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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76709445
Applicant	Gary Fujarek
Applied for Mark	VOICE
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Submission	Appeal Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Application Serial Number: 76709445
Applicant: FUJAREK, GARY
Mark: VOICE
Law Office: 116
Examining Attorney: KRISTINA MORRIS

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Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPEAL BRIEF

Dear Sir or Madam:

Gary Fujarek appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 76709445 for VOICE in Class 38 for broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network. In response to the Final Office Action, the Applicant submits the following.

The refusal to register has been appealed as to Class 38 for broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network. The Trademark Office refused to register Applicant's mark in class 38 (1) because of an alleged likelihood of confusion with the marks in U.S. Registration Nos. 3129368, 3205170, 3695547¹, and 1845914; and (2) because the Trademark Office alleges the "applied-for mark merely describes a feature of applicant's services. Trademark Act Section 2(e)(1). Applicant respectfully disagrees and submits the following.

A. No Likelihood of Confusing Exists Between The Marks of The Cited Registrations and Applicant's Mark.

i. The Number and Nature of Similar Marks in Use on Similar Goods

The existence of third party use of the word VOICE in the marketplace is sufficient to show that the use of the term "voice" for registered marks is weak and entitled to only a narrow scope of protection. The large amount of evidence provided below is probative of the weakening of the source indicating power of the Cited Registrations. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991).

Evidence of third-party use falls under the sixth du Pont factor – the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc.*

¹ The Examining Attorney withdrew the refusal based on Registration No. 3695547 in her Denial of the Request for Reconsideration of July 5, 2016.

v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Below is a non-exhaustive list of third party U.S. trademark registrations that include the word VOICE in class 38². Worth noting is the large number of the marks cited in the list below that are used in conjunction with broadcasting.

- U.S. Reg. No. 4823558 in class 38
- U.S. Reg. No. 4823216 in class 38
- U.S. Reg. No. 4814908 in class 38
- U.S. Reg. No. 4806899 in class 38
- U.S. Reg. No. 4804725 in class 38
- U.S. Reg. No. 4797067 in class 38
- U.S. Reg. No. 4752676 in class 38
- U.S. Reg. No. 4796359 in class 38
- U.S. Reg. No. 4753785 in class 38
- U.S. Reg. No. 4591882 in class 38
- U.S. Reg. No. 4618729 in class 38

² Copies of all U.S. Registrations in this list were previously attached to Applicant's Request for Reconsideration as Exhibit A.

- U.S. Reg. No. 4761772 in class 38
- U.S. Reg. No. 4761513 in class 38
- U.S. Reg. No. 4755992 in class 38
- U.S. Reg. No. 4654062 in class 38
- U.S. Reg. No. 4744275 in class 38
- U.S. Reg. No. 47414819 in class 38
- U.S. Reg. No. 4717725 in class 38
- U.S. Reg. No. 4713487 in class 38
- U.S. Reg. No. 4701615 in class 38
- U.S. Reg. No. 4680995 in class 38
- U.S. Reg. No. 4662614 in class 38
- U.S. Reg. No. 4165580 in class 38
- U.S. Reg. No. 4508913 in class 38
- U.S. Reg. No. 4153358 in class 38
- U.S. Reg. No. 4471207 in class 38
- U.S. Reg. No. 4031386 in class 38
- U.S. Reg. No. 3405740 in class 38

- U.S. Reg. No. 3129368 in class 38
- U.S. Reg. No. 3688330 in class 38
- U.S. Reg. No. 3918467 in class 38
- U.S. Reg. No. 3688330 in class 38
- U.S. Reg. No. 3697506 in class 38
- U.S. Reg. No. 3664480 in class 38
- U.S. Reg. No. 3601049 in class 38
- U.S. Reg. No. 3740376 in class 38
- U.S. Reg. No. 4235584 in class 38
- U.S. Reg. No. 3728749 in class 38
- U.S. Reg. No. 3008342 in class 38
- U.S. Reg. No. 1858891 in class 38
- U.S. Reg. No. 1845914 in class 38
- U.S. Reg. No. 1992278 in class 38

