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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZOE International Ministries

Serial No. 78519745

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Gina Hayes, Trademark Examining Attorney, Law Office 112
(Angela Bishop Wilson, Managing Attorney).

Before Drost, Zervas and Bergsman, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On November 18, 2004, ZOE International Ministries
filed an application (Serial No. 78519745) to register the
mark



on the Principal Register for services ultimately
identified as,

"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.

Applicant has entered a translation statement in its application providing that an English translation of the Greek word "zoe" is "life."

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of Registration No. 2839818 for the mark ZOE (in typed form, registered May 11, 2004) 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.

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is affirmed.

Our determination of the examining attorney's refusal to register the mark under Section 2(d) of the Trademark Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We first consider the similarity or dissimilarity of the marks. Specifically, we consider whether applicant's mark and the registered mark, when viewed in their entirety, are similar in appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve*

Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The only wording in both applicant's and registrant's marks is the term ZOE. Applicant has stated at p. 3 of its brief that "[s]ound is conceded to be the same." It has been consistently held that similarity in any one of the elements of sound, appearance or meaning is sufficient to support a finding of likelihood of confusion. See *Krim-Ko Corporation v. The Coca-Cola Company*, 390 F.2d 728, 156 USPQ 523 (CCPA 1968). Additionally, ZOE dominates over the design component of applicant's mark for two reasons. First, as the literal portion of applicant's mark, purchasers will use ZOE to recall the mark and purchase the services. *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). Second, the design component of applicant's mark is not particularly distinctive. Thus, we find that the marks are identical in meaning, sound and commercial impression, and highly similar in appearance, differing only by the inclusion of the design component of applicant's mark.¹

¹ Applicant's argument at p. 3 of its brief that the registered mark is in "plain text" is not valid; because the registration is in typed form, registrant may display its mark in the same lettering style as applicant displays its ZOE letters. See, e.g., *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The *du Pont* factor regarding the similarity of the marks therefore supports a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity and nature of the services as described in the application and cited registration. It is settled that it is not necessary that the services be identical or even competitive in order to find that the services are related for purposes of our likelihood of confusion analysis. It is sufficient that the services be related in some manner, or that the circumstances surrounding their marketing be such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. See *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

Additionally, applicant's argument regarding the manner in which registrant uses its mark (in connection with "the company title of Zoe Life Enrichment Program") is without merit because the registration does not include "Zoe Life Enrichment Program" in the mark. Also, we are not persuaded by applicant's argument that the mark is connotative of life, at least in part because the logo "contains the circle of completeness of ZOE," i.e., life. The typical consumer of applicant's services would not translate the mark and would not recognize the simple band in applicant's mark as a representation of the "circle of life."

(TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Registrant's identification of services includes "providing educational scholarships" and "administration of scholarship programs" and applicant's International Class 41 identification of services includes "language instruction" and "vocational education in the field of husbandry." There is a direct relationship between applicant's and registrant's services because scholarships are given so that one may obtain educational services and because they would be provided to the same persons at the same time.

Additionally, the examining attorney has submitted various use-based third-party registrations with her final Office action which suggest that various trademark owners have adopted a single mark for services of the kind that are identified in both the application and the registration. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). The following registrations are relevant:

Registered to Olive Crest Treatment Centers:

Registration No. 2749688 for ONE LIFE AT A TIME for, inter alia, "charitable fundraising services" and "providing temporary housing"; and

Registration Nos. 2915706 and 3033437 for MAKING A DIFFERENCE IN THE LIVES OF CHILDREN AND FAMILIES and TODAY'S CHILD IS TOMORROW'S HOPE, respectively, both for, inter alia, "charitable fundraising services," "vocational training classes for children and adolescents" and "emergency shelter services, namely providing temporary housing."

Registered to Children of Promise International:

Registration No. 2841427 for PROMISE TEAMS for, inter alia, "charitable fundraising, namely, providing financial assistance for orphans, widows and needy children" and "charitable services, namely ... temporary housing."

Registered to Plan International, Inc.:

Registration Nos. 2891820 and 2949485 for PLAN and Design and for PLAN BE A PART OF IT and Design, respectively, both for, inter alia, "charitable fundraising," "providing formal and informal education services and skills training for needy children, their families and communities, namely primary and secondary schooling ... agriculture and animal husbandry workshops" and "emergency shelter services, namely providing temporary housing or shelter."

Registered to Shelter for Abused Women:

Registration No. 2740408 for a Design for, inter alia, "charitable fundraising," "emergency shelter services, namely providing temporary housing." ²

² The remaining handful of third-party registrations submitted by the examining attorney do not recite any of the services from both applicant's and registrant's identifications of services.

