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COMMUNICATION - 1336-002 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77826338

MARK: BEREAN COMMUNICATION



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1336-002

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the trademark examining attorney's final refusal under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), refusing its mark BEREAN COMMUNICATION and design for "writing of texts" in class 41 because the mark for which registration is sought is likely, when used in connection with the services, to cause confusion with the marks shown in U.S. Registration Nos. 3118732 and 3118733 for BEREAN CHURCH OF GOD INTERNATIONAL (standard character mark) and THE BEREAN CHURCH OF GOD INTERNATIONAL and design, both for, in relevant part, "providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics" in class 41. The cited registrations are owned by a single registrant.

FACTS AND HISTORY OF THE CASE

The current application was filed on September 15, 2009. In the first office action of December 16, 2009, registration of applicant's mark was refused under Section 2(d) with regard to several registrations because, when used on or in connection with the identified goods and services, so resembles the marks in the cited registrations as to be likely to cause confusion, to cause mistake, or to deceive. Additionally, it was noted that a pending application posed as a potential bar to the registration of applicant's mark under Section 2(d). Applicant was also required to submit a substitute specimen showing proper service mark use, provide a disclaimer of the wording BEREAN COMMUNICATION, and provide a clear and accurate description of the mark.

Applicant filed a response on January 28, 2010, presenting arguments against the likelihood of confusion refusal. Applicant amended the application to seek registration under Section 1(b); consequently, the requirement for a specimen was withdrawn. Additionally, applicant provided the required disclaimer and an acceptable description of the mark.

On March 25, 2010, the examining attorney issued a Final Office Action with regard to the refusal under Section 2(d), limiting the refusal to Reg. Nos. 3118732 and 3118733 only; the refusal with regard to the remaining previously cited registrations and prior pending application was withdrawn. On August 2, 2010, applicant filed an appeal brief with the Trademark Trial and Appeal Board (hereafter "the Board") appealing the likelihood of confusion refusal under Section 2(d) of the Trademark Act.

ISSUES

The sole issue before the Board is whether there is a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d) between applicant's mark, BEREAN COMMUNICATION and design, for "writing of texts" and the cited registrant's marks, BEREAN CHURCH OF GOD INTERNATIONAL (standard character mark) and THE BEREAN CHURCH OF GOD INTERNATIONAL and design, both for "providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics."

ARGUMENTS

To determine whether there is a likelihood of confusion, a case must be analyzed in two steps. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). TMEP §§1207.01 *et seq.*

A. Applicant's Services Are Highly Related to the Services of Registrant

Applicant's services consist simply of "writing of texts." Registrant's services feature the provision of newsletters via a global computer network in the fields of

Christianity, religion, theology, spirituality, and ethics. These services are sufficiently related so that confusion as to their source is likely.

Material attached to the Final Office Action as well as the First Action demonstrates that it is common for an entity providing services similar to those of applicant to also provide the services of registrant, i.e., the publication of newsletters often accompanies the provision of writing services in the same area. That is, copies of printouts from the USPTO X-Search database, show third-party registrations of marks used in connection with the same or similar services as those of applicant and registrant in this case. Such material has probative value to the extent that it demonstrates that the services in question are of a kind that may emanate from the same source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); TMEP §1207.01(d)(iii).

Applicant's services and registrant's services are likely to be encountered by the same class of purchasers. Applicant has not identified a specific area or subject matter in which its services are provided, however, material submitted by applicant as a potential specimen, suggests that its services feature Christian areas or themes – the same subject matter featured by registrant's services. This same material also makes clear that applicant writes for different types of publications, including newsletters – the same type of goods featured by registrant's services. Applicant also has a blog (as is clear from the proposed specimen) which features a variety of topics, including religion. Thus, not only are applicant's services provided within the same area or field as the services of registrant, but they are intended for the same audience – those who read online material, including newsletters, e-zines, and blogs featuring Christian themes and subject matter.

Moreover, the sampling of registrations submitted with the First Office Action of December 16, 2009, specifically shows that it is common for a single entity to provide publishing services and writing services both featuring areas of religion and spirituality. Therefore, it may be presumed that the services of both applicant and registrant will be marketed through the same channels of trade, to the same class of purchasers.

Applicant contends that its services and those of registrant are dissimilar, claiming that the registrant's newsletters are directed to its own membership and concerned with internal communications on its own behalf, while applicant's services are directed to third parties.

