

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
April 13, 2009
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kuvata, Inc.

Serial No. 78980002

Jeffrey P. Thennisch of Dobrusin & Thennisch PC for Kuvata,
Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Kuvata, Inc. seeks registration on the Principal
Register of the mark **MEDIACAST** (*in standard character
format*) for goods identified in the application, as amended,
as follows:

"computer programs for delivering and
displaying audiovisual content for others,
database management, operating systems,
user interfaces, electronic mail, network
browsing, and presentations, namely, video
on demand, audiovisual content on demand,
music on demand, and text and graphics on
demand in the fields of business,

scientific, technical, commercial, educational, and personal computing, and instructional manuals distributed therewith" in International Class 9.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified goods, so resembles the mark **MediaCast** (*in standard character format*) for "electronic, electric, and digital transmission of voice, data, images, signals, and messages"² in International Class 38, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the case.

We affirm the refusal to register.

In urging registrability, applicant argues that evidence drawn from registrant's website demonstrates that

¹ Application Serial No. 78611807 was filed on April 19, 2005 based upon applicant's claims of first use anywhere and first use in commerce at least as early as May 13, 2004. The original combined class application was divided on March 17, 2008 keeping only the Class 9 goods in this "child application," Serial No. 78980002.

² Registration No. 3200346 issued to The MediaTile Company on January 23, 2007.

registrant is involved in providing a digital signage network for its customers, something altogether different from applicant's computer programs. Additionally, applicant argues there are other trademark owners with composite marks having the words "Media" and "Cast" in that order, indicating that the cited mark co-exists in a crowded field.

By contrast, the Trademark Examining Attorney contends that applicant has failed to demonstrate that the registered mark is weak for the recited services; that telecommunications services of the type recited by registrant and computer programs of the type identified by applicant are marketed under the same trademark by third parties; that the respective goods and services, as described, are legally related, and hence, must be presumed to flow through overlapping channels of trade to the same classes of consumers.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the

factors bearing on this issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks

We turn first to the *du Pont* factor focusing on the similarities or dissimilarities in the appearance, sound, connotation and commercial impression of the respective marks. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The involved marks are legally identical, and applicant does not argue otherwise. This factor weighs heavily in favor of a finding of likelihood of confusion.

The number and nature of similar marks on similar goods/services

Applicant's arguments related to the cited mark are focused on its contention that registrant's mark should be accorded a narrow scope of protection. However, applicant has failed to provide any probative evidence in support of this position. Applicant argues that prospective purchasers will "encounter the terms MEDIA and CAST on many similar products" (brief at 10), citing to only three, earlier-pending applications. However, an application shows only that someone filed a trademark application. Two of these three applications - involving marks having quite different connotations and commercial impressions from both registrant's and applicant's marks - have since been abandoned. The last of these applications (SN 77001237) appears to be suspended pending the outcome of this very proceeding.

Accordingly, we must agree with the Trademark Examining Attorney that as applied to registrant's recited services, the mark **MediaCast** must be deemed to be arbitrary, or at worst, suggestive. On this record, under Section 7 of the Trademark Act, we must accord registrant's mark the scope of protection appropriate for any mark

registered on the Principal Register. Hence, this *du Pont* factor also favors the position of the Trademark Examining Attorney herein.

Relationship of the Goods and Services

We begin our discussion of this *du Pont* factor keeping in mind that whenever the marks are legally identical, the relationship between the involved goods and services need not be as close to support a holding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Melville Corp.*, 18 USPQ2d 1386, 1387 (TTAB 1991); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983); and *Ancor, Inc. v. Ancor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981).

Nonetheless, applicant is correct in arguing that there is certainly no *per se* rule that all computer programs and telecommunications services are related. On the other hand, it is well settled that goods and services need not be identical or even competitive in order to support a finding of likelihood of confusion; it is sufficient that the goods and services be related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by

the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992) and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978).

