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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/519745

APPLICANT: ZOE International Ministries



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

CORRESPONDENT ADDRESS:

Ken Dallara
Law Office of Ken Dallara
Suite 100
2259 Ward Ave
Simi Valley CA 93065

MARK: ZOE

CORRESPONDENT'S REFERENCE/DOCKET NO: ZOE

CORRESPONDENT EMAIL ADDRESS:

kdallara@dallaralaw.com

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF FACTS

On November 18, 2004, Applicant, ZOE International Ministries applied to register the proposed mark ZOE (and design)¹ for language instruction, religious instruction services, vocational education, production of radio and television programs, production & distribution of motion pictures, presentation of live show performances, and publishing of books, magazines, and newspapers; and charitable services, namely, housing for children.

In the first office action, dated June 24, 2005, the undersigned examining attorney refused

¹ Applicant's brief at page 2 states that its mark was originally filed as a standard character mark, but was changed to a design mark after communication between the Examiner and Applicant's attorney of record. In fact, the applicant's initial application contained a stylized drawing, but the application incorrectly stated that the mark was in Standard Character form. Thus, the record was amended to reflect that the mark was not Standard Character.

registration on the grounds that the proposed mark is likely to be confused with the Registration Number 2839818, ZOE for “providing assistance to public and private entities, namely assisting entities in identifying and acquiring grant-funding; providing professional assistance and technical assistance to social service entities, namely, helping such entities with charitable fundraising; providing charitable fund raising services; providing educational scholarships and fellowships; administration of philanthropic programs in the nature of grant funding, placement of fellows in educational programs; administration of charitable fund raising; administration of educational scholarship programs; consultation services in the field of personal finances and personal financial management” in International Class 36. In addition, the first office action refused the specimen, the recitation of services, the classification in International Class 35 and requested a translation of the mark.

The applicant responded on December 24, 2005. Through its response, the applicant added a translation to the record, submitted a new specimen that was accepted by the Examiner and amended the recitation of services to “providing temporary housing accommodation for children and young adults/arranging temporary housing accommodations for children and young adults, charitable services, namely, providing food, clothing and housing to needy persons, emergency shelter services, namely, providing temporary housing, clothing and food, providing temporary accommodation” in international class 43; and “language instruction, religious instructional services, vocational education in the field of husbandry, and basic home building skills, charitable services, namely, providing training in the field of languages, religion and hygiene skills,

development and dissemination of educational materials of others in the field of languages, religion and hygiene skills, education services, namely, providing classes in the field of languages, religion and hygiene skills, production of radio and television programs, publication of books, of magazines, of journals, of newspapers, of periodicals, of catalogs, of brochures, charitable services, namely, providing arts and crafts and educational materials to needy and underprivileged children, and presentation of live show performances” in International Class 041.

On July 4, 2006, the refusal under Section 2(d) of the Trademark Act was made final. The applicant filed its brief with the Board on February 6, 2007. On April 16, 2007, this case was remanded to the Examining Attorney for issuance of an Office action to address the recitation of services as amended by the applicant’s response on December 24, 2005. The amended recitation was adopted erroneously. The Examiner issued an office action on April 23, 2007, addressing the fact that the amended recitation adopted goods outside the scope of the initial application. The applicant responded on April 25, 2007 adopting the examiner’s suggestion, namely, “language instruction, religious instructional services, vocational education in the field of husbandry and basic home building skills; charitable services, namely, providing training in the field of languages and religion; production of radio and television programs; publication of books, magazines, and newspapers; presentation of live show performances” in International Class 41 and “Charitable services, namely, providing housing to needy children; emergency shelter services, namely, providing temporary housing for children; providing temporary accommodations for children” in International Class 43. The file was returned to the Board on May 23,

2007 for continuance of the issue on appeal. The examining attorney now files this reply brief and respectfully requests the Board to affirm the refusal to register under Section 2(d) of the Trademark Act.

ISSUE ON APPEAL

Whether the proposed mark, ZOE and design is likely to be confused with the registered mark ZOE.

ARGUMENT

I. Applicant's stylized mark is likely to be confused with the registrant's standard character mark bearing the same wording.

