

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 16, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Zoom Video Communications, Inc.
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Serial No. 97747222
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Pamela Chestek of Chestek Legal,
for Zoom Video Communications, Inc.

Mitchell Knief, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

—
Before Adlin, Allard, and O'Connor,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:¹

¹ This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For opinions of the Board, this opinion uses citations to the LEXIS legal database and cites only precedential decisions, unless otherwise noted. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03(a)(2) (June 2024). For reference, precedential decisions of the Board, and precedential decisions of the Federal Circuit involving Board decisions that issued January 1, 2008, or after may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available online from the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

Zoom Video Communications, Inc. (“Applicant”) seeks registration on the Principal Register of the mark ZOOM CALENDAR (in standard characters, “CALENDAR” disclaimed) for goods and services ultimately identified as follows:

- “Downloadable calendaring software; downloadable computer software for creating an electronic calendar, scheduling meetings and events, managing calendars, synchronizing calendars, and managing group calendars,” in International Class 9;
- “Telecommunication services, namely, providing transmission of electronic calendars via the internet,” in International Class 38; and
- “Software as a service (SAAS) services featuring software for use in creating an electronic calendar, scheduling meetings and events, managing calendars, synchronizing calendars, and managing group calendars; Computer services, namely, hosting on-line interactive public calendars that allow multiple participants to share event schedules,” in International Class 42.²

Registration is refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, when used on the identified goods and services indicated above, so resembles the mark ZOOM REHEARSE (in standard characters) registered on the Principal Register, for, in relevant part:

software as a service (SAAS) services featuring software for administrative staff, business office staff and employees that provides electronic reports, dashboards, launchpads for third party software applications, information and applications specific to employee and staff business health and life insurance policies, benefits and administration, retirement income plans, vacation policies, paid time off policies, employee benefits, payroll procedures and policies, travel planning and assistance, business hours of operation, business leave policies, record keeping, electronic delivery enrollment information, customer

² Application Serial No. 97747222 was filed under Sections 1(b) and 44(d) of the Trademark Act, 15 U.S.C. §§ 1051(b) and 1126(d), based upon Applicant’s allegation of a bona fide intention to use the mark in commerce, and claiming a priority date of July 28, 2022 based on the filing date of Applicant’s Jamaican application No. 087061.

reports, electronic payment reports, electronic mail, electronic calendaring, electronic social media, electronic billboards and electronic announcements

in International Class 42,³ that it is likely to cause confusion, to cause mistake, or to deceive. After the refusal was made final, Applicant appealed. The appeal is fully briefed.⁴ We affirm the refusal to register.

I. Evidentiary Issues

Before proceeding to the merits of the refusal, we address two evidentiary matters.

A. Evidence Attached to Applicant's Brief

Applicant has attached to its brief two exhibits consisting of dictionary definitions of the terms “calendar” and “rehearse.”⁵ Although Applicant does not expressly request that we take judicial notice of these definitions, because dictionary definitions are subject matter of which the Board takes judicial notice, *see Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co., Inc.*, Opp. No. 61847, 1982 TTAB LEXIS 146, at *7 (TTAB 1982), *aff'd*, 703 F.2d 1372 (Fed. Cir. 1983), we have considered this evidence.

³ Registration No. 5908581 was issued on November 12, 2019.

⁴ Applicant's brief appears at 4 TTABVUE, the Examining Attorney's brief appears at 6 TTABVUE, and Applicant's reply brief appears at 7 TTABVUE.

Citations to the record throughout the decision include references to TTABVUE, the Board's online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 251, at *2 n.1 (TTAB 2022).

⁵ 4 TTABVUE 17-29.

