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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Optimize Technologies, Inc.

v.

Wicom GmbH

Opposition No. 91156666

Opposition No. 91158331

Everett E. Fruehling of Christensen O'Connor Johnson Kindness
PLLC for Optimize Technologies, Inc.

Stanley C. Macel, III of Connolly Bove Lodge & Hutz LLP for Wicom
GmbH.

Before Seeherman, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Wicom GmbH, has filed applications to register
the mark **OPTIFLOW** for "laboratory filters for purification and
cleaning of fluid laboratory samples, sold separately" in Class
9;¹ and the mark **OPTI-LIGHT** for the following two classes of
goods: "chromatography chemicals" in Class 1; and "analytical
devices and systems for use in the chemical and physical analysis

¹ Application Serial No. 78095516, filed November 28, 2001, alleging a
bona fide intention to use the mark in commerce.

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of solid, liquid and gaseous compounds and mixtures and structural and replacement parts therefore [sic]" in Class 9.² Both marks are in standard character form.

Opposer filed a notice of opposition against each application,³ asserting as its ground for opposition, priority and likelihood of confusion under Section 2(d) of the Trademark Act.⁴ In particular, opposer alleges prior use and registration of the following marks, all in standard character form:

Registration No. 2048831: **OPTI** for "liquid transfer components of chemical analysis equipment, namely High-Performance Liquid Chromatography (HPLC) - pistons and plunger seals for pumps; solvent reservoir filters; in-line filters; tubing; check valves; prime and purge valves; pump heads, precolumn filters; and fittings for tubing" in Class 9;

Registration No. 2100804: **OPTI-GUARD** for "precolumn filters and guard columns for High-Performance Liquid Chromatography (HPLC)" in Class 9;

Registration No. 2023739: **OPTI-MAX** for "check valves for High-Performance Liquid Chromatography (HPLC) pumps" in Class 9;

Registration No. 2023740: **OPTI-SEAL** for "piston and plunger seals for High-Performance Liquid Chromatography (HPLC) pumps" in Class 9; and

Registration No. 2107751: **OPTIMIZE TECHNOLOGIES** (TECHNOLOGIES disclaimed) for "liquid transfer

² Serial No. 78176019, filed October 18, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

³ Opposition No. 91156666 was filed on May 5, 2003 against application Serial No. 78095516 (OPTIFLOW); Opposition No. 91158331 was filed on October 23, 2003 against application Serial No. 78176019 (OPTI-LIGHT). The oppositions were consolidated by the Board on April 27, 2004.

⁴ Opposer also asserts that the marks falsely suggest a connection with opposer under Section 2(a) of the Act. Inasmuch as opposer submitted no evidence or argument on this claim, the claim will be given no further consideration.

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components of chemical analytic equipment, namely, High-Performance Liquid Chromatography (HPLC) - tubing; fittings; packed columns; guard columns; precolumn filters; seals; pump components, namely, pumpheads, pistons, plungers and seals; check valves; priming valves; priming adapters; detector source lamps; filters; manifold ball seals; injector components, namely, syringes, seals and needles; pressure regulators; sample processor components, namely, syringes, needles, seals, washers and frits, all for HPLC instruments; HPLC maintenance kits comprising inlet cartridge check valves, outlet cartridge check valves, replacement cartridges, pistons, pump seals, filters and fittings; and HPLC fitting kits comprising tubing, nuts and ferrules" in Class 9.

Opposer also asserts prior use of two additional marks and ownership of pending applications (filed subsequent to the involved applications) for those marks as follows:

Serial No. 78235546: **OPTI-PAK** for "capillary trap cartridges for High-Performance Liquid Chromatography (HPLC) and other analytical techniques involving analyte trapping and sample purification" in Class 9; and

Serial No. 78235551: **OPTI-SOLV** for "filters for High-Performance Liquid Chromatography (HPLC), Mass Spectrometry, sample preparation, and other analytical techniques involving filtration of solvents, mobile phases, and samples" in Class 9.

In addition, opposer alleges in paragraph 7 of the oppositions:

Opposer's and Applicant's goods are sold in the same channels of trade to the same consumers or class of consumers, namely, university research laboratories, biotech research laboratories, pharmaceutical manufacturers, crime investigation laboratories; hospitals, and other laboratories and instructions [sic] performing liquid study and analysis.

