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

Proceeding	78980002
Applicant	Kuvata, Inc.
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Date	03/16/2009

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

Applicant: Kuvata, Inc.

Serial No. 78/980002

Filed: April 19, 2005

Mark: MEDIACAST in International Class 009

Examining TM Attorney: Steven Jackson, Law Office 107

Docket No.: 1271-002D1

Date: March 16, 2009

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**APPLICANT'S REPLY BRIEF**

In accordance with 1203.02(c), Applicant respectfully submits the following reply brief in supports of its application for MEDIACAST, Serial No. 78/980,002, and in opposition to the Examining Attorney's final refusal under Trademark Act Section 2(d), 15 U.S.C. 1052(d) to register the above-referenced mark.

**I. Introduction**

The Examining Attorney argues that the use of the MEDIACAST mark on the following goods:

Computer Programs For Delivering And Displaying Audiovisual Content For Others, Database Management, Operating Systems, User Interfaces, Electronic Mail, Network Browsing, Presentations, And Entertainment, Namely, Video On Demand, Audiovisual Content On Demand, Music On Demand, And Text And Graphics On Demand In The Fields Of Business, Entertainment, Scientific, Technical, Commercial, Educational, Media Presentation, And Personal Computing, And Instructional Manuals Distributed Therewith in International Class 009

is likely to be confused with the use of MEDIACAST for services in connection with “electronic, electric, and digital transmission of voice, data, images, signals, and messages” in International Class 038 as cited in Registration No. 3,200,346 (the ‘346 Registration). In making this argument, the Examining Argument gives insufficient weight to the limited protection afforded the MEDIACAST mark, the differences in the Applicant’s *goods* as opposed to the Registrant’s *services*, and the sophistication and identity of the consumers of both. Contrary to the Examining Attorney’s conclusion, a proper analysis of the case shows that when all of these factors are properly weighed, there is no likelihood of confusion.

**II. The Nature Of The MEDIACAST Mark Is A Highly Relevant Factor Which Impacts Its Scope Of Limited Protection**

The Examining Attorney lightly dismisses Applicant’s argument regarding the strength of the MEDIACAST mark, claiming that such an argument “suggests that the registrant’s mark should be diluted and afforded no protection of a registered mark.” See Examining Attorney’s Brief, Part I<sup>1</sup>. In doing so, the Examining Attorney respectfully chooses to ignore long-standing law that the strength of a mark can vary whether or not the mark is registered. Indeed, a registered mark can be arbitrary, suggestive, or descriptive, and its categorization can greatly affect a likelihood of confusion analysis. See, e.g., In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992) (because of the suggestive nature of the mark GRAND PRIX, there was no likelihood of confusion between the use of the mark on automobiles and automobile replacement parts).

Moreover, the Examining Attorney wrongly states that because Applicant has not submitted evidence of third party registrations for MEDIACAST on the same or similar goods and services, the MEDIACAST mark must be arbitrary and entitled to a broad scope of

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<sup>1</sup> Applicant notes that the Examining Attorney’s Brief does not include page numbers and therefore Applicant is unable to cite to particular page of the Brief containing this statement.

protection. See Examining Attorney’s Brief, Part I. First, Applicant *has* submitted evidence of other third party registrations using the terms MEDIA and CAST, and one other pending application for MEDIACAST on services so similar to the goods in the subject application that it has been suspended pending the outcome of this appeal. See Applicant’s Appeal Brief, p. 9-10 and Exhibit B. Second, the absence of third party use of a mark on similar goods and services *does not* preclude a finding that the mark is highly suggestive. See Centraz Indus. v. Spartan Chem. Co., 77 USPQ2d 1698, 1701-02 (TTAB 2005) (even absent evidence of third party use, mark found to be highly suggestive); see also TMEP 1209.01(a) (“Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services.”).

The MEDIACAST mark suggests the transmittal, i.e. “casting”, of media. More specifically, “media” is the plural of medium, which is defined as “a means of effecting or conveying something.” See Exhibit C.<sup>2</sup> Additionally, the term “cast” is defined as “to cause to move or send forth by throwing.” Id. Indeed, when a child learns how to fish, an important aspect is that they properly “cast” their line to actually achieve the objective of catching a fish. Therefore, any use of the term MEDIACAST as a trademark is necessarily going to be made in connection with goods or services that serve to send or “cast” media in some way. See The Dracket Co. v. Kohnstamm & Co., Inc., 160 USPQ 407, 408 (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.”). The Board must accordingly consider the limited protection afforded the MEDIACAST mark when evaluating whether a likelihood of confusion exists in this case.

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<sup>2</sup> Applicant notes that these definitions were not made of record below, but that the Board may take judicial notice of them. See Univ. of Notre Dame de Lac v. J.C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), aff’d, 217 USPW 505 (Fed. Cir. 1983).

