

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
March 18, 2003
Paper No. 33
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Behavioral Dynamics, Inc.
v.
Motivision, PLC (formerly Unicorn Services, PLC.)

Opposition No. 104,893
to Application No. 74/713,159
filed on August 9, 1995

Royal W. Craig, Gregory M. Stone and Deborah J. Westervelt
of Law Offices of Royal W. Craig for Behavioral Dynamics,
Inc.

Edward P. Kelly of Lelfe & Lynch for Motivision, PLC.

Before Seherman, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Motivision, PLC
(formerly Unicorn Services, PLC) to register the mark
MOTIVATOR PLUS for "scientific and electrical devices,
namely, a device for delivering minimally liminal
electrical signals for behavioral modification" in
International Class 9.¹

¹ Application Serial No. 74/713,159 filed on August 9, 1995
alleging a *bona fide* intention to use the mark in commerce in
addition to claiming a basis for registration under Section 44(e)
on the basis of a Benelux registration.

Registration has been opposed by Behavioral Dynamics, Inc. on the ground that it is the owner of a registration for the mark MotivAider in the form shown below:



for "electronic unit for providing a sensory stimulus to an individual to effect a response," also in International Class 9,² and that applicant's mark, if used in connection with the identified goods, so resembles opposer's mark as to be likely to cause confusion, to cause mistake or to deceive.

Applicant, in its answer, denied the salient allegations of the likelihood of confusion claim. Only opposer has filed a brief in this case.

The record consists of the file of the involved application; the trial testimony deposition of Steve Levinson, opposer's president, with accompanying exhibits, including a copy of opposer's pleaded registration; the trial testimony deposition, with exhibits, of James B.

² Registration No. 1,625,784 issued on December 4, 1990, Section 8 affidavit accepted and Section 15 affidavit acknowledged; first renewal. The special form drawing is lined for the color gray but color is not claimed as a feature of the mark.

Caldwell, president and owner of Future Thunder Productions, Inc.; and the trial testimony deposition, with exhibits, of Leslie S. Weber, applicant's President and CEO.

Initially, we find that based upon the submission into the record of its federal trademark registration, opposer has demonstrated standing in this case. Further, in view of that registration, priority is not in issue. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn our attention to the issue of likelihood of confusion, the crux of this controversy. In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The du Pont case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

We begin our analysis by turning to the similarity or dissimilarity of the marks in their entireties as to sound, appearance and meaning.

As opposer has consistently argued, the aural differences in the pronunciation of the words "Motivator" and "MotivAider" would be difficult for most listeners to discern. To the extent the host of an infomercial, for

example, were repeatedly to pronounce opposer's "MotivAider" without benefit of a graphic presentation appearing on the screen, opposer's mark would likely sound to the listener exactly like "Motivator."

As to appearance, while the capital letter "A" in the middle of opposer's mark sets apart the word "Aider," the evidence indicates that this novel depiction does not have a great impact on consumers. Specifically, opposer has submitted a series of orders and letters in which its customers incorrectly use the term "Motivator" to refer to its "MotivAider" product. Under actual marketing conditions consumers do not have the luxury of making side-by-side comparisons between marks. Rather, they must rely upon hazy, past recollections. See Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255 (TTAB 1980). The evidence that consumers refer to opposer's goods as "Motivator" demonstrates that consumers do not note or remember the novel presentation of opposer's mark, and therefore they are not likely to distinguish the parties' marks on the basis of this difference in appearance.

We also note that applicant's mark contains the additional word PLUS. However, the word "Plus" follows the

leading word, "Motivator," and is lauditorily descriptive³ of applicant's goods, and is insufficient to distinguish the marks. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985)[in comparing marks, it is permissible to accord more or less weight to a particular feature of a mark, provided that the marks are considered in their entireties]. Moreover, despite the difference in spelling, the two marks have the same basic connotation of a device that can help to motivate or change behavior. Applicant's addition of the word "Plus" to the phonetic equivalent of opposer's mark does not alter that connotation.