Although the applicant's mark contains a slight design element, the word portion of both the applicant's proposed mark and the registrant's mark is "**ZOE.**" The applicant claims however that its mark is distinctively different. When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. Therefore, the word portion is normally accorded greater weight in determining likelihood of confusion. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976); TMEP §1207.01(c)(ii). In this case the word portion, ZOE is identical in both marks. The applicant seeks to draw a major distinction between the two marks by over emphasizing the logo in the applicant's mark.

In considering the likelihood of confusion between marks, the examining attorney must consider the overall commercial impression of the marks. See *Long John Distilleries, Ltd. V. Sazerac*, 426 F.2d 1406 (CCPA 1970). The applicant argues that because its proposed mark is the Greek word for “life” with an elliptical band symbolizing the circle of life, its mark is distinctive. The applicant also maintains that the registrant uses the term ZOE only in connection with its company name, “Zoe Life Enrichment Program.” The applicant’s argument is not convincing. While it may be true that the registrant uses the word ZOE in connection with its organization’s name, the determinative issue is the mark on the registration. Moreover, the applicant’s statement as to how the registrant uses its mark is self-serving and is of little probative value.

Applicant also argues that its mark is a symbol recognized by those in need of the applicant’s services. Applicant’s Brief, p. 4. The applicant goes on to say that the targeted users of its services are “poor, impoverished, uneducated young people whose language is not necessarily English or Greek.” Applicant’s Brief, p. 4. The applicant’s argument is not plausible, because it is even more likely that uneducated people would be confused by two highly similar marks bearing identical wording. The term “ZOE” in both marks is clearly dominant. The slightly stylized type and circle design of the applicant’s does not create a dominant commercial impression that would be recalled by the public. Apart from the wording ZOE, the applicant’s mark would merely be a geometric shape, not a distinguishable design element. Thus, even if the users of the applicant’s service are illiterate, it is presumed that the three-letter word ZOE is the actual symbol that the non-reader would recognize. In this context, the registrant’s

identical word ZOE would likely be confused if encountered by the applicant's customers. On the other hand, the applicant points out that its customers are not solely poor and unlearned children in need of housing, but that it also solicits donations from individuals desiring to give donations to homeless abused children around the world, which are presumably educated consumers. Therefore, the applicant's argument that its services are targeted to the uneducated is not fully supported by its own concession.

II. APPLICANT'S SERVICES ARE LIKELY TO BE CONFUSED WITH THE REGISTRANT'S SERVICES.

It is well settled that the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Furthermore, likelihood of confusion is determined on the basis of the goods or services as they are identified in the application and the registration. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil*

Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Since the identification of the registrant's goods and/or services is very broad, especially "providing charitable fund raising services," it is presumed that the registration encompasses all goods and/or services of the type described, including those in the applicant's more specific identification, namely, "charitable services, namely, providing housing to needy children; emergency shelter services, namely, providing temporary housing for children; providing temporary accommodations for children," and that they move in all normal channels of trade and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re Optica International*, 196 USPQ 775 (TTAB 1977); TMEP §1207.01(a)(iii). Moreover, The examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). TMEP §1207.01(a)(v).

Applicant argues that its services are also distinctive. The applicant's argument is without merit. The applicant claims that the registrant's mark is "aimed at entities looking to write grants," while the proposed mark is "on the front line providing services." Applicant's Brief, p. 4. The applicant ignores the fact that the registrant provides direct assistance in the form of educational scholarships and charitable fund raising services in addition to assisting entities with acquiring grant funding. Thus, the direct services provided by the registrant are related to those provided by the applicant.

In particular, the registrant's broad recitation "charitable fund raising services" could include services provided by the applicant, e.g., providing housing to needy children; emergency shelter services, namely, providing temporary housing for children and providing temporary accommodations for children. In fact, a page from the applicant's website (attached to the final office action) shows the applicant is also a charitable fundraiser. The website has a link that reads "Donate Online." Thus, the applicant not only provides housing, but the applicant also raises money for charitable purposes. Moreover, both the applicant and the registrant provide educational services.

