

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 5, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Zoom Media Group Inc.
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Serial No. 85740217
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Gregory T. Ourada of Hill Kertscher & Wharton LLP,
for Zoom Media Group Inc.

Katina J. Joiner, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Cataldo, Greenbaum and Lynch,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

I. Background

Zoom Media Group Inc. (“Applicant”) seeks registration on the Principal Register
of the mark ZOOM in stylized form displayed as

**ZO
OM**

for

Advertising material for others, namely, printed publications in the nature of pamphlets, samples, flyers and brochures in the fields of music, film, consumer products and services; stickers, drawing boards, cardboard, paperboard, cards, boxes, paper and cardboard posters, paper signboards, in International Class 16;

Distribution of advertising and marketing materials to promote products and services, music, video; Advertising and marketing services for others, namely, advertising display services for others, providing advertising space for others, preparing, placing and transmission of advertisements for others on digital signage, digital displays, online electronic communication networks and closed circuit video network, and via printed publications, television, radio, Internet, text message, posters, billboards, signboards, pamphlets, flyers, brochures, stickers, boards, cardboard, paperboard, cards, boxes, cassettes, cellular telephones, and videos and digital films; consultation services related to advertising design, advertising campaigns for others, commercial messages, advertising posters, advertising mail, and advertising communication programs aimed at others; development, operation and administration of audio and video digital signage systems for others, namely, providing advertising space by electronic means; rental services for others for advertising space; distribution of advertising and promotional material and product samples for others, namely, via printed publications, television, radio, Internet, text message, posters, billboards, signboards, pamphlets, flyers, brochures, stickers, boards, cardboard, paperboard, cards, boxes, cassettes, cellular telephones, and videos and digital films; Production of advertising materials intended to be posted in any way or on any type of medium, in International Class 35;

Broadcasting services, namely, transmission of media advertising communications and mobile media services in the nature of electronic transmission of entertainment media content via digital communications networks, and broadcasting of advertising material for others, namely, via billboards, television, radio, Internet, text message, cellular telephones, and videos and digital films; consultation related to broadcasting of advertising messages, in International Class 38;

Printing services for others of advertising material intended to be posted in any way or on any type of medium, in International Class 40; and

Distribution of television programs for targeted communal audiences, in International Class 41.¹

The Trademark Examining Attorney has refused registration of Applicant's mark in each International Class under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered mark ZOOM in stylized form displayed as



for various telecommunications and broadcasting services in Class 38 and various entertainment services in Class 41.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and Applicant filed a brief. Then, the Examining Attorney requested remand to issue a subsequent refusal based on the

¹ Application Serial No. 85740217 was filed on September 27, 2012, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) of the Trademark Act. Applicant filed a Statement of Use on March 10, 2015, claiming first use anywhere and use in commerce since at least as early as January 3, 2013 for each class of goods and services. The description of the mark reads: "The mark consists of the letters 'ZO' and the letters 'OM' underneath." Color is not claimed as a feature of the mark.

² Registration No. 4743814 issued on May 26, 2015. The description of the mark reads: "The mark consists of the word 'ZOOM,' with both letter 'O's as spheres, and the right sphere as larger than the left." Color is not claimed as a feature of the mark.

specimens, which the Board granted. On remand, the Examining Attorney maintained and continued the Section 2(d) refusal, and partially refused registration of Applicant's mark under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, because the specimens do not show use of the mark on or in connection with the identified goods and services in International Classes 16, 38, 40 and 41.³

When the subsequent refusal was made final, the Board resumed proceedings.⁴ Applicant then filed a supplemental appeal brief that incorporated the original brief in its entirety and added a section on the specimen refusal, the Examining Attorney filed a brief, and Applicant filed a reply brief.

We affirm the Section 2(d) refusal as to the services in Classes 38 and 41, and reverse the refusal as to the goods and services in Classes 16, 35 and 40. In addition, we affirm the specimen refusal as to the goods in Class 16 and the services in Classes 40 and 41, and reverse the refusal as to the services in Class 38. As noted above, the specimen refusal does not pertain to the services in Class 35.

II. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be

³ The refusal does not apply to the Class 35 services.

