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Subject: U.S. TRADEMARK APPLICATION NO. 76709445 - VOICE - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 76709445

MARK: VOICE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Gary Fujarek ("Applicant") has appealed the final refusal to register the proposed mark VOICE in standard characters for "broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network" in International Class 38. The applied-for mark was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that the applied-for mark is likely to be confused with the following marks:

- U.S. Registration No. 1845914: THE VOICE OF ST. LOUIS in typed characters for “radio broadcasting services” in International Class 38.
- U.S. Registration No. 3129368: THE VOICE OF CHICAGO in standard characters for “radio broadcasting” in International Class 38.
- U.S. Registration No. 3205170: VOICE OF AMERICA in standard characters for “Audio broadcasting; Broadcast of cable television programmes; Broadcasting programs via a global computer network; Cable radio broadcasting; Cable radio transmission; Cable television broadcasting; Cable television transmission; Communication via radio, telephone and television transmissions; Radio broadcasting; Radio broadcasting of information and other programs; Radio communication; Radio program broadcasting; Radio programme broadcasting; Radio, telephone, telegraph communication services; Satellite communication services; Satellite television broadcasting; Satellite transmission services; Satellite, cable, network transmission of sounds, images, signals and data; Streaming of audio material on the Internet; Streaming of video material on the Internet; Subscription television broadcasting; Television broadcasting; Television programme broadcasting via cable; Television transmission services; Transmission of news; Video broadcasting; Webcasting services” in International Class 38.

The applied-for mark was also refused under Trademark Action Section 2(e)(1), U.S.C. §1052(e)(1) as to broadcasting services, namely, radio broadcasting by satellite and mobile phones, via a global computer network” in International Class 38, on the grounds that the applied-for mark merely describes a feature of Applicant’s services.

STATEMENT OF FACTS

On October 18, 2011, Applicant filed a use-based application for the proposed mark VOICE for “broadcasting services, namely, radio and television broadcasting by satellite [sic] and mobile phones, via a global computer network” in International Class 38.

On February 13, 2012, the Examining Attorney refused registration based on Trademark Act Section 2(d) based on a number of registrations and issued a descriptiveness refusal under Section 2(e)1.

Following a series of intermediate actions, on May 19, 2016, the Examining Attorney issued an Office action comprising a final refusal under Section 2(d) based on a likelihood of confusion with the marks in U.S. Registration Nos. 3129368, 3205170, and 1845914, and a final refusal under Section

2(e)(1) as to “broadcasting services, namely, radio broadcasting by satellite and mobile phones, via a global computer network.”

On September 2, 2016, Applicant timely filed the present appeal with the Board and the application was reassigned to the undersigned examining attorney.

ISSUES

The two issues on appeal are whether the applied-for VOICE mark is likely to be confused with the registered marks, THE VOICE OF CHICAGO, VOICE OF AMERICA, and THE VOICE OF ST. LOUIS, when used in connection with overlapping and related services, and whether Applicant’s applied-for VOICE mark is merely descriptive in connection with the identified services.

ARGUMENTS

THE REFUSAL TO REGISTER BECAUSE OF LIKELIHOOD OF CONFUSION SHOULD BE AFFIRMED

I. **THE PROPOSED MARK “VOICE” IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARKS “THE VOICE OF ST. LOUIS”, “THE VOICE OF CHICAGO” AND “VOICE OF AMERICA” UNDER SECTION 2(d) OF THE TRADEMARK ACT**

A likelihood of confusion exists between Applicant’s and Registrants’ marks because Applicant’s and Registrants’ radio and television broadcasting services are nearly identical. In addition, Applicant’s mark (“VOICE”) is likely to cause confusion with Registrants’ marks (“THE VOICE OF ST. LOUIS”, “THE VOICE OF CHICAGO” and “VOICE OF AMERICA”) because Applicant’s mark is identical to the dominant wording in Registrants’ marks and is incorporated in its entirety in Registrants’ marks.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the services of the Applicant and Registrant. *See* 15 U.S.C. §1052(d). A determination of

likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp, Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the services. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 (TTAB 2015) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *see* TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. Applicant's services are identical in part and substantially similar to the services in the registered marks.

