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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Futura, D.O.O.
v.
Media Farm Solutions, LLC

Opposition No. 91174999
to application Serial No. 78773408
filed on December 14, 2005

Marsha G. Gentner of Jacobson Holman PLLC for Futura, D.O.O.

Robert S. Broder of Robert S. Broder, P.C. for Media Farm
Solutions, LLC.

Before Kuhlke, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Media Farm Solutions, LLC, seeks
registration of the standard character mark OPENPAD for
goods identified in the application as "computer software
for designing, authoring, editing, maintaining, publishing,
exporting and storing user-defined text, graphics,
animation, video and database content on and over computer
networks, intranets, the Internet and personal computers;
computer software for use in collaborating and conducting

interactive discussions and messaging over computer networks, intranets and the Internet and instruction manuals for use with the foregoing sold as a unit" in International Class 9 and "computer services, namely, hosting online websites for others and creating customized websites for others; computer software consultation; computer software design for others" in International Class 42.¹

Opposer, Futura, D.O.O., opposed registration of applicant's mark on the grounds that, as applied to applicant's goods, the mark so resembles opposer's previously used and applied-for mark **OpenAd** for "a variety of business, management, and consulting services, including the preparation, dissemination and streaming of audio, video and multi media materials and presentations via the Internet, web hosting and other web-related services" as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer by which it denied the salient allegations.

The evidence of record consists of the pleadings herein; the file of the opposed application; opposer's

¹ Serial No. 78773408, filed December 14, 2005. The application is based on an allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

notices of reliance on its pleaded registration, printed publications and applicant's discovery responses, and opposer's testimony deposition, with exhibits, of James Earl Mills, Information Technology Manager for opposer's outside counsel.

Applicant did not attend the deposition of opposer's witness, nor did applicant submit any evidence on its own behalf. Applicant's unsupported factual statements in its brief, have been accorded no evidentiary value or consideration. See TBMP §§ 704.06(a) and (b) (2d ed. rev. 2004).

Both parties also filed main briefs and opposer filed a reply brief.

PRIORITY/STANDING

Because opposer has made its pleaded registration of record by way of notice of reliance, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue.² See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

² In the notice of opposition, opposer pleaded its pending application and further pleaded that "when registration issues on Opposer's OpenAd Application, Opposer will rely herein in such registration." Opposer's registration issued on June 12, 2007 and we consider the pleadings amended to incorporate that registration.

Accordingly, we turn to the question of likelihood of confusion.

LIKELIHOOD OF CONFUSION

Opposer's pleaded registration is in full force and effect and the services are set forth as follows:

Registration No. 2629732 for the mark **OpenAd** for "business marketing and direct mail consulting services; providing business marketing information; arranging and conducting trade show exhibitions for associations, companies, and groups for advertising and marketing purposes; advertising agencies; advertising services, namely, promoting the goods and services of others through the distribution of printed and audio visual promotional materials and by rendering sales promotion advice; advertising services, namely, creating corporate logos, corporate and brand identity for others; advertising slogan licensing; direct mail advertising; direct marketing advertising for others; dissemination of advertising matter; preparing audio-visual presentations for use in advertising; providing television, electronic, multi-media and print advertising for others; real estate advertising services; advertising services, namely, providing advertising space in a periodical; agencies for advertising time and space; cooperative advertising and marketing; contests and incentive award programs to promote the sale of products and services of others; promoting the sale of goods and services of others by awarding purchase points for credit card use; promoting the sale of goods and services of others through the distribution of printed material and promotional contests; providing a web site at which users can offer goods for sale and buy goods offered for sale; on-line trading services in which the seller posts products to be auctioned and bidding is done via the Internet; providing consumer product information via the Internet; business management and consultation; business management consultation; business management planning; conducting business and market research surveys; conducting business research and surveys;

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consultation in the field of business acquisitions; developing promotional campaigns for business; advertising services, namely design for others in the field of print and multimedia advertising, marketing and promotional materials, and point of purchase displays" in International Class 35,

"commercial lending services" in International Class 36,

"streaming of audio material on the Internet, streaming of video material on the Internet; telecommunication services in the field of providing long distance service with audio advertising for others as a component of the long distance service" in International Class 38,