### **III. The Registrant's Services Are Different Than the Applicant's Goods**

The Board must review the parties' goods and services as they are cited in the registration and the application. TMEP 1207.01(a)(iii) ("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 also Hewlett-Packard Co. v. Packard Press Inc., 62 USPQ2d 1001 (Fed. Cir. 2002). The '346 Registration clearly covers *services* related to "electronic, electric, and digital transmission of voice, data, images, signals, and messages." By this language precisely, the '346 Registration does not cover *goods* or tangible products, such as a piece of software or other computer peripheral used to electronically transmit voice, data, images, signals, and message. By the same token, it does not cover *computer programs* used to electronically transmit voice, data, images, signals, and messages. Conversely, the Applicant's *goods* are computer programs. These programs have to be purchased by the consumer and are then used to deliver and display media such as e-mail and video-on-demand. See Information Resources, Inc. v. X\*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1998) (noting marked differences between opposer's specialized computer programs and applicant's services transmitting news and general information to home and business computers because the software provided to the applicant's consumers by the applicant is incidental to the service and has no value apart therefrom).

The Examining Attorney argues that because the Applicant's computer programs can be used for "electronically transmitting and displaying voice, data, images, signals, and messages," confusion is likely. See Examining Attorney's Brief, Part II. Quite frankly, the Examining Attorney's interpretation of the services cited in the '346 Registration is untenably broad and arguably stretch TMEP 1207.01(a)(iii) beyond its own limits. According to the Examining Attorney's interpretation, the use MEDIACAST for a telephone, a radio, a television – indeed

*anything* that electronically transmits data -- would be barred by the '346 Registration because it could be used to transmit voice or signals. Presumably, this will include any future mode or medium to "cast" such a "media" in the future regardless of how it actually operates, what it really is, and how it is sold. Under the same rationale, the use of the same mark for an oven and a bakery would be prohibited because an oven could be used to bake bread or any other type of food product in existence simply because the product may be "comestible". The Examining Attorney is clearly stretching the interpretation of the goods in the '346 Registration to preclude the use of the mark on goods and services that are in reality quite unrelated. See Information Resources, Inc., 6 USPQ2d at 1038 (no likelihood of confusion even though opposer's product may be used to access the computer data bases of information and data retrieval services, which compete with applicant's service).

**IV. The Channels of Trade and Sophistication of Purchasers Make Confusion Even Less Likely**

The Examining Attorney all but admits that consumers of the Registrant's services and the Applicant's goods are sophisticated and would take great care in the applicable purchasing decision. See Examining Attorney's Brief, Part II. Rather, the Examining Attorney simply concludes that even if relevant purchasers are sophisticated, they may not be sophisticated in the field of trademark law or be immune from confusion. However, the channels of trade and sophistication of purchaser inquiry does not require the relevant purchaser to simultaneously be knowledgeable about the nuances of the Lanham Act of 1946, but simply knowledgeable about their particular area of goods and services, which in this case are both highly-technical and expensive. It is therefore undisputed that consumers of both the Registrant's services and the Applicant's goods are sophisticated in the fields in which they will encounter the Applicant's goods and the Registrant's services. Both the goods and services are expensive and highly

specialized products and services. In the case of the Applicant's goods, the programs are selected, downloaded, and implemented by consumers with specific technical expertise looking for a very specific function. Likewise, in the case of Registrant's services, the services are likely selected and employed by consumers with similar technical expertise looking to remotely control digital signage. This technical expertise needed and the time spent selecting the Applicant's goods and the Registrant's services are enhanced by the relatively high cost of such goods and services. Additionally, consumers of Registrant's services are also likely to have spent significant resources to obtain a vast network of digital signs for which Registrant's services would be needed, increasing the level of scrutiny applied in selecting the Registrant's services.

Moreover, based on the differences in the goods and services offered by the Registrant and the Applicant, consumers of the Registrant's services are not necessarily likely to be the same as consumers of the Applicant's goods. That is, consumers of Registrant's services are looking for a way to remotely control a network of digital signage, and thus Registrant's services are targeted to such businesses and relevant purchasers, skilled in this area. Registrant's goods, on the other hand, are targeted to those consumers looking for computer programs to transmit and display email, video, etc. on their computers. There is no inherent overlap in these two sets of consumers. Therefore, given the difference in the consumers and their levels of sophistication, confusion is very unlikely.

**V. Conclusion**

For all the above reasons, Applicant respectfully requests that the Board reverse the refusal of the Examining Attorney and allow the mark to pass publication.

