

ESTTA Tracking number: **ESTTA568913**

Filing date: **11/04/2013**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|---|-------------|----------|
| Name | ZeetoGroup, LLC | | |
| Entity | Limited Liability Company | Citizenship | Delaware |
| Address | 925 B Street, Fifth Floor San Diego, CA 92101 UNITED STATES | | |

| | | | |
|----------------------|--|--|--|
| Attorney information | Shannon Koehler General Counsel for ZeetoGroup, LLC 925 B Street, Fifth Floor San Diego, CA 92101 UNITED STATES shannon.k@zeetogroup.com Phone:619-961-0434 | | |
|----------------------|--|--|--|

Registration Subject to Cancellation

| | | | |
|-----------------|--|-------------------|------------|
| Registration No | 3739584 | Registration date | 01/19/2010 |
| Registrant | CLJC Enterprises, Inc. 7866 Witney Place Lone Tree, CO 80124 COLOMBIA | | |

Goods/Services Subject to Cancellation

| |
|---|
| Class 035. First Use: 2009/06/01 First Use In Commerce: 2009/06/01 All goods and services in the class are cancelled, namely: Creative marketing design services |
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Grounds for Cancellation

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Petitioner as Basis for Cancellation

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4083896 | Application Date | 06/07/2011 |
| Registration Date | 01/10/2012 | Foreign Priority Date | NONE |
| Word Mark | ZEETO | | |

| | |
|---------------------|---|
| Design Mark | <h1>ZEETO</h1> |
| Description of Mark | NONE |
| Goods/Services | <p>Class 035. First use: First Use: 2007/08/05 First Use In Commerce: 2007/08/05 Providing demand creation and lead generation activities and services. Dissemination of advertising for others via the Internet. Dissemination of advertising for others via an on-line communications network using a network of affiliates</p> <p>Class 042. First use: First Use: 2007/08/05 First Use In Commerce: 2007/08/05 Providing on-line non-downloadable software for conducting and managing online marketing campaigns</p> |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4095926 | Application Date | 06/07/2011 |
| Registration Date | 02/07/2012 | Foreign Priority Date | NONE |

| | |
|---------------------|---|
| Word Mark | ZEETO GROUP |
| Design Mark | <h1>ZEETO GROUP</h1> |
| Description of Mark | NONE |
| Goods/Services | <p>Class 035. First use: First Use: 2007/08/05 First Use In Commerce: 2007/08/05 Providing demand creation and lead generation activities and services; dissemination of advertising for others via the Internet; dissemination of advertising for others via an on-line communications network using a network of affiliates</p> <p>Class 042. First use: First Use: 2007/08/05 First Use In Commerce: 2007/08/05 Providing on-line non-downloadable software for conducting and managing online marketing campaigns</p> |

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|-------------|---|
| Attachments | 85339803#TMSN.jpeg(bytes) 85339827#TMSN.jpeg(bytes) 20131104 Petition for Cancellation Zeto Creative Trademark Filed.pdf(113684 |
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|--|--|
| | bytes) Ex A 20120110 ZEETO Registration Certificate.pdf(196703 bytes) Ex B 20120207 ZEETO GROUP Registration Certificate.pdf(200050 bytes) Ex C 20121101 USPTO OA without attachments.pdf(418271 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

| | |
|-----------|-------------------|
| Signature | /Shannon Koehler/ |
| Name | Shannon Koehler |
| Date | 11/04/2013 |

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

In the Matter of Registration No.: 3,739,584
Mark: ZETO CREATIVE
Date Registered: January 19, 2010

| | | |
|-------------------------|---|-------------------------------|
| _____ |) | |
| ZEETOGROUP, LLC, |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | Cancellation No. _____ |
| |) | |
| CLJC ENTERPRISES, INC., |) | |
| |) | |
| Registrant. |) | |
| _____ |) | |

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

ZEETOGROUP, LLC (“Petitioner”), a Delaware limited liability company, located and doing business at 925 B Street, Fifth Floor, San Diego, CA 92101 believes that it is damaged by Registration No. 3,739,584 as it relates to services in Class 35, namely creative marketing design services, and hereby petitions to cancel the registration of the mark ZETO CREATIVE for these services.

To the best of Petitioner’s knowledge, the name and address of the current owner of the registration are CLJC ENTERPRISES, Inc., 7866 Witney Place, Lone Tree, Colorado 80124 (“Registrant”).