Applicant does not dispute the related nature of its services to those identified in the cited registrations and has in fact conceded that its services are related to those of the Registrants' by failing to address the issue of relatedness in any response to Office actions or in its Appeal Brief.¹

Indeed, confusion as to the source of the services is clearly present in this case as Applicant and Registrants provide nearly identical services in part. A likelihood of confusion analysis is concerned with the likelihood of confusion as to the source of the services being provided.

Applicant and Registrants provide the following services:

- Applicant provides "broadcasting services, namely, **radio and television broadcasting** by satellite and mobile phones, via a global computer network" in International Class 38.
- U.S. Registration No. 1845914 identifies "**radio broadcasting services**" in International Class 38.
- U.S. Registration No. 3129368 identifies "**radio broadcasting**" in International Class 38.
- U.S. Registration No. 3205170 identifies "Audio broadcasting; Broadcast of cable television programmes; Broadcasting programs via a global computer network; Cable radio broadcasting; **Cable radio transmission; Cable television broadcasting;** Cable television transmission; Communication via radio, telephone and television transmissions; Radio broadcasting; **Radio broadcasting of information and other programs;** Radio communication; **Radio program broadcasting; Radio programme broadcasting;** Radio, telephone, telegraph communication services; Satellite communication services; **Satellite television broadcasting;** Satellite transmission services; Satellite, cable, network transmission of sounds, images, signals and data; Streaming of audio material on the Internet; Streaming of video material on the Internet; Subscription television broadcasting; **Television broadcasting;** Television programme broadcasting via cable; Television transmission services; Transmission of news; Video broadcasting; Webcasting services" in International Class 38.

¹ See Page 1, June 28, 2012, Incoming Response to Office Action; Page 1, February 1, 2013, Incoming Response to Office Action; Page 23, October 15, 2015, Request for Reconsideration; Page 12, September 2, 2016, Applicant's Appeal Brief.

Absent restrictions in an application and/or registration, the identified services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

The identifications set forth in the application and registrations have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services “travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Further, the registrations use broad wording to describe the services (“radio broadcasting” and “television broadcasting”) and this wording is presumed to encompass all services of the type described, including those in Applicant’s more narrow identifications (“broadcasting services, namely, radio and television broadcasting by satellite and mobile phones, via a global computer network”). See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Therefore, Applicant's and Registrants' services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

B. The applied-for mark “VOICE” is confusingly similar to the registered marks “THE VOICE OF ST. LOUIS”, “THE VOICE OF CHICAGO” and “VOICE OF AMERICA”

Confusion is also likely because Applicant’s mark is identical to the dominant wording in Registrants’ marks and incorporated in its entirety in Registrants’ marks. Although, as Applicant argues,

marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

Applicant's and Registrants' marks are as follows:

- Applicant's mark is VOICE in standard characters;
- U.S. Registration No. 1845914: THE VOICE OF ST. LOUIS in typed characters;
- U.S. Registration No. 3129368: THE VOICE OF CHICAGO in standard characters; and
- U.S. Registration No. 3205170: VOICE OF AMERICA in standard characters.

In the present case, Applicant's mark, VOICE, is incorporated in its entirety in each of Registrants' marks. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2D 1651, 1660-61 (TTAB 2014) (finding PRECISION and PRECISION DISTRIBUTION CONTROL confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Moreover, the Applicant's mark is identical to the dominant portions of Registrants' marks. Disclaimed matter that is descriptive of or generic for a party's services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP

§1207.01(b)(viii), (c)(ii). Here, the wording “ST. LOUIS”, “CHICAGO”, AND “AMERICA” is disclaimed in Registrants’ marks. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording VOICE the more dominant element of Registrants’ marks.