B. Registrations Cited by the Examining Attorney in His Brief

In support of an argument about the similarity of the marks, the Examining Attorney cites in his brief three other registered marks owned by Applicant.⁶ Applicant objects because these registrations were not made of record during examination.⁷ It is well settled that the record in an application should be complete prior to the filing of an appeal, Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), and here Applicant is correct that the registrations were not made of record during prosecution. Therefore, Applicant's objection is sustained, and these cited registrations, together with any arguments based on them, have been given no consideration. *See In re Inn at St. John's, LLC*, Ser. No. 87075988, 2018 TTAB LEXIS 170, at *3-5 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019).

II. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive”¹⁵ U.S.C. § 1052(d). Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1314 (Fed. Cir. 2003). Varying

⁶ 6 TTABVUE 9.

⁷ 7 TTABVUE 5.

weights may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1356 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”).

In every Section 2(d) case, two key factors are the similarity or dissimilarity of the marks and the goods or services. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976). These two factors, and the third factor, are addressed in this decision.

A. Similarity or Dissimilarity and Nature of the Goods and Services, and Likely-to-Continue Channels of Trade

We begin with the second *DuPont* factor and consider the similarity or dissimilarity and nature of the goods and services as they are identified in the involved application and cited registration. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1306 (Fed. Cir. 2018); *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 942-43 (Fed. Cir. 1990).

1. Applicant’s Class 9 and 38 Goods and Services

For ease of reference, the following chart sets out Applicant’s Class 9 and 38 goods and services, together with the pertinent services forming the basis of the refusal as identified in the cited registration:

Applicant's Class 9 Goods	Applicant's Class 38 Services	Registrant's Pertinent Services
Downloadable calendaring software; downloadable computer software for creating an electronic calendar, scheduling meetings and events, managing calendars, synchronizing calendars, and managing group calendars	Telecommunication services, namely, providing transmission of electronic calendars via the internet	Software as a service (SAAS) services featuring software for administrative staff, business office staff and employees that provides... electronic calendaring

The Examining Attorney contends that Applicant's goods and services are closely related to Registrant's identified services.⁸

The goods and services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000). The goods and services need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Serv. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, Opp. No. 91117739, 2007 TTAB LEXIS 58, at *28-29 (TTAB 2007)).

"Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods [or services] are used together or used by the same purchasers; advertisements showing that the relevant goods [or services] are advertised together or sold by the same manufacturer or dealer; or copies of prior

⁸ 6 TTABVUE 11.

use-based registrations of the same mark for both applicant's goods [or services] and the goods [or services] listed in the cited registration." *In re Embiid*, Ser. No. 88202890, 2021 TTAB LEXIS 168, at *30 (TTAB 2021).

The Examining Attorney made of record the following third-party website evidence showing that providers of SAAS services featuring a calendaring function, like Registrant's, also provide Applicant's downloadable calendaring software (in Class 9) and Applicant's means of transmitting a calendar (in Class 38):

- Apple.com offers SAAS with calendaring capabilities, downloadable calendaring software, and the ability to transmit those calendars to others.⁹
- Google.com offers SAAS with calendaring capabilities, downloadable calendaring software, and the ability to transmit those calendars to others.¹⁰
- Microsoft.com offers SAAS with calendaring capabilities, downloadable calendaring software, and the ability to transmit those calendars.¹¹

The Examining Attorney made additional evidence of record from the following third-party websites: Calendar.com;¹² Asana.com;¹³ Calendly.com;¹⁴ Teamup.com;¹⁵

⁹ April 4, 2024 Office Action at TSDR 12-14.

Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, Ser. No. 86705287, 2018 TTAB LEXIS 220, at *3 n.4 (TTAB 2018).

¹⁰ *Id.* at TSDR 15-24.

¹¹ *Id.* at TSDR 25-26.

¹² November 2, 2023 Office Action at TSDR 23-34.

¹³ *Id.* at TSDR 15-22.

¹⁴ *Id.* at TSDR 35-46.

¹⁵ *Id.* at TSDR 59-68.

and Zoho.com.¹⁶ This website evidence similarly shows that each of these entities also offer SAAS services with a calendaring function (like those of Registrant), together with downloadable calendaring software (as identified by Applicant in Class 9) and services to transmit those calendars (as identified by Applicant in Class 38), all under the same mark.

