.[24] According to Applicant, the OP and OPT prefixes create different commercial impressions because OP is an abbreviation

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[23] Applicant's Brief, p. 13 (43 TTABVUE 16) (Serial No. 8845653). *See also* Applicant's Reply Brief (56 TTABVUE 2) (Serial No. 88458583) ("In Applicant's OPTCONNECT mark, the prefix OPT suggests "optimal" or 'optimum', and the word CONNECT suggests the communications connection made by a cellular modem, and remote management software and services.").

[24] *Id.*

for "operation" and OPT is a shortened form for "optimal" or "option."[25] Even assuming arguendo that consumers perceive OP as "operation" and OPT as "optimal" or "option," OPCONNECT engenders the commercial impression of a working connection while OPTCONNECT engenders the commercial impression of the best connection. These are similar, albeit not identical, meanings and commercial impressions.

We find Applicant's mark OPTCONNECT and the registered mark OPCONNECT to be similar in appearance, sound, connotation and commercial impression.

2. OPTCONNECT EMA

Applicant's mark is OPTCONNECT EMA and the registered mark is OPCONNECT. Applicant uses "EMA as an acronym for 'Embedded Modem Architecture' or 'Embedded Managed Modem Architecture,' to reference the technology of its OPTCONNECT EMA cellular modem."[26] Nevertheless, we find that Applicant's mark OPTCONNECT EMA and the registered mark OPCONNECT are similar for the reasons Applicant's OPTCONNECT mark is similar to OPCONNECT.

In addition, OPTCONNECT plays a more significant role than EMA in the appearance, sound, and commercial impression engendered by OPTCONNECT EMA because of its position as the first term in the mark. The lead element in a mark has a position of prominence; it is likely to be noticed and remembered by consumers and

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[25] *Id.*

[26] Applicant's Brief, p. 12 (43 TTABVUE 14) (Serial No. 88458583) (citing October 2, 2020 Request for Reconsideration (TSDR 6 and 19)).

so as to play a dominant role in the mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondee En 1772,* 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.,* 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The presence of the initialism EMA in Applicant's mark is a relatively minor difference that does not rise to the level of changing the connotation or commercial impression of Applicant's mark OPTCONNECT. A consumer familiar with Registrant's OPCONNECT mark upon encountering Applicant's OPTCONNECT EMA mark is likely to perceive EMA as identifying a specific part or component. For example, in addition to OPTCONNECT EMA, Applicant advertises OPTCONNECT

NEO2 multi-carrier cellular router,[27] OPTCONNECT MYLO router,[28] and OPTCONNECT SOLO.[29] Consumers may mistakenly believe that OPTCONNECT EMA is a specific product line from the previously encountered OPCONNECT products. Applicant's inclusion of EMA fails to distinguish the marks because of the similarity between OPTCONNECT and OPCONNECT. *See In re Denisi,* 225 USPQ 624, 624 (TTAB 1985) ("[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences."). *See also Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products).

We find that Applicant's mark OPTCONNECT EMA is similar to the registered mark OPCONNECT.

3. OPTCONNECT MANAGED WIRELESS SOLUTIONS and design

Applicant is seeking to register the mark OPTCONNECT MANAGED WIRELESS SOLUTIONS and design reproduced below:

[27] February 16, 2021 Request for Reconsideration (TSDR 18).

[28] *Id.*

[29] *Id.* at TSDR 19.

Once again, we find that the term OPTCONNECT is the dominant portion of Applicant's mark. First, OPTCONNECT is the part of Applicant's mark that first catches the consumer's eye because of its large size and central location.

Second, "[i]n the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because "[t]he word portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Aquitane Wine USA*, 126 USPQ2d at 1184 (quoting *Viterra*, 101 USPQ2d at 1911).

Finally, Applicant has disclaimed the exclusive right to use the descriptive term "Managed Wireless Solutions." It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because consumers will tend to focus on the more distinctive parts of marks. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *Dixie Rests.,* 41 USPQ2d at 1533-34); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'") (quoting *Nat'l Data Corp.*, 224 USPQ at 752); *In re Code*

Consultants, Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression").