As evidence of the relatedness of the services, the examining attorney attached registrations to the final office action, which indicate single registrants provide the services that both the applicant and the registrant provide under the same mark. For example services like those provided by the registrant, charitable fundraising and services like those provided by the applicant, fundraising for education, training, and temporary housing/shelter are provided under the same marks (see Reg. Nos. 22880156, 2891820, 2949485 and 2740408, each owned by the same registrant). Also, single registrants also raise donations for charities and non-profit education and housing in addition to making grants and monetary donations for education and housing under the same mark (Reg. Nos. 2861358, 2962609 and 2960732, each owned by the same registrant). Single registrants also provide charitable fundraising services, vocational training and temporary housing under the same mark (See Reg. Nos. 2749688, 2915706, 3033437 and 2841427). These registrations have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely charitable fundraising services and/or educational services and temporary housing and/or grant funding, are of a kind that may

emanate from a single source. See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). Thus the applicant's claim that the services are unrelated cannot be sustained.

In its brief, the applicant compares its organization's mission statement with that of the registrant's mission statement². The applicant's brief ignores the actual recitation of services, which is the underlying basis for the likelihood of confusion refusal. Even assuming the mission statements are relevant, they support the likelihood of confusion. For example, as indicated by the applicant, the registrant's mission statement is to "empower churches and ministries," while the applicant's organization is an International Christian organization. Thus, the two entities share a common field. Further, the registrant's funding areas, according to the applicant's brief are "educational enlightenment and social improvement." See Applicant's Brief, p. 2. Likewise, the applicant targets social improvement and education in that it is an "effective participant in ending human trafficking of children worldwide." Applicant's Brief, p. 3. In providing for the basic necessities of life, the applicant provides education for children. Id. Therefore, it is apparent from the mission statements that both the applicant and the registrant's services overlap. Further, as pointed out in the Final Office action, the applicant provides a link to UNICEF on its website. UNICEF like the applicant protects children from violence, exploitation and abuse through its charitable fundraising efforts

² In fact, the source of the registrant's mission statement provided by the applicant is not provided. The applicant provided the mission statement for the first time in its' brief. See Applicant's Brief, p. 2.

(see the excerpt from UNICEF's website attached to the Final Office action). Yet, UNICEF, like the registrant provides charitable fundraising services as well.

Moreover even if the services are not identical, any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The services herein are well within the registrant's logical zone of expansion.

III. APPLICANT'S CHANNELS OF TRADE ARE THE SAME AS REGISTRANT'S CHANNELS OF TRADE.

Applicant argues the three market factors under the Lanham Act, (1) degree of similarity, (2) similarity in marketing methods and (3) characteristics of prospective purchasers are not met in this case. The applicant markets its charitable services to individual donors just as the registrant does. In addition, the registrant provides scholarships and educational services, while the applicant provided educational services. Thus the services travel in the same channels of trade and are available to and marketed to the same consumers. Consumers who are familiar with the applicant's use of ZOE upon encountering the registrant's mark for related services are likely to be confused. The

Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Banff Ltd., v. Federated Department Stores*, 6 USPQ2d 1187 (2d Cir. 1988); *Fisons Horticulture v. Vigoror Industries*, 31 USPQ2d 1592 (3d Cir. 1994). Furthermore, even if the registrant only marketed its services to churches and ministries, as the applicant alleges, confusion would be likely because these churches/ministries are not necessarily sophisticated in trademarks and could mistake the applicant's proposed mark with the registrant's mark. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii). Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

Finally, applicant alleges that the owner of the registration is the subject of theft, corruption, and criminal indictments. The applicant's assertion is without foundation and is neither relevant nor supported by the record. Applicant's Brief, p. 6. In addition, applicant argues the registrant's website is no longer operable, but fails to provide proof of it. The applicant's argument in this regard is also without foundation. Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the

Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration such as a registrant's nonuse of the mark. See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n. 5 (TTAB 1992); *In re White Swan Ltd.*, 8 USPQ2d 1534 (TTAB 1988); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988). The arguments pertaining to the registrant's website and personal corruption are not relevant and should not be considered by the Board. Moreover, if the Board was inclined to consider the evidence, the examiner notes that the record is void of any documentation to support the allegations.

CONCLUSION

Applicant's mark and the registrant's mark are highly similar because the word portion of both marks is identical. The only difference between the two marks is the elliptical design around the wording in the registrant's mark. The applicant's services and the registrant's services are identical, in part, and highly related. Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974). Accordingly, the Examining Attorney respectfully requests that the Section 2(d) refusal be affirmed.

Respectfully submitted,

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Gina Hayes
Trademark Examining Attorney
U.S. Patent and Trademark Office
Law Office 112
571-272-9407

Angela Bishop Wilson
Managing Attorney
Law Office 112

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