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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/980002

MARK: MEDIACAST



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Kuvata, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

1271-002

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's refusal to register the trademark "MEDIACAST" (standard character mark) for "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" under Section 2(d) of the Trademark Act on the basis that it is confusingly similar to the registered mark "MEDIACAST" (standard character mark; Reg. No. 3200346) for "electronic, electric, and digital transmission of voice, data, images, signals, and messages."

FACTS

On April 19, 2005, the applicant applied to register the mark “MEDIACAST” for “computer programs for business, entertainment, scientific, technical, commercial, educational, media presentation, and personal computing uses, in the fields of 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; and instructional manuals distributed therewith;” and “computer services; namely, consultation and application development in the field of computer software and delivering and displaying audiovisual content for others; programming, design, development, analysis, implementation, management, integration, deployment, maintenance, updating and repair of computer software and audiovisual content for others; service provider, namely hosting, managing and administering computer software and audiovisual content for others; technical assistance and consultation services, namely troubleshooting, managing, and maintaining computer software and audiovisual content for others; production, leasing and rental of computer software and audiovisual content; computer services, namely, creating, maintaining and disseminating audiovisual content for others; hosting audiovisual content of others on computer servers for local area networks, cable infrastructure, intranets, and the internet; consultation services and providing technical assistance related to the design, creation, dissemination, hosting, maintenance, operation, and management of audiovisual content for others; and providing information in the fields of computers, computer software, and the broadcast and dissemination of audiovisual content.” On November 22, 2005, the examining attorney issued a refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) based upon a

likelihood of confusion with the mark “MEDIA CASTING” in Registration No. 2247140 and indicated that there may be a likelihood of confusion between the applicant’s mark and the pending Application Serial No. 78410801. The examining attorney also required the applicant to amend the identification goods and services and to provide a substitute specimen of the goods in Class 009.

On June 23, 2006, the examining attorney suspended action on the application pending the disposition of Application Serial No. 78410801. The examining attorney withdrew the Section 2(d) refusal citing Reg. No. 2247140.

On August 29, 2007, the examining issued a Section 2(d) refusal based upon a likelihood of confusion with the mark “MEDIACAST” in Registration No. 3200346 for “electronic, electric, and digital transmission of voice, data, images, signals, and messages.”

On February 29, 2008, the applicant requested to Divide the Application. The application was divided on March 17, 2008 keeping the Class 009 goods in this “child application.”

On April 2, 2008, after reviewing the applicant’s response to the refusal, the examining attorney issued a Final Refusal.

On October 22, 2008, after careful consideration of the law and facts of the case, the examining attorney denied the applicant’s request for reconsideration.

The applicant filed a Notice of Appeal on October 1, 2008. The application was subsequently forwarded to the examining attorney for a brief on December 30, 2008.

ISSUE

The issue on appeal is whether the applicant's mark "MEDIACAST" is confusingly similar to the mark "MEDIACAST" in Registration No. 3200346 under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

ARGUMENT

THE PARTIES' MARKS ARE IDENTICAL IN SIGHT, SOUND, CONNOTATION, AND COMMERCIAL IMPRESSION, AND THE GOODS AND SERVICES ARE CLOSELY RELATED SUCH THAT A LIKELIHOOD OF CONFUSION EXISTS AS TO THE SOURCE OF THE GOODS AND SERVICES UNDER TRADEMARK ACT SECTION 2(d), 15 U.S.C. SECTION 1052(d).

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and services. The overriding concern is to prevent buyer confusion as to the source of the goods and services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co.*

v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. 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 & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). The examining attorney asserts that the commercial impression of the marks are similar, namely, that consumers would likely conclude that the source of the goods and services would be MEDIACAST.

I. The Marks are Confusingly Similar

The examining attorney asserts that the applicant's mark and the registered mark are similar in appearance, meaning and connotation because they share identical wording, which creates a common commercial impression that the applicant's goods and the registrant's services originate from a single source or sponsor i.e., MEDIACAST. It is

well settled that similarity in the elements of appearance, meaning and connotation are sufficient to indicate likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977). The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); see TMEP §1207.01(b)(iv).

When compared in their entireties, the marks are identical in both connotation and commercial impression in light of the common term, “MEDIACAST.” The applicant asserts that the registrant’s mark is a weak term and is entitled to limited protection. In support, the applicant has provided evidence in the form of three third-party applications that contain the words “media” and “cast.”¹ Applicant’s Brief, pp. 9-10. The applicant’s assertion that the term MEDIACAST is weak and should be granted a limited scope of protection is not persuasive. The applicant’s assertion basically suggests that the registrant’s mark should be diluted and afforded no protection of a registered mark. The mere fact that there are other uses of a mark does not per se make the mark under consideration a weak mark. *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1131 (TTAB 1995) (“The pictures of these restaurants tend to indicate that the operations are small and local in nature”).

¹ Of the three third-party applications listed, only Serial No. 77001237 is pending. Application Serial Nos. 77032070 and 77130616 were abandoned.