The large amount of evidence provided above is probative of the weakening of the source indicating power of the registrant's marks in class 38. Assuming *arguendo* that the registrations listed above co-exist peacefully in the marketplace, this plethora of evidence establishes that the consuming public is exposed to third-party use of marks similar to the cited marks in connection

with the same or similar goods. Consequently, aforesaid evidence “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

ii. The Marks Are Not Compared in their Entireties

On page 2 of the Office Action, the Examining Attorney argues that the Applicant’s mark does not create a distinct commercial impression because it contains common wording as the Cited Registrations. However, respectfully speaking, the Examining Attorney argument does not adequately take into account that the use of the word “of” in the Cited Registrations creates an overall commercial impression quite different than the Applicant’s mark.

When comparing marks, they must be examined in their entireties. *Sears, Roebuck & Co. v. Hoffman*, 119 U.S.P.Q. 137 (C.C.P.A. 1958). Thus, contrary to the examining attorney’s contention, the mere phonetic similarity of one piece of the textual portion of the marks will not suffice to create a likelihood of confusion, where the overall commercial impressions are distinct. For example, in *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998), although two highly similar marks were used in connection with identical goods, (“CRISTAL” and “CRYSTAL CREEK”), the Federal Circuit affirmed the TTAB’s decision to allow registration because the sound, connotation and commercial impression differed. *See also, In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (C.A.F.C. 1992) (“THE VARGA GIRL” was sufficiently different from the registered mark “VARGAS” to permit registration even when the marks were for virtually identical products); *Anderson, Clayton & Co. v. Christie Food Prods. Inc.*, 4 U.S.P.Q.2d 1555, 1557 (T.T.A.B. 1987) (The common use of one

word insufficient to establish likelihood of confusion, where marks include other components, even when used in identical or similar goods and services.).

A portion of the textual portion of the cited registration may be similar to the textual portion of Applicant's mark, but the overall commercial impression of the two marks are squarely different. Unlike the Applicant's mark, all of the Cited Registrations have a common thread – all the Cited Registrations use the words “voice of” followed by a specific geographic location.

The use of the words “voice of” followed by a specific geographic location gives the Cited Registrations the commercial impression that the mark or someone associated with the mark is speaking on behalf of a specific geographic location. According to the Merriam-Webster Dictionary, the term “voice of” means an instrument or medium of expression or an opinion openly or formally expressed. *See* Exhibit B previously attached to Applicant's Request for Reconsideration. As a result, the commercial impression of each of the Cited Registrations are indeed quite similar to each of the other Cited Registrations in that they all give the commercial impression of: expressing the opinions of a geographic area, i.e., Chicago, America, New York and St. Louis.

On the other hand, the Applicant's mark gives quite a different commercial impression. In the Applicant's case, the textual portion of Applicant's mark includes only the single word “VOICE”. The Applicant, specifically chose not to include any word before or after the word “VOICE”. The Applicant specifically chose to not include the letter “A” or the word “The” before the word “VOICE”. The Applicant specifically chose not to include the words “of” or include any geographic location after word “VOICE”. The use of a single word of the

Applicant's mark as opposed to multiple letter adds to the distinctiveness of Applicant's mark. As a result, the commercial impression can be: the musical sound produced by the vocal cord. See Exhibit B previously attached to Applicant's Request for Reconsideration. Additionally, the commercial impression intended by the Applicant is of the Applicant himself (as illustrated in Exhibit C previously attached to Applicant's Request for Reconsideration), which is very different than the commercial impression of the Cited Registrations, namely someone speaking on behalf of a geographic area.

