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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Asist, Inc.

Serial No. 77396813
Filed: February 14, 2008

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**Before Zervas, Mermelstein, and Wellington, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant seeks registration of the mark



for "video teleconferencing" in International Class 38.¹

The examining attorney has refused registration, having determined that registration of applicant's mark would lead to a likelihood of confusion in view of Registration No.

¹ Based on the allegation of first use and use in commerce as of November 1, 2007. "The color(s) blue, red, and white is/are claimed as a feature of the mark."

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3088658² for DITTOCAM (in standard characters) as used in connection with "radio broadcasting services; telecommunications services, namely, broadcasting of real time images via the global computer network," in International Class 38. Trademark Act § 2(d); 15 U.S.C. § 1052(d). Applicant appeals from the examining attorney's final refusal.³

We affirm.

I. Applicable Law

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential

² Issued May 2, 2006, based on use of the mark in commerce.

³ We grant applicant's and the examining attorney's requests that we take judicial notice of proffered dictionary definitions. *In*

characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

II. Discussion

A. The Similarity or Dissimilarity of the Marks in Their Entireties

In a likelihood of confusion analysis, we compare the marks for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1692. "[T]he test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. "[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate

re Red Bull GmbH, 78 USPQ2d 1375, 1377 (TTAB 2006).

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conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

As noted above, applicant's mark is:



Applicant's mark comprises the wording DITTOPRO, displayed in an unremarkable sans-serif font, with the "DITTO" portion displayed in large, red, uppercase characters, and the "PRO" portion in smaller, blue letters, with an initial capital. Thus, although physically connected to "PRO," the "DITTO" feature of the mark makes a separate - and significantly greater - impression as a constituent feature of the wording in the mark. We also note that "DITTO" is the first literal part of applicant's mark, and therefore "most likely to be impressed upon the mind of a purchaser and remembered." *Palm Bay*, 73 USPQ2d at 1692; *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Moreover, PRO is a frequently-used synonym for "professional," MERRIAM-WEBSTER

DICTIONARY, www.merriam-webster.com (March 29, 2011),⁴ and in the context of applicant's mark and goods, is suggestive of either the quality of applicant's services or the intended users of them. Suggestive terms tend to be weak, and therefore less likely to form a strong impression on the potential consumer when distinguishing similar marks.

Visually, while applicant's mark also includes a design (of a globe wearing a telephone headset) we find - as we often do - that the wording creates the dominant impression of the mark. This is because when a mark consists of words as well as a design, the words are used to call for, or refer to the goods. *E.g.*, *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82 (Fed. Cir. 1983). As a result, we find that the term DITTO is clearly the dominant feature of opposer's mark.

Applicant argues that DITTO in its mark "is an acronym for 'Digital Interpreting, Translation, and Transliteration Online.'" App. Br. at 13. But applicant offers no evidence that this is an accepted meaning of "DITTO," or that the relevant consumers would be aware of it. On the contrary, there is nothing in this record to suggest that consumers (of either applicant's or registrant's services)

⁴ We *sua sponte* take judicial notice of this definition, and the definition of "cam," *infra*.

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would understand DITTO to have anything other than its common meaning: "same here: used instead of repeating something that has just been said to indicate that the same thing applies to you (*informal*)."
MSN ENCARTA DICTIONARY
<http://encarta.msn.com> (Sept. 21, 2010). We thus consider the term DITTO in both marks to share the same meaning.

The mark in the prior registration is DITTOCAM (in standard characters). We consider "DITTO" to be the dominant portion of the cited registrant's mark. As was the case with applicant's mark, "DITTO" is the first part of the registered mark, and therefore "most likely to be impressed upon the mind of a purchaser and remembered." Moreover, the second part of the prior registrant's mark - CAM - is suggestive of the registrant's "broadcasting of real time *images*...." (emphasis added), inasmuch as the likely connotation of CAM in the context of the registrant's services is that of a video camera. See MERRIAM-WEBSTER DICTIONARY, www.merriam-webster.com (March 29, 2011) ("cam *noun* ... :CAMERA; *especially*: VIDEO CAMERA").

A mark registered in standard characters must be considered without regard to any particular font style, size or color in which it might be displayed. *Citigroup Inc. v. Capital City Bank Group, Inc.*, ___ F.3d ___, ___ USPQ2d ___, slip op. at 12-13 (Fed. Cir. Mar. 28, 2011).