Applicant has not submitted any evidence of any third-party registrations of other “MEDIACAST” marks in connection with the same or similar goods and services. Thus, it must be concluded that “MEDIACAST” is an arbitrary and strong mark as applied to registrant's services, and hence entitled to a wider scope of protection than less distinctive, weaker, suggestive or descriptive marks. *See, e.g., In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (when word marks are identical but neither suggestive nor descriptive of the goods, the first DuPont factor weighs heavily against the applicant); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1292 (9th Cir. 1992) (strong marks are given the highest degree of trademark protection); *Time, Inc. v. Petersen Publ'g Co.*, 173 F.3d 113, 118, 50 USPQ2d 1474 (2d Cir. 1999) (“The strongest marks are arbitrary or fanciful marks, which are entitled to the fullest protection against infringement.”); *In re Emulex*, 6 USPQ2d 1312, 1314 (TTAB 1987). The applicant is a subsequent user of an identical mark for closely related goods and services. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant.

Accordingly, the marks are sufficiently similar that if they were contemporaneously used on related goods and services, confusion as to the source or sponsorship of such goods and services would be likely.

II. The Goods and Services are Closely Related

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need

only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984). If the marks of the respective parties are identical, the relationship between the goods and services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Ancor, Inc. v. Ancor Indus., Inc.*, 210 USPQ 70, 78 (TTAB 1981); TMEP §1207.01(a).

The applicant's goods are "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." The registrant's services are "electronic, electric, and digital transmission of voice, data, images, signals, and messages." The examining attorney asserts that the applicant's goods can be used for electronically transmitting and displaying voice, data, images, signals, and messages.

Registrant's services are commonly associated with applicant's goods. For instance, applicant's goods include computer programs for electronic mail, video-on-demand and music-on-demand systems. As indicated in the action denying reconsideration, these systems denote electronically transmitting mail, videos and music. 10/22/08 Office action, pp. 2-6. Consumers are likely to believe that registrant's services utilize applicant's goods and that the goods and services come from a common source.

The examining attorney's additional evidence further supports this assertion. In particular, the examining attorney provided several third-party registrations in which these types of goods and services are commonly marketed under the same trademarks.

The relevant portions of some of the third-party registrations, which demonstrate the related nature of the goods and services, read as follows:

Registration No. 1926842 – for “computer programs for use in communication between computers, facsimile machines, and other related transmitters and receivers, and instruction manuals therefore; and communication services, namely electronic transmission of messages between computers, facsimile machines, and other related receivers and transmitters.”

Registration No. 2687452 – for “computer programs for electronic communication and messaging; and online communications services, namely, providing electronic transmission of data; e-mail services provided over global computer networks.”

Registration No. 2805814 – for “computer programs, namely computer programs for calendaring, sharing of calendar information, instant text and voice messaging, file sharing and web browsing; and electronic transmission of messages and data in the nature of community calendar information; instant text and voice messaging services.”

Registration No. 2702467 – for “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; and 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.”

These third-party registrations have probative value to the extent that they serve to suggest that the goods and services listed therein are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

The applicant avers that the registrant’s services are used in connection with digital signage, and that the applicant’s goods have nothing to do with digital signage.²

Applicant’s Brief, pp 6-7. However, in its initial application, the applicant’s submitted specimen from its website, www.kuvata.com, indicates that its product is “in deployment in cable television, *digital signage*, and web environments reaching tens of thousands of viewers every day” (emphasis added by the examining attorney). Applicant’s 4/19/05 application, page 8.

The Applicant states that buyers of the goods and services exemplified by the Applicant’s mark and the registrant’s mark are sophisticated consumers who would not be confused regarding the source of the goods and services. Appeal Brief, pp. 11-12. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Moreover, in

² The applicant makes reference to Exhibit A, which the applicant had provided in its 2/29/08 response. However, the exhibit does not contain or mention the registered mark.

view of the third party registrations, sophisticated purchasers would be aware that both applicant's goods and registrant's services are of a type which may emanate from a single source, and therefore, are likely to believe that these goods and services, if marketed under an identical mark, emanate from the same source.

The applicant contends that its goods and registrant's services are not targeted to the same consumers. Appeal Brief, page 12. The registration describes its services broadly, and there are no limitations as to the nature, type, channels of trade or class of purchasers. The applicant may not restrict the scope of registrant's identification of services. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Since neither applicant's goods as identified in the application nor registrant's services as identified in the registration are limited or restricted in any way as to trade channels or classes of purchasers, then it is presumed that the respective goods and services are marketed in all normal trade channels for such goods and services and to all normal classes of purchasers for such goods and services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Therefore, the same consumers would purchase both applicant's goods and registrant's services.

The applicant also refers to the actions of another trademark examining attorney's prosecution of an existing similar application. Appeal Brief, pp. 7-8 and Exhibit B. Prior decisions and actions of other trademark examining attorneys in registering different marks have little evidentiary value and are not binding upon the Office. TMEP §1207.01(d)(vi). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268,

269 (C.C.P.A. 1973); *In re Int'l Taste, Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Accordingly, the identified goods and services are so closely related that if consumers were to encounter these identical marks on the identified goods and services, they are likely to assume that the source of these goods and services are related or associated in some way. Therefore, confusion would be likely.

CONCLUSION

The applicant's mark, MEDIACAST, on its face, is confusingly similar to the mark in U.S. Reg. No. 3200346, MEDIACAST, in that the marks are identical. In addition, both the applicant's mark and registrant's mark are used in conjunction with closely related goods and services. Furthermore, the applicant has failed to properly demonstrate that the registrant's mark is undeserving of protection. As such, it is highly likely that the applicant's mark, MEDICAST, and the registrant's mark, MEDIACAST, will cause consumer confusion. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant.

Respectfully submitted,

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