While we have parsed out the minor elements of Applicant's mark to come to the conclusion that OPTCONNECT is the dominant part of the mark, we have not forgotten the fundamental rule that we must consider the marks in their entireties. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (CCPA 1974). We note the specific differences pointed out by Applicant. These differences, however, are outweighed by the similarities of the marks. Thus, for the same reasons we find Applicant's mark OPTCONNECT similar to the registered mark OPCONNECT, when comparing the marks OPTCONNECT MANAGED WIRELESS SOLUTIONS and design and OPCONNECT, they are similar in sound, connotation and commercial impression.

C. The similarity or dissimilarity and nature of the goods and services and established, likely-to-continue channels of trade

Applicant is seeking to register its marks for specialized connectivity hardware, software, and transmission, management and monitoring services to facilitate machine-to-machine communications in connection with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment.

The mark in the cited registration is registered for "interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging." Applicant and the Examining Attorney disagree as to the meaning of Registrant's description of goods:

● Applicant contends that Registrant's description of goods identifies a kiosk that is used for both digital advertising and electrical vehicle charging – a combined purpose – and not two separate purposes;[30] and

● The Examining Attorney contends that Registrant's description of goods encompasses kiosks for use in digital advertising, electrical vehicle charging, or digital advertising and electrical vehicle charging.[31]

Because both descriptions of goods and services are technical and complex and because Applicant and Registrant disagree as to the meaning of Registrant's description of goods, we refer to extrinsic evidence to clarify the nature of the products and services at issue. *See, e.g.*, *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 n.10 (TTAB 2009) (noting that, although extrinsic evidence may not be used to limit or restrict the identified goods, it is nonetheless proper to consider extrinsic evidence in the nature of dictionary entries to define the terminology used to describe the goods); *In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007) (evidence accepted to show registrant's goods would be used by industrial plastics manufacturers, not

[30] Applicant's Reply Brief (56 TTABVUE 4).

[31] Examining Attorney's Brief (55 TTABVUE 11).

handypersons); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) ("[W]hen the description of goods for a cited registration is somewhat unclear … it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade." (internal citations omitted)). We have considered the evidence discussed below in that light and not to restrict the goods and services identified in the application or registration.[32]

We turn first to Registrant's "interactive computer kiosks."

> Interactive kiosks are self-contained computing terminals that provide access to on-demand information and transactions. These devices can take a number of forms, such as touchscreen product displays, interactive mail directories, and employee HR stations. Some devices serve multiple purposes, e.g. a product catalog and gift registry for customers and job application center for prospective employees. Kiosks may be found in a growing number of industries, including retail, automotive, education, food service, and banking. Increasingly, multi-channel retailers are deploying these self-service devices to help customers choose products in the store and order out-of-stock items.
>
> Kiosk systems employ modular hardware designs that can be expanded to include numerous peripherals, such as touchscreens, thermal pointers, and barcode scanners. By their nature, interactive kiosks require robust and secure hardware and software to ensure a consistent user experience and prevent unauthorized modifications.[33]

[32] We disagree with the Examining Attorney's contention that Applicant uses extrinsic evidence to distort and distract from the description of goods set forth in the applications. Examining Attorney's Brief (55 TTABVUE 11).

[33] Wirespring.com attached to the April 2, 2020 Office Action (TSDR 35).

Registrant's description of goods identifies interactive computer kiosks for "digital advertising and electrical vehicle charging." As noted above, Applicant contends that Registrant has a dual purpose kiosk that is an electric vehicle charging station that also provides digital advertising. The Examining Attorney, on the other hand, contends that Registrant provides an interactive computer kiosk that provides digital advertising, electric vehicle charging, or both.[34]

Registrant's website refers to electric vehicle charging.[35] It does not refer to digital advertising either as a stand alone function or in combination with electric vehicle charging. However, one screenshot on Registrant's website refers to the "Marketing Opportunity" discussed below:

> **Marketing Opportunity: digital advertising opportunities:** Appear on apps and online networks like PlugShare (http://www.plugshare.com/). This advertisement can draw customers who need a charging station.[36]

Apparently, the owner of an electric vehicle charging station may advertise access to its electric vehicle charging station by posting online the location of its charging stations to attract customers. This is not an example of Registrant providing an interactive computer kiosk for digital advertising.