Therefore, not only is the applied-for mark incorporated in its entirety in each of Registrants’ marks, it is also identical to the dominant element of Registrants’ marks. Thus, the marks are identical in part in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, Llc*, 116 USPQ2d 1406, 1411 (TTAB 2015). Additionally, because they are identical in part, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with Applicant’s and Registrants’ respective services. *In re i.am.symbolic, Llc*, 116 USPQ2d at 1411.

a. Inclusion of the Additional Wording in Cited Registrations Does Not Obviate the Similarity between the Marks.

In the Appeal Brief, Applicant relies heavily on Registrants’ inclusion of the word “of” in their marks, arguing that “use of the word ‘of’ in the Cited Registrations creates an overall commercial impression quite different than Applicant’s mark”, and that “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.”² It argues that use of the wording “VOICE OF” followed by a geographic location gives the commercial impression that “the mark or someone associated with the mark is speaking on behalf of a specific geographic location.”³ However, Applicant uses the wording “VOICE” in the applied-for mark to refer to *himself*, as the “Voice of the World”.⁴

² Page 6, September 2, 2016, Applicant’s Appeal Brief.

³ Page 7, September 2, 2016, Applicant’s Appeal Brief.

⁴ Page 4-5, February 1, 2016, Incoming Response to Office Action; Page 69, October 15, 2015, Request for Reconsideration.

In addition, Applicant's decision to delete the wording "of" followed by a geographic location does not obviate the similarity between the marks. Applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark. In addition, as Applicant notes in its brief, Applicant "specifically chose not to include any word before or after the word "VOICE", and there is no other wording in Applicant's mark to distinguish it from the registered mark.⁵ The mere deletion of wording from a registered mark, as in this case in this case, is not sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii).

b. The Third Party Registrations in the Applicant's Appeal Brief Include Additional Wording, Identify Unrelated Services, are Cancelled and/or Duplicative

Applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording "VOICE" to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection.⁶ However, third-party registrations are entitled to little weight on the question of likelihood of confusion because they are "not evidence that the registered marks are actually in use or that the public is familiar with them." *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)); see TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

⁵ Page 7-8, September 2, 2016, Applicant's Appeal Brief.

⁶ Pages 13-17, September 2, 2016, Applicant's Appeal Brief; Pages 13-17, 28-252, October 15, 2015, Request for Reconsideration.

In addition, as demonstrated in the table below, the third party registrations relied on by Applicant (1) include additional wording that provide an arguably different commercial impression, (2) identify unrelated services in the identification, (3) are cancelled, and/or (4) are duplicative.

U.S. Registration. No.	Mark	Additional Wording	Services
Reg. No. 1845914 ⁷	THE VOICE OF SAINT LOUIS	YES	Radio programming services
Reg. No. 1858891 ⁸	AMERICA'S SPORTS VOICE	YES	Radio broadcasting services
Reg. No. 1992278 ⁹	SPORTS VOICE OF THE SOUTH	YES	Radio broadcasting services
Reg. No. 2952895 ¹⁰	<i>VOICE GENESIS - CANCELLED</i>	YES	<i>Telecommunication services</i>
Reg. No. 3008342 ¹¹	LA VOZ DE LA COMUNIDAD (Translation: THE VOICE OF THE COMMUNITY)	YES	Television broadcasting services
Reg. No. 3129368 ¹²	THE VOICE OF CHICAGO	YES	Radio broadcasting
Reg. No. 3405740 ¹³	FUTURE VOICE	YES	Broadcasting of television programs
Reg. No. 3601049 ¹⁴	SECUVOICE	YES	Radio broadcasting services
Reg. No. 3664480 ¹⁵	<i>MYCATHOLICVOICE - CANCELLED</i>	YES	<i>broadcasting services over the Internet and other communications network</i>
Reg. No. 3688330 ¹⁶	<i>LA VOZ DEL PUEBLO (Translation: THE PEOPLE'S VOICE) - CANCELLED</i>	YES	<i>Radio Broadcasting</i>

⁷ Page 50, October 15, 2015, Request for Reconsideration. Reg. No. 1845914, one of the cited Registrations, includes "voice" plus additional descriptive wording. Unlike the other "voice" marks in the table above with similar services, the cited Registrations include descriptive wording that is disclaimed, thus, rendering the wording "voice" the dominant element of Reg. No. 1845914.