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We therefore must consider that the prior registrant's mark could be displayed in any font style, size, or color - including the same way in which applicant displays the wording in its mark.

We thus find that DITTO is clearly the dominant feature of both marks, and that the marks are substantially similar in appearance, sound, and meaning, a factor which favors a finding of likelihood of confusion.

B. Similarity of the Services

Applicant's recited services are "video teleconferencing," while the services set out in the cited registration are "radio broadcasting services; telecommunications services, namely, broadcasting of real time images via the global computer network."

[G]oods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used or intended to be used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

In comparing the services at issue, the examining attorney overstates his case somewhat. For instance, the

examining attorney states that "it is immaterial that the '[r]egistrant broadcasts; Applicant does not.'" Ex. Att. Br. at 10 (citing App. Br. at 6). While it is true that likelihood of confusion may be found even when the services are not identical, the relationship of the services is certainly not immaterial; when services are more closely related, confusion will be found to be more likely.

Similarly, the examining attorney contends that "because of the broad wording in the registrant's identification, ... the respective services are identical in part," Ex. Att. Br. at 6, and that the registrant's services are "so broad as to encompass the applicant's services," *id.* at 7. The examining attorney apparently reaches this conclusion only because both applicant and the registrant offer types of telecommunications services, and because such services could be rendered using telephone lines. But even if this is correct, it does not establish that the services recited in the application and the registration are identical in whole or in part, only that they utilize similar technology.

Indeed, given the ordinary meaning of "broadcasting" and "teleconferencing" - aided by the dictionary evidence of record - we conclude that the services are in fact different. Teleconferencing is "the holding of a

conference among people remote from one another by means of telecommunication devices," App. Br. at 6 (quoting MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (11th ed.)), and video teleconferencing presumably adds a video component to what might otherwise be an audio-only service. While a (tele) conference may sometimes involve only one party speaking to a designated group of one or more listeners, a "conference" implies that the service at least includes ability for the parties to confer - *i.e.*, engage in a two-way exchange of information.

By contrast, broadcasting⁵ is usually understood (at least in this context) to be the one-way dissemination of information, typically to a large - and often undefined - group. This is the case with the classic radio or television broadcast: the broadcaster transmits a signal to an anonymous public to which individuals may (or may not) tune in. Unlike teleconferencing, broadcasting generally does not offer any opportunity for two-way communication.

⁵ Our focus here is on "broadcasting" as it is used in the cited registration, given the ordinary meaning of that term. We reject applicant's contention that "[r]egistrant ... utilizes its mark in conjunction with radio broadcasting services for radio shows, such as the Rush Limbaugh show, and incidental Internet video broadcasts - streaming one-way video - of the radio show." App. Br. at 7. An applicant may not restrict the scope of the services covered in the cited registration by extrinsic evidence. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). We thus consider the cited registration to cover all types of broadcasting consistent with the recitation of services.

Thus, although they are both broadly involved with the dissemination of information, teleconferencing and broadcasting are two different services.

Nonetheless, that does not end our inquiry. As the examining attorney correctly notes, the fact that the relevant services are not identical or even competitive is not in itself dispositive. The question is not whether the goods or services could be confused, but whether use of the marks in connection with the identified services "would give rise to the mistaken belief that the services come from a common source." Ex. Att. Br. at 10; See, e.g., *Online Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000) ("although the services are different, it is reasonable to believe that the general public would likely assume that the origin of the services are the same." (citing *Recot v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000))).

In this regard, the examining attorney has submitted a number of third-party use-based registrations⁶ covering both broadcasting services and video teleconferencing services

⁶ The examining attorney submitted 15 registrations. One (2995724) did not explicitly list broadcasting services of the type identified in the cited registration; two others (3477183 and 3469785) are for word and design versions of the same mark. Accordingly, for these purposes, we consider the total to be 13 registrations.

as recited in the subject application and the cited registration. Third-party registrations which individually cover a number of different items and which are based on use in commerce may serve to suggest that the listed goods are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd* (unpublished) No. 88-1444 (Fed. Cir. Nov. 14, 1988). These registrations indicate that third parties have registered the same marks for a variety of telecommunications services, including both applicant's and registrant's identified services.