⁴ We do not consider Applicant's second Notice of Appeal, which Applicant filed after the Examining Attorney issued the Subsequent Final Refusal. Such filing was unnecessary, as the Board would have resumed proceedings upon issuance of the Subsequent Final, and would have permitted Applicant time to file a Supplemental Appeal Brief that addressed the new refusal.

considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key considerations are the similarities between the marks and the relatedness of the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). Applicant argues that the pertinent considerations under *DuPont* are these two key factors, the third *DuPont* factor regarding the channels of trade, the fourth *DuPont* factor regarding the conditions under which and buyers to whom sales are made, and the eighth *DuPont* factor, the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

A. The Similarity or Dissimilarity of the Goods and Services and Channels of Trade

Under the second and third *DuPont* factors, we base our evaluation on the goods and services as they are identified in the application and the services as they are identified in the cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Therefore,

Applicant's many arguments about the actual differences between its goods and services, channels of trade and targeted customers, and those of Registrant, have no bearing on these factors.⁵

1. Services in Classes 38 and 41

Here, the Class 38 services identified in the application include "broadcasting services, namely, transmission of media advertising communications and mobile media services in the nature of electronic transmission of entertainment media content via digital communications network" and the Class 38 services identified in the registration include "electronic transmission of entertainment media content via a global computer network, all related to the film industry." Applicant's aforementioned Class 38 services are broadly identified, with no limitation as to the type of "entertainment media content," and therefore must be presumed to encompass all types of such content, including content "related to the film industry," as set forth in Registrant's Class 38 services. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and

⁵ For example, Applicant contends that its "business is advertising and marketing" and it targets its goods and services to a "business enterprise seeking to reach particular customers, specifically those who patronize health and fitness clubs," while "Registrant is an 'Indian glamour and entertainment television channel primarily covering Bollywood and based in Mumbai' that is 'popular among young, urban audiences' and whose 'programming is distributed in the United States on DishTV Channel 715 and only appears to be available as part of a specific cable package that is highly tailored to appeal to Indian immigrants and Americans of Indian descent.'" App. Supp. Br., 13 TTABVUE 13-14. We cannot consider alleged marketplace realities not reflected in the identification of goods and services. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (affirming Board finding that where the identification is unrestricted, "we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods").

commercial furniture.”); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). We note that Applicant provides these services “via a digital communications network” and Registrant provides these services “via a global computer network,” but find that this does not differentiate the services. The underlying “electronic transmission of entertainment media content” services is identical. We therefore find that Applicant’s and Registrant’s services overlap and are legally identical.

Similarly, the Class 41 services identified in the application are “distribution of television programs for targeted communal audiences” and the Class 41 services identified in the registration include “distribution of television programming for others to cable, terrestrial or satellite television systems.” Although Applicant has limited its services to certain recipients, and Registrant has limited its services to certain methods of distribution, the limitations are not mutually exclusive and do not distinguish the services. Rather, the services are identified broadly enough to encompass each other in that both include distribution of television programming for others to cable terrestrial or satellite television systems for targeted communal audiences. The services therefore are legally identical. *See, e.g., In re Hughes Furniture Indus., Inc.*, 114 USPQ2d at 1137; *In re Linkvest S.A.*, 24 USPQ2d at 1716.

Because the Class 38 and Class 41 services in the application and cited registration include legally identical services, we need not further consider their relatedness. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335,

209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application).

Further, we presume that these legally identical services travel through at least some of the same channels of trade to the same class of purchasers, considerations under the third *DuPont* factor. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”); *see also In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

2. Goods in Class 16 and Services in Classes 35 and 40

We now consider Applicant’s Class 16 goods and Class 35 and Class 40 services, none of which are sufficiently related on their face to any of the Class 38 telecommunications and broadcasting services or Class 41 entertainment services identified in the cited registration. Nonetheless, “likelihood of confusion can be found ‘if the respective [goods and services] are 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 Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (citation omitted). To this end, the Examining Attorney made of record a few third-party use-based registrations to show that it is common for a single entity to register the same mark for goods and services that are the same as, or very similar to, those

at issue. While third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, such registrations that individually cover a number of different items and are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods and services are of a type which may emanate from a single source. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); *see also In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Here, there are only a few third-party registrations, and we find them only slightly probative of the relatedness of Applicant's Class 16, 35 and 40 goods and services to Registrant's Class 38 and 41 services.