First, as noted above, applicant has not provided any limitations as to its channels of trade, class of purchasers, or even subject matter of its services. Second, there is nothing in the cited registrations which limits those services to a specific group. In a likelihood of confusion analysis, the comparison of the parties' services is based on the services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see* TMEP §1207.01(a)(iii). Thus, limitations not clearly delineated in the cited registrations may not be presumed to be there – regardless of any extrinsic evidence proffered by applicant. It is presumed that applicant's services encompass all services of the type described, including those in the registrant's more specific identification, that the services move in all normal channels of trade, and that they are available to all potential customers. *See In re La Peregrina Ltd.*,

86 USPQ2d 1645, 1646 (TTAB 2008); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); TMEP §1207.01(a)(iii).

Third, as demonstrated above, applicant's services likely feature the same area as specified by registrant. Therefore, despite applicant's submission that registrant's services are restricted to a distinct channel of trade and to a specific class of purchaser separate from that of applicant, the record supports a finding to the contrary. Furthermore, there is nothing which restricts registrant from providing its services to the general public – or which prohibits applicant from providing its services to registrant's members. In fact, it must be presumed that the services of both move in all normal channels of trade and are available to all potential consumers.

In sum, evidence demonstrates that the services of applicant and registrant are highly related, *and* that the subject matter or areas of such services are the same; therefore, it follows that applicant's and registrant's services will indeed travel through the same channels of trade and be encountered by the same class of purchasers.

B. Applicant's Mark is Confusingly Similar to Registrant's Mark

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *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). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see*

TMEP §1207.01(b). Applicant's mark is confusingly similar in appearance, sound, connotation and overall commercial impression to registrant's mark.

Applicant's mark consists of the wording BEREAN COMMUNICATION with the "T" in COMMUNICATION as a cross that is surrounded by a star within a dark rectangle. One of registrant's marks consists of the wording BEREAN CHURCH OF GOD INTERNATIONAL in standard character format; the other consists of the wording THE BEREAN CHURCH OF GOD INTERNATIONAL in a circular format surrounding an open book overlying a globe with a cross over the book.

In a likelihood of confusion determination, the marks in their entireties must be considered. However, one feature of a mark may be recognized as more significant, i.e., as the portion most likely to be remembered or recognized by consumers in identifying the source of the goods or services. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *see* TMEP §1207.01(b)(viii), (c)(ii). In this instance, the term BEREAN in each mark is likely to stand out as the more obvious element of the marks. Purchasers are likely to recollect this term and view it as identifying the source of the services – and are likely to believe that the common element in the marks identifies a common source of the services. The additional elements in each mark do not sufficiently distinguish one mark from the other.

Despite the fact that the wording BEREAN COMMUNICATION has been disclaimed in applicant's mark, the term BEREAN nonetheless is most likely to be viewed as the dominant portion of that mark. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re Nat'l Data*

Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010). Purchasers are not aware of disclaimers that reside only in the records of the Office. The term BEREAN is the first literal (or, non-design) element in the mark. Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Moreover, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999).

Similarly, the term BEREAN is likely to stand out in registrant’s marks as the only non-disclaimed element in one mark, and the only non-disclaimed and non-design element in the other. It is this term which is most likely to create the overall meaning and commercial impression of each of the marks and the portion which is most likely to be remembered by purchasers when referring to the services.

Finally, it should be noted that one of registrant’s marks is in standard character format, thus giving registrant the right to use this mark in any manner it chooses – including one identical to that of applicant. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element

itself and not in any particular display. TMEP §1207.01(c)(iii); *see* 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Melville Corp.*, 18 USPQ2d 1386, 1387-88 (TTAB 1991); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988).

Accordingly, the marks are confusingly similar.

C. Applicant's Argument With Regard to The Confusing Similarity of the Marks

Applicant's primary contention is that the term BEREAN is descriptive and therefore entitled to limited protection.

First, it should be noted that there is no dispute as to the descriptiveness of the term BEREAN; the dispute is as to whether registrant's marks should be a bar to the registration of applicant's mark under Section 2(d). Applicant's argument is predicated on a collateral attack on the cited registrations; in essence, applicant contends that the existence of these registrations is inconsequential. However, Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During *ex parte* prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

Applicant submits that it is not attacking the validity of the registrations, but simply providing evidence that the term BEREAN is descriptive and therefore weak, and not entitled to prohibit the registration of other marks with this term.

In support of its contention that the term BEREAN is descriptive and therefore weak, applicant submitted nine live registrations and applications containing this term. This material simply does not evidence that the term is weak – or, even descriptive. Of those nine, seven are registered, five of which are owned by the cited registrant, the other two owned by separate entities; in none is the term BEREAN disclaimed, or the marks on the Supplemental Register or registered pursuant to Section 2(f). The remaining two are applications – including the current application, as well as another pending application in which the term BEREAN has been disclaimed.

