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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Opt It, Inc.

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Serial No. 78591138

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Stephen Lesavich, PhD of Lesavich High-Tech Law Group, P.C.  
for Opt It, Inc.

Carol Spils, Trademark Examining Attorney, Law Office 104  
(Chris Doninger, Managing Attorney).

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Before Grendel, Holtzman and Rogers, Administrative  
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark depicted below



for goods identified in the application as "computer software, namely, computer software for text messaging."<sup>1</sup>

At issue in this appeal is the Trademark Examining Attorney's final refusal to register on the ground that applicant's mark, as applied to the goods identified in the application, so resembles the mark **OPT!**, previously registered (in standard character form) for goods identified in the registration as "computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details,"<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

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<sup>1</sup> Serial No. 78591138, filed March 20, 2005. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). May 12, 2004 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce. The application includes applicant's color claim: "The colors red and white are claimed as a feature of the mark." The color location statement reads: "The color red appears inside the two circles and the color white appears in the outline of the circles and the wording OPT IT."

<sup>2</sup> Reg. No. 2101964, issued September 30, 1997. Affidavits under Sections 8 and 15 accepted and acknowledged. Renewed.

The appeal is fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, 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); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Under the first *du Pont* factor, we determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc.*, *supra*. The test, under the first *du Pont* factor, 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.

The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applying these principles in the present case, we find as follows. First, we find that the dominant feature in both marks is the word OPT. It essentially comprises the entirety of the cited registered mark; the exclamation point emphasizes and reinforces the significance of the word OPT. OPT likewise is the dominant feature in the commercial impression created by applicant's mark. It is the first word in the mark. It appears in the mark as an active verb, meaning to choose or select. By contrast, the word IT in the mark is an undefined pronoun which refers back to, and is subordinate to, the word OPT. The design elements of applicant's mark contribute to the mark's

commercial impression, but would be viewed primarily as mere background or carrier devices and thus are of lesser source-indicating significance than the wording in the mark, especially the word OPT. We view the marks in their entirety, but we conclude for the reasons stated above that the word OPT would be perceived as the dominant source-indicating feature of both marks. We therefore accord to it more weight in our comparison of the marks. *See In re Chatam International Inc., supra; In re National Data Corp., supra.*

In terms of appearance, we find that the applicant's mark is similar to the cited registered mark to the extent that both feature the word OPT as their dominant features. The two marks are dissimilar in appearance to the extent that applicant's mark also includes the word IT, as well as the design elements. We note that the wording in applicant's mark is stylized. However, the cited mark is registered in standard character form, which entitles registrant to display the mark in all reasonable manners, including in lower case letters. *See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).* The similarity in the appearance of the marks is lessened by the presence of the circle and arrow design elements in applicant's mark. However, viewing the marks in their

entireties in terms of appearance, we find them to be similar.

In terms of sound, the marks obviously are similar to the extent that they both include the dominant word OPT, as the first word in applicant's mark and as the entirety of the registered mark. OPT would be pronounced the same in both marks. The marks are dissimilar to the extent that applicant's mark also includes the word IT. On balance, we find that the similarity in sound which results from the presence of OPT in both marks outweighs the dissimilarity which results from the presence of the word IT in applicant's mark, and that the marks in their entireties are similar in terms of sound.

In terms of connotation, we find that the marks are similar. OPT IT carries a connotation of a command or suggestion, encouraging the purchaser to "opt" for or choose "it," whatever "it" is. The registered mark likewise connotes a command or suggestion that the purchaser "opt" for or choose something.

In terms of overall commercial impression, we find that the marks are similar. The dominance of the verb OPT as the source-indicating element of both marks makes it likely that purchasers would view the OPT IT mark as a mere

extension of or variation on the OPT! mark. Both marks encourage purchasers to "opt" for an undefined something.

Considering the marks in their entireties in terms of appearance, sound, connotation and commercial impression, and giving appropriate weight to the word OPT as the dominant source-indicating feature of both marks, we find that the marks are very similar. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the goods as identified in the application and in the cited registration. It is settled that it is not necessary that the goods be identical or even competitive in order to find that the goods are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. See *In*

*re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Finally, it is settled that our determination under the second *du Pont* factor must be based on a comparison of the goods as they are identified in the application and registration, respectively, and not on the basis of any evidence offered to show the nature of the goods as they are actually marketed (such as the printouts of applicant's and registrant's websites submitted by applicant herein). See, e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

To review, applicant's goods are identified in the application as "computer software, namely, computer software for text messaging." The goods identified in the cited registration are "computer program for managing personal and business contacts; organizing personal information; keeping calendar and personal reminders; keeping history of contacts; keeping record of expenses; making phone calls; sending/receiving faxes and E-mail; and printing letters, labels, envelopes, phone books, address books, and contact details."

Initially, applicant argues that its text messaging software is used only in connection with applicant's advertising services, which are the subject of applicant's prior registration of the mark for "advertising services, namely, providing special offers, promotions and updates for others via text messaging."<sup>3</sup> However, the identification of goods in the current application does not include any such limitation; applicant seeks to register the mark for the text messaging software alone. Applicant's prior registration of the mark for advertising services (and the Office's issuance of that registration based on an implicit finding of no likelihood of confusion) is not relevant or dispositive here, even if the advertising services involve text messaging.