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[34] Meridian provides self-service electrical vehicle charging stations that are compatible with its software for providing digital advertising. February 16, 2021 Request for Reconsideration (TSDR 106 and 109); April 2, 2020 Office Action (TSDR 136-55).

[35] February 16, 2022 Request for Reconsideration (TSDR 60-79); October 2, 2020 Request for Reconsideration (TSDR 21-24 and 30); March 4, 2020 Response to Office Action (TSDR 16-33).

[36] March 4, 2020 Response to Office Action (TSDR 21).

The fact that neither Applicant, nor the Examining Attorney, submitted any evidence that Registrant offers an interactive computer kiosk for digital advertising does not mean that Registrant does not offer such a kiosk. A comparison with Applicant's description of goods and services offers a useful comparison. Applicant specifies that its hardware, software and associated services are used for (i) automated teller machines, (ii) cash automation systems, (iii) commercial laundry equipment, (iv) vending machines, (v) self-service retail point-of-sale devices, and (vi) agricultural equipment. Its products and services are purchased and used by technical professionals in the banking, laundry, vending, and agricultural businesses,[37] not a combined banking, laundry, vending, and agricultural business. If Applicant's goods and services can be used in connection within six distinct industries or fields, then Registrant's description of goods should be interpreted the same way (i.e., Registrant's goods can be used in connection with two distinct industries or fields: digital advertising or electrical vehicle charging).

In addition to Registrant's OPCONNECT interactive computer kiosks for electrical vehicle charging, Registrant offers OPCONNECT "fleet charging solutions":

> Working with [Registrant] to electrify your fleet simplifies the process. [Registrant] offers turnkey services from planning to installation, a range of charging station options from the highest powered DC fast chargers to Level 2, advanced energy management software features to save fleets money and protect critical utility infrastructure and charging-as-a-service business plans that let you pay one

[37] Applicant's Brief, pp. 7-8 (43 TTABVUE 9-10).

> monthly fee for the complete charger, software and service solution.[38]

OPCONNECT-as-a-service includes chargers, software, installation, maintenance, and operations with software and equipment upgrades.[39] Registrant "offers advanced software features to minimize the costs of implementing EVs and operating them."[40] For example, Registrant offers truck, shuttle, and bus fleet managers the following:

- High-powered chargers;
- Energy management software functionality to lower installation costs and protect critical infrastructure;
- Integration fleet management software to provide optimal planning and data tracking;
- Integration with onsite renewables and battery storage; and
- Automated delivery of reports required for grant or utility program compliance.[41]

In condominiums and apartments, Registrant provides a Bluetooth interface to drivers' mobile devices for charging and payment.[42] For commercial properties and workplaces, Registrant offers Wi-Fi, NFC, ethernet hard wire, and cellular options.[43]

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[38] February 16, 2021 Request for Reconsideration (TSDR 60).

[39] *Id.*

[40] *Id.* at TSDR 61.

[41] *Id.* at TSDR 62.

[42] *Id.* at TSDR 71.

[43] *Id.* at TSDR 75 and 78.