Collectively, this website evidence from eight different third-parties strongly supports a finding that SAAS software featuring electronic calendaring of the type identified in the cited registration is related to downloadable calendaring software and telecommunications services for transmitting calendars of the type identified in Classes 9 and 38, respectively, of the involved application. The evidence shows that consumers are accustomed to encountering these goods and services offered under the same mark by a single source. *See, e.g., Detroit Athletic*, 903 F.3d at 1306 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because “[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both”); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

Applicant makes a series of arguments that its goods and services are not related to those identified in the cited registration. First, Applicant argues that “[t]he examining attorney has refused registration of the mark on the basis that the mark

¹⁶ *Id.* at TSDR 69-82.

is confusingly similar to ZOOM REHEARSE for, *inter alia*, ‘hosting, managing and maintaining applications and software of others in the fields of payroll, human resource and accounting’¹⁷ It is true that this quoted language corresponds to a service identified in the cited registration, but this particular service does not form the basis of the refusal.¹⁸ Here, Applicant misstates the basis of the refusal, which is, as discussed above, based upon Registrant’s SAAS services which include a calendaring function.

Second, Applicant asserts that “[a]lthough not raised by the examining attorney, there is one passing mention of ‘calendar’ in the single item in registrant’s recitation of services” but that “the calendaring [function] is at most a minor, ancillary function of the platform, indeed so minor that the Examining Attorney did not mention it as a basis for refusal.”¹⁹ This argument fails for two reasons. First, the calendaring function of Registrant’s SAAS services has consistently formed the basis of the refusal throughout examination²⁰ and all of the third-party website evidence of record expressly refers to the calendaring feature of the software, confirming that the calendaring function of the SAAS services is a feature of import in the identification of the cited registration. This argument also fails because, again, Applicant misstates and misconstrues the basis of the refusal: the cited registration clearly identifies

¹⁷ 4 TTABVUE 5.

¹⁸ April 4, 2023 Office Action at TSDR 5; November 2, 2023 (Final) Office Action at TSDR 9-10.

¹⁹ 4 TTABVUE 12-13 (footnote omitted).

²⁰ April 4, 2023 Office Action at TSDR 5-6; November 2, 2023 (Final) Office Action at TSDR 9-10.

calendaring as a function of the SAAS services. This function, albeit one of several, does not render it, as Applicant contends, “at most a minor, ancillary, function of the platform.”²¹ Importantly, even if it was in fact a relatively “minor” feature of Registrant’s services, that would not matter; the point is that it is part of the identification of services and the basis for the refusal. *See Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 1336-37 (CCPA 1981) (sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the identification of goods within a particular class in the application).

Third, Applicant attempts to discredit the Examining Attorney’s showing of relatedness by purporting to “translate” the services identified in the cited registration to “ordinary language,” but in so doing, mischaracterizes the identification that forms the basis of the refusal by omitting the calendaring function. Applicant then misstates the purpose of the evidence offered by the Examining Attorney:

The examining attorney instead raised a relatedness argument. Translating the registrant’s description of services into more ordinary language, the registrant provides a software-as-a-service platform for the administration of employee insurance; benefits such as retirement, vacation, time off and leave; payroll; and travel planning.

The examining attorney [sic] theory on similarity of goods and services based on relatedness is this:

[H]ere, applicant’s goods and services [list of Applicant’s goods and services in Classes 9 and 38] are closely related to registrant’s

²¹ 4 TTABVUE 13. *See also* 7 TTABVUE 8.

services [list of services in Class 42]. The previously attached Internet evidence, consisting of *Apple*, *Google* and *Microsoft* establishes that the same entity commonly manufactures, produces, or provides the relevant goods and markets the goods under the same mark.

