

9/6/02

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

Paper No. 30  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Electric Lightwave, Inc.

v.

Electric Lite, Inc.  
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Opposition No. 109,511  
to application Serial No. 75/239,782  
filed on January 30, 1997  
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David S. Aman of Tonkon Torp LLP for Electric Lightwave,  
Inc.

James D. Cockman for Electric Lite, Inc.  
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Before Cissel, Hanak and Hairston, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

Applicant, a South Carolina corporation, filed the  
above-identified application to register the mark  
"ELECTRIC LITE" on the Principal Register for services  
which were subsequently identified by amendment as  
"brokerage services in the field of electricity  
distribution," in Class 36. Also by amendment, applicant  
disclaimed the exclusive right to use the word "ELECTRIC"

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apart from the mark as shown. The basis for filing the application was applicant's assertion that it possesses a bona fide intention to use the mark in connection with the recited services in commerce.

A timely Notice of Opposition was filed on February 13, 1998 by Electric Lightwave, Inc., a Delaware corporation doing business in Vancouver, Washington. As grounds for opposition, opposer asserted that it adopted and has continuously used the mark "ELECTRIC LIGHTWAVE" since at least as early as August 31, 1988 in connection with a wide range of services; that opposer is the owner of Registration No. 1,716,539, which issued on September 15, 1992, for the mark "ELECTRIC LIGHTWAVE" for "telecommunications services," in Class 38; and that applicant's mark so resembles opposer's mark that if applicant were to use its mark in connection with the services specified in the application, confusion would be likely. Additionally, opposer pleaded that the mark sought to be registered so resembles opposer's mark that if it were used in connection with the services of applicant, it would disparage or falsely suggest a connection with opposer.

Applicant's answer to the Notice of Opposition denied the essential allegations made by opposer.

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Additionally, applicant asserted that the existence of two prior third-party registrations demonstrate that opposer has acquiesced to the use and registration of marks including the terms "lite" and "lightwave," so that opposer should not be heard to object to the registration of applicant's mark.

A trial was conducted in accordance with the Trademark Rules of Practice. Only opposer, however, introduced evidence, and only opposer filed a brief. Neither party requested an oral hearing before the Board.

On January 26, 1999, opposer filed a Notice of Reliance which made of record the file wrapper of opposer's pleaded registration and applicant's responses to various interrogatories which had been propounded by opposer. On the same day, opposer also filed 24 exhibits pursuant to a stipulation by the parties. These exhibits include advertisements and other promotional materials for applicant's services and information concerning advertising, marketing and other promotional activities in which applicant has engaged. Opposer filed a second Notice of Reliance on February 1, 1999. It made of record 29 published articles and advertisements relating to opposer's services.

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The parties had stipulated that testimony could be submitted in the form of affidavits, and accordingly, on February 1, 1999 and February 4, 1999, opposer submitted the affidavits of John Unverferth, opposer's Director of Marketing Communications; Richard Stevens, Mr. Unverferth's neighbor; Kristin Rethlefsen, and administrative assistant who works for opposer; Sara Goodwin, a "Subject Matter Expert" and former customer service representative for opposer; and Karen Johnson, the Senior Attorney for opposer. Also on February 4, 1999, opposer submitted a paper announcing its intention to rely on dictionary definitions of "telecommunication" and "wave."

Although opposer pleaded that applicant's mark disparages and falsely suggests a connection with opposer, these allegations were neither argued nor proved by opposer. Accordingly, in view of opposer's clear priority of use, the sole issue remaining for the Board to resolve in this proceeding is whether or not applicant's use of "ELECTRIC LITE" as a mark for brokerage services in the field of electricity distribution would be likely to cause confusion with opposer's mark for its telecommunications services, "ELECTRIC LIGHTWAVE."

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Based on careful consideration of the record and arguments before us, we find that these marks, when considered in their entireties, are not so similar in appearance, pronunciation or connotation, and the services with which opposer uses its mark are not so closely related to the services set forth in the application that the use of these marks in connection with them would be likely to cause confusion.

Simply put, opposer had the burden of proving that the marks are similar and that the services are related such that the use of these two marks in connection with them would make confusion likely, but opposer has not met this burden.

The first numbered section of opposer's brief is titled "The Marks are Similar in their Entireties as to Sound and Commercial Impression," but after essentially restating this proposition, opposer goes on to discuss the similarities in customers and trade channels, rather than to demonstrate how the evidence or testimony supports this conclusion. Contrary to opposer's assertion at the end of this discussion, similarities between the markets and customers for electricity and telecommunications services do not "lead to a similar commercial impression and connotation" for the marks.