Likewise, third parties that offer charging stations provide a similar package of services. For example,

● ChargePoint provides charging stations and offers "an integrated portfolio of hardware, cloud services and support."[44] "ChargePoint cloud plans deliver everything station owners need to easily manage EV charging through a simple online dashboard."[45] Like Registrant, ChargePoint offers ChargePoint-as-a-service providing a complete electrical vehicle charging program.[46] "ChargePoint cloud plans let station owners easily control all aspects of EV charging from a powerful online dashboard."[47]

● SemaConnect offers electric vehicle charging stations and "comprehensive management software for [station owners] need for the EV fleet and shared parking.[48]

● ABB (abb.com) advertises AC wall boxes and DC fast charging stations for electric bus charging stations along with APIs for back office integration, web tools for real-time charger access, and SLAs to provide connectivity, monitoring, and diagnostics.[49]

● Greenlots Solutions (greenlosts.com) provides a turnkey electric vehicle charging program providing "hardware, software and support services to ensure that

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[44] *Id.* at TSDR 82.

[45] *Id.* at TSDR 89.

[46] *Id.* at TSDR 96. *See also* September 4, 2019 Office Action (TSDR 29-33).

[47] February 16, 2021 Request for Reconsideration (TSDR 96).

[48] *Id.* at TSDR 170, 173, and 174.

[49] September 4, 2019 Office Action (TSDR 8-13).

you can build out and maintain your charging infrastructure."[50] Greenlots' "software is an end-to-end EV charging network management solution."[51] Its "cloud-based software solutions give you the ability to deploy charging infrastructure."[52]

- EVBox.com provides electric vehicle charging stations[53] and charging management software that controls the charging station, tracks and manages all of the charging sessions, and configures the stations to operate to the customer's order and specifications.[54]

- ENEL X (evercharging.enelx.com) offers the JUICEBOX electric vehicle charging station and JUICEBOX Utility Edition software for load management.[55]

Vendors that sell electric vehicle charging stations also offer associated software packages to operate the system.

Registrant's clients include any organization or business where it is practical to provide electric vehicle charging stations, including but not limited to, school districts, trucking companies, municipalities for their buses, apartments and condominiums, commercial properties, workplaces, parking facilities.[56]

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[50] *Id.* at TSDR 18.

[51] *Id.* at TSDR 14.

[52] *Id.* at TSDR 20.

[53] *Id.* at TSDR 84.

[54] *Id.* at TSDR 79, 88.

[55] *Id.* at TSDR 106-107 and 115

[56] February 16, 2021 Request for Reconsideration (TSDR 61-63, 68, 73, 76, 84, 93, 100, 107-09, 116, 121, 123-24, 131-33, 139-42).

We turn now to Applicant's highly specialized computer hardware, software, and associated activities for facilitating machine-to-machine communications. "Self-service retail point-of-sale devices" is one of the fields in which Applicant offers its specialized computer hardware, software, and associated services. "Self-service retail point-of-sale devices" could include an electric vehicle charging station where an electric vehicle owner plugs in his/her vehicle and charges it for a fee. "Self-service retail point-of-sale devices" are broad enough to encompass electric vehicle charging stations. *See In re Solid State Design Inc.,* 125 USPQ2d 1409, 1413-14 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). Applicant's website (optconnect.com/solutions/parking-ev-charging) advertises that it provides a bundle of services and support for parking and electric vehicle charging.[57]

Applicant provides "the most reliable connectivity with the industry's best customer service in a complete and fully managed solution." Applicant provides a private network.[58] These products and services are unseen components of a finished

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[57] March 21, 2022 Denial of Request for Reconsideration (TSDR 14-16). *See also id.* at TSDR 17-19) (identifying, inter alia, parking and electric vehicle charging, kiosks, and digital signage applications).

[58] March 21, 2022 Denial of Request for Reconsideration (TSDR 32). Applicant provides more than just a connection to the Internet, Applicant "bundles that with an entire suite of

product and provide connectivity services undetected by the ultimate consumers.[59] Applicant's OPTCONNECT products and services enable those machines to communicate with other devices (i.e., machine-to-machine networking).[60]

> [Applicant] is in the business of networking physical objects that contain embedded technology – such as self-service kiosks – to communicate and sense their internal status out to an external environment, all without human interaction.[61]
>
> ___
>
> [Applicant] provides a secure and reliable monitored wireless connection to the Internet for unattended equipment.[62]

For example,

- Applicant's OPTCONNECT NEO2 is a cellular router "perfectly suited for kiosks, micro markets, digital signs and other applications that require high-speed connectivity";[63]

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managed services that provides greater IoT connectivity uptime and less stress and worry for the operators since every necessary component is taken care of." *Id.* at TSDR 14.