The Applicant's attorney searched in vain for any exhibits that show that Apple, Google, Microsoft, or any other identified vendor is the source of both calendaring software and the business software described in the registrant's registration. The exhibits show that Apple, Google and Microsoft have their own calendaring applications, but there are no exhibits whatsoever (other than a press release about the registrant) that show anyone, much less Apple, Google or Microsoft, manufacture, produce or provide services of the type described by the registrant. The evidence the examining attorney presented consists only of different calendaring software products that do not relate to software for the administration of employee related benefits.²²

Contrary to Applicant's argument, the Examining Attorney's evidence was not intended to "show that Apple, Google, Microsoft, or any other identified vendor is the source of both calendaring software and the business software described in the registrant's registration" because, as the Examining Attorney explains,²³ there was no need for such a showing. Rather, the evidence properly shows that entities who provide Registrant's SAAS services with a calendaring function also regularly provide Applicant's "Downloadable calendaring software; downloadable computer software for creating an electronic calendar, scheduling meetings and events, managing calendars, synchronizing calendars, and managing group calendars" in International

²² 4 TTABVUE 13-14 (citations omitted).

²³ 6 TTABVUE 13-14.

Class 9 and its “Telecommunication services, namely, providing transmission of electronic calendars via the internet” in International Class 038.²⁴

Lastly, Applicant argues that the “electronic calendaring” feature in Registrant’s identification is unclear and that, as a result, it is proper to rely on extrinsic evidence to show that the description of services has a specific meaning in the trade.²⁵ Applicant then relies on Registrant’s press release to argue that Registrant’s software is a type of “enterprise resource planning (ERP) application testing tool” and that the electronic calendaring function is “for scheduling a run of test suites that will ensure the software will operate properly when put into active use.”²⁶ With this new understanding, Applicant contends that Registrant’s calendaring services “[have] nothing to do with” Applicant’s.²⁷ We are not persuaded. As an initial matter, we disagree that the terms “electronic calendaring” are unclear and that extrinsic evidence is necessary to understand them. Here, Applicant simply seeks to use extrinsic evidence about the specific nature and function of Registrant’s software to distinguish it from Applicant’s. This is improper. It is well-settled that we must consider the identifications as written, not on what extrinsic evidence may show about them. *See e.g., In re La Peregrina Ltd.*, Ser. No. 78676199, 2008 TTAB LEXIS 38, at *6-7 (TTAB 2008) (“[I]t is well established, as noted above, that it is the

²⁴ *Id.*

²⁵ 7 TTABVUE 8-9.

²⁶ *Id.* at 9.

²⁷ *Id.* at 8-9 (citing the press release attached to the November 2, 2023 (Final) Office Action at TSDR 12-14).

identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods. Similarly, applicant's reliance on registrant's website in an attempt to restrict the scope of registrant's goods is to no avail. An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence.”).

Although not addressed by either Applicant or the Examining Attorney, we consider the third *DuPont* factor pertaining to the similarity or dissimilarity of the trade channels in which the goods and services identified in the involved application and registration, respectively, are marketed. *Detroit Athletic Co.*, 903 F.3d at 1308 (quoting *DuPont*, 476 F.2d at 1361). Because Applicant's identifications do not contain any restrictions or limitations as to trade channels or classes of consumers, we presume that the identified goods and services are or would be marketed in all normal trade channels for such goods to normal classes of consumers, which include the “administrative staff, business office staff and employees” identified in the cited registration. See *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1361 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). The third-party website evidence demonstrating that the goods and services identified in Applicant's Class 9 and Class 38 identifications, respectively, are related to those of Registrant's (e.g., Apple.com, Google.com and Microsoft.com website evidence) also supports a finding that the goods and services move through overlapping channels of trade and that they are sold

to the overlapping classes of consumers, namely, administrative staff, business office staff and employees, who seek software calendaring solutions.

