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

Proceeding	78832702
Applicant	Allegro Multimedia, Inc.
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Date	01/28/2008

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

In re Allegro Multimedia, Inc.

Serial No. 78832702

Filed: 3/8/06

Mark: Wizard Tunes

**REPLY BRIEF IN SUPPORT OF
APPLICANT'S APPEAL BRIEF**

I. INTRODUCTION

Applicant Allegro Multimedia, Inc. has requested registration for the mark WIZARD TUNES for use as an on-line retail store services featuring downloadable pre-recorded music and video. The Examining Attorney, over the objection of Applicant's counsel, denied the registration due to the existence of the mark THE WIZ, which is registered for use as a retail store featuring audio and visual equipment, consumer electronics, computers, CD's, DVD's and appliances. The Examining Attorney's Appeal Brief presents no legitimate basis for the denial of registration, in light of Applicant's showing that there is no likelihood of confusion between Applicant's mark and the mark of THE WIZ, a non-objecting party to these proceedings.

**II. APPLICANT'S MARK "WIZARD TUNES" CAUSES NO LIKELIHOOD OF
CONFUSION WITH THE MARK "THE WIZ"**

There is no mechanical test for determining likelihood of confusion. TMEP 1207.01. The issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Each case must be decided on its own facts. TMEP 1207.01.

The Examining Attorney's argument against registration of Applicant's mark is premised on (1) her belief that the term "Wiz" is similar enough to the term "Wizard" to cause a likelihood of confusion, and (2) her disregard of the word "tunes".

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. TMEP 1207.01(b)(i); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Similarity of the marks in one respect – sight, sound or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987). When viewed as a whole, as the marks must be, WIZARD TUNES is substantially different from THE WIZ, and not likely to cause confusion for an ordinary consumer.

A. The Word Marks Are Not Similar

Without justification for doing so, the Examining Attorney has requested that the Board make the leap that "wiz" and "wizard" are in fact the same word. Although it is true that the first *syllable* of "wizard" is the same as the *entirety* of the word "wiz", this cannot mean, in and of itself, that the words are interchangeable. The Examining Attorney's attempt to mislead the Board by making the statement that "WIZ/WIZARD" is the same "term" should not cause the Board to mistakenly believe that these two separate words are indeed the same.

Historically, the USPTO has indicated (with regards to THE WIZ mark in particular) that "the term 'WIZ' [] is strong (as the dominant, memorable word in a famous musical comedy title. . . The word "WIZ" is famous because of the musical, not necessarily because of applicant's stores. At any rate the word "WIZ" is recognizable by

most of the American consuming public. The fame of the word makes it stand out.” (See Office Action dated September 28, 1993 in Serial number 74801816 for the Mark The Wiz, at pages 3 and 4, attached as Exhibit “A”). It is evident from this examination of THE WIZ mark that upon its initial application, that examining attorney believed that THE WIZ would conjure up in the minds of the public, the musical. Yet, in this case, the current Examining Attorney scoffs at that suggestion, stating, “applicant’s argument that registrant’s mark may refer to the children’s classic book and movie, *The Wizard of Oz*, and the similarly themed musical, *The Wiz*, is a stretch, at best.”

Exceptions to the general rule regarding additions or deletions to what may otherwise be similar marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with “CATFISH” disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH’S GOLD’N CRUST and design (with “GOLD’N CRUST” disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Applicant’s mark “WIZARD TUNES” is decidedly different from registrant’s mark “THE WIZ”. When viewed in its entirety, the fact that the first word of applicant’s mark contains a portion of the second word of registrant’s mark cannot possibly justify a determination of similarity between the two marks. Although the word “tunes” has been disclaimed as descriptive, it still may be reviewed for the purposes of any allegations of a

likelihood of confusion. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). As such, applicant's mark contains a distinguishing word – "TUNES" – which sets it even further apart from registrant's simple mark "THE WIZ".

When assessing the likelihood of confusion between compound word marks, one must determine whether there is a portion of the word mark that is dominant in terms of creating a commercial impression. TMEP 1207.01(b)(viii). Applicant's mark conveys the commercial impression of a store that provides excellent or otherworldly music products. THE WIZ mark, however, does not convey any particular commercial impression. If anything, THE WIZ mark conveys a commercial impression of simple accomplishment. It is not likely that the average consumer would see the mark WIZARD TUNES and confuse it with a mark that is as removed from it as THE WIZ. When spoken, the mark WIZARD TUNES comes out much differently than THE WIZ. No exercise is needed for a consumer to notice the differences when vocalizing Applicant's mark and THE WIZ. To a consumer, the relationship between the two marks would likely not rise to the level of acknowledgement; if it did, it would be a tenuous connection, at best. Applicant's mark WIZARD TUNES conveys a significantly different meaning and commercial impression than THE WIZ mark, and, as such, there is no likelihood of confusion.