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The fact that these marks may well make commercial impressions on some of the same people does not make their respective commercial impressions similar.

In fact, based on consideration of the marks themselves, we find that when they are considered in their entireties, they are not so similar that their use in connection with the services of opposer and the services set forth in the application would be likely to cause confusion. Although both marks begin with the same word "ELECTRIC," this word is descriptive of applicant's services and suggestive in connection with opposer's services, so its inclusion in both marks is not a proper basis for finding the marks in their entireties to be similar. The remaining parts of each mark are different from each other, and when these different components are combined with the word "ELECTRIC," the marks in their entireties are not so similar that they would be likely to cause confusion if used in connection with the respective services of the parties. "ELECTRIC LITE" is simply different in appearance, sound and connotation from "ELECTRIC LIGHTWAVE." Although "LITE" is the phonetic equivalent of "LIGHT," opposer's mark is not "ELECTRIC LIGHT," but rather "ELECTRIC LIGHTWAVE," and "LIGHTWAVE" is quite different in appearance,

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pronunciation and connotation from "LITE." Opposer has not established otherwise.

Opposer did not plead that its mark is famous, but opposer nonetheless makes this argument in its brief. Even if opposer had pleaded fame, the record does not support this conclusion. The evidence of record with respect to the use, promotion and recognition of opposer's mark does not establish the level of notoriety necessary for us to reach the conclusion that the mark is entitled to a broader scope of protection than any other registered mark. Moreover, even if opposer had pleaded and proved that its mark is famous, applicant's mark still creates a different commercial impression from that created by opposer's mark, and this fact, combined with the differences in appearance and pronunciation, leads us to conclude that in connection with the respective services of the parties, these two marks are not so similar that confusion would be likely.

We thus turn to the relationship between the services specified in the application and the services rendered by opposer under its registered mark. Contrary to opposer's assertions, the facts that telecommunications services and electricity are both sold to ordinary consumers and businesses and that both

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services are rendered by means of wires running to homes or businesses do not establish that the services of the parties are so closely related that the use of these marks in connection with them would be likely to cause confusion. Individuals and businesses also use other utilities, such as water and gas, both of which are delivered through pipes, but these facts do not provide the basis for concluding that customers have reason to believe that both gas and water are provided by the same entity. In fact, this conclusion would be contrary to common experience, just as would be the conclusion that the same entity provides both telephone service and electric service. As noted above, this record does not establish that these marks create similar commercial impressions or that they are very similar in appearance or pronunciation. Similarly, it does not contain evidence or testimony upon which we could base the conclusion that consumers have any reason to assume that the use of two similar marks would be an indication that both brokerage services in the field of electricity distribution and telecommunications services are provided by a single entity.

At first blush, applicant's argument with respect to actual confusion appears to be persuasive. Ms. Goodwin,

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a former customer service representative for opposer, states in her affidavit that during her 10-month tenure at that post, she received "numerous calls" from people seeking electric power service. She states that she received several calls a day during weeks when applicant was advertising its services in her area, and that callers told her that they had seen or heard applicant's ads. Ms. Goodwin concludes from these inquiries that these callers were confused about whether Electric Lightwave was the same company as, or was affiliated with, Electric Lite. Ms. Rethlefsen states in her affidavit that as a receptionist for opposer during a three-month period in 1998, she answered telephone calls from people who actually wanted to reach applicant, Electric Lite. She states that callers expressed confusion as to whether Electric Lightwave was the "power company" or the "electric company." Mr. Stevens, the neighbor of opposer's marketing communications director, states in his affidavit that when he saw a headline in the newspaper regarding a court ruling involving "Electric Lite," he thought it referred to "Electric Lightwave," the telecommunications company with which he was familiar. Discussion of this matter with opposer's marketing communications director eliminated this

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misunderstanding. Opposer argues that these affidavits establish that actual confusion because of the similarity of the marks has taken place, and that this is persuasive evidence that confusion is likely.

The fourth incident opposer argues is evidence of actual confusion is related in applicant's response to Interrogatory No. 5, wherein opposer asked applicant to describe any incidents in which applicant became aware of confusion between the source of its services and the source of opposer's services. Applicant responded by stating that on July 23, 1998, at 8:30 in the morning, a man who identified himself as a representative of Adidas inquired of applicant's receptionist concerning a recent Portland newspaper article announcing the closing of Electric Lite's Portland office, "allegedly to reassure himself that Electric Lite had nothing to do with the Electric Lightwave with which Adidas' Portland Office had its phone service."