2. Applicant's Class 42 Services

Turning to Applicant's Class 42 services, we focus on the following services identified by Applicant: "Software as a service (SAAS) services featuring software for use in creating an electronic calendar, scheduling meetings and events, managing calendars, synchronizing calendars, and managing group calendars." Registrant's services, as mentioned, are "software as a service (SAAS) services featuring software for administrative staff, business office staff and employees that provides... electronic calendaring." Applicant's services are thus broad enough to encompass Registrant's more narrowly identified SAAS services. Thus, the services are legally identical in part because Applicant's identified services encompass Registrant's. *See e.g., In re Hughes Furniture Indus., Inc.*, Ser. No. 85627379, 2015 TTAB LEXIS 65, at *9-10 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"); *S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, Con. Use No. 94002242, 2015 TTAB LEXIS 176, at *60-61 (TTAB 2015) (where the goods or services in an application or registration are broadly described, they are deemed to encompass all the goods or services of the nature and type described therein).

Like the Examining Attorney,²⁸ we next turn to the third *DuPont* factor, which requires us to consider "the similarity or dissimilarity of established, likely-to-

²⁸ 6 TTABVUE 10.

continue trade channels.” *DuPont*, 476 F.2d at 1361. We recognize that the identification of the cited registration is limited to the extent that the identified software is offered “for administrative staff, business office staff and employees.” However, because the services are legally identical in part, and because Applicant’s Class 42 services have no restrictions as to channels of trade or classes of consumers, we presume that the channels of trade are the same and that the classes of purchasers overlap to the extent that both encompass software “for administrative staff, business office staff and employees.” See *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1321-23 (Fed. Cir. 2014); *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (finding Board entitled to rely on legal presumption of channels of trade and classes of consumers in determining likelihood of confusion); *In re Info. Builders Inc.*, Ser. No. 87753964, 2020 TTAB LEXIS 20, at *11-12 (TTAB 2020) (“Because ... Applicant’s and Registrant’s goods and services are legally identical in part, we must presume that these goods and services travel through the same channels of trade and are offered or rendered to the same or overlapping classes of purchasers.”) (citing *Viterra*, 671 F.3d at 1362; and *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 754 (CCPA 1968)).

B. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we determine the similarity or dissimilarity of marks in their entireties, considering their appearance, sound, meaning and commercial impression. *DuPont*, 476 F.2d at 1361. See also *Detroit Athletic*, 903 F.3d at 1303. “Similarity in any one of these elements may be sufficient to find the marks

confusingly similar.” *Inn at St. John’s*, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia*, Ser. No. 85497617, 2014 TTAB LEXIS 214, at *3-4 (TTAB 2014)).

The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012). “The proper perspective on which the analysis must focus is on the recollection of the average customer, who retains a general rather than specific impression of marks.” *In re i.am.symbolic, llc*, Ser. No. 85916778, 2018 TTAB LEXIS 281, at *11 (TTAB 2018).

While marks must be compared in their entireties and the analysis cannot be predicated on dissecting the marks into their various components, different features may be analyzed to determine whether the marks are similar. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *41-42 (TTAB 2020). 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 a consideration of the marks in their entireties. *In re Charger Ventures LLC*, 64 F.4th 1375, 1382 (Fed. Cir. 2023) (permissible for the Board “to focus on dominant portions of a mark”); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342 (Fed. Cir. 2004); *Packard Press*, 227 F.3d at 1357.

Where the services are legally identical, as they are in this case at least with respect to Applicant's Class 42 services, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods. *See e.g., In re Bay State Brewing Co.*, Ser. No. 85826258, 2016 TTAB LEXIS 46, at *7 (TTAB 2016) (citing *Coach Servs.*, 668 F.3d at 1370).

We find ZOOM is the dominant portion of Applicant's mark because it is the first term in the mark. *See e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 876 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, Opp. No. 74797, 1988 TTAB LEXIS 60, at *7-8 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). Moreover, Applicant's disclaimer of the descriptive term CALENDAR supports our finding, as descriptive, disclaimed terms have less source-identifying significance. *See e.g., Chatam Int'l*, 380 F.3d at 1342-43; *Nat'l Data*, 753 F.2d at 1058 (stating "[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark").