The above-identified Petitioner hereby petitions to cancel the registration of the mark ZETO CREATIVE. As grounds therefor, it is alleged that:

1. Petitioner is the current owner of all right, title and interest in and to United States Trademark Registration No. 4,083,896 for the mark ZEETO, registered on January 10, 2012, on the Principal Register in International Class 35, for "providing demand creation and lead generation activities and services; dissemination of advertising for others via the Internet; and dissemination of advertising for others via an on-line communications network using a network of affiliates" and on the Principal Register in International Class 42 for "providing on-line non-downloadable software for conducting and managing online marketing campaigns" (collectively hereinafter "Petitioner's Services"), said Registration being in full force and effect. A copy of the registration is appended to this petition as Exhibit "A". Use of the mark since August 5, 2007 is alleged.

2. Petitioner is also the current owner of all right, title and interest in and to United States Trademark Registration No. 4,095,926 for the mark ZEETO GROUP, registered on February 7, 2012, on the Principal Register in International Classes 35 and 42, for Petitioner's Services, said Registration being in full force and effect. A copy of the registration is appended to this petition as Exhibit "B". Use of the mark since August 5, 2007 is alleged.

3. Petitioner has also filed Application Serial No. 85-670,820 for the mark ZEETO MEDIA as used to identify Petitioner's Services. The U.S. Patent and Trademark Office refused registration of this application based upon the allegation of a likelihood of confusion with the mark shown in Registration No. 3,739,584.

4. Petitioner has, for many years, since at least as early as August 5, 2007, and prior to any date of first use upon which Registrant can rely, i.e. June 1, 2009, adopted and used, continuously and exclusively, the trademarks ZEETO and ZEETO GROUP in interstate commerce and in commerce regulated by Congress, in connection with Petitioner's Services.

5. Registrant is the owner of record of the ZETO CREATIVE Registration, Registration No. 3,739,584, in International Class 35, for "creative marketing design services" (hereinafter "Registrant's Services").
6. Registrant's ZETO CREATIVE application was filed as an In-Use application with a date of first use of June 1, 2009 and a date of first use in commerce of June 1, 2009.
7. Upon information and belief, Registrant did not use the ZETO CREATIVE mark for the goods listed in Registration No. 3,739,584, prior to August 5, 2007.
8. Petitioner's date of first use and date of first use in commerce (August 5, 2007) of both the ZEETO and ZEETO GROUP trademarks, in conjunction with Petitioner's Services, is well before Registrant's claimed dates of use of its ZETO CREATIVE trademark in conjunction with Registrant's Services (i.e. June 1, 2009).
9. Registrant's ZETO CREATIVE trademark is confusingly similar to the ZEETO trademark and is likely to cause confusion, deception, or mistake to Petitioner's irreparable damage and injury, in violation of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).
10. Registrant's Services as identified in the ZETO CREATIVE registration are closely related to the Petitioner's Services under its ZEETO and ZEETO GROUP trademarks.
11. Petitioner has expended considerable effort and expense in promoting its trademarks ZEETO and ZEETO GROUP and the services provided under each mark, with the result that the relevant public has come to know, rely upon, and recognize the services provided by the Petitioner by such marks.
12. Because Petitioner's mark ZEETO and Registrant's mark ZETO CREATIVE are confusingly similar and Petitioner's and Registrant's services are closely related, Petitioner is being prevented from registering an additional mark, ZEETO MEDIA (application no. 85-

670,820). The descriptive words “MEDIA” and “CREATIVE” have been disclaimed from the respective marks, leaving the words ZEETO and ZETO which are “essentially phonetic equivalents and thus sound similar.” (See November 1, 2011 Office Action for the mark Zeeto Media, Serial Number 85-670,820, attached without attachments as Exhibit C).

13. As the current owner of all right, title and interest in and to United States Trademark Registration No. 4,083,896 for the mark ZEETO, registered on January 10, 2012, on the Principal Register in International Classes 35 and 42, Petitioner has the right to use and register the mark ZEETO MEDIA in International Classes 35 and 42 because it is essentially the already registered mark of Petitioner (ZEETO) along with a descriptive word “MEDIA”.

14. If the Registrant is permitted to retain the registration sought to be cancelled, and thereby, the *prima facie* exclusive right to use in commerce the mark ZETO CREATIVE in connection with similar services offered by Petitioner, then Petitioner will continue to be damaged by being prevented from securing its rights in ZEETO MEDIA.