[59] February 16, 2021 Request for Reconsideration (TSDR 34-58).

[60] March 4, 2020 Response to Office Action (TSDR 35) ("[Applicant] offers machine to machine wireless service for ATMs, Kiosks, Digital Signage, Facility Management, Smart Safes, and may other industry sectors. … to make your data connection."); *Id.* at TSDR 36 ("For IoT & M2M Applications" providing a wireless connection to the Internet for unattended equipment).

[61] March 4, 2020 Response to Office Action (TSDR 37).

[62] *Id.* at TSDR 38.

[63] February 16, 2021 Request for Reconsideration (TSDR 18). It provides "primary network connectivity for micro markets, kiosks, signs, POS, ATMs, etc." and replaces "landline dialup circuits or analog cell-phones-Primary connectivity for PLCs, RTUs, POS, ATM solutions." *Id.* at TSDR 21.

- Applicant's OPTCONNECT EMA is a "modem with onboard intelligence, embedded firmware, and software paired with [Applicant's] industry leading suite of managed services";[64] and

- "[Applicant] provides a simple, fully managed solution for your device connectivity needs … [Applicant] include[s] a full suite of managed services so you can focus on your core business. … [Applicant] include[s] the hardware, the data plan, carrier management, and monitoring, secure private network."[65]

Applicant advertises that it offers more than a hardware or network service. Applicant "offers a completely managed service designed to make your data connection simple and reliable,"[66] and "a secure and reliable monitored wireless connection to the Internet for unattended equipment."[67] In other words, Applicant "is in the business of networking physical objects that contain embedded technology – such as self-service kiosks – to communicate and sense their internal status out to an external environment."[68]

> With benefits ranging for cost savings, flexibility, reliability, proactive alerting, and faster speeds, [Applicant] is helping make cellular-wireless solutions the new standard for deployments.[69]

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[64] *Id.* at TSDR 19.

[65] *Id.* at TSDR 31.

[66] March 4, 2020 Response to an Office Action (TSDR 36).

[67] *Id.* at TSDR 37.

[68] *Id.* at TSDR 38.

[69] *Id.*

As such, Applicant's connectivity products and services may be extended across unlimited fields.[70] For example, Applicant's products and services are used in connection with kiosks, digital signage, and electric vehicle charging.[71]

Applicant's customers such as ATM USA,[72] 365 Retail Markets (vending machines – micro markets),[73] BCC Payments (vending payments),[74] eGlobabl ATM Services,[75] and Parlevel Systems (vending machines)[76] advertise their products and services under their own trademarks without referring to Applicant's components or services.[77] For example,

- Joe Hellsing, CEO for 365 Retail Markets, states that his company uses Applicant's products and services to get its micromarket technology connected faster

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[70] Applicant promotes itself as "an industry leader in managed wireless solutions" working with a diverse customer base including ATMs, smart safes, kiosks, micro markets, digital signage, and electric vehicle charging. March 21, 2022 Denial of Request for Reconsideration (TSDR 17-18). Applicant "connect[s] an array of IoT devices across many markets and verticals." *Id.* at TSDR 19.

[71] Applicant provides equipment and associated services to third-party digital signage companies. *Id.* at TSDR 4, 11-12, and 26-29. Applicant provides equipment and associated services to support electric vehicle charging. *Id.* at TSDR 14-16. Applicant provides equipment and services to support wireless kiosks. *Id.* at TSDR 23-24.

[72] *Id.* at TSDR 37-39.

[73] *Id.* at TSDR 40-42.

[74] *Id.* at TSDR 43-45.

[75] *Id.* at TSDR 46-49.

[76] *Id.* at TSDR 50-58.