Applicant complains that

many of the registrations cited by the Examiner are for marks used in connection with goods and services that run the gamut of the telecommunications class.... [Such marks] should be viewed distinctly from marks used in conjunction with individual, specialized telecommunication services, such as Applicant's and Registrant's identified services. Telecommunications companies that provide the infrastructure and connectivity required for accessing the Internet will necessarily be involved in almost all types of communication services. This is common, and even unsophisticated consumers would surely differentiate those marks utilized with such broad types of services from companies that offer specific types of communications and related services.

App. Br. at 10-11 (emphasis added). But applicant misses the point - it is precisely *because* many companies offer a broad range of telecommunications services that consumers are likely to think that such services may - when offered under similar marks - come from a common source.⁷

We therefore conclude that, although the services are not the same, they are nonetheless of a type which come from a single source, and are at times identified in use-based registrations for the same mark.

C. Channels of Trade

The examining attorney cites the channels of trade for the relevant services as a factor supporting refusal of registration. Ex. Att. Br. at 3. Nonetheless, most of the examining attorney's analysis of this issue, see ex. Att. Br. at 6-9, relates to the similarity of the services, rather than their respective channels of trade.

While it is true that in *ex parte* examination, consideration of the trade channels begins with an analysis

⁷ We do not find that the third-party registration show that "registrant's services encompass the applicant's ... services," as applicant complains that the examining attorney has done. App. Br. at 9-10. Applicant also disagrees with the examining attorney's comments (in the Final Office Action) that the involved services are within the "normal field of expansion of either party." We need not address this question because expansion of trade is an matter related to priority, which is not an issue in an *ex parte* appeal. *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 n.9 (TTAB 2007).

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of the involved services, it does not end there - it is still necessary to determine how those services are promoted and rendered in commerce. The examining attorney mistakenly assumes - because neither recitation of services includes an explicit limitation as to trade channels or classes of customers - "that the respective services do not have any limitation as to the trade channels or particular customers. Therefore, both parties may offer their services to any customer in any trade channel." Ex. Att. Br. at 12-13 (emphasis added).

The examining attorney is correct that we must determine the channels of trade by considering the identified goods or services; we will not import extrinsic limitations based on the applicant's or the registrant's actual business activities. However, the absence of explicit trade channel limitations in an application or registration does not mean that such goods or services "do not have any limitation" or that they are sold "to any customer in any trade channel." What it means is that the goods or services are presumed to be sold in any trade channel and to any class of consumer normal for such goods or services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 119 USPQ 139 (CCPA 1958)) ("it is presumed that ... the identified goods

move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers." (emphasis added). Although it follows that if the services at issue are identical, then the channels of trade and classes of customers must also be considered to be identical, *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003), that is not true when the services are not identical, as in this case.

Here, the examining attorney offers no evidence as to the normal channels of trade or normal purchasers for video teleconferencing or broadcasting services, and it is not readily apparent to us that these trade channels or groups of consumers would necessarily overlap. Indeed, applicant argues that they are "distinctly different," App. Br. at 12, but in doing so relies mostly on the differences in the services themselves, and not on the normal channels of trade or classes of purchasers for them. Again, if the services are not identical, we will not presume that the channels of trade are identical; but neither will we presume that they are entirely distinct. But in any event, it is the examining attorney's burden to show likelihood of confusion, so the failure of applicant to show entirely distinct channels of trade does not count against it.

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We conclude that the *du Pont* factor addressing the channels of trade for the identified services is neutral, or possibly leaning slightly in applicant's favor.

III. Conclusion

We have carefully considered the entire record and all of the arguments and evidence submitted by applicant and the examining attorney. As discussed, applicant's mark is similar to that of the cited registrant, and the involved services are related in that they are of a type which emanate from a common source. The factor of the relevant channels of trade for the involved services is either neutral or (to be generous) slightly in applicant's favor, but in any event, this factor does not outweigh the similarity of the marks and relationship of the services.

Although our ultimate decision may not be entirely free from doubt, "reasonable doubt as to the likelihood of confusion is resolved against the newcomer, 'for the newcomer has the opportunity of avoiding confusion, and is charged with the obligation to do so.'" *In re Mighty Leaf Tea*, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).

Decision: The refusal to register under Trademark Act § 2(d) is accordingly affirmed.