15. If the Registrant is permitted to retain the registration sought to be cancelled, and thereby, the *prima facie* exclusive right to use in commerce the mark ZETO CREATIVE in connection with similar services offered by Petitioner, confusion in trade is likely to result from any concurrent use of Petitioner's mark and that of the Registrant all to the great detriment of Petitioner, who has expended considerable sums and effort in promoting its mark.

16. Purchasers are likely to consider the services of the Registrant offered under the mark ZETO CREATIVE as emanating from Petitioner, and purchase such services as those of the Petitioner, resulting in loss of sales to Petitioner. Concurrent use of the mark by Registrant and Petitioner may result in irreparable damage to Petitioner's reputation. Any defect, objection or

fault found with Registrant's services would reflect upon and seriously injure the reputation and value that Petitioner has established under Petitioner's trademark.

17. Petitioner is damaged and will continue to be damaged by the use and registration of Registrant's ZETO CREATIVE trademark within the meaning of 15 U.S.C. § 1064.

WHEREFORE, Petitioner deems that it is or will be damaged by Registration No. 3739584, and petitions for cancellation thereof as it relates to goods in Class 35.

A duplicate Petition for Cancellation is being filed herewith, along with the filing fee required in §2.6(a)(16).

Dated: November 4, 2013

Respectfully submitted,

By: /Shannon Koehler/
Shannon Koehler, Esq.
California Bar No. 270767

General Counsel
ZeetoGroup, LLC
925 B Street, Fifth Floor
San Diego, CA 92101
Telephone: 619-961-0434
Email: shannon.k@zeetogroup.com

Attorney for Petitioner ZeetoGroup, LLC

United States of America
United States Patent and Trademark Office

ZEETO

Reg. No. 4,083,896

ZEETOGROUP, LLC (DELAWARE LIMITED LIABILITY COMPANY)
861 6TH AVENUE #715
SAN DIEGO, CA 92101

Registered Jan. 10, 2012

Int. Cls.: 35 and 42

FOR: PROVIDING DEMAND CREATION AND LEAD GENERATION ACTIVITIES AND SERVICES. DISSEMINATION OF ADVERTISING FOR OTHERS VIA THE INTERNET. DISSEMINATION OF ADVERTISING FOR OTHERS VIA AN ON-LINE COMMUNICATIONS NETWORK USING A NETWORK OF AFFILIATES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

PRINCIPAL REGISTER

FIRST USE 8-5-2007; IN COMMERCE 8-5-2007.

FOR: PROVIDING ON-LINE NON-DOWNLOADABLE SOFTWARE FOR CONDUCTING AND MANAGING ONLINE MARKETING CAMPAIGNS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 8-5-2007; IN COMMERCE 8-5-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-339,803, FILED 6-7-2011.

DAWN FELDMAN, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

United States of America
United States Patent and Trademark Office

ZEETO GROUP

Reg. No. 4,095,926

Registered Feb. 7, 2012

Int. Cls.: 35 and 42

SERVICE MARK

PRINCIPAL REGISTER

ZEETOGROUP, LLC (DELAWARE LIMITED LIABILITY COMPANY)
861 6TH AVENUE #715
SAN DIEGO, CA 92101

FOR: PROVIDING DEMAND CREATION AND LEAD GENERATION ACTIVITIES AND SERVICES; DISSEMINATION OF ADVERTISING FOR OTHERS VIA THE INTERNET; DISSEMINATION OF ADVERTISING FOR OTHERS VIA AN ON-LINE COMMUNICATIONS NETWORK USING A NETWORK OF AFFILIATES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

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FIRST USE 8-5-2007; IN COMMERCE 8-5-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GROUP", APART FROM THE MARK AS SHOWN.

SER. NO. 85-339,827, FILED 6-7-2011.

DAWN FELDMAN, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
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NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

To: ZeetoGroup, LLC (shannon.k@zeetogroup.com)

Subject: U.S. TRADEMARK APPLICATION NO. 85670820 - ZEETO MEDIA - N/A

Sent: 11/1/2012 5:46:26 PM

Sent As: ECOM108@USPTO.GOV

Attachments: [Attachment - 1](#)
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85670820

MARK: ZEETO MEDIA

85670820

CORRESPONDENT ADDRESS:

SHANNON KOEHLER
ZEETOGROUP, LLC
925 B ST FL 5
SAN DIEGO, CA 92101-4628

CLICK HERE TO RESPOND
<http://www.uspto.gov/trademarks/te>

APPLICANT: ZeetoGroup, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

shannon.k@zeetogroup.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST

RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 11/1/2012

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- Refusal under Section 2(d) – Likelihood of Confusion
- Disclaimer Required
- Specimen Required
- Claim of Ownership of Registrations
- Loss of TEAS Plus Status – Fee Required

