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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glader

Serial No. 85368391

Luke Brean of BreanLaw LLC for Paul Glader

Caroline E. Wood, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

Before Bucher, Kuhlke and Ritchie, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Paul Glader, filed an application to register on the Principal Register the standard character mark **WiredAcademic** for services identified as “providing information, news and commentary in the field of education,” in International Class 41.¹

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used with the

¹ Application Serial No. 85368391, filed on March 28, 2012, based on an allegation of first use on April 1, 2011, and first use in commerce on May 1, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

identified services, so resembles the standard character marks WIRED LIVE (the word “Live” disclaimed) registered on the Principal Register for “arranging and conducting educational conferences; organizing exhibitions for educational and entertainment purposes” in International Class 41,² and WIRED for “arranging and conducting educational conferences; organizing exhibitions for educational purposes in the field of technology,” in International Class 41,³ as to be likely to cause confusion, mistake or deception.

When the refusal was made final, Applicant appealed, and Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

When the question is likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

SIMILARITY OF THE MARKS

We first consider the marks WiredAcademic, and WIRED LIVE and WIRED and compare them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*

² Registration No. 4147701, issued on May 22, 2012.

³ Registration No. 4347147, issued on June 4, 2013.

Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567.

Applicant argues that:

WIREDACADEMIC is a unitary mark, it is one word, and does not look nor does it sound like WIRED LIVE or WIRED. The incorporation of the term “academic” in the applicant’s mark connotes education and scholarship. In contrast the term “live” has a much broader, general connotation, of which education and scholarship are but a very minuscule subset of what is likely to come to mind. Because the applicant’s mark differs in sight, sound, and meaning in comparison to the cited registered and pending marks, there is no likelihood of confusion.⁴

In comparing the marks, the Examining Attorney found the term “WIRED” to be the dominant term in both Applicant’s mark and the registered marks. In addition, the Examining Attorney noted that consumers are generally more inclined to focus on the first word in a mark, and “WIRED” is the first word in the marks. Finally, the Examining Attorney argues that Applicant has appropriated a significant portion of registrant’s marks and only added the highly descriptive word, ‘ACADEMIC,’ to the shared term ‘WIRED.’⁵

Applicant is correct in stating that the marks must be compared as a whole in determining likelihood of confusion, and not dissected. However, “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re National Data Corporation*,

⁴ App. Br. p. 4.

⁵ Ex. Att. Br. p. 8.

753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). We agree with the Examining Attorney's analysis finding the term WIRED to be the dominant element in Applicant's mark **WiredAcademic** and registrant's mark WIRED LIVE. In the case of registrant's mark WIRED, Applicant's mark incorporates in full the entirety of registrant's mark. As the Examining Attorney correctly observes the first part of a mark is often the "most likely to be impressed upon the mind of a purchaser and remembered." *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). *See also Palm Bay*, 73 USPQ2d at 1692. In addition, the terms "Academic" and "Live" simply serve to describe significant aspects of the respective services, namely, the subject matter of the information services in the "field of education" ("Academic") and the manner in which the exhibition services are provided ("Live"). The addition of descriptive matter generally does not serve to distinguish otherwise similar marks. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.").

The fact that Applicant's mark compresses the words WIRED and ACADEMIC does not alter our analysis. The absence of a space between the clearly recognizable separate words WIRED and ACADEMIC is not significant and does not alter the meaning or overall commercial impression. *Seaguard Corp. v. Seaward International, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and

SEAGUARD are “essentially identical”) and *In re Best Western Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”). *Cf. In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) (“We find, first, that the compression of the words URBAN and HOUSING into a single term, URBANHOUZING, still conveys the commercial impression of two words. In other words, consumers would recognize the mark as consisting of the separate elements URBAN and HOUSING”).

While the marks include differences in appearances, sound and meaning, we find the common element to be dominant, such that consumers would view Applicant’s mark as another variant of registrant’s WIRED and WIRED LIVE marks. In view thereof, the *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

SIMILARITY OF THE SERVICES/CHANNELS OF TRADE/CONSUMERS

We turn then to a consideration of the services, channels of trade and classes of consumers. We must make our determinations under these factors based on the services as they are identified in the registrations and application. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). It is settled that it is not necessary that the respective services be identical or even competitive

in order to find that they are related for purposes of our likelihood of confusion analysis. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. *See In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The services need only be sufficiently related that consumers would be likely to assume, upon encountering the services under similar marks, that the services originate from, are sponsored or authorized by, or are otherwise connected to the same source. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The evidence submitted by the Examining Attorney sufficiently demonstrates that Applicant's services "providing information, news and commentary in the field of education" are related to registrant's services "arranging and conducting educational conferences; organizing exhibitions for educational and entertainment purposes" and "arranging and conducting educational conferences; organizing exhibitions for educational purposes in the field of technology." *See, e.g.*, third-party registrations for similar services attached to June 24, 2013 Office Action. *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012) (copies of use-based, third-party registrations may serve to suggest that the services are of a type which may emanate from a single source); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

Noting that registrant is Advance Magazine Publishers, Inc., and asserting that it does business as Condé Nast, Applicant argues that:

The WIRED LIVE exhibition has a clear tie-in to the registrant's *Wired* magazine and the *Wired* magazine logo appears in the specimen for this mark and in the side bar of Exhibit G. Finally, it can only be presumed the WIRED [sic] will be used for promoting similar conferences and educational exhibits to *Wired* magazine readers.

In contrast, to the wide ranging, cultural, economic, and technological topics covered by the Condé Nast *Wired* magazine properties, WIREDACADEMIC is a narrowly focused website that is an independent news source and thought center about digital learning and education innovation. ... Because WIREDACADEMIC's limited focus on the digital learning and education innovation, there is little likelihood of confusion with Condé Nast's *Wired* magazine properties.⁶

However, as the Examining Attorney explains, the question of likelihood of confusion is determined based on the description of the services stated in the application and registrations at issue and may not be limited by extrinsic evidence. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1637 (TTAB 2009); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). We further note that the "wide ranging" topics covered by registrant's website could encompass Applicant's "limited focus on the digital learning and education innovation."

Considering the channels of trade and classes of purchasers, because the services are closely related and there are no limitations as to channels of trade or classes of consumers in the cited registrations, we must presume that Applicant's and registrant's services will be offered in the same channels of trade to the same classes of consumers. *Viterra Inc.*, 101 USPQ2d at 1908; *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d at 1005; *Canadian Imperial Bank v. Wells Fargo*

⁶ App. Br. pp. 6-7.

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Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

In view of the above, the *du Pont* factors of the similarity of the services, the channels of trade and classes of consumers favor a finding of likelihood of confusion.

In conclusion, because the marks are similar, the services are closely related, and the channels of trade and consumers are the same, confusion is likely between Applicant's mark **WiredAcademic** and the marks WIRED LIVE and WIRED in the cited registrations.

Decision: The refusal to register based on a likelihood of confusion under Section 2(d) of the Trademark Act is affirmed.