⁸ Applicant did not provide a copy of Reg. No. 1858891.

⁹ Page 55, October 15, 2015, Request for Reconsideration.

¹⁰ Page 100, October 15, 2015, Request for Reconsideration.

¹¹ Page 59, October 15, 2015, Request for Reconsideration.

¹² Page 126 October 15, 2015, Request for Reconsideration. Reg. No. 3129368, one of the cited Registrations, includes "voice" plus additional descriptive wording. Unlike the other "voice" marks in the table above with similar services, the cited Registrations include descriptive wording that is disclaimed, thus, rendering the wording "voice" the dominant element of Reg. No. 3129368.

¹³ Page 130, October 15, 2015, Request for Reconsideration.

¹⁴ Page 80, October 15, 2015, Request for Reconsideration.

¹⁵ Page 84, October 15, 2015, Request for Reconsideration.

¹⁶ Page 89, October 15, 2015, Request for Reconsideration.

Reg. No. 3688330	Duplicate	Duplicate	Duplicate
Reg. No. 3695547 ¹⁷	THE VOICE OF NEW YORK - CANCELLED	YES	Radio Broadcasting Services
Reg. No. 3697506 ¹⁸	MEDIA VOICE GENERATION	YES	Broadcast services
Reg. No. 3728749 ¹⁹	SPHELAR VOICE - CANCELLED	YES	Telecommunication Services
Reg. No. 3740376 ²⁰	STUDENTVOICES BY MATT.ORG - CANCELLED	YES	Broadcasting programs via a global computer network
Reg. No. 3918467 ²¹	VOICECASH	YES	Broadcasting radio and television programs
Reg. No. 4031386 ²²	WE'RE CHICAGOLAND'S ETHNIC VOICE	YES	Radio program broadcasting
Reg. No. 4153358 ²³	RAISE YOUR VOICE	YES	Audio, text and video broadcasting services
Reg. No. 4165580 ²⁴	AMERICA'S NU VOICE	YES	Broadcasting programs via a global computer network
Reg. No. 4235584 (Owned by Applicant) ²⁵	RTV VOICE OF THE WORLD VOICE	YES	Satellite Transmission Services, Television and Radio Broadcasting Services
Reg. No. 4471207 ²⁶	VOICE OF THE SOCIAL GENERATION	YES	Providing online chat rooms and streaming of audiovisual material
Reg. No. 4508913 ²⁷	CHILDREN'S RADIO FOUNDATION AMPLIFYING YOUTH VOICES ACROSS AFRICA	YES	Radio broadcasting services
Reg. No. 4591882 ²⁸	CHARTER SPECTRUM TV INTERNET VOICE	YES	Providing online data storage
Reg. No. 4618729 ²⁹	CHARTER SPECTRUM VOICE	YES	Telecommunication services

¹⁷ Page 92, October 15, 2015, Request for Reconsideration.

¹⁸ Page 83, October 15, 2015, Request for Reconsideration.

¹⁹ Page 64, October 15, 2015, Request for Reconsideration.

²⁰ Page 75, October 15, 2015, Request for Reconsideration.

²¹ Page 96, October 15, 2015, Request for Reconsideration.

²² Page 134, October 15, 2015, Request for Reconsideration.

²³ Page 156, October 15, 2015, Request for Reconsideration.

²⁴ Page 151, October 15, 2015, Request for Reconsideration.

²⁵ Page 69, October 15, 2015, Request for Reconsideration.

²⁶ Page 140, October 15, 2015, Request for Reconsideration.

²⁷ Page 161, October 15, 2015, Request for Reconsideration.

²⁸ Page 172, October 15, 2015, Request for Reconsideration.

²⁹ Page 166, October 15, 2015, Request for Reconsideration.