The Examining Attorney also submitted a handful of websites to demonstrate that a single entity is likely to offer for sale under the same mark Applicant's Class 16 goods and Class 35 and Class 40 services, and Registrant's Class 38 and 41 services. If focused on the goods and services at issue, this type of evidence is probative of the relatedness of the goods and services because it demonstrates consumer exposure to the same source using the same mark for goods and services like those identified in the application and services like those identified in the registration. *See, e.g., In re C.H. Hanson Co.*, 115 USPQ2d 1351, 1355-56 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). Here, however, the websites are for advertising and marketing agencies that all offer essentially the same goods and

services as Applicant, but who do not appear to offer the types of services identified in the registration. This evidence therefore does not support a finding that consumers would expect a company that creates advertisements and marketing materials like Applicant to also provide transmission or broadcasting of advertisements for others, or to distribute television programming for others like Registrant.

On the totality of the evidence of record, the second and third *DuPont* factors favor a finding of likelihood of confusion in Classes 38 and 41, but not in Classes 16, 35 and 40.

B. The similarity or dissimilarity of the marks

Under this factor, we compare Applicant's and Registrant's marks "in their entireties as to appearance, sound, connotation and commercial impression." *Viterra*, 101 USPQ2d at 1908 (quoting *DuPont*, 177 USPQ at 567). *See also Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). In comparing the marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs.*, 101 USPQ2d at 1721 (quotation omitted). Further, marks "must be considered ... in light of the fallibility of memory" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)). The proper focus is on the recollection of the average purchaser, who normally retains a general rather than

a specific impression of trademarks. *See St. Helena Hosp.*, 113 USPQ2d at 1085; *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971).

Applicant argues that the differences in the marks' appearance are sufficient to distinguish them, and that the marks create different commercial impressions, with "both letter "O's" in Registrant's mark appearing "as spheres, and the right sphere as larger than the left, somewhat resembling a cartoon character's eyeballs, evoking a playful, cartoonish motif," while Applicant's mark "conveys a more formal and modernistic theme." App. Supp. Br., 13 TTABVUE 5-6. The Examining Attorney focuses on the identity of the literal element ZOOM in each mark, which she contends outweighs any differences in stylization or designs present in the marks. We agree with the Examining Attorney.

Because the similarity of the marks is determined based on the marks in their entireties, our analysis is not predicated on dissecting the marks into their various components. *Stone Lion*, 110 USPQ2d at 1161; *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). On the other hand, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Looking at the marks in their entireties, the identical literal term ZOOM stands out as the most prominent element, conveying the strongest commercial impression, in each mark. This creates similarity between the two marks in sight, sound, and meaning.

While both marks include elements of stylization or design, generally, it is “the verbal portion of a word and design mark [that] will be the dominant portion.” *Viterra*, 101 USPQ2d at 1911; *see also CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) (“[T]he verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.”). We find that to be the case here, where the stylization and design in the marks highlight rather than overwhelm or detract from the wording. The stylization in Applicant’s mark is not remarkable, and is more in the nature of a simple layout choice, where the letters ZO and OM may be read either left to right or top to bottom. In the case of Registrant’s mark, where the letters “O” are described “as spheres, and the right sphere as larger than the left,” the display of the mark evokes a feeling of speed, thereby reinforcing the meaning of the word “zoom.”⁶ The stylization in Applicant’s mark and the design in Registrant’s mark would not be articulated, separate and apart from the literal terms of the marks. *See Viterra*, 101 USPQ2d at 1908 (normally according greater weight to the

⁶ “Zoom” is defined as “to move rapidly : comets that zoom through space” We take judicial notice of this definition from <https://www.ahdictionary.com/word/search.html?q=zoom> based on THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Ed. (2020), accessed on February 4, 2020. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

word in composite word and design marks because purchasers would use the word to request or refer to the goods or services).

When viewed in their entirety, we find the marks to be similar in appearance, sound, connotation, and commercial impression. This *DuPont* factor supports a finding of a likelihood of confusion.

