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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peters

Serial No. 75/252,506

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Leydig, Voit & Mayer, Ltd. for Wayne Peters.

Michael W. Baird, Trademark Examining Attorney, Law Office 109
(Ron Sussman, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Wayne Peters has filed an application to register the
mark "VIRTUAL BIT" for the "development of software and global

computer information network applications, and computer consulting services."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if used in connection with his services, so resembles both of the following marks, which are owned by the same registrant, as to be likely to cause confusion, mistake or deception:

(i) the mark "BIT," which is registered for "computer software consulting services";² and

(ii) the mark "BIT" and design, which is registered, as illustrated below,

for "computer software consulting services".³

¹ Ser. No. 75/252,506, filed on February 18, 1997, which alleges a bona fide intention to use the mark in commerce.

² Reg. No. 1,747,595, issued on January 19, 1993, which sets forth dates of first use of December 22, 1982; combined affidavit §§8 and 15.

³ Reg. No. 2,047,471, issued on March 25, 1997, which sets forth dates of first use of December 22, 1982.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

Turning first to consideration of the respective services, it is well settled that that the issue of likelihood of confusion must be determined on the basis of the services as they are respectively set forth in the involved application and cited registration(s). See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Applicant, in this respect, asserts in his initial brief that, while the respective services "are admittedly similar, ... the Examiner overstates the case in stating that applicant's services are identical to the registrant's services ... since only Applicant's services specifically include development of global computer information network applications." However, it is clear that both applicant and registrant offer computer software consulting services since, as applicant further concedes, applicant "provides computer consulting services including development of software and global computer information network applications." Thus, whether registrant's "computer software consulting services" are viewed as encompassed by applicant's more general "computer

consulting services," or whether applicant's "development of software and global computer information network applications" are regarded as included within registrant's more expansive "computer software consulting services," the respective services plainly are at least identical in part and are otherwise so closely related that, if marketed under the same or similar marks, confusion as to the source or sponsorship of such services would be likely to occur.

Directing our attention, therefore, to consideration of the respective marks, the Examining Attorney invokes the general rule that "[t]he simple addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d)." As more accurately stated in TMEP Section 1207.01(b)(i) (citations omitted):

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services. Sometimes the rule is expressed in terms of the dominance of the common term. Thus, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.

Here, while admitting that the marks at issue differ in sound and appearance, the Examining Attorney nevertheless contends that such differences do not create a significantly different overall commercial impression inasmuch as the respective marks

are similar in connotation. Applicant's "VIRTUAL BIT" mark, the Examining Attorney insists, is dominated by the term "BIT," which is the sole or distinguishing element of registrant's "BIT" marks, because "the term VIRTUAL is so prevalent within the computer industry that it has little weight when compared with the relatively suggestive term BIT."

In particular, with respect to applicant's argument that the addition of the term "VIRTUAL" to the word "BIT" changes the fundamental meaning of the latter, the Examining Attorney contends that:

As Applicant correctly notes, the common definition of VIRTUAL is as an adjective, describing something which is "existing or resulting in effect or essence though not in actual fact, form, or name." The Examining Attorney also agrees with Applicant's assertion that consumers are very familiar with the word VIRTUAL "especially in light of the recent popularity of 'virtual reality' technology." However, Applicant inappropriately concludes that VIRTUAL BIT is ... something "that has the effect or essence of a bit, but is not actually a bit." This statement might be true if Applicant was seeking to register its mark for computer circuitry; however, Applicant's services consist of software development and computer consulting services. Applicant ignores the fact that the word BIT has been registered for these same services. Because the term BIT already identifies such services, a more appropriate conclusion is ... that VIRTUAL BIT is ... "something that has the essence of computer software consultation services but not the typical physical form of such services;" i.e., computer software consulting services

that are provided electronically, without a traditional place of business. Prospective consumers are likely to believe that the term VIRTUAL BIT merely identifies an alternative method by which the registrant's BIT services are provided.

Finally, as to various third-party registrations made of record by applicant for marks which either consist of or contain the word "VIRTUAL" or contain the term "BIT," the Examining Attorney maintains that, as to the former, "the goods and services are only tangentially related to the computer industry, and the ... registrations do nothing to rebut the Examining Attorney's finding that the term VIRTUAL has little or no meaning when referring to computer-related products or services." Such registrations, according to the Examining Attorney, serve instead to highlight the fact that, as set forth in the excerpt of record from The Computer Glossary (7th ed. 1995), the word "VIRTUAL" is listed as "[a]n adjective applied to almost anything today that expresses a condition without boundaries or constraints." Thus, the Examining Attorney concludes, any trademark significance which the word "VIRTUAL" may have in applicant's mark "is minimal at best, and the dominant feature of the mark remains the term BIT."

Furthermore, the Examining Attorney insists that the third-party registrations for marks containing the term "BIT" are inadequate to show that such term is a "weak" mark, entitled

to only a narrow scope of protection, inasmuch as none of the registrations is for computer-related consulting services. Consequently, because applicant's "VIRTUAL BIT" mark is dominated by the term "BIT" and the word "VIRTUAL," which modifies such term, is "a relatively weak adjective," the Examining Attorney finds that applicant's contemporaneous use of such mark, in connection with the development of software and global computer information network applications and with computer consulting services, would be likely to cause confusion with registrant's use of its "BIT" marks in conjunction with computer software consulting services.