We also find that ZOOM is the dominant portion of the cited ZOOM REHEARSE mark due in part to its position as the first term in the mark. *See e.g., Palm Bay*, 396 F.3d at 1372; *Century 21*, 970 F.2d at 876; *Presto Prods.*, 1988 TTAB LEXIS 60, at *7-8. Moreover, although Registrant was not required to disclaim the term REHEARSE, Registrant's own press release indicates that the term is descriptive of the identified services: "Zoom Rehearse includes a built-in test agent to replicate the user stress and interaction on each system from a source environment, enabling a full **rehearsal** of actual user activities and providing an accurate data comparison to verify and validate performance of all necessary application functionality."²⁹ Thus, we agree with Applicant that the term REHEARSE is descriptive,³⁰ and, as a result, the weakness of the term REHEARSE reinforces the dominant nature of the ZOOM element.

For these reasons, we give more weight to the common dominant element ZOOM in each mark, as we consider the marks in their entirety. *Nat'l Data*, 753 F.2d at 1058. With this in mind, we undertake the task of comparing the entire marks.

While there are some specific differences between Applicant's mark and Registrant's mark, we find that the marks are similar in appearance and sound due to the shared, dominant term ZOOM. As for connotation, the record shows that

²⁹ November 2, 2023 (Final) Office Action at TSDR at 14 (emphasis added).

³⁰ Applicant itself made the argument that the term REHEARSE is descriptive, albeit in the context of arguing that this term causes the mark to make a different commercial impression than the cited mark. 4 TTABVUE 11-12 ("The word 'REHEARSE' in registrant's mark thus also serves an informative function.").

ZOOM is defined as “to move rapidly: *comets that zoom through space.*”³¹ Applicant’s and Registrant’s marks connote swift and energetic software for carrying out their overlapping purposes, i.e., calendaring, and, as a result, the marks engender similar commercial impressions. Thus, we find that the marks have similar connotations and commercial impressions to the extent that they share the term ZOOM.

Applicant implicitly concedes that the first term in each mark is dominant, but argues that the “second word of each mark is equally important” and that “the differences in the two words ‘CALENDAR’ and ‘REHEARSE’ significantly contribute to different connotations for the two marks.”³² Applicant maintains that, simply put, the words CALENDAR and REHEARSE “were just ignored”³³ and that, when the marks are considered as a whole, the ZOOM CALENDAR mark “clearly messages that the goods are for calendaring software” and that ZOOM REHEARSE connotes that it is for “‘rehearsing,’ – that is replicating – user activity in the registrant’s software in a test environment to ensure the software service functions properly.”³⁴

Applicant’s arguments are not persuasive. While we acknowledge that each mark includes a second term, the second term of each mark is descriptive of the services offered under it and, as a result, has less source-identifying significance. Contrary to Applicant’s argument, the descriptive nature of the terms CALENDAR and

³¹ April 4, 2023 Office Action at TSDR 11 (AMERICAN HERITAGE DICTIONARY definition) (emphasis in original).

³² 4 TTABVUE 12 (“The second word of each mark is equally as important, albeit not dominant, when appreciating the commercial impression of the mark.”).

³³ 7 TTABVUE 3.

³⁴ *Id.* at 3.

REHEARSE reinforces the dominant nature of the shared first term ZOOM and they are insufficient to render the marks dissimilar in their entireties.