Based on the forgoing, we find that there are at least viable relationships between registrant's charitable fund raising services, and applicant's International Class 41 vocational education services and International Class 43 temporary housing services.³

Applicant has argued that the registered mark "is used in connection with an organization that provides assistance to entities" while applicant provides housing internationally for children of abuse and neglect and educational and religious services, and that the "users of this service are poor, impoverished, uneducated young people whose language is not necessarily English or Greek." Applicant concludes that "the two services ... have no competing value nor would their chain of commerce ever cross as the Mark 'ZOE' is not associated with the grants

³ The examining attorney has not argued that a relationship exists between applicant's "production of radio and television programs; publication of books, magazines, and newspapers; presentation of live show performances" and registrant's services. We may find a likelihood of confusion, however, when only one item in a class of services is commercially similar to registrant's services. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) ("[L]ikelihood of confusion must be found if the public, being familiar with appellee's use of MONOPOLY for board games and seeing the mark *on any item that comes within the description of goods set forth by appellant in its application*, is likely to believe that appellee has expanded its use of the mark, directly or under a license, for such item ..." (emphasis added)).

once they are funded." Brief at p. 4. Applicant's argument is not well taken because registrant's identification of services does not limit all of registrant's services to entities or exclude individuals. Also, applicant's services are not limited to individuals. Certainly, individuals would use some of registrant's services, and, as discussed *infra*, entities would purchase applicant's services. Further, goods and services do not have to have some "competing value" to be related for purposes of the likelihood of confusion analysis.

Thus, we resolve the *du Pont* factor regarding the similarity of the services for both applicant's International Class 41 and 43 services against applicant.

We now consider the trade channels and classes of purchasers of both applicant's and registrant's services. Neither applicant's nor registrant's identifications of services contain any specific trade channel limitations. If there are no trade channel limitations, we presume that registrant's and applicant's identifications of services encompass all services of the nature and type described, and that the identified services move in all channels of trade that would be normal for such services, and that they are available to all classes of purchasers for the

described services. See *Linkvest*, 24 USPQ2d at 1716; *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

The trade channels and classes of purchasers for applicant's International Class 41 "language instruction" and "vocational education in the field of husbandry and basic home building skills" are identical to registrant's "providing educational scholarships." There certainly is a cost for language instruction and vocational education services, and those who desire such services and do not have the necessary funds would look for educational scholarships, perhaps even from the institution providing such services. The marketing of the services would be to the same individuals and through the same media as the marketing of the educational services, and would be targeted to the general population seeking language instruction and/or a vocational education.

As for applicant's International Class 43 charitable services regarding training in languages and religion as well as in providing housing and temporary accommodations for children and registrant's services relating to fundraising, applicant maintains that "the markets [are] different, getting money versus giving money, [and] the buyers are different - entities versus individuals, basically it is the givers versus the receivers." Brief at

p. 5. Applicant's argument is not persuasive because service organizations involved in placing children that are victims of abuse and neglect in temporary shelters and/or matching needy individuals with entities providing language instruction and vocational education, would also require registrant's charitable fund raising services and/or grant-funding services. Thus, we reject applicant's "givers versus the receivers" argument and find that in certain cases, the same organizations requiring applicant's services would require registrant's services. Consequently, both applicant's and registrant's marketing efforts would be directed to the same entities.

In view of the foregoing, the *du Pont* factors regarding trade channels and classes of consumers are resolved against applicant for both its International Class 41 and 43 services.

With regards to the *du Pont* factor regarding the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing, we agree with applicant that purchases of both applicant's and registrant's services would be made with some care. The selection of a home for needy children, whether it be by family members, government entities or social service organizations, would certainly be made with care. If not

made by family members, such selections would likely be made by an individual with some training or expertise, mindful of a variety of considerations including the needs of the children. Thus, selections of housing providers would be done by those with some level of sophistication and also with care. With respect to the International Class 41 services, and particularly applicant's "language instruction and vocational education in the field of husbandry and basic home building skills," we know of no reason why those seeking such services would have as much sophistication or spend as much time in selecting providers of such services, or even that the cost of such services demands that greater care be taken in making purchasing decisions. With respect to registrant's related services, i.e., providing educational scholarships, the time and effort needed to obtain such scholarships and fellowships is not inconsiderable, and would require interaction with registrant, which reduces the likelihood of source confusion.

Upon considering the above, including the different levels of purchaser sophistication and the different degrees of purchaser care for those services discussed in applicant's International Class 41 and 43 identifications, we resolve the *du Pont* factor regarding purchaser

sophistication and conditions of purchase in applicant's favor. For the reasons discussed in the preceding paragraph, this factor only weighs slightly in applicant's favor for those International Class 41 services. For the International Class 43 services where greater care is taken and some purchaser sophistication can be presumed, we also weigh this factor only slightly in applicant's favor because the wording in both marks is identical and the services are related, and because even the sophisticated purchasers are likely to be confused as to the source of applicant's and registrant's services. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962) (even sophisticated purchasers are not necessarily immune from source confusion); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Upon consideration of all of the relevant *du Pont* factors discussed above, as well as the evidence of record and the arguments of the examining attorney and applicant, we conclude that when purchasers who are familiar with registrant's mark for its claimed services encounter applicant's mark on its International Class 41 and 43 services, they are likely to be confused as to the source of such services. Although we have stated that the *du Pont* factor regarding the sophistication of purchasers and the

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conditions under which and buyers to whom sales are made weighs slightly in applicant's favor, they are not sufficient to outweigh our findings on the other *du Pont* factors which do not favor applicant.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed for both the International Class 41 and 43 services.