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3739584. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); TMEP §1207.01; *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533

(Fed. Cir. 1997). That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Applicant's mark is "ZEETO MEDIA". Registrant's mark is "ZETO CREATIVE". Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed, descriptive or generic matter is typically less significant or less dominant in relation to other wording in a mark. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

In the present case, the attached evidence in the paragraphs below under the heading "Disclaimer Required" shows that the wording "MEDIA" in applicant's is merely descriptive in relation to applicant's services. Thus, this wording is less significant in terms of affecting the mark's commercial impression, and renders the wording "ZEETO" the more dominant, source-indicating element of the mark. Similarly, the wording "CREATIVE" has been disclaimed from registrant's mark; thus, the wording "ZETO" is the more dominant element of the mark.

Accordingly, the dominant part of applicant's mark is "ZEETO" and the dominant part of registrant's mark is the word "ZETO". The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Additionally, the marks appear nearly identical; the only difference is that applicant's mark contains two letters "E", whereas registrant's mark only contains one letter "E".

Thus, because the dominant parts of applicant's mark and registrant's mark sound similar and appear almost identical, the marks are confusingly similar for the purposes of a likelihood of confusion analysis.

Relatedness of the Services /Channels of Trade

The services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000);

Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); see *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant’s services are “Advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; Advertising services, namely, cost-per-action on-line advertising; Dissemination of advertising for others via the Internet; Online advertising and promotional services; Providing demand creation and lead generation activities and services” in International Class 35 and “Providing on-line non-downloadable software for conducting and managing online marketing campaigns” in International Class 42. Registrant’s services are “Creative marketing design services” in International Class 35.

The attached Internet evidence from four third-party websites demonstrates that third parties who offer applicant’s services also offer registrant’s services under the same brand:

- <http://www.zetocreative.com/Services/>
- <http://www.mvpdesign.com/web-design-services/>
- <http://www.mvpdesign.com/services/design.aspx>
- <http://williamsmarketingdesign.com/print.php>
- <http://williamsmarketingdesign.com/web.php>
- <http://www.typethink.com/services/>

The trademark examining attorney has attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the services listed therein, namely advertising and marketing services, providing software for marketing and advertising, and marketing design services, are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). Accordingly, as is evidenced by the aforementioned Internet evidence and third-party websites, applicant’s services are closely related to registrant’s services for the purpose of a likelihood of confusion analysis.

Applicant is denied registration under Section 2(d) for likelihood of confusion because applicant’s mark and registrant’s mark are confusingly similar, and applicant’s services are closely related to registrant’s services.

Although applicant’s mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

If applicant responds to the refusal above, then applicant must also respond to the requirements set forth

below.

DISCLAIMER REQUIRED

Applicant must disclaim the descriptive wording “MEDIA” apart from the mark as shown because it merely describes a function or purpose of applicant’s services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); TMEP §§1213, 1213.03(a).

Specifically, the attached evidence from Collins English online dictionary defines “media” as “the means of communication that reach large numbers of people, such as television, newspapers, and radio.” Applicant’s services involve use of various communications methods, such as social media and the internet, and therefore the word “media” describes a function or purpose of applicant’s services. Additionally, the attached Internet evidence from three third-party websites demonstrates that third parties who offer services similar to applicant’s services also use the word media to describe their services:

- <http://www.marketingmedia.ca/services.html>
- <http://www.haworthmedia.com/about/>
- <http://www.m3group.biz/our-ideas/services>

Therefore, the wording merely describes a function or purpose of applicant’s services and must be disclaimed.

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “MEDIA” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

SPECIMEN REQUIRED

The examining attorney found issues with the specimens for both International Class 35 and International Class 42. This Office action will address these issues, and then provide information on responding to the specimen requirement at the end.

The marks on both specimens disagree with the mark on the drawing. In this case, the specimens display the mark as “ZEETO”; and the drawing shows the mark as “ZEETO MEDIA”.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). The mark on the drawing must be a substantially exact representation of the mark on the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a); *see* 37 C.F.R. §2.72(a)(1).

The drawing of the mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* However, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration in this case because the mark on the specimen creates a different commercial impression from the mark on the

drawing. Specifically, the word “ZEETO” by itself does not allude to applicant’s services in any way, whereas “ZEETO MEDIA” suggests that applicant provides some type of media service.