It is unclear how the existence of seven registrations – where the term was not held descriptive – is evidence of the weakness of a term. 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* goods and/or services. *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); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Here, applicant has submitted very few registrations even showing use of this term – the majority of which are owned by the cited registrant. Additionally, with the exception of the cited registrations, none of the above referenced applications and registrations are for services which may be considered sufficiently related to the services at issue, and thus, do not show that the relevant wording is commonly used in connection with the services at issue. Consequently, the

number and nature of the marks provided fails to evidence the weakness of the term BEREAN in relation to the relevant services

In further support of its allegation that the term BEREAN is so descriptive that it must be deemed a “non-exclusive” term, i.e., deserving of limited protection, applicant cites *Christian Science Board of Directors of the First Church of Christ, Scientist v. Evan*, 2 USPQ2d 1093 (N.J. 1987). Based on an analysis of that case, applicant analogizes BEREAN to such commonly-used and understood religious affiliations as Baptist, Catholic, Jewish, etc. However, reliance on this case is misplaced. Terms such as Baptist, Catholic, Jewish, etc., are considered generic designations, overwhelmingly used and understood by the general public. There is no evidence to demonstrate that BEREAN, like CHRISTIAN SCIENCE in that case, has come even close to gaining such notoriety. The fact that the word is descriptive of the subject matter or area in which applicant’s, and perhaps registrant’s, services are provided does not lead to a foregone conclusion that this term is not deserving of protection. Applicant has provided no evidence to show that BEREAN is such a common term that it is viewed by the general public – or even the relevant purchasing public – as a generic or even highly descriptive term.

Applicant submits neither “real world” evidence, i.e., showing that BEREAN is a commonly-used term, recognized by many, nor even a dictionary definition, to support its contention that BEREAN is a term which is deserving of limited protection. Rather, in addition to the submitted registrations and applications, applicant relies on the following: 1) the Wikipedia definition supplied by the examining attorney in support of the Office’s requirement of a disclaimer of the term; 2) applicant’s agreement to the disclaimer; 3) the

fact that another applicant has agreed to disclaim the term for different services; and 4) registrant's own prosecution records. None of this is proof that consumers would not be confused by applicant's and registrant's use of the same, seemingly uncommon, though admittedly descriptive, term in connection with highly related services. Even applicant's own disclaimer of the term is not persuasive. "The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO . . . such action cannot affect the scope of protection to which *another's* mark is entitled." *In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985).

Likewise, the concessions made by registrant during the prosecution of its own trademark applications should not affect the scope of protection to which that registrant is entitled. Applicant submits that registrant itself conceded the descriptiveness of the term in the prosecution of its trademark applications and provides copies of material from those applications proceedings. Such material simply has no bearing on the case at hand. Every applicant is entitled to prosecute its application as it sees fit in an effort to obtain a registration; admissions or concessions at the time of prosecution are not evidence of a lack of confusion between that mark and a later applied-for mark. Such reasoning would severely impinge upon the rights of a party to fully advocate on behalf of itself to secure a registration.

In support of its submission of this material, applicant cites *In re National Data Corp.*, 224 USPQ2d 749 (Fed. Cir. 1985), contending that such evidence was improperly ignored by the examining attorney. A review of *In re National Data Corp.*, does not change the outcome here. In that case, there was evidence that the wording at issue was a *commonly-used* expression in the relevant industry; thus, regardless of the fact that the

wording had not been disclaimed, there was no doubt as to its descriptive significance – and public recognition of the wording. Here, *there is no such evidence*. There is nothing which demonstrates that the purchasing public has been conditioned to view the term BEREAN as part of “ordinary descriptive speech.” *Id.* at 752. As noted previously, applicant has not even provided a dictionary definition of the term. Additionally, it should be noted that even in that case, where the court acknowledged the descriptiveness of the marks, the likelihood of confusion finding was affirmed.

Finally, applicant asserts that a mark with a “weak” portion is entitled to a narrow scope of protection. Again, there simply is no evidence that this term – even if descriptive – is weak. And, even if it were, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

Thus, regardless of the potential descriptiveness of the term BEREAN, registrant’s marks are entitled to protection against applicant’s use of a confusingly similar mark for highly related services.

CONCLUSION

Applicant's services are highly related to the services of registrant so that such services are likely to be marketed through the same channels of trade and encountered by the same class of purchasers. The dominant portion of the marks is identical; and, regardless of the descriptiveness of the term BEREAN, this common element in the marks, is likely to confuse purchasers into mistakenly believing that the services come from a single source.

Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register applicant's mark under Section 2(d) of the Trademark Act.

Respectfully submitted,

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