The TTAB has previously found that even the use of an identical mark is not likely to cause confusion if the marks convey different meanings. See, for example, *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (no likelihood of confusion between CROSS-OVER for bras and CROSSOVER for ladies' sportswear, namely, tops, shorts and pants); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for shoes); and *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (no likelihood of confusion between BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's suits, coats and trousers).

iii. Textual Portions of the Marks Differ

It is well established that a significant distinctiveness can be created even if the marks in question differ only with respect to a single letter. See *Jacobs v. Int'l Multifoods Corp.*, 212 U.S.P.Q. 641 (C.C.P.A. 1982) ("BOSTON SEA PARTY" and "BOSTON TEA PARTY"); *Lever Brothers Company v. Babson*, 94 U.S.P.Q. 161, 164 (C.C.P.A. 1952) ("SURF" and "SURGE"). The marks must be considered in the way they are used and perceived, with all components

given appropriate weight. *See Id.* In the Applicant's case, the textual portions of the Applicant's mark and marks of the Cited Registrations differ significantly.

The Applicant's mark completely lacks dominant portions of the Cited Registrations. Cited Registration No. 3129368 includes the words "THE", "VOICE OF" and "CHICAGO" and takes three (3X) times longer for a consumer to say than the Applicant's mark. Cited Cited Registration No. 1845914 includes the words "THE", "VOICE OF" and "SAINT LOUIS" and takes three (4X) times longer for a consumer to say than the Applicant's mark. Cited Registration No. 3205170 includes the words "VOICE OF" and "AMERICA" and takes at least twice (2X) times longer for a consumer to say than the Applicant's mark. Registration No. 3695547 is not considered because the Examining Attorney withdrew the refusal based on Registration No. 3695547 in her Denial of the Request for Reconsideration of July 5, 2016.

On the other hand, the Applicant's mark consists of only the word "VOICE". Applicant's mark differs in size, number of words, and number of letters from Cited Registration Nos. 3129368 (THE VOICE OF CHICAGO), and 1845914 (THE VOICE OF SAINT LOUIS). Applicant's mark is a single word – VOICE. The Applicant's mark is concise and provides only one syllable to be said by a consumer.

iv. The Marks Are Not Compared in their Entireties

On page 2 of the Office Action, the Examining Attorney argues that the Applicant's mark does not create a distinct commercial impression because it contains common wording as the Cited Registrations. However, respectfully speaking, the Examining Attorney argument does not

adequately take into account that the word “of” in the Cited Registrations creates an overall commercial impression quite different than the Applicant’s mark.

When comparing marks, they must be examined in their entireties. *Sears, Roebuck & Co. v. Hoffman*, 119 U.S.P.Q. 137 (C.C.P.A. 1958). Thus, contrary to the examining attorney’s contention, the mere phonetic similarity of one piece of the textual portion of the marks will not suffice to create a likelihood of confusion, where the overall commercial impressions are distinct. For example, in *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998), although two highly similar marks were used in connection with identical goods, (“CRISTAL” and “CRYSTAL CREEK”), the Federal Circuit affirmed the TTAB’s decision to allow registration because the sound, connotation and commercial impression differed. See also, *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (C.A.F.C. 1992) (“THE VARGA GIRL” was sufficiently different from the registered mark “VARGAS” to permit registration even when the marks were for virtually identical products); *Anderson, Clayton & Co. v. Christie Food Prods. Inc.*, 4 U.S.P.Q.2d 1555, 1557 (T.T.A.B. 1987) (The common use of one word insufficient to establish likelihood of confusion, where marks include other components, even when used in identical or similar goods and services.).

Further, a portion of the textual portion of the cited registration may be similar to the textual portion of Applicant’s mark, but the overall commercial impression of the two marks are squarely different. Unlike the Applicant’s mark, all of the Cited Registrations have a common thread – all the Cited Registrations use the words “voice of” followed by a specific geographic location.