[77] Again, Applicant submitted webpages without providing URLs. However, because the Examining Attorney did not object, we will consider the webpages. *See* the discussion regarding Applicant's submission of unidentified third-party use in the Preliminary Issues, *supra*.

and reliably;[78]

● Michael Levesque, SVP Operations for Captivate, asserts that Applicant helps his company leverage telecommunications;[79]

● Larry Dunwald, President of MobileMoney, states that his company has chosen Applicant for its wireless solutions in its ATM portfolio;[80] and

● Brian Fitzpatrick, President and CEO of Revel Media Group, Inc., a digital signage company, states that Applicant provides stable connectivity and it provides a connectivity solution that is "truly plug and play";[81]

Applicant contends that it sells its products to the companies that develop and operate devices that incorporate its products and to the technical professionals at the businesses that use the end devices but that the end users of those devices do not encounter Applicant's products or services. For example,

● ATM and cash automation system operators and developers and technical professionals at banks (for automated teller machines and cash automation systems);

● Developers and operators of technology for commercial laundry operators and technical professionals at commercial laundries (for commercial laundry equipment);

● Vending machine developers and operators (for vending machines and self-service retail point-of-sale devices);

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[78] March 4, 2020 Response to Office Action (TSDR 41). *See also* October 2, 2020 Request for Reconsideration (TSDR 26-28).

[79] March 4, 2020 Response to Office Action (TSDR 38 and 41).

[80] *Id.* at TSDR 41.

[81] *Id.*

● Developers and operators of connected farm equipment and technical professionals at farms (for agricultural equipment);[82] and

● As discussed above, "self-service retail point-of-sale devices" that may include electric vehicle charging stations.

The key to finding goods and services related is that the same purchasers encounter the marks for both goods and services. *See Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (the consuming public must perceive the goods and services as originating from the same source). Companies that have purchased electric vehicle charging stations have also encountered the package of software that these vendors offer to operate the electric vehicle charging stations. Owners of electric vehicle charging stations also need a connection to the Internet to operate and manage their stations.

Here, a company that has an OPCONNECT electric vehicle charging station—such as a school district for its school buses and staff, trucking companies, municipalities for their buses and staff, apartments and condominiums, commercial properties, workplaces, and parking facilities—that is having connectivity issues or just needs to improve performance that subsequently encounters OPTCONNECT connectivity hardware, software and associated services for connecting to the Internet will mistakenly believe that the goods and services are related. They will believe that software and services for operating the electric vehicle charging stations

[82] Applicant's Brief pp. 8-9 (43 TTABVUE 10-11).

include connectivity hardware, software and associated services for connecting to the Internet.

We find that Applicant's connectivity hardware, software and associated services are related to Registrant's interactive computer kiosks for electric vehicle charging and that Applicant's goods and services are offered in some of the same channels of trade to some of the same classes of consumers that purchase Registrant's interactive kiosks for electric vehicle charging.

D. Conditions under which sales are made

There is no direct evidence or express testimony regarding the sales process or the degree of care relevant consumers exercise when purchasing Applicant's connectivity hardware, software and services or Registrant's kiosks for digital advertising and electric vehicle charging.[83] However, by virtue of the inherent nature of the goods and services at issue, the relevant consumers will exercise a high degree of purchasing care.[84] For example, the relevant purchasers have a focused need for these specific

[83] Applicant contends that its description of goods and services "clearly identifies specialized goods that are intended for nonconsumer, commercial uses, whose purchase requires technical sophistication and care" "purchased by technical professionals at companies who develop the devices that engage in machine-to-machine networking and at the business that use the end devices" citing the October 2, 2020 Request for Reconsideration (TSDR 26-28). Applicant's Reply Brief (56 TTABVUE 5) and February 16, 2021 Request for Reconsideration (TSDR 34-36). The evidence merely tells us that specific companies engaged Applicant for its connectivity solutions; it provided no information regarding the sales process, the purchasing process, or degree of care purchasing care prospective customers exercise. Applicant asks us to assume that consumers will exercise a high degree of purchasing care based on the nature of the products and services.