B. The Marks Identify Distinct Retail Services.

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. See, e.g., *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811

F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

Under its mark THE WIZ, registrant sells pre-recorded movies and music in the form of CDs and DVDs. Under its mark WIZARD TUNES, applicant will be selling pre-recorded videos and music in the form of *downloadable files from a computer*. The two mediums are distinct. To purchase an item from THE WIZ, the consumer can go to a physical brick-and-mortar store and pick out the CD or DVD they want. To then utilize the items purchased from THE WIZ, a consumer must place the CD in a CD player or the DVD in a DVD player. No computer is required for either item. To purchase any item from WIZARD TUNES, however, the consumer necessarily must first visit the website, on a computer. From there, the consumer will choose the pre-recorded music or movie to download directly onto their computer from the WIZARD TUNES website.

THE WIZ specifically identifies its goods to be sold through “retail stores”, whereas WIZARD TUNES identifies its sales to be done specifically through “on-line retail stores”. Whereas the trade channels for retail stores and on-line retail stores may overlap as a general principle; when, as here, THE WIZ brick-and-mortar retail store *does not sell the same goods* as WIZARD TUNES’s on-line retail store, there is no likelihood of confusion between the two marks. Someone who wants to purchase a physical CD with prerecorded music on it will not visit the iTunes website. Conversely, someone who wishes to download prerecorded music to their computer will not visit Barnes & Noble’s website.

It should be noted that in the specimens submitted by THE WIZ in support of its application for renewal of the mark, despite listing over sixty-five categories of items that are sold or otherwise shown on their website, prerecorded movies and music *are nowhere to be found*. See Specimens dated May 6, 2005 for Serial No. 74801816.

III. CONCLUSION

For a likelihood of confusion analysis, the issue is whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). The average purchaser, when presented with the option of purchasing a CD or DVD at THE WIZ or downloading music or movies from WIZARD TUNES, will not encounter confusion between the two marks. Based on the complete lack of confusion between applicant's mark and registrant's mark, applicant respectfully requests that the decision of the Examining Attorney be reversed and that the mark WIZARD TUNES be allowed registration on the Principal Register.

DATED this 28th day of January, 2008.

JABURG & WILK, P.C.

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I hereby certify that the Reply Brief was filed electronically via ESTTA on this 28th day of January, 2008.

/Debra Gower/

EXHIBIT A



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

74801816

SERIAL NO.

APPLICANT

Wiz, Inc., The

MARK

PAPER NO.

ADDRESS

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

If no fees are enclosed, the address should
include the words "BOX 5."

THE WIZ
ADDRESS

ACTION NO.

02

MAILING DATE

09/28/93

REF. NO.

WIZ-10.0-009

Please provide in all correspondence:

1. Filing date, serial number, mark, and applicant's name.
2. Mailing date of this Office action.
3. Your telephone number and ZIP code.
4. Examining attorney's name and law office number.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

This letter responds to applicant's communication filed on August 25, 1993.

I. IDENTIFICATION OF GOODS

Applicant's amendments to the identification of goods have been received and entered. However, there are yet many incorrectly worded items and many mis-classified items. The faultily worded items are as follows:

- key chains not of precious metal, Class 6
- key chains of plastic, Class 20
- money clips of precious metal, Class 14
(money clips not of precious metal, Class 6)
- children's toys NAMELY toy trucks, toy cards and dolls
- stereo receivers or amplifiers or tuners not "equipment" in Class 9.