Opposer claims that applicant's marks, when applied to applicant's goods, so resemble opposer's previously used and

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registered OPTI and OPTI- prefixed marks referenced above as to be likely to cause confusion.

Applicant, by its amended answers, admitted paragraph 7 of the oppositions quoted above, and denied the remaining salient allegations.

The record includes the pleadings; the file of the involved applications; opposer's notice of reliance on status and title copies of its pleaded registrations;⁵ and the testimony, with an exhibit, of Doug Ford, opposer's president and owner.

Applicant neither attended the deposition of opposer's witness nor took any testimony or offered any other evidence in its own behalf. Only opposer filed a brief.⁶

As a preliminary matter, we note that opposer submitted for the first time with its brief, copies of certain responses to opposer's interrogatories and requests for admission, and what opposer refers to as "correct copies of documents numbered OPTI

⁵ Opposer also seeks to introduce, by its notice of reliance, a copy of a product catalog. However, this type of evidence is not admissible by notice of reliance because it is not considered a printed publication available to the public within the meaning of Trademark Rule 2.122(e). See *Glamorene Products Corporation. v. Earl Grissmer Company, Inc.*, 203 USPQ 1090 (TTAB 1979) (private promotional literature is not presumed to be publicly available within the meaning of the rule); and *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33 (TTAB 1976) (catalogs and other house publications are not publications of general circulation within the contemplation of the rule). Thus, the product catalog is not properly of record and will not be considered.

⁶ The transcript of Mr. Ford's deposition which was filed for the first time with its brief is considered timely as it was filed prior to the submission of the case for final decision. See Trademark Rule 2.125(c); *Hewlett-Packard Company v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390 (TTAB 1991); and TBMP §703.01(k) (2d ed. 2004).

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000001 through OPTI 000010" which consist of a series of e-mails between the parties. This evidence is untimely and will not be considered. See TBMP §704.05(b) (2d ed. rev. 2004) ("Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony").

We turn then to the merits of the case. Opposer, Optimize Technologies, Inc., markets equipment and components for use in chromatography. Chromatography is the chemical analysis of fluids, that is, the separation of a solution into its separate molecular components. Mr. Ford explains chromatography as follows (Dep., p. 5):

Chromatography -- the chrome is color, and it's the separation of the components, analogous to separating a solution that is colorful into separate components. So now there's gas chromatography and liquid chromatography, and it's the separation of either a gas or a liquid.

Opposer's products are used in a particular chromatography technique known as High-Pressure Liquid Chromatography (HPLC). Opposer sells a line of 500 HPLC components worldwide through its authorized dealers under a variety of "Opti" prefix marks, and opposer has continually used such marks since the inception of its business in 1985. Opposer first used an OPTI- prefix mark, OPTI-LOK, in 1985 on finger-type fittings that connected the tubing in the HPLC instrument. Opposer has used OPTI-SEAL on plunger seals for HPLC instruments since January 1988; OPTI-MAX on check valves since January 1990; OPTI-GUARD on pre-column

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filters, guard columns, and any other type of packed bed since 1994; and opposer's "parent" mark, OPTIMIZE TECHNOLOGIES, in connection with all of opposer's products since October 15, 1985. In addition, opposer has been selling products under the mark OPTI-SOLV since March 2002 and under the mark OPTI-PAK since February 1993.

Opposer advertises and promotes its products at trade shows where, according to Mr. Ford, opposer is "very visible with all of our trademark names, the Opti's"; through distributors' catalogs where "the Opti names are prominent"; and in national trade journals such as *LCGC* ("Liquid Chromatography/Gas Chromatography"). Dep., p. 10.

Opposer markets its products under the OPTI and OPTI- prefix marks primarily to the pharmaceutical industry, and also to universities, the petrochemical industry, and to purchasers such as university research laboratories, biotech research laboratories, pharmaceutical manufacturers, crime investigation laboratories, hospitals and any laboratory separating chemical solutions, performing liquid study analysis.