C. Purchasing Conditions

Next, we address Applicant's contentions pertaining to consumer sophistication. This argument concerns the fourth *DuPont* factor, the "conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. In addition to arguing that Applicant and Registrant actually provide different goods and services to different targeted business customers,⁷ Applicant contends that advertising and broadcasting services are, by their nature, expensive, and the "relevant customers are, by virtue of their being business organizations, going to be more sophisticated than an individual person." Although there is no evidence about the cost of the goods and services identified in the application or the services identified in the registration, we acknowledge that some advertising and broadcasting services might be expensive. Nonetheless, the relevant customers are not necessarily sophisticated, and even in the business realm, consumers of advertising and broadcasting services (and the other goods and services involved in this appeal) would encompass individual entrepreneurs and small

⁷ These arguments actually pertain to the second and third *DuPont* factors, and we have addressed them above.

businesses. Thus, the goods and services may be offered to a broad range of individuals and businesses, with widely varying degrees of experience, care and sophistication, and we must consider the least sophisticated such consumer. *See Stone Lion*, 110 USPQ2d at 1163 (“Accordingly, the Board properly considered all potential investors for the recited services, including ordinary consumers seeking to invest in services with no minimum investment requirement. Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based ‘on the least sophisticated potential purchasers.’”).

This factor is neutral.

D. Actual Confusion/Length of Time of Concurrent Use

Applicant argues there have been “no documented actual confusion between the marks, despite a period of concurrent use.” App. Supp. Br., 13 TTABVUE 15. As evidence, Applicant points to: a Declaration from Louis-Phillippe Denis, Applicant’s Vice President of Legal Affairs, attesting to no actual confusion since 2011 between Registrant’s mark and Applicant’s mark and several other ZOOM-formative marks for some of the same goods and services identified in the application; ownership of a prior registration featuring the word ZOOM for advertising services in Class 35; and a consent agreement between Applicant and Registrant in Canada.⁸ This evidence is of little probative value.

⁸The Declaration and prior registration are attached as exhibits to Applicant’s November 21, 2016 Response to Office Action, TSDR pp. 27-37, and the Consent Agreement, with supporting materials, are attached as exhibits to Applicant’s July 12, 2017 Request for Reconsideration, TSDR pp. 6-25.

While Mr. Denis might not be aware of any instances of actual confusion between Applicant's and Registrant's marks since 2011, there is no evidence of record relating to the extent of use of Applicant's or Registrant's marks and, thus, whether there have been meaningful opportunities for actual confusion to have occurred in the marketplace. *See Cunningham*, 55 USPQ2d at 1847. Moreover, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." *Majestic Distilling*, 65 USPQ2d at 1205. *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-17 (TTAB 1984) (a claim of no "actual confusion as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding where we have no evidence pertaining to the nature and extent of the use by applicant and registrant" and "the registrant has no chance to be heard from"). *Cf. Guild Mortg.*, 129 USPQ2d at 1163-66 (requiring the Board to consider the applicant's "evidence of concurrent use of the two marks for a particularly long period of time—over 40 years—in which the two business operated in the same geographic market—southern California—without any evidence of actual confusion.").

The existence of Applicant's prior registration does not overcome evidence that a mark is now unregistrable. It is well settled that we must assess each application on its own record at the time registration is sought, and that we are not bound by the

decisions of examining attorneys in other cases. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement ... even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *see also In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (“The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.”); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“[D]ecisions regarding other registrations do not bind either the agency or this court.”).

Moreover, Applicant’s prior registration has been cancelled, and thus is not entitled to any of the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).⁹ *See Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) (“Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled.”); *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”).

⁹ Notwithstanding the foregoing, this application will register in Class 35 for the reasons discussed herein.

Finally, it is settled that when an applicant and registrant have entered into a consent agreement, that fact may play a critical role in the likelihood of confusion analysis. *See, e.g., In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071, 1072 (Fed. Cir. 1993) (holding that the consent agreement carries great weight); *Bongrain Int’l (Am.) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775, 1778 (Fed. Cir. 1987) (“We have often said in trademark cases involving agreements reflecting parties’ views on the likelihood of confusion in the marketplace, that they are in a much better position to know the real life situation than bureaucrats or judges and therefore such agreements may, depending on the circumstances, carry great weight....”). However, there is no agreement between Applicant and Registrant in the United States, and we will not infer that Registrant consents to registration of Applicant’s mark in the United States based on an agreement to coexist in Canada.

