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Sent: 1/8/2008 1:27:49 PM

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Subject: TRADEMARK APPLICATION NO. 78832702 - WIZARD TUNES - N/A

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/832702

**MARK:** WIZARD TUNES



**CORRESPONDENT ADDRESS:**

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**APPLICANT:** Allegro Multimedia, Inc.

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's refusal to register the service mark

WIZARD TUNES on the ground that it is likely to cause confusion with cited Registration No.

1,893,461 within the meaning of Section 2(d) of the Trademark Act, 15 USC 1052(d).

**FACTS**

Applicant, Allegro Multimedia, Inc., filed an intent to use application under Section 1(b) of the

trademark statute for registration of the standard character mark WIZARD TUNES, to designate

on-line retail store services featuring downloadable prerecorded music and video.

The examining attorney refused registration under Section 2(d) of the Trademark Act on the

basis of likelihood of confusion, citing Registration No. 1,893,461 for the typed mark THE WIZ

for retail store services in the fields of consumer electronics and accessories, computer hardware

and software, **prerecorded music and movies** and household appliances. (Bold type added for

emphasis. Registration No. 1,204,052 from the same owner also was cited initially but later

dropped as a bar to registration.) Extracts from on-line dictionaries were attached as evidence of

the meanings of the terms “wiz” and “tune”.

In its response, applicant disclaimed “tunes” and referenced, without attaching any evidence,

Google and X-search research regarding “wiz” and “wizard”.

The final refusal includes additional evidence from on-line dictionaries regarding the overlap of

meaning between the terms “wiz” and “wizard”. It also contains materials showing that Borders

(Group) and Barnes & Noble sell prerecorded music and movies both on-line and in physical retail

stores. Another article discusses changes in the registrant’s updated outlets.

Applicant’s request for reconsideration included a listing of its other “wizard” applications.

The final refusal of registration was maintained and the application returned to the Board for

resumption of the appeal process.

## ARGUMENT

**APPLICANT’S MARK IS LIKELY TO CAUSE CONFUSION WITH THE CITED REGISTRATION.**

A. The marks feature equivalent terminology.

Applicant's mark consists of the wording WIZARD TUNES, while the cited registration is for

THE WIZ. Since the definite article "the" does not function to indicate source but only is a term of

reference, the first syllable of each mark, in actuality, is the same, "wiz". *In re The Place, Inc.*, 76

USPQ2d 1467 (TTAB, 2005); *In re The Computer Store, Inc.*, 211 USPQ 72 (TTAB, 1981).

Precedent holds that the presence of a "strong distinctive term (here, WIZ/WIZARD) as the first

word in both parties' marks renders the marks similar, especially in light of the (non-source

identifying) significance of the (disclaimed) word ("tunes")". *Palm Bay Imports, Inc. v. Veuve*

*Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689 (CAFC, 2005). TMEP

1207.01(b)(iii).

The dictionary evidence of record reinforces this similarity, since it establishes that "wiz" and

"wizard" share meanings and that "wiz" is an abbreviation of "wizard". Both terms refer to an

individual who is exceptionally gifted or skilled, for example a financial or computer wiz or

wizard. (TICRS, Outgoing, July 16, 2006, pp. 5 – 7 and February 8, 2007, pp. 2 – 3.)

Contrary to applicant's assertions, the facts at issue do not fall within either of the exceptions to

the above illustrated general rule that likelihood of confusion is not avoided between otherwise

confusingly similar marks merely by adding matter that is descriptive of the named goods or

services. TMEP 1207.01(b)(iii). First, the marks do not convey significantly different commercial

impressions. Specifically, 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. If true, applicant's mark is equally likely to possess the same meaning. In fact, neither

party's services mention or are limited to children's fare. At the conclusion of its argument,

applicant tacitly admits that the marks have similar meanings, both referring to high quality

services. (Brief, pp. 5 – 6.)

Even the definition of "wizard" as a magician or sorcerer is related to "wiz" in the sense that the

former makes the apparently impossible look easy, like a wiz. An example of such usage is: He's a

magician at music – performing tunes and songs.

The second exception to the general rule also is inapplicable here, since the matter common to

both marks, "wiz", is the source-distinguishing portion of each mark, not being merely descriptive

of either's services.

