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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re GoZone WiFi LLC*

Serial No. 86624361

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for GoZone WiFi LLC.

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Before Cataldo, Ritchie, and Lynch  
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

GoZone WiFi LLC (“Applicant”) seeks registration on the Principal Register of the standard character mark SMART WIFI for goods identified as “Computer application software for mobile phones, computers, laptops, tablets, namely, software for storing data and processing information,” in International Class 9.<sup>1</sup> The Examining Attorney

<sup>1</sup> Serial No. 86624361, filed on May 9, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1(a), alleging dates of first use and first use in commerce on January 4, 2015.

refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on the prior registration of various certification marks, all owned by the same registrant, including the certification mark WI-FI, in typed drawing form,<sup>2</sup> for "Computer hardware and peripherals, namely, wireless local area networking products," in Class A.<sup>3</sup> The registration contains a certification statement that "[t]he certification mark, as intended to be used, will certify that goods manufactured by authorized persons comply with interoperability standards."

After the Examining Attorney made the refusal final,<sup>4</sup> Applicant filed a request for reconsideration and an appeal. When the request for reconsideration was denied, the appeal was resumed, and is fully briefed. We affirm the refusal to register.

#### I. Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). As noted

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<sup>2</sup> *See* TMEP § 807.03(i) (October 2018) ("Prior to November 2, 2003, 'standard character' drawings were known as 'typed' drawings. The mark on a typed drawing was required to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.").

<sup>3</sup> Registration No. 2525795, registered January 1, 2002. Sections 8 and Section 15 accepted and acknowledged. Renewed.

<sup>4</sup> Other requirements by the Examining Attorney were considered to be satisfied and no other refusals were made final.

above, the cited registration is for a certification mark. The applicable section of the Trademark Act dictates that certification marks “shall be registrable under this chapter, in the same manner and with the same effect as are trademarks.” Trademark Act Section 4, 15 U.S.C. § 1054. The Section states further that: “[a]pplications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.”

Our precedent further clarifies that the classification as a certification mark “has very little effect on our determination as to whether or not there is a likelihood of confusion.” *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012). As further stated in that case:

The test for determining likelihood of confusion with respect to certification marks is the same as that applied to trademarks, *i.e.*, the *du Pont* analysis. However, because the certification mark owner does not itself use the mark, the question of whether there is a likelihood of confusion is based on a comparison of the mark as applied to the goods or services of the certification mark users. (citations omitted). Other issues relating to the goods and services, including the channels of trade and purchasers therefor, are determined from the standpoint of the users as well.

*Id.*, quoting *Motion Picture Ass’n of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559 (TTAB 2007). Thus, in considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014). “Not all of the [*du Pont*] factors are relevant to every case,

and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir 2010)).

As noted, as grounds for the refusal, the Examining Attorney cited several certification marks. All are owned by the same registrant, and all contain the term Wi-Fi or WiFi, either with a design or with other literal elements. All contain the same certification statement, or a variant thereof. We find the mark in Registration No. 2525795, which is comprised of only the term WI-FI in typed drawing form, to be the most relevant for our *du Pont* analysis, and we proceed accordingly. If we find a likelihood of confusion as to this registration, we need not reach the others. On the other hand, since this is the most relevant registration, if we find no likelihood of confusion as to this registration, we would not find it as to the other cited registrations either. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

#### A. Strength of the Cited Mark

Applicant argues that the shared term WiFi (or WI-FI) is weak. In particular, Applicant argues in its brief:

As noted by Applicant during prosecution, there are dozens of existing registrations and applications that utilize the term WIFI. The term is entitled to only weak protection, and consumers have learned to distinguish between marks with this common term. Thus, the term WIFI does not serve as a distinctive portion of any of the marks.

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Both Applicant and the Examining Attorney discuss the meaning of the term “WiFi” or “Wi-Fi,” although neither introduced a dictionary definition into the record. We take judicial notice of the following dictionary definitions:<sup>5</sup>

Wi-Fi: (certification mark) used to certify the interoperability of wireless computer networking devices.  
Merriam-Webster.com.

Wi-Fi: (trademark) A facility allowing computers, smartphones, or other devices to connect to the Internet or communicate with one another wirelessly within a particular area.  
Lexico.com; Lexico Powered by Oxford.

Wifi: a brand name certifying that a device or other product is compatible with a set of broadband wireless networking standards.  
Dictionary.com.

As demonstrated by these dictionary definitions, there does not appear to be any difference in the understood meaning of the terms WiFi or Wi-Fi, whether appearing with or without a hyphen, and both are referred to as a trademarked term.

Applicant submitted with its December 26, 2018 Request for Reconsideration webpages showing third-party use of the term WiFi or Wi-Fi in reference to what appear to be computer-related services. There is no indication, however, as to whether Registrant, a certifying organization, has certified these uses of its WI-FI certification mark.