Respectfully submitted,

Date: March 16, 2009

By: Jeffrey P. Thennisch/  
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# EXHIBIT C



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## cast

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**Main Entry:** **'cast**   
**Pronunciation:** \ˈkɑst\  
**Function:** *verb*  
**Inflected Form(s):** **cast; cast-ing**  
**Etymology:** Middle English, from Old Norse *kasta*; akin to Old Norse *kǫs* heap  
**Date:** 13th century

*transitive verb*

**1 a :** to cause to move or send forth by throwing <*cast a fishing lure*> <*cast dice*>  
**b :** [DIRECT](#) <*cast a glance*> **c (1) :** to put forth <the fire *casts* a warm glow> <*cast light on the subject*> (2) : to place as if by throwing <*cast doubt on their reliability*> **d :** to deposit (a ballot) formally **e (1) :** to throw off or away <the horse *cast* a shoe> (2) : to get rid of : [DISCARD](#) <*cast off all restraint*> (3) : [SHED](#) , [MOLT](#) (4) : to bring forth ; *especially* : to give birth to prematurely **f :** to throw to the ground especially in wrestling **g :** to build by throwing up earth  
**2 a (1) :** to perform arithmetical operations on : [ADD](#) (2) : to calculate by means of astrology **b archaic :** [DECIDE](#) , [INTEND](#)  
**3 a :** to dispose or arrange into parts or into a suitable form or order **b (1) :** to assign the parts of (a dramatic production) to actors <*cast a movie*> (2) : to assign (as an actor) to a role or part <*was cast in the leading role*>  
**4 a :** to give a shape to (a substance) by pouring in liquid or plastic form into a mold and letting harden without pressure <*cast steel*> **b :** to form by this process  
**5 :** [TURN](#) <*cast the scale slightly*>  
**6 :** to make (a knot or stitch) by looping or catching up  
**7 :** [TWIST](#) , [WARP](#) <a beam *cast* by age>

*intransitive verb*

**1 :** to throw something ; *specifically* : to throw out a lure with a fishing rod  
**2 dialect British :** [VOMIT](#)  
**3 dialect English :** to bear fruit : [YIELD](#)  
**4 a :** to perform addition **b obsolete :** [ESTIMATE](#) , [CONJECTURE](#)  
**5 :** [WARP](#)  
**6 :** to range over land in search of a trail —used of hunting dogs or trackers  
**7 :** [VEER](#)

**synonyms** see [DISCARD](#) , [THROW](#)  
 — **cast-abil-i-ty**  \ˌkɑs-tə-ˈbi-lə-tē\ *noun*  
 — **cast-able**  \ˌkɑs-tə-bəl\ *adjective*  
 — **cast lots** : to draw lots to determine a matter by chance

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- 1 **media** (noun)
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- 1 **medium** (noun)

**Main Entry:** <sup>2</sup>**media**  
**Function:** *noun*  
**Inflected Form(s):** *plural me-di-as*  
**Usage:** *often attributive*  
**Etymology:** plural of *medium*  
**Date:** 1923

**1** : a medium of cultivation, conveyance, or expression ; *especially* : **MEDIUM** **2b**  
**2 a** *singular or plural in construction* : **MASS MEDIA** **b plural** : members of the mass media

**usage** The singular *media* and its plural *medias* seem to have originated in the field of advertising over 70 years ago; they are apparently still so used without stigma in that specialized field. In most other applications *media* is used as a plural of *medium*. The great popularity of the word in references to the agencies of mass communication is leading to the formation of a mass noun, construed as a singular <there's no basis for it. You know, the news *media* gets on to something — Edwin Meese 3d> <the *media* is less interested in the party's policies — James Lewis, *Guardian Weekly*>. This use is not as well established as the mass-noun use of *data* and is likely to incur criticism especially in writing.

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- 2 **medium** (adjective)
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- medium frequency**

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Main Entry: **'me-di-um** 

Pronunciation: \mē-dē-əm\

Function: *noun*

Inflected Form(s): *plural mediums or me-dia*  \-dē-ə\

Etymology: Latin, from neuter of *medius* middle — more at [MID](#)

Date: 1593

- 1 a** : something in a middle position **b** : a middle condition or degree : [MEAN](#)
- 2** : a means of effecting or conveying something: as **a** (1) : a substance regarded as the means of transmission of a force or effect (2) : a surrounding or enveloping substance (3) : the tenuous material (as gas and dust) in space that exists outside large agglomerations of matter (as stars) <interstellar *medium*> **b plural usually media** (1) : a channel or system of communication, information, or entertainment — compare [MASS MEDIUM](#) (2) : a publication or broadcast that carries advertising (3) : a mode of artistic expression or communication (4) : something (as a magnetic disk) on which information may be stored **c** : [GO-BETWEEN](#) , [INTERMEDIARY](#) **d plural mediums** : an individual held to be a channel of communication between the earthly world and a world of spirits **e** : material or technical means of artistic expression
- 3 a** : a condition or environment in which something may function or flourish **b plural media** (1) : a nutrient system for the artificial cultivation of cells or organisms and especially bacteria (2) : a fluid or solid in which organic structures are placed (as for preservation or mounting) **c** : a liquid with which pigment is mixed by a painter

**usage** see [MEDIA](#)

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