As applicant states in its argument: "In the marketplace, a consumer will not likely engage in a

drawn-out analysis of the etymology of the words". (Brief, p. 4.) Therefore, potential customers

are unlikely to count syllables or perform other similar linguistic exercises. For example, a

shopper is likely to become confused and recall the marks as THE WIZARD or WIZ TUNES.

In short, the marks at issue are related in appearance, sound and meaning, especially within the

context of these similar enterprises.

B. The marks at issue identify related retail services.

Applicant will provide on-line retail store services featuring downloadable prerecorded music

and video. The registrant also has retail store services in the field of prerecorded music and

movies, in addition to consumer electronics and household appliances. In other words, both parties

provide retail outlet services for music and moving pictures/videos produced by others. In

focusing on the other goods sold by registrant, applicant conveniently ignores the evidence that

“music and movies occupy the middle of the store...” (TICRS, Outgoing, February 8, 2007, p. 5.)

As demonstrated by the Borders and Barnes & Noble evidence, it is common for a single entity

to sell prerecorded music and movies both on-line and in “brick and mortar” establishments.

(TICRS, Outgoing, February 8, 2007, pp. 8 – 9.) Members of the general public, most of whom

are increasingly tech savvy, due to their computerized work environment, education and leisure

pursuits, such as blogs and interactive games, are likely to use both methods of shopping,

depending on whim. In other words, each customer decides, before each expenditure, whether to

mingle with others at malls or order on-line from the comfort of home or during a break at work.

This is analogous to the decision whether to shop via mail order catalogue or in the physical store.

Due to the overlap of these retail trade channels, in terms of consumer base, offerings and source

unity, a potential customer is likely to think that applicant and registrant are related or the same

entity.

In contrast, applicant has provided no evidence, only argument, that the customers for its and

registrant's services are sharply different. Even assuming this is true, applicant's customers,

nonetheless, are likely to frequent Best Buy or the registrant for gifts. Moreover, a given

individual uses a computer to purchase music or movies, whether delivered on-line or several days

later. As reflected in other evidence, a person may choose to listen to music on CDs at home, due

to better sound quality, but will compromise and order downloadable music for convenience while

traveling or commuting. (TICRS, Outgoing, February 8, 2007, p. 7.) In other words, the current

marketplace offers multiple ways to purchase the same content in varying media and format.

The customers for both party's services are the general public, not sophisticated purchasers.

Moreover, prerecorded movies and music are relatively inexpensive items, bought on impulse and

in quantity. Under these circumstances, the likelihood of confusion as to source increases. TMEP

1207.01(d)(vii).

Applicant's services fall within the registrant's normal field of expansion.  
Registrant's chain of

stores apparently was purchased by Cablevision Systems which operates a "family of  
entertainment

and media businesses". (TICRS, Outgoing, February 8, 2007, pp. 4 – 6.) One of  
registrant's

executives stated that THE WIZ "brings together all our brands and services and puts a  
personal

face to our company". In addition to being a cable television operator, Cablevision owns  
Madison

Square Garden, its sports teams, Radio City Music Hall, the Rockettes, a chain of movie  
theaters,

and a high-speed Internet service. Another executive dubbed THE WIZ a "connectivity  
store".

The article deemed THE WIZ's position unique, because Cablevision "owns the pipe".  
Registrant

also has a web site, Thewiz.com. It certainly seems within the reach and capability of  
Cablevision,

with all of its entertainment and media endeavors, to sell downloadable music and movies  
through

THE WIZ and its associated web site.

A trademark owner is entitled to protection against the registration of a similar mark  
on

products or services that might reasonably be expected to be produced by him in the  
normal

expansion of his business. TMEP 1207.01(a)(v).

As shown above, the services of applicant and registrant are so related that the same  
people are

likely to encounter their respective marketing under circumstances that would create the mistaken

belief that they originate from the same source. *On-line Careline Inc. v. America Online Inc.*, 56

USPQ2d 1471 (CAFC, 2000).

#### CONCLUSION

Because of the cumulative similarities of the services, their field, and the appearance, sound,

and meaning of the marks, the refusal to register on the basis of Section 2(d) of the Trademark Act,

15 USC 1052(d), should be upheld.

Respectfully submitted,

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