Applicant's goods, as seen above, include "computer programs for delivering ... electronic mail, network browsing, and presentations, namely, video on demand, audiovisual content on demand, music on demand, and text and graphics on demand ..." Registrant's services are recited as "electronic, electric, and digital transmission of voice, data, images, signals, and messages."

The cited registration is not limited as to the content of the electronic, electric and digital transmission services, but lists a variety of forms of such transmissions, such as voice, data, images, signals and messages. Because registrant's services are broadly described, we find no limitation as to the nature or type of transmission services, and no restrictions as to channels of trade or classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). The services could well include the delivery of email, video on demand, audiovisual content on demand, music on demand, text and

graphics on demand, etc.; and these activities are the focus of applicant's identified goods. Thus, applicant's identified goods and registrant's recited services must be deemed to be legally related because they are complementary. The Trademark Examining Attorney has also introduced evidence from the Internet that registrant, as part of its service offerings, also provides for its customers computerized components that would be classified in International Class 9.

However, applicant argues that in reality, its goods are quite different from, and hence, unrelated to, registrant's services. Applicant posits that information drawn from registrant's own website provides evidence that registrant is a vendor involved in providing for merchants and manufacturers a digital signage network or a "narrowcast network." Clearly, this is a much narrower scope of services than that recited in the registration. As narrowed by applicant, registrant has a targeted and much more restricted audience than the presumptive population of potential purchasers for applicant's goods. However, applicant also points out that its goods are enterprise solutions, that they are expensive, and are targeted to sophisticated persons in business enterprises.

It is well settled that the issue of likelihood of confusion between an applied-for mark and a registered mark must be determined on the basis of the goods and services as they are identified in the involved application and cited registration, not on the basis of whatever the extrinsic evidence may show. See *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); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *Paula Payne Products Company v. Johnson Publishing Company*, 177 USPQ 76 (CCPA 1973); and *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). In this regard, it would be improper to permit applicant to restrict the scope of registrant's registration based upon extrinsic evidence that applicant produced from registrant's website. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

In the present case, without resort to extrinsic evidence, we must presume that registrant's services include the delivery of email and all kinds of content on demand for ordinary online computer users. Additionally, applicant's goods, as identified, clearly are not limited to LAN-based or enterprise-wide applications, and must be

presumed to include programs available to any potential user of services such as email, video on demand and music on demand, etc.

The related nature of the goods and services and the presumptive similarity in consumers for the goods and services would be sufficient for us to find the involved goods and services related. However, in addition, the Trademark Examining Attorney has placed into the record a representative sampling of use-based, third-party registrations showing the same mark registered for both computer programs for electronic messaging in class 9 and electronic, electric and digital transmission services in class 38. While third-party registrations are not evidence of commercial use of the marks shown therein, or if in use, that the public is familiar with them, this is a common method of presenting probative evidence that suggests the listed goods and services may be viewed by consumers as emanating from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993) and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 n.6 (TTAB 1988):

WEBPINE

for "computer programs for electronic communication and messaging" in Int. Class 9;
"online communications services, namely, providing electronic transmission of data;

e-mail services provided over global computer networks" in International Class 38;³

VOXIVA

for, *inter alia*, "computer software for enabling electronic data exchange, electronic messaging, electronic voice messaging, and electronic transactions between others via telephones, wireless communications devices, and the internet" in International Class 9;

"communications and telecommunications services, namely, providing electronic data exchange, electronic messaging, electronic voice messaging, and electronic transactions between others via telephones, wireless communications devices, and the internet; electronic transmission of messages and data; electronic, electric, and digital transmission of voice, data, images, signals, and messages" in International Class 38;⁴

RIVETED

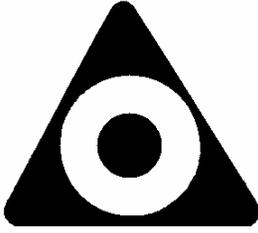
for "computer programs, namely computer programs for calendaring, sharing of calendar information, instant text and voice messaging, file sharing and web browsing" in Int. Class 9;

"electronic transmission of messages and data in the nature of community calendar information; instant text and voice messaging services" in International Class 38;⁵

³ Registration No. 2687452 issued on February 11, 2003.

