

**This Opinion is Not a
Precedent of the TTAB**

Hearing: March 26, 2019

Mailed: May 10, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Media Device Limited

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Serial No. 79212632

Rebecca Gan of Wenderoth LLP for Media Device Limited.

Dezmona F. Mizelle-Howard, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

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Before Cataldo, Shaw and Dunn,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Media Device Limited, seeks registration on the Principal Register of the standard character mark EARSHOT, identifying “wired and wireless headphones and earphones” in International Class 9.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15

¹ Application Serial No. 79212632 was filed on May 15, 2017, seeking an extension of protection under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f), based upon Applicant’s ownership of International Registration No. 1356254, issued on May 15, 2017.

U.S.C. §1052(d), in view of the registered mark **earshot** issued on the

Principal Register, identifying

Computer software for coordinating real-time communication and feedback between businesses and individuals; Computer software providing social media tools through which users can share, interact and follow real-time feedback relating to businesses, individuals and places; Computer software for finding and sharing a user's location and displaying a user's real-time communication relating to the user's location

in International Class 9.²

The refusal has been fully briefed, including a reply brief from Applicant. In addition, Applicant and the Examining Attorney presented arguments at an oral hearing conducted on March 26, 2019 by the above-named panel of this tribunal.

Based upon the record and the arguments made, we affirm the likelihood of confusion refusal.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated*

² Reg. No. 4565398 issued on July 8, 2014 with the following description and color claim: "The mark consists of the word 'earshot' with the inside of the 'o' being a comment bubble." "Color is not claimed as a feature of the mark."

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Similarity or Dissimilarity of the Marks

We compare the marks in their entireties and, in so doing, look to their appearance, sound, connotation and commercial impression. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). Although we place the marks alongside each other in the following paragraph for purposes of this decision, consumers may not encounter the marks in such a manner.

Applicant’s mark is EARSHOT in standard characters and the registered mark is

earshot

. The marks are identical in sound and highly similar in appearance. The fact that the registered mark is displayed in a slightly stylized form with a comment bubble comprising the interior of the letter “O” and possibly the letter “E” is of little consequence here inasmuch as Applicant’s mark is in standard character form and therefore we must consider all reasonable presentations of that mark including in the same stylization found in the registered mark. See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); see also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir.

2000). To the extent viewers of the registered mark will perceive the comment bubble forming the interior of one or more letters of the mark as a distinct design element, it is settled that where a mark consists of both a word and a design, the word is normally accorded greater weight, in part because consumers are likely to remember and use the word(s) to request the goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (“[T]he verbal portion of a word and design mark likely will be the dominant portion”); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). This is particularly so in this case due to the subtlety of the design and its overall lack of prominence within the larger context of the mark.

With regard to meaning, “earshot” is defined as “the range or distance within which a sound, voice, etc., can be heard.”³ There is neither record evidence nor argument that the term “earshot” would have a different meaning as applied to Applicant’s headphones and earphones on the one hand and the computer software identified in

³ We note with some puzzlement that no definition of the term comprising both marks was made of record. We therefore exercise our discretion to take judicial notice of this definition from Dictionary.com, based upon Random House Unabridged Dictionary (2019). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014). Definition from dictionary.com, based upon The Random House Unabridged Dictionary (2019).

the registered mark on the other. As a result, we find the marks are identical in meaning or connotation.

In sum, we view the marks in their entirety and find them to be identical in sound and meaning, highly similar in appearance and, overall, to convey very similar commercial impressions. Thus, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

Similarity of the Goods and Trade Channels

With regard to the *du Pont* factor addressing the relatedness of the goods, we must make our determinations based on the goods as they are identified in the application and cited registration. *See In re Dixie Rests. Inc.*, 41 USPQ2d at 1534. *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). A proper comparison of the goods considers whether “the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods.” *Hewlett Packard*, 62 USPQ2d at 1004. Therefore, to support a finding of likelihood of confusion, it is not necessary that the goods be identical or even competitive. It is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an

association or connection between the sources of the goods. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

Again, Applicant's goods are "wired and wireless headphones and earphones" and the goods in the cited registration are

Computer software for coordinating real-time communication and feedback between businesses and individuals; Computer software providing social media tools through which users can share, interact and follow real-time feedback relating to businesses, individuals and places; Computer software for finding and sharing a user's location and displaying a user's real-time communication relating to the user's location.