"arranging of exhibitions, seminars and conferences" in International Class 41, and "providing on-line intellectual property consultation; licensing of intellectual property via the Internet" in International Class 42.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Another factor is the fame of the mark. While fame has not been pleaded, opposer argues that its mark is strong in

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that it is inherently distinctive and has received wide unsolicited media coverage and publicity and there is no evidence of third-party use of similar marks. The record supports a finding that opposer's mark is a strong mark, to the extent that we must presume that it is inherently distinctive in view of its registration on the Principal Register, has received some amount of publicity and there are no third-party uses of record. However, the strength of the mark on this record does not reach the level of playing "a 'dominant' role in the process of balancing the du Pont factors." *Recot Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, *Palm Bay Imports, Inc. v. Veuve Clicquot*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003); and *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).

We turn then to a consideration of the first du Pont factor, i.e., whether applicant's standard character mark OPENPAD and opposer's stylized mark OpenAd are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a

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side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions 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). The average overlapping purchaser in this case would have some level of sophistication as discussed below.

Certainly the sound, appearance and commercial impression are similar in that the marks begin with the word OPEN and end with AD. The fact that opposer's registration is for a stylized mark is of no consequence here inasmuch as applicant's mark is in standard character form and therefore we must consider all reasonable presentations of that mark including in the same stylization found in registrant's mark. See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000). In fact, the record shows that applicant uses its mark in a similar style depicted as OpenPad.

The difference in the marks is the addition of the P in applicant's mark which does create some difference in connotation. The AD portion of opposer's mark, in

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particular in relation to its services, connotes advertising, whereas the PAD portion of applicant's mark, in particular in relation to its goods and services, connotes a writing or sketch pad, resulting in two different meanings, namely, open advertising versus open pad. However, although the letter P creates a difference in meaning, this does not serve to obviate a likelihood of confusion in view of the relatedness of the goods and services as discussed below. Rather, it may serve to indicate an extension of opposer's services. Further, the first term, OPEN, is identical in both marks and would have the same connotation. Moreover, the word OPEN is the prominent feature of each mark due to its placement at the beginning of each mark. Palm Bay, 73 USPQ2d at 1692. Thus, despite the addition of the letter P in the middle of applicant's mark, the overall commercial impression of each mark is similar. In view thereof, and considering the near identity in sound, appearance, and commercial impression, we find the marks to be similar.

This brings us then to our consideration of the similarities between opposer's and applicant's goods and services, channels of trade and class of purchasers. We must make our determinations under these factors based on the goods and services as they are recited in the application and registrations, respectively. See *In re Elbaum*, 211 USPQ 636 (TTAB 1981). Although opposer argues

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that it also may rely on its established common law uses, the record does not sufficiently establish the dates of use based on common law use. Opposer relies on articles from various publications as evidence of its use and while applicant did not object on hearsay grounds even if we were to take the statements made in the articles for "the truth of the matter asserted" it is unclear what the date of first use is in the United States. Thus, the relevance of the evidence regarding actual use, both as to opposer's use and applicant's use is confined to assisting the Board in understanding what is encompassed by the identification of goods and services in the registration and application. In re Steelbuilding.com, 75 USPQ2d 1420 (Fed. Cir. 2005). Finally, "the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a likelihood of confusion ... [i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding, Corp., 222 USPQ 355, 356 (TTAB 1983).

Opposer argues that:

There is a precise or near identity between at least some of the goods of OpenAd's pleaded registration and those of the opposed application ... For example, providing television, electronic

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multimedia and print advertising and design for others in the field of multimedia and print advertising [OpenAd registration] is the same as [computer software for] designing, authoring, editing, maintaining, publishing, exporting and storing user-defined text, graphics, animation, video and database content on and over the Internet and creating customized web sites for others (web sites, being, after all advertising) [OPENPAD application]; and providing a web site at which users can offer goods for sale and buy goods offered for sale [OpenAd registration] is the same as hosting online web sites for others [OPENPAD applications].

Br. pp. 10-11.