Reg. No. 4654062 ³⁰	VOICE COMPLETE	YES	Telecommunications services
Reg. No. 4662614 ³¹	VOICE OF ISRAEL	YES	Broadcasting of video and audio programming over the Internet.
Reg. No. 4680995 ³²	CERTIFIED VOICE	YES	Telephone communication services
Reg. No. 4701615 ³³	VOICELINX	YES	Telecommunication Services
Reg. No. 4713487 ³⁴	FASTRE TEXT VOICE VIDEO IN GROUPS	YES	Telecommunication Services
Reg. No. 4717725 ³⁵	DIRECTVOICE	YES	Voice over internet protocol (VOIP) services
Reg. No. 4714819 ³⁶	INDEPENDENT WOMEN'S VOICE	YES	Providing online cultural forums
Reg. No. 4744275 ³⁷	VOICELAYER	YES	Messaging and data-sharing services
Reg. No. 4752676 ³⁸	CHARTER SPECTRUM VOICE	YES	Telecommunication services
Reg. No. 4757385 ³⁹	CHARTER SPECTRUM INTERNET VOICE	YES	Telecommunication services
Reg. No. 4755992 ⁴⁰	VOICENEXT	YES	Telephone communications services;
Reg. No. 4761513 ⁴¹	VOICE	NO	Electronic and online message sending
Reg. No. 4761772 ⁴²	LIBERTY'S VOICE	YES	Broadcasting of television, cable television, satellite television, internet and radio programs
Reg. No. 4796359 ⁴³	AT&T HD VOICE CRYSTAL CLEAR CONVERSATION	YES	Telecommunication services

³⁰ Page 44, October 15, 2015, Request for Reconsideration.

³¹ Page 208, October 15, 2015, Request for Reconsideration.

³² Page 212, October 15, 2015, Request for Reconsideration.

³³ Page 216, October 15, 2015, Request for Reconsideration.

³⁴ Page 189, October 15, 2015, Request for Reconsideration.

³⁵ Page 30, October 15, 2015, Request for Reconsideration.

³⁶ Page 199, October 15, 2015, Request for Reconsideration.

³⁷ Page 35, October 15, 2015, Request for Reconsideration.

³⁸ Page 178, October 15, 2015, Request for Reconsideration.

³⁹ Page 184, October 15, 2015, Request for Reconsideration.

⁴⁰ Page 40, October 15, 2015, Request for Reconsideration.

⁴¹ Page 204, October 15, 2015, Request for Reconsideration.

⁴² Page 231, October 15, 2015, Request for Reconsideration.

⁴³ Page 220, October 15, 2015, Request for Reconsideration.

Reg. No. 4797067 ⁴⁴	VOICE 365	YES	Voice over internet protocol (VOIP) services
<i>Reg. No. 4797067</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>
Reg. No. 4804725 ⁴⁵	REACH BEYOND THE VOICE AND HANDS OF JESUS. TOGETHER	YES	Broadcasting of radio programs
<i>Reg. No. 4804725</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>
Reg. No. 4806899 ⁴⁶	AMERICAN VOICE MAIL	YES	Broadcast communication services
<i>Reg. No. 4806899</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>
Reg. No. 4814908 ⁴⁷	VOYCE ACTIVATED	YES	Telecommunication services
<i>Reg. No. 4814908</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>
Reg. No. 4823216 ⁴⁸	MOBIOLOGIX GIVING MACHINES A VOICE...	YES	Wireless broadband communication services
<i>Reg. No. 4823216</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>
Reg. No. 4823558 ⁴⁹	VOICEKICK	YES	Audio broadcasting services
<i>Reg. No. 4823558</i>	<i>Duplicate</i>	<i>Duplicate</i>	<i>Duplicate</i>

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar services. See *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of *similar marks with similar services* "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74,

⁴⁴ Page 246, October 15, 2015, Request for Reconsideration.

⁴⁵ Page 194, October 15, 2015, Request for Reconsideration.

⁴⁶ Page 241, October 15, 2015, Request for Reconsideration.

⁴⁷ Page 251, October 15, 2015, Request for Reconsideration.

⁴⁸ Page 225, October 15, 2015, Request for Reconsideration.

⁴⁹ Page 236, October 15, 2015, Request for Reconsideration.