Applicant is hereby required to submit a clean copy of the entire identification of goods, corrected as follows:

In Class 6: money clips not of precious metal; key chains not of precious metal;

74801816

In Class 7: kitchen appliances, namely dishwashers, blenders, electric can openers, food processors, electric knives, electric mixers, garbage disposals and trash compactors, clothes washing machines;

In Class 9: consumer electronic equipment namely stereo receivers and/or amplifiers and/or tuners, computer hardware, computer software, computer peripherals, radios, television sets, calculators, facsimile machines and telephones, cameras, videotape, audiotape, tape measure;

In Class 11: clothes dryers, microwave ovens, refrigerators, freezers, refrigerator-freezers, electric toasters, domestic cooking ovens, toaster ovens, convection ovens, electric stoves;

In Class 14: tie clips, money clips of precious metal, watches, pins;

In Class 16: pens, pencils, note pads, paper weights, memo pads, calendars, desk organizers, bumper stickers;

In Class 18: plastic and textile shopping bags;

In Class 20: plastic key chains;

In Class 21: cups, mugs;

In Class 25: hats, T-shirts, sweatshirts, socks, jackets, running suits, footwear;

In Class 26: patches for clothing;

In Class 28: children's toys, namely flying toy discs, toy cars and trucks, dolls;

In Class 42: retail store services in the fields of consumer electronics and accessories, computer hardware and software, pre-recorded movies and music and household appliances.

The requirement for a properly worded properly classified identification of goods is hereby made final.

Applicant, by listing "clothing patches" which are classified in Class 26 and "plastic key chains" which are in Class 20 has added two classes of goods to its application. Applicant must either delete these goods or add a class to the application. (One added class is all right because Class 19 goods were deleted.)

If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

74801816

(1) The applicant must list the goods and services by international class with the classes listed in ascending numerical order. TMEP section 1113.01.

(2) The applicant must submit a filing fee for each international class of goods and services not covered by the fee already paid; the filing fee is \$210.00 per class. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01.

II. HISTORY OF THE APPLICATION

Applicant's mark "THE WIZ" was refused registration under Section 2(d) of the Trademark Act in Classes 14, 16 and 25 because of the likelihood of its confusion with registrant's mark "BOOM BOOM WIZ" for goods in Classes 14, 16 and 25. Applicant has argued that the marks are not confusingly similar because: 1) "WIZ" is not the dominant word in the cited registration, "BOOM BOOM" is dominant because it comes first, has a repetitive sound and the two words together are longer than "WIZ"; 2) the channels of trade differ because applicant's products are "house brands" sold only in applicant's stores; 3) applicant's stores do not carry registrant's goods, i.e. jewelry, paper goods and clothing. The examining attorney has read applicant's arguments with care but remains unpersuaded.

III. LIKELIHOOD OF CONFUSION

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), cert. denied, 351 U.S. 973, 109 USPQ 517 (1956).

A. The Similarities of the Marks

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling and Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

In this case the marks share the term "WIZ" which is strong (as the dominant, memorable word in a famous musical comedy title) and

74801816

arbitrary for the goods. The word "WIZ" is famous because of the musical, not necessarily because of applicant's stores. At any rate the word "WIZ" is recognizable by most of the American consuming public. The fame of the word makes it stand out. The term "BOOM BOOM" is also strong but not famous and, in the context of a trademark for jewelry, paper goods and clothing, not meaningful, not connotative. Therefore the strong term in both applicant and registrant's mark is "WIZ." In both marks it appears the same way, sounds the same, means the same thing and creates the same commercial impression. Thus it fulfills all four elements of appearance, sound, meaning and connotation while only one element is necessary to a likelihood-of-confusion finding.

As to the inclusion of the term "BOOM BOOM" in registrant's mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.) cert. denied, 351 U.S. 973, 109 USPQ 517 (1956).

B. Relatedness of the Goods

The goods at issue, jewelry in Class 14, paper goods in Class 16 and clothing in Class 25, are identical for both parties.

If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Since the identification of the applicant's goods is very broad, it is presumed that the application encompasses all goods of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available for all potential customers.

In this case, the parties use their marks for jewelry, paper goods and clothing. Each of these classes of goods are sold in the same types of stores or departments to the same classes of buyer. Applicant says its goods will only be sold in its stores. Then it says that registrant's categories of goods are not sold in its stores. This is contradictory because applicant's kinds of goods and registrant's kinds of goods are the same. However, applicant's identification of goods does not limit its channels of trade to its own stores. Even if the identification of goods did

74801816

limit marketing thus, it would not prevent registrant from selling its identical goods in similar stores.

IV. CONCLUSION

Accordingly, for the reasons stated above, the refusal under Section 2(d) of the Trademark Act is hereby made final.

Please note that the only appropriate responses to a final refusal are either: (1) compliance with the outstanding requirements, if feasible or (2) filing of an appeal to the Trademark Trial and Appeal Board. If the Applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.64(a).



JCA:jec

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