⁴ Registration No. 2702467 issued on April 1, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁵ Registration No. 2805814 issued on January 13, 2004.



for, *inter alia*, "computer programs, namely prerecorded computer programs for data collection and distribution in the field of real estate, sales, appraisals, and services; custom designed computer programs for web pages in the field of internet displays" in International Class 9; "electronic transmission of data images and documents via computer terminals; electronic mail services providing online electronic bulletin boards among computer users concerning real estate sales, listings, tax information, and tax listings" in International Class 38;⁶

SDFI

for "computer software for organizing and viewing digital images and photographs" in International Class 9; "electronic, electric, and digital transmission of voice, data, images, signals, and messages" in International Class 38;⁷

DICOM GRID

for "apparatus for acquisition, digital storage, transmission or reproduction of still images, moving images, sound or text related to medical imaging of humans or animals, namely, computer networks comprised of computer hardware, software and firmware" in International Class 9; and "electronic services allowing at least one person to communicate with another by means of voice, still images, moving images or text, namely computer aided transmission of information, images and videos; electronic delivery of images, video and photographs via a global computer network; electronic, electric and digital transmission of voice, data, images, video signals and messages; transmission of information, images and video relating to pharmaceuticals, medicine

⁶ Registration No. 2947133 issued on May 10, 2005.

⁷ Registration No. 3193711 issued on January 2, 2007.

and hygiene; wireless electronic transmission of voice signals, data, facsimiles, images, video and information; online document delivery via a global computer network" in International Class 38.⁸

We note that applicant relies extensively on the result and analysis in *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988), arguing that the *Information Resources* case is akin to the present case. However, in *Information Resources*, opposer's computer software involved specialized programs for information analysis, while the applicant was offering a news service through a cable TV system. The Board also found that there was evidence in the record of widespread use of the term "Express" in opposer's field, and that the applicant's **X*PRESS** mark creates a distinctly different commercial impression from opposer's **EXPRESS** mark when each was applied to the respective goods and services.

Channels of trade and conditions under which and buyers to whom sales are made

We turn to two related *du Pont* factors that focus on the similarity or dissimilarity of established,

⁸ Registration No. 3254335 issued on June 19, 2007. No claim is made to the term "Dicom" apart from the mark as shown.

likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made. In reaching our decision, we have considered applicant's contention that the purchasers of all of the involved goods and services are sophisticated, and that the purchases are made only after careful thought. Specifically, applicant argues that registrant's narrowcast network services are directed to a narrow grouping of sophisticated individuals, and that its enterprise computerized systems are marketed to sophisticated information technology specialists or well-informed business persons.

On the other hand, as noted above, neither registrant's services nor applicant's goods are limited by classes of purchasers. Neither is explicitly restricted to niche channels of trade. Thus, we must presume that registrant's services and applicant's goods will be available through all normal trade channels to all potential customers, including individual, online computer users and small-business persons, who would not necessarily be as sophisticated or thoughtful in purchasing such goods or services. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); and *In re Optica Int'l*,

196 USPQ 775, 778 (TTAB 1977). These factors too favor a finding of likelihood of confusion.

Finally, even if prospective consumers of applicant's goods and registrant's services should be deemed to be sophisticated, we find that the legal identity between the marks and closely-related goods and services clearly outweigh any purchaser sophistication. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Conclusion: Likelihood of Confusion

In conclusion, the *du Pont* factors favoring a finding of likelihood of confusion include the fact that the marks are legally identical, the goods and services are related, and we must presume that they will move through some of the same channels of trade to the same classes of ordinary consumers.

Decision: The refusal to register this mark based upon Section 2(d) of the Lanham Act is hereby affirmed.