[84] While the Examining Attorney is correct that "[t]here are no limitations in the identification of [Applicant's] goods and services that would limit their sale to particularly sophisticated buyers" or that "the goods are particularly expensive," he is incorrect that there

products and services, the products and services are complex requiring substantial care and research, and experts will oversee the purchase. Because the products and services are not ordinary consumer products, we anticipate that customers will gather information about the products and services and make a selection based on factors other than the vendors' name.

We find that this *DuPont* factor weighs against finding a likelihood of confusion.

E. The nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion

Applicant contends that Applicant and Registrant have been using their well-publicized marks, respectively, since October 2009 and since May 2010, without any reported instances of confusion. However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Registrant under its mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

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is "nothing to indicate that the goods can only be used in highly specialized situations, … or require care in purchasing decisions, and nothing to indicate that they are offered only in specific and narrow channels of trade." Examining Attorney's Brief (55 TTABVUE 12). First, Applicant's description of goods and services is confined to "remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment." Thus, the goods and services are offered in specific channels of trade. Second, the products are designed "to designed to facilitate machine-to-machine communications." Thus, the products are used in highly specialized situations.

In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-07 (TTAB 1988).

The seventh and eighth *DuPont* factors regarding actual confusion require us to look at actual market conditions, to the extent there is evidence of such conditions of record. *New Era Cap Co.,* 2020 USPQ2d 10596, at *17 (TTAB 2020); *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020). Any lengthy absence of actual confusion during a period of known, rather than legally presumed, use in the same channels of trade could be telling. In this regard, we consider all of the evidence of record that may be relevant to the seventh and eighth *DuPont* factors.

First, there is no evidence regarding how long the parties have been using their marks concurrently. Applicant relies on the dates of use set forth in the respective applications. However, pursuant to Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), neither Applicant's, nor Registrant's, claimed dates of first use in their applications is evidence on behalf of Applicant and Registrant; "a date of use of a mark must be established by competent evidence." Applicant's constructive date of first use is June 4, 2019, the filing dates of its applications. Accordingly, on this record, that is date on which we must assess whether there has been an opportunity for confusion to occur.

Second, Applicant relies on two press releases to support its contention that Applicant's and Registrant's marks have been well-publicized.[85] There is no evidence as to the circulation of these press releases or the number or readers who may have encountered the press releases.

Third, there is no evidence regarding the extent of Applicant's or Registrant's advertising, revenues, market share, or renown.

Finally, in this ex parte context, there has been no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We, therefore, are getting only half the story. *See, e.g.*, *Guild Mortg. Co.*, 2020 USPQ2d 10279, at *7; *In re Opus One, Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001) ("The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred.") (citations omitted). This constraint, inherent in the ex parte context, necessarily limits the potential probative value of evidence bearing on the seventh and eighth *DuPont* factors, compared with an inter partes proceeding, where the registrant has an opportunity to present argument and evidence in response.

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[85] October 2,2020 Request for Reconsideration (TSDR 30-32)

Under these circumstances, therefore, these *DuPont* factors are neutral.

F. Conclusion

Despite the complex and technical nature of Applicant's goods and services, because the marks are similar and the goods and services have been proven to be related and are offered in some of the same channels of trade to some of the same classes of consumers, we find that Applicant's marks OPTCONNECT EMA (in standard characters), OPTCONNECT (in standard characters), and OPTCONNECT MANAGED WIRELESS SOLUTIONS and design, for specialized connectivity hardware, software, and transmission, management and monitoring services to facilitate machine-to-machine communications in connection with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment is likely to cause confusion with the registered mark OPCONNECT for "interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging."

Decision: We affirm the refusals to register Applicant's marks OPTCONNECT EMA (in standard characters), OPTCONNECT (in standard characters), and OPTCONNECT MANAGED WIRELESS SOLUTIONS and design.