73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003). That is not the case here.

In the case at hand, many of these registrations appear to be for telecommunication services, which are predominantly different from or unrelated to those identified in Applicant's application. Thus, the few similar third-party registrations with *related* services submitted by Applicant are insufficient to establish that the wording "voice", *particularly the term used on its own without additional wording*, is weak or diluted.

Further, evidence comprising third-party registrations for similar marks with different or unrelated services, as in the present case, is of limited probative value in determining the strength of a mark. *See Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (C.C.P.A. 1972); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). Thus, these third-party registrations submitted by Applicant are insufficient to establish that the wording "voice" is weak or diluted.

Where the third party registrations are for similar services, in every instance, the marks in the third party registrations *include additional distinctive wording* that, unlike the applied-for mark, arguably creates a different commercial impression.

The remaining third-party registrations are cancelled. Cancelled or expired third-party registrations is "only evidence that the registration issued and does not afford an applicant any legal presumptions under [Section] 7(b)," including the presumption that the registration is valid, owned by the registrant, and the registrant has the exclusive right to use the mark in commerce in connection with the services specified in the certificate. *In re Pedersen*, 109 USPQ2d 1185, 1197 (TTAB 2013) (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 1248, 178 USPQ 46, 47 (C.C.P.A. 1973) (statutory benefits of registration disappear when the registration is cancelled); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1047 n.2 (TTAB

2002)); *see* TBMP §704.03(b)(1)(A); TMEP §1207.01(d)(iv). Nor does a cancelled or expired registration provide constructive notice under Section 22, in which registration serves as constructive notice to the public of a registrant's ownership of a mark. *See Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 1566, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] canceled registration does not provide constructive notice of anything.”).

Thus, these third-party registrations have little, if any, probative value with respect to the registrability of Applicant's mark.

Finally, the degree of similarity between the marks to find a likelihood of confusion is lesser in the present cases. Where the services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). As discussed above, Applicant's and Registrants' services are virtually identical and Applicant has made no argument to the contrary.

Accordingly, giving each feature of the marks appropriate weight, the marks when compared in their entireties are sufficiently similar to create consumer confusion or mistake as to the source of the services despite some differences.

II. THE APPLIED-FOR MARK “VOICE” MERELY DESCRIBES A FEATURE OF APPLICANT'S SERVICES

Applicant has proposed the mark “VOICE” for use in connection with “broadcasting services, namely, radio broadcasting by satellite and mobile phones, via a global computer network” in International Class 38. Registration is refused because the applied-for mark merely describes a characteristic or feature of Applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Trademark Act Section 2(e)(1) bars registration on the Principal Register of an applied-for mark that is merely descriptive in connection with the services listed in the application without sufficient proof of acquired distinctiveness. See 15 U.S.C. §1052(e)(1). A mark is merely descriptive if “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods or services.” *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b).

Determining the descriptiveness of a mark is done in relation to an applicant’s services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. TMEP §1209.01(b).

Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

In the present case, the term “Voice” refers to “the sound or sounds uttered through the mouths of human beings.”⁵⁰ The Internet evidence attached in the April 14, 2015 Office action provides the following information about how use of the “voice” is a central component of radio broadcasting services.⁵¹

- “Radio broadcasting is essentially based on *voice*. Listeners know hardly about the face, dressing up at times the age of the person whose *voice* they are listening to. Most broadcasters have their peculiar *voice* – soft, hard, harsh or sharp.” *Voice Broadcasting: Introduction to Broadcasting*, at <http://www.ckbooks.com/>. The author also discusses voice characteristics of a good broadcaster, including using appropriate speech, accent, volume, stretch, stress, and pauses.⁵²
- “[n] a broadcast talk . . . method of improving the *voices* of some of the political speakers was described. By using a subtle combination of electrical devices in connexion with the microphone,

⁵⁰ Page 30, Feb. 13, 2012, Office Action.

⁵¹ Pages 2, 5-9, 13-15, April 14, 2015, Office Action.