The use of the words “voice of” followed by a specific geographic location gives the Cited Registrations the commercial impression that the mark or someone associated with the mark is speaking on behalf of a specific geographic location. According to the Merriam-Webster Dictionary, the term “voice of” means an instrument or medium of expression or an opinion openly or formally expressed. *See Exhibit B.* As a result, the commercial impression of each of the Cited Registrations are indeed quite similar to each of the other Cited Registrations in that they all give the commercial impression of: expressing the opinions of a geographic area, i.e. Chicago, America, New York and St. Louis.

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The TTAB has previously found that even the use of an identical mark is not likely to cause confusion if the marks convey different meanings. See, for example, *In re Sears, Roebuck*

and Co., 2 USPQ2d 1312 (TTAB 1987) (no likelihood of confusion between CROSS-OVER for bras and CROSSOVER for ladies' sportswear, namely, tops, shorts and pants); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for shoes); and *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (no likelihood of confusion between BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's suits, coats and trousers).

Again, the overall commercial impressions between the two marks are distinct. Consequently, there can be no likelihood of confusion between Applicant's mark and the marks of the Cited Registrations.

B. Applicant's Mark Is Not Merely Descriptive.

The Examining Attorney has refused registration on the ground that the Examining Attorney believes that the word "VOICE" is merely descriptive of Applicant's services. Applicant respectfully disagrees, and asserts that VOICE is suggestive rather than descriptive. Section 2(e)(1) of the Lanham Act does not prohibit registration of a mark unless the primary significance of the words comprising the mark is to describe the applicant's goods or services or their feature or characteristics. *See In re Waldorf Paper Prods. Co.*, 155 U.S.P.Q. 174, 174 (T.T.A.B 1967) (finding STRIP-FLAP for opening device for paper board containers not merely descriptive even though the opening device contains strips and flaps).

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services with which it is used, or intended to be used. *See In Re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987). "On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine

what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive. [internal citations omitted]. . . incongruity is a strong indication that a mark is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 196, 197 (T.T.A.B. 1978) (holding the mark TENNIS IN THE ROUND to be suggestive for providing circular tennis facilities); see also *Playboy Enter., Inc. v. Chuckleberry Publ’g Inc.*, 468 F. Supp. 414, 420 (S.D.N.Y. 1980) (finding PLAYBOY not descriptive when used to designate a magazine.)

In this case, the word “VOICE” is only one component of the Applicant’s services and imagination, thought and perception are required to reach a conclusion as to the nature of Applicant’s goods or services, which are broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network. A number of similar marks have been found to be suggestive, and not descriptive, by both the courts and the T.T.A.B. on the grounds that they convey a general idea of the goods or services without being descriptive of the essence of those goods or services.

For example, in *The Money Store v. Harriscorp Finance, Inc.*, 216 U.S.P.Q. 11 (7th Cir. 1982), the Seventh Circuit opined:

If we were considering the validity of “THE MONEY STORE” mark de novo, we would find this an extremely close case. On the one hand, THE MONEY STORE” conveys the idea of a commercial establishment whose service involves supplying money. The terms does not, however, necessarily convey the essence of the business, money lending. Arguably, the mark might refer to twenty four teller services, or establishments which deal in foreign currency or traveler’s checks, to mention a few possibilities. Some imagination and perception are therefore required to identify the precise nature of the services offered by the plaintiff.

Id. at 18.

For similar reasons, the T.T.A.B., in *In re Southern Bank of North Carolina*, 219 U.S.P.Q. 1231 (T.T.A.B. 1983), reversed the Examining Attorney's refusal of registration of the mark MONEY 24 for "banking services, namely, automatic teller machine services." The Board wrote:

The term "MONEY 24" suggests the nature or characteristic of applicant's banking services. The term "MONEY 24" involves, in applicant's words, "an element of incongruity" or incompleteness which we believe an individual encountering the mark must interpret in order to arrive at the conclusion that one has access to his or her money by use of applicant's services on a twenty-four hour-a-day basis. While automatic teller machines are vehicles for receiving deposits and for disbursing cash from accounts, we do not believe that the word "money" per se is merely descriptive of these services. One needs some degree of imagination or perception to determine the nature of the services. The addition of the numeral "24" to this word, we believe, further lessens any arguable descriptive significance. This is so because one must mentally reserve the order of the elements of the mark and add the word "hour" or possible "hours a day" after "24" to transform the mark into a readily comprehensible expression. In sum, we cannot say that the term as a whole does nothing but describe applicant's services since the characteristic or functions or [sic] applicant's services are not instantly apparent or immediately indicated by the mark sought to be registered.