Applicant, Wicom GmbH, was opposer's dealer of "OPTI" products in Germany since the late '80s or early 90's. Many of opposer's products can be used specifically for the same purpose as the products which applicant intends to sell under its OPTIFLOW mark. All of applicant's products as well as all of opposer's products "are used in the HPLC technique or any

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instrumentation in that field" (Dep., p. 13); applicant's OPTILIGHT products "all involve chromatography" and are "in the same category as all of [opposer's] components for chromatography" (Dep., p. 14); and applicant's goods can be sold in the same channels of trade and to the same classes of purchasers as opposer's goods.

Priority

Opposer has made of record status and title copies of its five pleaded registrations for the marks OPTI, OPTI-GUARD, OPTI-MAX, OPTI-SEAL and OPTIMIZE TECHNOLOGIES.⁷ Thus, opposer's standing has been established, and its priority with respect to the registered marks for the goods identified therein is not in issue. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer has demonstrated first use of the mark OPTI and each of the registered OPTI- prefix marks in connection with the goods identified in the registrations prior to the November 28, 2001 and October 18, 2002 constructive dates of first use of the subject applications.

Opposer states in its brief that its pleaded applications for OPTI-SOLV and OPTI-PAK issued into registrations on November 30, 2004, subsequent to the filing of the oppositions, and

⁷ Registration No. 2048831 (OPTI), issued April 1, 1997; Registration No. 2100804 (OPTI-GUARD), issued September 30, 1997; Registration No. 2023739 (OPTI-MAX), issued December 17, 1996; and Registration No. 2107751 (OPTIMIZE TECHNOLOGIES), issued October 21, 1997. The copies

opposer is seeking to rely on these registrations, as well. However, opposer did not introduce status and title copies of the registrations or otherwise properly make the registrations of record. Nor has opposer established common law rights in these marks. Although Mr. Ford testified that opposer's OPTI-SOLV and OPTI-PAK marks were first used in February 1993 and March 2002, respectively, Mr. Ford did not identify any goods on which these marks were used. Furthermore, the OPTI-PAK mark was not in use prior to the November 28, 2001 filing date of the application for OPTIFLOW.⁸

Likelihood of confusion

Thus, we turn to the question of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the

of the registrations show that Sections 8 and 15 affidavits have been accepted and acknowledged, respectively, for each.

⁸ Opposer has not established common law use of the other alleged OPTI-prefix marks mentioned in opposer's brief. Mr. Ford testified that opposer used OPTI-FLOW for a digital flowmeter "around the mid-'90s." However, opposer apparently no longer sells this product, and Mr. Ford's testimony regarding the first use of this mark in the United States is unclear. The mark OPTI-LOK, according to opposer, was first used in 1985, but it is not clear from the testimony whether that mark is still in use. Opposer offered no evidence of use of the marks OPTI-

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goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Opposer has pleaded⁹ and argued that it owns a family of "OPTI" marks. However, the requisite showing of a family of marks has not been made. Mr. Ford's nonspecific and unsupported statements that opposer promotes the marks together at tradeshow and in distributors' catalogs are insufficient to prove that opposer has created widespread public recognition of "OPTI" as a family name. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 403, 164 USPQ 43 (CCPA 1969); and *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987).

Therefore, we must determine the issue of likelihood of confusion based on the individual marks that are the subject of opposer's registrations. In our analysis we will direct our attention to the registered mark of opposer which can be considered closest to the marks in the subject applications, namely Registration No. 2048831 for the mark OPTI.

We turn first to a comparison of the goods. Opposer's goods are identified in the registration for OPTI as "liquid transfer components of chemical analysis equipment, namely High-

DRAW, OPTI-PEEK or OPTI-LYNX, all of which were mentioned in a footnote in opposer's brief.

⁹ We have construed the notices of opposition as asserting a family of marks.