We agree with applicant, however, that the respective marks are distinguishable. As applicant correctly notes in its reply, TMEP Section 1207.01(b)(i) provides that "[e]xceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the respective marks in their entireties convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source due to its mere descriptiveness or the commonness of its use." Although we disagree with applicant that he "has presented evidence indicating that the word BIT is descriptive in the computer industry" and "is commonly used in many trademarks and source identifiers," we concur with applicant that confusion is

not likely. Specifically, notwithstanding that applicant's mark adds the suggestive term "VIRTUAL" to the term "BIT" in registrant's marks, we find that, when considered in their entirety, applicant's "VIRTUAL BIT" mark presents a significantly different commercial impression from registrant's "BIT" and "BIT" and design marks so as to preclude a likelihood of confusion.

In this regard, we observe that the record contains various excerpts from the "NEXIS" database which, for the most part, discuss or otherwise refer to "virtual private networks" of computers. The record also includes a definition from the Random House Compact Unabridged Dictionary (spec. 2d ed. 1996) which defines "virtual," in relevant part, as meaning "3. temporarily simulated or extended by computer software: a *virtual disk in RAM; virtual memory on a hard disk.*" While such evidence establishes that the term "VIRTUAL" has a technical meaning in the field of computer products, the third-party registrations made of record by applicant demonstrate that such term has also been frequently adopted, in the field of computer services, as a mark or a portion thereof on account of its suggestiveness for those services.

Moreover, and perhaps of even greater importance, such registrations show that while, as the other previously mentioned dictionary definitions make clear, the term "VIRTUAL" is an

amorphous or ethereal concept, it nevertheless is not essentially devoid of service mark significance as contended by the Examining Attorney. To the contrary, as evidenced by the third-party registrations⁴ for such marks as "THE VIRTUAL LOT" for "providing information in a wide variety of fields by means of a global computer network," "VIRTUAL VALET" for "personal shopping services for others provided on-line," "THE VIRTUAL PET CEMETERY" for "providing pet information ... via a global computer network," "THE VIRTUAL OIL COMPANY" for "energy consulting services," "THE VIRTUAL BIRDER" for "providing information in the field of birding and bird watching via a global computer information network" and "VIRTUAL DIABETIC" for "providing diabetes information through an on-line database,"⁵ it is plain that the term "VIRTUAL," while suggestive of the particular services recited, has source-indicative significance.

In a similar vein, the following definition of record from The Computer Glossary (7th ed. 1995) confirms that the term "bit" has a special meaning in the computer field:

⁴ It is pointed out that while the third-party registrations in the record do not constitute evidence of use of the marks which are the subjects thereof, the registrations are entitled to some weight inasmuch as they show the meaning of the subject marks, including any suggestive portions thereof, in the same way that dictionaries may be used. See, e.g., *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 695-96 (CCPA 1976).

⁵ None of the above registrations, each of which issued on the Principal Register, contains a disclaimer of "VIRTUAL."

(BInary digiT) A single digit in a binary number (0 or 1). Within the computer, a bit is physically a transistor or capacitor in a memory cell, a magnetic spot on a disk or tape or a high or a low voltage pulsing through a circuit. A bit is like a light bulb: on or off.

Groups of bits make up storage units in the computer, called characters, bytes, or words, which are manipulated as a group. The most common is the byte, made up of eight bits and equivalent to one alphanumeric character.

As is the case with the word "virtual," the term "bit" has been adopted by third parties in connection with marks which, in their entirety, are suggestive of the goods or services with which such marks are associated. Examples thereof in the record include third-party registrations for marks such as "RENT-A-BIT" for "rental and leasing of computers," "BIT-BY-BIT" for "computer hardware rental and leasing services," "BITCOM" for "computer programs for data transmission and telecommunications," "BIT-BY-BIT" for "computer programs" and "BITSTREAM" for "computer software ... containing information representing typefaces."

It is clear, therefore, that when used in conjunction with computer software consulting services and such closely related services as the development of software and global computer information network applications, the terms "virtual" and "bit" are both highly suggestive of those services. Consequently, not only is the mere presence of the shared term

"BIT" in applicant's mark and registrant's marks an insufficient basis for a finding of likelihood of confusion, but the addition to such term of the highly suggestive term "VIRTUAL" in applicant's "VIRTUAL BIT" mark creates a mark which overall differs significantly in commercial impression from registrant's "BIT" and "BIT" and design marks. In particular, rather than engendering the connotation of "an alternative method by which the registrant's BIT services are provided," as urged by the Examining Attorney, we concur with applicant that the mark "VIRTUAL BIT" conveys the image of "something that has the effect or essence of a bit, but is not actually a bit." As applicant persuasively argues:

The consumer is ... capable of discerning a difference in meaning and commercial impression between the proposed and cited marks, especially in light of the recent popularity of "virtual reality" technology. It is widely known that "virtual reality" is not actually reality but is instead an approximation or simulation of something which appears to be reality. Consumers in the computer industry are especially capable of noting this distinction.

Finally, as an additional factor, we note that customers for applicant's and registrant's services would typically be knowledgeable and discriminating consumers who would be expected to exercise care in the selection of a computer consultant which meets their needs. In light of such purchaser sophistication, and in view of the significant

differences in appearance, sound, connotation and overall commercial impression between the respective marks, we conclude that contemporaneous use by applicant of the mark "VIRTUAL BIT" for the "development of software and global computer information network applications, and computer consulting services" is not likely to cause confusion with registrant's use of the marks "BIT" and "BIT" and design for "computer software consulting services."

Decision: The refusal to register under Section 2(d) is reversed.

G. D. Hohein

B. A. Chapman

H. R. Wendel
Administrative Trademark

Judges,

Trademark Trial and Appeal

Board