While both of the marks appear to be somewhat suggestive of behavior modification devices where human "motivation" plays a key role, there is no probative evidence that the term "motivator" is weak for these goods. Specifically, there is no evidence of third-party use or registrations for "Motivator" marks in conjunction with similar goods (e.g., the du Pont factor dealing with the number and nature of similar marks in use on similar goods). Further, to whatever extent the marks are

³ **Plus:** (adj) ... (2) Added or extra ... The American Heritage Dictionary of the English Language (3rd Ed. 1992).

suggestive, they are both suggestive in the same way, i.e., their connotation is the same.

Accordingly, although there are some differences in the appearance of the marks, we find that they are similar in their overall commercial impressions.

We turn next to the du Pont factor dealing with the similarity or dissimilarity and nature of the goods as described in the application and registration. The record shows that applicant's device is to be attached to one's television, and that applicant claims based upon the science of mind/body communications, its device delivers visual subliminal messages designed to modify behavior to, for example, achieve weight loss. Opposer's device is a small hand-held device that vibrates at intervals set by the user. It, too, is designed to modify behaviors in order to lose weight, stop smoking, or make other personal changes.

Hence, both devices are designed to help modify behaviors. Although applicant's device is a fairly large peripheral attached to one's television and opposer's device is a small portable device having characteristics similar to an egg timer or stopwatch, these specific differences are not set forth in the respective identifications of goods in the application and

registration. Rather, as identified, the goods must be deemed to be quite similar if not legally identical.

As to the similarity or dissimilarity of established, likely-to-continue trade channels, the record shows that both applicant and opposer have used infomercials broadcast over television to tout the benefits of their respective products.⁴ Both are directed to the same ordinary purchasers, especially those wanting, for example, to lose weight.

As to any market interface between applicant and opposer, the record reflects an initiative taken by applicant in 1995 to acquire opposer's company based upon its belief that there may be some synergy between their respective product lines. While applicant drafted a letter of intent and a letter of non-opposition, the documents were never executed and the acquisition did not go forward.⁵ In his trial testimony deposition, applicant's President and CEO Leslie S. Weber stressed that opposer's device is completely different from applicant's product. On the other hand, in a letter to Dr. Steve Levinson, opposer's

⁴ Although applicant's instant application is based upon an intention to use the mark, the evidence of record indicates that applicant has commenced use.

⁵ The record does not suggest that there was any litigation between the parties in 1995. Hence, this exchange was a good faith exploration of a potential business venture and not in any way part of a proposed settlement of any litigation.

president, dated November 16, 1995, Mr. Weber included the following paragraph:

If you choose, for whatever reason, not to sign the Letter of Intent and the Letter of Non-opposition, then we will instruct our marketing and design people to proceed with different trademarks, redesign our packaging with the result that the Motivator Plus will be re-named. We would then withdraw our letter of Intent and attempt to reach new understandings which would hopefully result in the acquisition ultimately being completed.

Opposer points out that when the acquisition deal fell through, applicant reneged on its offer to rename its product and continued to pursue the instant federal trademark application.

In an attempt to demonstrate the extent of actual confusion between the respective marks, opposer has, as noted previously, made of record a series of orders and letters in which its customers incorrectly use the term "Motivator" to refer to its "MotivAider" product. However, none of these examples appears to be probative of confusion with applicant's specific "Motivator Plus" product. Rather, they appear to be misspellings of opposer's trademark on the part of its customers who failed to appreciate opposer's choice of a clever spelling when naming its product.

Accordingly, based upon the fact that the respective marks form similar overall commercial impressions, that the goods are very similar if not legally identical, that they will move in similar channels of trade to ordinary consumers pursuing similar behavior modifications, and that there is no evidence in the record of third-party use or registrations for related products, we find that applicant's MOTIVATOR PLUS trademark for its identified goods is likely to cause confusion with opposer's mark.

Decision: The opposition is sustained, and registration to applicant is refused.