In support of their respective positions, Applicant and the Examining Attorney each cite several cases involving marks which share a common term. As the differing outcomes of these cases indicate, there is no general rule regarding likelihood of confusion in such cases, rather each case must be decided on its particular facts. Applicant cites, for example, *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004),³⁵ in which the Federal Circuit reversed the Board's decision sustaining Shen's opposition to Ritz Hotel's application to register THE RITZ KIDS for clothing items based on likelihood of confusion with Shen's mark RITZ for kitchen textiles (including barbeque mitts). Among its reasons for reversal, the Federal Circuit stated:

We cannot sanction the [B]oard's dissection of [Ritz Hotel's] mark. While it is accurate that terms such as "the" and "kids" often have little impact on consumers, this is not universally true. In this case, for instance, "the" has elevated significance because of the well-known manner in which people refer to [Ritz Hotel] ... as "*The Ritz*" or "*The Ritz Hotel*," but not as "Ritz" or "Ritz Hotel." Therefore, "the" operates as an indicator of source in [Ritz Hotel's] mark even though it has diminished importance in most other marks. And, while "kids" is undeniably used to indicate that the product is geared toward children, it distinguishes [Ritz Hotel's] mark from Shen's; it is unlikely that consumers would mistakenly believe that Shen, the manufacturer of kitchen textiles, has expanded into children's clothing. In addition, the pronunciation of THE RITZ KIDS sounds like "The Rich Kids," leaving the impression of wealth, a concept tied strongly to [Ritz Hotel] ... and not associated in any way with Shen's RITZ mark.

³⁵ 4 TTABVUE 10.

Thus, taking into consideration the “appearance, sound, connotation, and commercial impression of the two marks,” we reverse the [B]oard’s finding that THE RITZ KIDS is similar to RITZ.

Id. at 1245 (citations omitted). A plain reading of the *Shen Mfg.* decision demonstrates unique circumstances regarding the public’s understanding of Ritz Hotel’s marks, such that the terms “the” and “kids” took on an elevated importance not normally encountered in trademark likelihood of confusion analyses. We therefore find the *Shen Mfg.* decision inapposite.

In further support of its arguments regarding the dissimilarity of the marks, Applicant relies on *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992) (holding that VARGA GIRL and VARGAS were not likely to be confused) and *Carefirst of Md., Inc. v. Firsthealth of the Carolinas, Inc.*, Opp. No. 91116355, 2005 TTAB LEXIS 406 (TTAB 2005) (holding that CAREFIRST and FIRSTCAROLINACARE are not likely to be confused).³⁶ These cases do not compel a different result, however, because the nature and structure of the marks compared in them differ in several important respects from the marks compared in this appeal. For example, in *Hearst Corp.*, the dominant term VARGA, while similar, is not identical to the registered mark VARGAS, and only the VARGA mark is followed by a second term, i.e., GIRL. Similarly, considering the CAREFIRST and FIRSTCAROLINACARE marks, it is obvious that the terms “care” and “first” appear in reverse order and that the geographic term CAROLINA appears in between the “first” and “care” elements of

³⁶ *Carefirst* is not designated as precedent.

one of the marks. These differences render *Hearst Corp.* and *Carefirst of Md.* inapposite. In any event, regardless of any similarities or differences, it is well settled that each case must be decided on its own facts and the Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001).

C. Balancing the Factors and Conclusion as to Likelihood of Confusion

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. Weighing the *DuPont* factors for which there has been evidence and argument, *Charger Ventures*, 64 F.4th at 1384, we find that Applicant's Class 9 and 38 goods and services, respectively, are related to those of the cited registration. With regard to Applicant's services identified in Class 42, we find that Applicant's and Registrant's identified services are legally identical. As a result, the second factor weighs in favor of a finding of likelihood of confusion as to Applicant's Class 9 and 38 goods and services, and heavily so as to the services identified in Class 42. The channels of trade and the classes of purchasers overlap, so the third *DuPont* factor weighs in favor of a likelihood of confusion. We find that the marks are similar due to the shared term ZOOM, thus the first *DuPont* factor also weighs in favor of finding a likelihood of confusion. Here, each factor weighs in favor of finding confusion and none weigh against it. Accordingly, we find that confusion is likely.

Decision

The refusal to register Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is affirmed as to all classes.