Opposer also points to the following excerpt of applicant's press release:

OpenPad launches a network for designers and developers interested in developing sites using OpenPad. OpenPad users can register their name and portfolio information to receive project leads, or to seek additional assistance with the development of a web site using the OpenPad service. When a client interested in using our services contacts us, we first consult with them to understand their needs. Then, we use this information to select the appropriate team from our network of designers, writers and developers. Additionally, OpenPad users wishing to register for a new electronic database, available for customers to browse online, please contact us.

Ex. 28.

Opposer asserts that:

This is exactly what the OpenAd concept, and the services Opposer provides under that mark on the OpenAd web site [sic]. Ex. 39 and Ex. 40. Web site design for others, in fact, is a significant aspect of the OpenAd services and web site. See Ex. 40 ("OpenAd idea" may consist of, inter alia, "Web Design"); and Ex. 41 through 44 (examples of prominent web site design projects created through OpenAd). See also Ex. 29 through 38 (regarding Opposer's sponsorship of the OpenAd Web Design

competition in the Golden Drum awards). The OpenAd web site also includes an electronic gallery of ideas for browsing online. See Ex. 39 and 40.

Br. p. 12.

Applicant argues that:

Applicant simply does not engage in advertising services of any kind...Nor does Applicant provide a website at which users [can] buy and sell goods or provide consumer product information or business management and consultation...That an OpenAd idea "may consist of a web design" is not only tentative, but demonstrates that the form of the idea submission may be in web site form, but not that the OpenAd website provides the tools to create the submission.

Br. pp. 12-13.

Applicant further argues that:

Although users of Applicant's software and services may ultimately host audio or video material, which may or may not be streamed, this is an incidental use that is user-defined. This incidental use does not make the parties' respective services similar or even related.

Br. p. 14.

Opposer's "design for others in the field of print and multimedia advertising" and applicant's services of "creating customized websites for others" are related to the extent that opposer's advertising services would include creating customized websites for others inasmuch as a company's website design is an important component of its overall advertising and marketing strategy.

Further, as applicant recognizes, users of its software and web design services "may host audio or visual material

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which may or may not be streamed." In fact, the relationship is closer. "Creative" users [those who create content/advertising] of opposer's services may view applicant's goods and services as an extension of opposer's services, the tool and place where they may design and create the content to be submitted to opposer's website. For example, a web designer and/or manager uses applicant's software from applicant's website to design a website and further uses applicant's website to "collaborate with others to design" (Ex. 28 printout of applicant's website) a website and then may submit this idea to opposer's website for sale. Thus, applicant's goods and services assist the customer in designing content to be on opposer's website. "Client" users [those seeking advertising for their products] of opposer's services may view applicant's website as another option for assisting their marketing and advertising needs. Thus, the record supports a finding that there is, at a minimum, a viable relationship between the parties' goods and services such that overlapping consumers are likely to be confused.

With regard to the channels of trade and class of purchasers, inasmuch as there are no restrictions in the registrations and the application, we must presume that applicant's goods and services would be sold in all appropriate channels of trade, including those in which

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opposer's services are sold and to the same relevant purchasers. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

As to the level of care in the purchasing decision, there is very little in the record to understand the level of care that would be exercised other than a few references in the articles about opposer which indicate that membership fees for clients run from \$3000 to \$100,000 but creatives may submit their work for free. Certainly the level of care in purchasing any of the goods and services offered by opposer and applicant would rise above general consumer items. In particular, opposer's potential customers would exercise care in using its services. Ultimately, however, there is not sufficient evidence for us to making a finding one way or the other on this factor.

Considering the respective marks in their entirety and the goods and services, we conclude that the evidence of record as it pertains to the relevant du Pont factors, in particular considering the strong similarity of the marks, supports a finding of likelihood of confusion between opposer's OPENAD mark and applicant's OPENPAD mark. To the extent we have any doubt, we must resolve that doubt in favor of opposer, the prior registrant. See *Hewlett-Packard*

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Co. v. Packard Press, Inc., 281 USPQ2d 1001, 1003 (Fed. Cir. 2002); Hard Rock Cafe International (USA) Inc. v. Thomas D. Elsea, 56 USPQ2d 1504, 1514 (TTAB 2000) and W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308, 311 (TTAB 1976).

Decision: The opposition is sustained.