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<sup>5</sup> See, e.g., *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

Applicant also submitted copies of nine third-party registrations with marks that include the term WiFi or Wi-Fi, and that either disclaim the term or that are registered on the Supplemental Register.<sup>6</sup> The “existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nonetheless, in determining the degree of weakness, if any, in the shared term WiFi (or Wi-Fi), “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

That said, to the extent Applicant is arguing that the mark in the cited registration is merely descriptive and unprotectably weak, the mark, which is registered on the Principal Register without a claim of acquired distinctiveness, is entitled to a presumption of validity that cannot be challenged via this ex parte proceeding. 15 U.S.C. § 1057(b). We find that there is some degree of conceptual weakness in the cited mark. It is, nevertheless, well recognized that even weak marks are entitled to protection against a mark that is substantially similar and is used on

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<sup>6</sup> Applicant also submitted one third-party pending application, as well as its own registration for GOZONE WIFI, Registration No. 4895020, which is registered on the Principal Register with a disclaimer of the term “WiFi.”

similar goods, as here. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974).

#### B. The Marks

We next compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721. Under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the United States Army*, 85 USPQ2d 1264 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the 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. Vv. 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, different features may be analyzed to determine whether the marks are similar. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (citing *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955)). In fact, 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 Corp.*, 224 USPQ at 751.

The mark in the cited registration is WI-FI, whereas Applicant’s mark is SMART WIFI. The marks are thus similar in sight and sound, with both including the term Wi-Fi or WiFi. As noted above, there is no apparent distinction in the understood meaning of this term, either with or without a hyphen. Although, as Applicant points out, its mark has a different first term, we consider the marks as a whole, and we note that WI-FI is the entirety of the cited mark. Adding the modifier “SMART” merely adds suggestive or laudatory information about the nature of Applicant’s goods. Applicant appears to admit this in its brief:

[T]he term [SMART] also conveys distinct impressions to consumers that it is either “smart” to use Applicant’s goods or services or that Applicant’s goods and services have additional “smart” elements or features above and beyond that which can be found in goods and services offered under other marks, including marks using only the single term WI-FI.

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In this regard, we note that WI-FI is a certification mark for various computer-related goods. Thus, Applicant's mark SMART WIFI for other computer-related goods is likely to be perceived as a variant of Registrant's WI-FI mark, registered and used with Registrant's certification and permission.

We find that the first *du Pont* factor favors finding a likelihood of confusion.

### C. The Goods, Trade Channels and Purchasers

We now consider the similarities or dissimilarities between the respective goods as identified in the application and the certified goods of the cited registration. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (goods as identified in involved application and cited registration compared); *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Applicant identifies "Computer application software for mobile phones, computers, laptops, tablets, namely, software for storing data and processing information." The cited registration identifies "Computer hardware and peripherals, namely, wireless local area networking products," with the certification statement that "[t]he certification mark, as intended to be used, will certify that goods manufactured by authorized persons comply with interoperability standards."

Applicant argues that its identified goods are not related since Applicant provides software, while Registrant's identified goods are for computer hardware. We agree that computer hardware and software products are not *per se* related. Nevertheless, as identified here, Applicant's broadly identified software for "storing data and

processing information” is likely to be used in conjunction with Registrant’s certified users’ “wireless local area networking products.” See *In re Iolo Technologies*, 95 USPQ2d 1498, 1500 (TTAB 2010) (finding likelihood of confusion where “based on the identifications themselves” the goods are “complementary in function and purpose”) (citing *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding likelihood of confusion “as a matter of law” based on a comparison of the parties’ identifications, although they involved different goods and services within the fields of technology).

Applicant’s specimens refer to use of Applicant’s product with “WiFi” (also referring to “Wi-Fi”):<sup>7</sup>



The Examining Attorney further submitted evidence of use-based, third-party registrations that include software for storing or processing information, as identified

<sup>7</sup> We note that Applicant’s specimens refer to “WiFi” and “Wi-Fi” in uppercase, which is more typically used to reference a trademark. See *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1190 (TTAB 2017).

by Applicant, and computer hardware and peripherals,<sup>8</sup> as identified by Registrant. These include INVINTORY, (Registration No. 5656623); BARK YARD (and design) (Registration No. 5654558); DEEPINVIEW (Registration No. 5657995); DARKFIGHTER (Registration No. 5656996); EARLOW (Registration No. 5649236); and TORYTRACK (Registration No. 5651701).

These third-party registrations serve to suggest that the goods are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). We find that the goods are similar and are likely to be complementary.

As to channels of trade and classes of consumers, neither the identification of goods in the application nor the identification of goods in the cited registration contains any limitations. Accordingly, we must assume that Applicant's and Registrant's certified users' goods may travel via all normal channels of trade and be marketed to typical consumers, which would include overlapping members of the general public that seek various types of computer-related products. *See Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). Accordingly, the second and third *du Pont* factors also weigh in favor of finding a likelihood of confusion.

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<sup>8</sup> We note that several of these third-party registrations identify, generally, "computer hardware and peripherals," which would be presumed to include, as a subset, Registrant's more narrowly identified goods.

#### D. Conclusion

After considering all of the arguments and evidence of record as they pertain to the relevant *du Pont* factors, we find that, despite some conceptual weakness of the term Wi-Fi, Applicant's mark is similar to the cited certification mark, when considered as a whole in sight, sound, connotation, and commercial impression. We further find that the goods are similar and are likely to be used in a complementary way, including travelling through some of the same channels of trade to the same classes of consumers. Accordingly, we find a likelihood of confusion between Applicant's mark SMART WIFI and the certification mark in the cited registration WI-FI for the goods identified.

**Decision:** The Section 2(d) refusal to register Applicant's mark is affirmed.