Additionally, the specimen does not show the applied-for mark used in connection with any of the services specified in International Class 42, and therefore is not acceptable. In this case, the specimen is a webpage snapshot from applicant’s website. There are two paragraphs explaining applicant’s services, however, this explanation does not provide any information about software for conducting or managing online marketing campaigns. Accordingly, the specimen is unacceptable because it does not show applicant’s mark used in connection with the services identified in International Class 42.

Therefore, applicant must submit the following:

- (1) Substitute specimens showing use in commerce of the mark on the drawing for both International Class 35 and International Class 42. *See* TMEP §807.12(a); and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“The substitute specimen was in use in commerce at least as early as the filing date of the application.”** *See* 37 C.F.R. §§2.59(a), 2.193(e)(1); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Applicant may respond to the stated specimen refusal by submitting a verified substitute specimen or amending the application to an intent to use filing basis under Trademark Act Section 1(b) by following the suggested directions below for responding either online or by mail.

If applicant responds to this Office action online via the Trademark Electronic Application System (TEAS), applicant should provide a substitute specimen as follows: (1) answer “yes” to the TEAS response form wizard question to “submit a new or substitute specimen,” (2) attach a jpg or pdf file of the substitute specimen, and (3) select the statement that “The substitute specimen(s) was in use in commerce at least as early as the filing date of the application.” However, if applicant is responding by amending the application to a Section 1(b) filing basis, applicant should do the following: (1) answer “yes” to the TEAS response form wizard questions to “change filing basis” and for a “signed declaration,” respectively; (2) uncheck the box for “Filing Basis Section 1(a);” and (3) check the box for “Filing Basis Section 1(b).” Please note that these steps appear on different pages of the TEAS response form.

Whether submitting a substitute specimen or amending the filing basis to Section 1(b), applicant must also personally sign or personally enter his/her electronic signature and date after the declaration at the end of the TEAS response form, and print or type the name of the signatory immediately below or adjacent to his/her signature or identify it elsewhere in the filing. *See* 37 C.F.R. §§2.34(a)(2), 2.59(a), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b).

If applicant experiences difficulty in submitting the required substitute specimen, supporting statement and/or declaration, or changing the filing basis, please e-mail TEAS@uspto.gov for technical assistance regarding the TEAS response form.

If applicant responds to this Office action on paper, via regular mail, applicant may provide a verified substitute specimen by (1) checking the first statement below and personally signing, dating, and printing or typing the name of the signatory in the declaration appearing below the statement; and (2) submitting a substitute specimen showing the applied-for mark in use in commerce. *See* 37 C.F.R. §§2.20, 2.59(a), 2.193(a)(1), (d), (e)(1); TMEP §§611.01(b), 804.01(b), 904.05. If applicant is responding by amending the application to a Section 1(b) filing basis, applicant may check the second statement below, and personally sign, date, and enter the printed or typed name of the signatory in the declaration appearing below the statement. *See* 37 C.F.R. §§2.20, 2.34(a)(2), 2.193(a)(1), (d), (e)(1); TMEP §§611.01(b), 804.01(b), 806.03(c).

q **The substitute specimen was in use in commerce at least as early as the filing date of the application.**

q **Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the filing date of the application.**

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a service mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

CLAIM OF OWNERSHIP OF REGISTRATIONS

If applicant owns U.S. Registration Nos. 4087959, 4083896, and 4095926, then applicant must submit for the application record a claim of ownership of these registrations. *See* 37 C.F.R. §2.36; TMEP §812. See the attached copies of the registrations. *See* TMEP §812.

Applicant may use the following format to claim ownership of these registrations:

Applicant is the owner of U.S. Registration Nos. 4087959, 4083896, and 4095926.

LOSS OF TEAS PLUS STATUS – FEE REQUIRED

Applicant must submit an additional application processing fee of \$50 per class because the application as filed did not meet the TEAS Plus application filing requirements. *See* 37 C.F.R. §§2.6(a)(1)(iv), 2.22(a), (b); TMEP §§819.01 *et seq.*, 819.04. Specifically, applicant failed to meet the following application filing requirement(s): a claim of ownership of applicant's prior registrations for the same mark was not provided;

The additional fee is required even if applicant later corrects these application requirements.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Juhi Kaveeshvar Patel/
Ms. Juhi Kaveeshvar Patel
Trademark Examining Attorney
Law Office 108
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint

applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.