⁵² Pages 13-15, April 14, 2015, Office Action.

it is possible to improve the broadcast *voice* by smoothing out rough and strengthening weak notes.” Article entitled *Modifying Broadcasting Voices*, at <http://www.nature.com/>.⁵³

- Article entitled *Top 10 Voices in Broadcast Journalism* at <http://www.journalismdegree.com/> listing iconic voices in television and radio broadcasting.⁵⁴

Allowing Applicant to inhibit competitors from using the term “voice” is of paramount concern due to the fact that the term “voice” is often used in broadcasting to identify various broadcasting service providers. For example, “The Quiet Roar – The *Voice* in the Yard” uses the term “voice” in connection with its campus radio broadcasting services.⁵⁵ Businesses and competitors should be free to use the term “Voice”, as many already do, to describe their radio broadcasting services. Additionally, companies have already started using “Voice” to describe radio broadcasting services, and whereas the other applications and registrations discussed above all contain sufficient other matter to differentiate the respective marks from others or incorporate “VOICE” into a unitary phrase, the mark in question to which Applicant seeks exclusive rights is VOICE alone. Allowing Applicant to monopolize the term would unfairly hinder these competitors’ use of the term.

A. Applicant’s mark is not suggestive when used in connection with the services.

Applicant argues that the word “VOICE” is only one component of Applicant’s services and that “imagination, thought and perception are required to reach a conclusion as to the nature of Applicant’s [] service,” and that “[a] consumer must undertake a multi-stage reasoning process in order to determine what product or service characteristics the term ‘voice’ indicates.”⁵⁶

However, *voices* are an integral and primary feature of radio broadcasting, as well as what distinguishes one broadcasting service from another. “A mark may be merely descriptive even if it does

⁵³ Page 2, April 14, 2015, Office Action.

⁵⁴ Pages 5-9, April 14, 2015, Office Action.

⁵⁵ Page 17-18, April 14, 2015, Office Action.

⁵⁶ Pages 15-16, September 2, 2016, Applicant’s Appeal Brief.

not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only *one* significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371. In this instance, “radio broadcasting is essentially based on *voice*”, thus “voice” is a significant attribute of Applicant’s radio broadcasting services.⁵⁷

B. Applicant has Previously Conceded to the Descriptiveness of the Wording “VOICE” in Connection with Similar Services

Applicant identifies itself as the “Voice” featured in its radio broadcasting services⁵⁸, refers to its radio broadcasting services as the “Voice of the World”⁵⁹, and acknowledges that “people’s voices are a component” of its services⁶⁰. Notably, in Applicant’s prior registration for “RTV VOICE OF THE WORLD VOICE”, Applicant agreed to disclaim the descriptive wording “VOICE”, in connection with its “television and radio broadcasting services”, thus conceding to the descriptive nature of the term when used in connection with radio services.⁶¹

In light of the foregoing, the applied-for mark must be refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because it is merely descriptive.

CONCLUSION

⁵⁷ Pages 13-15, April 14, 2014, Office Action (*Voice Broadcasting: Introduction to Broadcasting*, at <http://www.ckbooks.com/>).

⁵⁸ Page 8, September 2, 2016, Applicant’s Appeal Brief.

⁵⁹ Page 29, October 15, 2015, Request for Reconsideration.

⁶⁰ Page 15, September 2, 2016, Applicant’s Appeal Brief.

⁶¹ Page 69, October 15, 2015 Request for Reconsideration.

Applicant's applied-for mark VOICE and the Registrants' marks THE VOICE OF ST. LOUIS, THE VOICE OF CHICAGO and VOICE OF AMERICA, are likely to be confused by potential consumers. Confusion is likely because the marks are identical in appearance, sound, and connotation, and create similar overall commercial impressions. Further, Applicant's and Registrants' services are closely related. Therefore, because confusion is likely, the applied-for mark must be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Applicant's applied-for mark is also merely descriptive of the voice, or voices, featured in Applicant's "broadcasting services, namely, radio broadcasting by satellite and mobile phones, via a global computer network." Therefore, because the applied-for mark is merely descriptive, registration must be refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Respectfully submitted,

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