Registrant's software, as identified in the registration, assists the user in organizing personal and business information, and provides various tools for electronic communication with others, including telephone, fax and email. Applicant's software, as identified in the application, is used for text messaging, which is another method or tool for electronic communication. Applicant contends that text messaging and email do not employ

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<sup>3</sup> Registration No. 3068068, issued March 14, 2006.

"equivalent technologies." Even if that is so, it is not dispositive here. As noted above, the respective goods need not be identical to support a finding that they are related for purposes of the second *du Pont* factor.

The Trademark Examining Attorney has submitted evidence which shows that text messaging software and software such as registrant's involving other electronic communication tools function together as complementary goods. For example:

Smith said Ecuity had already been in the process of acquiring other complementary software for the secure delivery of text messaging, email, document and data transmission - primarily the acquisition of the core technology assets of Karunga Technologies Corp. "By bringing together the telephone infrastructure and business systems from Fox Communications and the proprietary software technologies for secure text messaging, email and document/data transmission, Ecuity is able to deliver a complete integrated communication system..."  
(PR Newswire, July 21, 2004);

Bitfone's software infrastructure leverages the worldwide success of text messaging and mobile email to enhance the end-user's experience and create true customer value...  
(Business Wire, September 6, 2001); and

eZiText™ is a leading software technology that connects people to text messaging, email, e-commerce and web browsing.  
(PR Newswire, March 27, 2000).

Some of the evidence submitted by applicant likewise

demonstrates the relationship between text messaging and other methods of electronic communication such as email, voice mail and fax:

Today, technology is moving towards the future of the wireless web. Mobile devices such as palmtops, handhelds, and cellular phones are becoming all the rage. People want these devices to do everything from access their e-mail accounts, to utilize the Internet, to access personal and corporate information. One type of service that is available is a technology called SMS (Short Messaging Service). SMS is the technology that allows text messages to be received and sent over mobile devices ... SMS is a very inexpensive method of communication. 160 characters take up as much room as a one-second voice call. Messages are delivered immediately (or when the phone is turned on). Like e-mail, they can also be reviewed or stored in your phone for as long as you wish. SMS messages can also be sent out to huge groups of people with the single press of a button. SMS also allows for unified messaging. This is where SMS can take on a number of different message formats (including voice mail, e-mail and fax) and allows users to access them from their mobile device. ([devx.com/wireless/articles/SMS/SMSIntro.asp](http://devx.com/wireless/articles/SMS/SMSIntro.asp)).

Based on this evidence, we find that purchasers are likely to assume or expect that text messaging software is or can be integrated with software that allows for other methods of electronic communication. Both types of software are incorporated into or can be used with mobile devices such as cellular phones and personal digital assistants. We note that these mobile devices also have the capability to perform many of the other personal and

business organizer functions covered by the software identified in the cited registration.

Applicant contends that text messaging was not in existence, or at least was not widely available, at the time that registrant's application was filed in 1995 or when the registration issued in 1997. To the extent that this argument is offered to prove that registrant's identification of goods cannot be deemed to include software which provides a text messaging function, we deem it unnecessary. We can see from the face of the registration's identification of goods that text messaging is not included among registrant's software's functions.

To the extent that applicant is arguing that, because there could have been no likelihood of confusion in 1995 due to the unavailability of text messaging at that time, there can be no likelihood of confusion today, the argument is unavailing. Our likelihood of confusion determination is based on purchasers' perceptions and assumptions today, not what those perceptions or assumptions might have been in 1995 or 1997. The evidence of record establishes that purchasers today would understand that text messaging capability is often combined or bundled with email and other electronic communication capabilities, all of which

are incorporated into and can be accessed via today's mobile devices.

We conclude that applicant's software is related to registrant's software, and that the second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We also conclude, under the third and fourth *du Pont* factors, that applicant's goods as identified in the application and registrant's goods as identified in the registration are or could be marketed in the same trade channels and to the same classes of purchasers. These purchasers would include end users who want their mobile devices to provide multiple tools or methods for electronic communication, including text messaging, phone and email. These end users include ordinary consumers who would exercise only a normal degree of care in purchasing the goods. The third and fourth *du Pont* factors weigh in favor of a finding of likelihood of confusion.

Applicant contends (under the seventh *du Pont* factor) that there have been no instances of actual confusion between applicant's goods marketed under applicant's mark and registrant's goods marketed under registrant's mark. However, the absence of actual confusion is entitled to little weight in the likelihood of confusion analysis in an *ex parte* proceeding like this. See *In re Majestic*

*Distilling Co., supra; In re Dixie Restaurants Inc., supra.*

This is especially so in the present case, where the record does not support a finding under the eighth *du Pont* factor that there has been any significant opportunity for actual confusion to have occurred.

Considering and balancing all of the evidence of record as it pertains to the *du Pont* factors, and for the reasons discussed above, we conclude that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register is affirmed.