Although we agree with opposer that ordinarily, the occurrence of actual confusion is an indication that confusion is likely, the incidents related in these three affidavits and in applicant's response to opposer's interrogatory do not clearly establish that confusion actually did occur. They do not overcome the fact that

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the other primary factors we must use to determine whether confusion is likely cut heavily in favor of applicant.

While it is clear that Mr. Stevens was confused by the name of applicant's business, this was an isolated incident, unrelated to his purchase of either telecommunications services or electricity, and Mr. Stevens' apparent confusion did not involve the purchase of either applicant's services or those of opposer.

The calls taken by Ms. Rethlefsen and Ms. Goodwin, however, do appear to show that people who saw or heard advertisements for "Electric Lite" made inquiries to opposer, "Electric Lightwave." Both of these affiants are employees of opposer, and therefore have an interest in the outcome of this proceeding. Apart from the hearsay problem, it is not clear that the incidents they relate show that actual confusion was caused by the similarity of the marks and the relatedness of the services of the parties. The inquiries fielded by these two ladies may be attributable to the imperfect recollection consumers have of promotional materials, or to the fact that the telephone directory for the area in which applicant had begun to promote its services may not yet have included applicant's telephone number. Without

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direct testimony from the people who allegedly made these inquiries, we are left to speculate as to what these people were actually thinking. See: *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). We do not know why these people apparently thought opposer sold electricity. We have no evidence that these callers called opposer as a result of confusing the mark "Electric Lightwave" with "Electric Lite." In any event, the callers all sought electricity, not telephone services, because they asked for "the power company" or "the electric company." That they called opposer trying to get electricity is not particularly surprising in view of the fact that the first word in opposer's name is "ELECTRIC." We simply cannot conclude from these affidavits that the callers who spoke with the affiants necessarily believed that a single business provided both electricity and telecommunications services under the marks of the parties to this proceeding.

As to the interrogatory response which opposer argues demonstrates actual confusion caused by these marks, we cannot agree with opposer's characterization of applicant's response. Opposer contends that this evidence shows confusion between the two marks because "the [opposer's] customer asked whether the fact that

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Electric Lite [applicant] was shutting down in Oregon meant that the ELI [opposer] customer's telephone services would be shut off as well." The actual interrogatory response, however, as quoted above, couches the customer's inquiry in terms of an effort "to reassure himself" that applicant had nothing to do with opposer. A fair reading of applicant's response to the interrogatory is that this man had assumed that applicant and opposer were not related, but that he sought to confirm his assumption. Mere inquiries as to source or affiliation reveal a less than totally confused state of mind in the inquiring person. *Pump Inc. v. Collins Management Inc.*, 15 USPQ2d 1716 (DC Mass 1990). Applicant's response is hardly strong evidence that the marks in question in this proceeding are so similar that this customer of applicant mistakenly believed that applicant sold telephone service under opposer's mark.

In summary as to the evidence opposer asserts shows actual confusion, we find that it is not all that clear that the marks in question here led to actual confusion in the marketplace for the respective services of the parties. This record provides no other basis upon which to conclude that consumers would be likely to think that the use of opposer's mark in connection with the services

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set forth in opposer's pleaded registration would indicate that opposer's services are being provided by the same entity that provides the services recited in the opposed application under the mark sought to be registered.

We note for the record that applicant's argument concerning the existence of the two cited third-party registrations is not a reason why we are ruling in favor of applicant in this proceeding. Opposer by no means conceded that applicant's mark would not be likely to cause confusion with opposer's mark by not objecting to the registration of the two marks in question, "VOICELITE" for telephone peripherals and "IEEE LTS THE MAGAZINE OF LIGHTWAVE TELECOMMUNICATIONS SYSTEMS" for printed publications. The marks and the goods in these registrations are not even arguably close to the threshold at which confusion with opposer's mark might occur. That these registrations exist does not support applicant's argument in this regard.

In summary, because the marks of applicant and opposer are different in appearance, pronunciation and connotation, they create different commercial impressions. This record does not establish that the services set forth in the application are closely related

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to the services in connection with which opposer has used and registered its mark or that confusion has actually taken place. In view of these facts, we hold that confusion would not be likely if applicant were to use the mark it seeks to register in connection with the services set forth in the application.

DECISION: The opposition is dismissed, and the application will proceed to registration.