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Performance Liquid Chromatography (HPLC) - pistons and plunger seals for pumps; solvent reservoir filters; in-line filters; tubing; check valves; prime and purge valves; pump heads, precolumn filters; and fittings for tubing." Applicant's goods under its OPTIFLOW mark are "laboratory filters for purification and cleaning of fluid laboratory samples"; and under its OPTI-LIGHT mark are "chromatography chemicals" and "analytical devices and systems for use in the chemical and physical analysis of solid, liquid and gaseous compounds." The parties' goods, as identified, are related on their face. Chromatography refers to the collective techniques, such as HPLC, used to separate, purify and analyze chemical solutions. Applicant's and registrant's goods are complementary, closely related equipment and components used in a chromatography or HPLC system. Further, Mr. Ford testified that applicant's analytical devices are "in the same category as all of our components for chromatography" (Dep., p. 14), and that opposer's chemicals and products are used for the same purpose as applicant's laboratory filters for purification and cleaning of fluid laboratory samples.

In addition, the record shows, and applicant admits, that the parties' goods would be sold in the same channels of trade and directed to the same classes of purchasers, including the petrochemical industry; pharmaceutical manufacturers; and university, biotech research and crime investigation laboratories.

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We turn then to a comparison of opposer's mark OPTI with applicant's marks OPTIFLOW and OPTI-LIGHT. In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *du Pont, supra*. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The parties' marks are similar in sound and appearance. The term OPTI is opposer's entire mark and, as the first term in OPTIFLOW and OPTI-LIGHT, it is visually and aurally the dominant feature of applicant's marks. Further, the term OPTI is dominant in conveying the meaning and creating the commercial impression of applicant's marks. To the extent that "OPTI" could be viewed as a shortened form of "optimize," as in opposer's mark OPTIMIZE TECHNOLOGIES, thereby suggesting the quality and effectiveness of opposer's products, that meaning would be the same in applicant's marks. The additional words FLOW and LIGHT in applicant's marks do not significantly change the meaning or commercial impression created by OPTI alone, particularly in view of the highly suggestive nature of those words in relation to applicant's goods. As opposer points out, the term FLOW is highly suggestive of the flow of liquid through a filter, and LIGHT is at least highly suggestive of applicant's analytical device which employs a lamp or other illumination device. Purchasers are likely to assume that OPTIFLOW and OPTI-LIGHT identify additional products

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in opposer's line of chromatography equipment and components rather than identifying a different source for the products.

In addition, although opposer has not established a family of marks, the fact that opposer has itself used variations of its OPTI mark by adding matter to it, e.g., OPTI-GUARD, OPTI-MAX and OPTI-SEAL, increases the likelihood that applicant's marks OPTIFLOW and OPTI-LIGHT would be perceived as additional variations of opposer's marks. See *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) (noting that this point is relevant even where a family of marks has not been proven, citing *Varian Associates, Inc. v. Leybold-Heraeus G.m.B.H.*, 219 USPQ 829 (TTAB 1983)).

We are not, however, persuaded by opposer's evidence and argument that OPTI is a famous mark. Long use alone is insufficient to show public recognition of the mark, and Mr. Ford has offered only self-serving and unsupported testimony that opposer has established goodwill in its marks and a reputation in the industry, and only vague and general statements about awards and kudos that the company has received. This evidence is far from sufficient to establish fame. On the other hand, there is no evidence that the mark OPTI, while somewhat suggestive of opposer's goods, is commonly used in the chromatography industry, nor is there any other evidence to indicate that the mark is weak, or entitled to anything less than a normal scope of protection.

We turn finally to the sophistication of the purchasers. Although there is no specific evidence on this factor, it is reasonable to assume that purchasers of chromatography equipment and components are sophisticated and knowledgeable about those products. However, even sophisticated purchasers would be susceptible to source confusion, particularly under circumstances where, as here, the goods are closely related and are sold under similar marks. See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Pellerin Milnor Corporation*, 221 USPQ 588 (TTAB 1983).

In view of the similarities between opposer's mark OPTI and applicant's marks OPTIFLOW and OPTI-LIGHT, and because the goods are closely related, and the trade channels and purchasers for the goods are the same, we find that confusion is likely.¹⁰

Decision: The consolidated oppositions are sustained, and registration to applicant is refused.

¹⁰ To the extent opposer is making the argument, there is insufficient evidence to show or from which we can infer that applicant adopted its marks in bad faith. Mere knowledge of the existence of a prior user's mark does not, by itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307 (Fed. Cir. 1989). Opposer must show that applicant intentionally sought to trade on opposer's good will or reputation. See *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). There is no testimony or other evidence regarding applicant's intent in adopting the mark.