In support of the refusal of registration, the Examining Attorney introduced into the record with her November 16, 2017 denial of Applicant's Request for Reconsideration⁴ copies of nineteen use-based, third-party registrations for marks identifying, *inter alia*, goods of a type identified in the involved application and the cited registration, namely, earphone or headphones and various types of computer software. The following examples are illustrative:

- Reg. No. 5367713 for goods including "computer software for multimedia format conversion" and "headphones;"
- Reg. No. 5349040 for goods including "global positioning system (GPS) consisting of...computer software" and "earphones and headphones;"
- Reg. No. 5419665 for goods including "computer software for communicating with users of hand-held computers" and "earphones and headphones;"
- Reg. No. 5414587 for goods including "computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images and moving pictures" and "headphones;" and

⁴ At .pdf 9-49.

- Reg. No. 5406505 for goods including “computer software for wireless content delivery; software to control and improve audio equipment sound quality” and “earphones.”

Use-based, third-party registrations may serve to suggest that the goods are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Moreover, it is not necessary that the goods be competitive to support a finding of likelihood of confusion. *In re Thor Tech Inc.*, 90 USPQ2d at 1635. It does not matter for the purposes of our determination that the goods perform different functions and would not be used in place of each other. Evidence of record establishes that the goods are related inasmuch as they are subject to registration by the same entities under the same marks. As a result, consumers are likely to believe that they originate from the same source and that there is an association or connection between the sources of the goods, even if consumers may not confuse the goods themselves. *Id.*; *Hewlett Packard*, 62 USPQ2d at 1004.

Applicant argues:

Applicant makes and sells specialized action headphones, designed to be worn by enthusiasts of action sports like snowboarding, skateboarding, and dirt biking. In marked contrast, Registrant makes software for tracking consumer responses on social media.⁵

However, it is well-settled that we must determine the relatedness of the goods at issue based upon the identification of goods in the involved application and cited

⁵ 4 TTABVUE 11. (Applicant’s brief)

registration. *See, e.g., In re Dixie Rests. Inc.*, 41 USPQ2d at 1534; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1161. The involved application recites “wired and wireless headphones and earphones” without limitation as to their purpose or use and must, therefore, be broadly construed to include earphones and headphones of all types.

Applicant further argues

Finally, that makers of computer gaming software also make headphones specially designed for use during computer game playing, or that makers of GPS systems with integrated computer software also make headphones for wearing in connection with said systems, is not probative of whether makers of computer software for business to track consumer habits generally make headphones.⁶

The identifications of goods in the third-party registrations excerpted above do not specify or limit the uses to which the broadly identified earphones and headphones may be put. Thus, we have no basis to limit the goods in the third-party registrations made of record by the Examining Attorney to earphones or headphones specifically for use with the identified computer software applications recited therein. Applicant’s argument, that the third party registrations are not probative, implicitly because the software “for business to track consumer habits” in the cited registration has a less obvious nexus to headphones than a third party registration for software for a GPS system or computer gaming, is not persuasive. The cited registration specifies that the software utilizes “real-time communication and feedback”, and so the software in the cited registration does include a nexus to headphones.

⁶ 4 TTABVUE 12.

In addition, the identifications of goods in both the cited registration and involved application do not recite any limitations as to the channels of trade in which the goods are offered. In the absence of trade channel limitations on the goods under the registered and applied-for marks, we must presume that these goods are offered in all customary trade channels. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 98 USPQ2d at 1261; *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

We find that the *du Pont* factors of the relatedness of the goods, channels of trade and consumers weigh in favor of likelihood of confusion.

Summary and Conclusion

In its brief, Applicant primarily discussed the *du Pont* factor addressing the relatedness of the goods, while the Examining Attorney additionally discussed the similarity of the marks. Inasmuch as we have no evidence of record addressing the additional *du Pont* factors, they appear to be neutral. Because the marks are identical in sound and meaning, and highly similar in appearance and overall commercial impression, the goods are related, and are presumed to be offered in all customary trade channels therefor, we find that Applicant's mark, if used in association with the goods identified in the applications, are likely to cause confusion with the registered mark in connection with the goods recited in the registration.

Decision: The likelihood of confusion refusal to register Applicant's mark is affirmed.