Id. at 1232; see also *In re TMS Corporation of the Americas*, 200 U.S.P.Q. 57 (T.T.A.B. 1978) (holding Applicant's THE MONEY SERVICE mark to be suggestive of Applicant's financial funds transferal services); *In re National Data Corporation*, 222 U.S.P.Q. 515 (T.T.A.B. 1984) (reversing the Examining Attorney's refusal to register the mark THE CASH MANAGEMENT EXCHANGE on descriptiveness grounds for "computerizing cash management services"); *In re WSI Corporation*, 1 U.S.P.Q.2d 1570 (T.T.A.B. 1986) (holding Applicant's SUPERSAT mark to be suggestive because purchasers of Applicant's service would not immediately recognize SAT to refer to a feature or characteristic of Applicant's

meteorological data generation analysis and distribution services); *In re Distribution Codes, Inc.*, 199 U.S.P.Q. 508 (T.T.A.B. 1978) (CODE & SYMBOL suggestive for journal because at least a two-step reasoning process was needed to associate the title with the content of the publication); *In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

As with the marks in the above cases, Applicant's mark is not immediately descriptive of its services because one needs imagination and perception to determine what the term "voice" means. Applicant's mark certainly does not necessarily convey the "essence" of Applicant's services, namely broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network. Similar to *In re TMS Corporation of the Americas*, where the T.T.A.B. found that the use of the term "money" in MONEY 24 was not merely descriptive of the services despite the fact that "money" was used along with the services provided, the Applicant's use of the term "VOICE" is not merely descriptive of the services of the Applicant's mark despite the fact that people's voices are a component along with the services to be provided.

Applicant's services also include the use of satellites, mobile phones, communication towers, electrical equipment, music, televisions, electrical components, and numerous other components. Applicant also provides videos, instrumental music and other music products, and visual art. The fact that a person's voice is one component utilized in conjunction with a variety of other components does not mean that a consumer will "immediately" ascertain nothing but Applicant's services.

A consumer must undertake a multi-stage reasoning process in order to determine what product or service characteristics the term “voice” indicates. First a consumer must determine “what is a broadcasting service?” Next, a consumer must then determine “what are components of broadcasting services? Next, a user must determine “in what content the term voice is to be used?”. Finally, the user MAY determine that the term “voice” is one of the components utilized with by a broadcasting service. As a result, the term “voice” is suggestive rather than merely descriptive.

If the term “voice” is considered merely descriptive of a broadcasting service as the Examining Attorney suggests, then - using that same line of reasoning – the terms “speaker”, “microphone”, “instrumental music”, and virtually every component utilized with broadcasting services would also be descriptive of the Applicant’s services. Such a line of reasoning is flawed, and respectfully speaking so too is the reasoning provided by the Examining Attorney.

Finally, Applicant wishes to further point out that it is well established that any doubts regarding the descriptiveness of a mark are to be settled in the Applicant's favor. *In re Grand Metropolitan Food Service, Inc.*, 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994); *John Harvey & Sons. Ltd.*, 32 U.S.P.Q. 2d 1451 (TTAB 1994); *In re Shutts*, 217 U.S.P.Q. 363, 365 (TTAB 1983). As previously stated by the Board, "when doubts exist as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication ..." *In re The Stroh Brewery Company*, 34 U.S.P.Q. 2d 1796 (TTAB 1994). Therefore, Applicant’s mark should be deemed suggestive and capable of registration.

By: /Mark Terry/

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