Accordingly, the eighth *DuPont* factor is neutral.

E. Conclusion—Likelihood of Confusion


On balance, after considering all of the arguments and evidence of record as they pertain to the relevant *DuPont* factors, we find that when considered in their entirety, the marks are similar in appearance, sound, connotation, and commercial impression, the services in Classes 38 and 41 include legally identical services that move in overlapping channels of trade, but the goods in Class 16 and the services in Classes 35 and 40 in the application are not sufficiently related to, and do not move in the same channels of trade as, the services identified in the cited registration, and

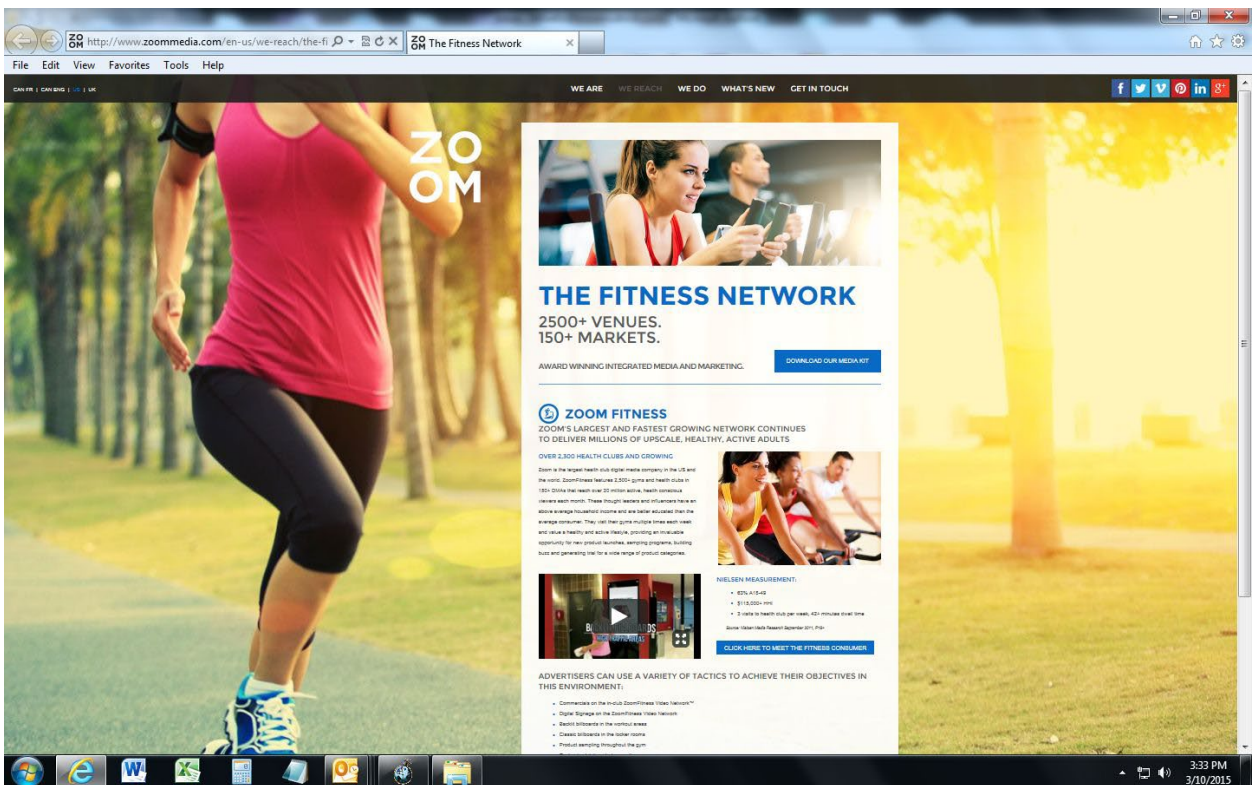
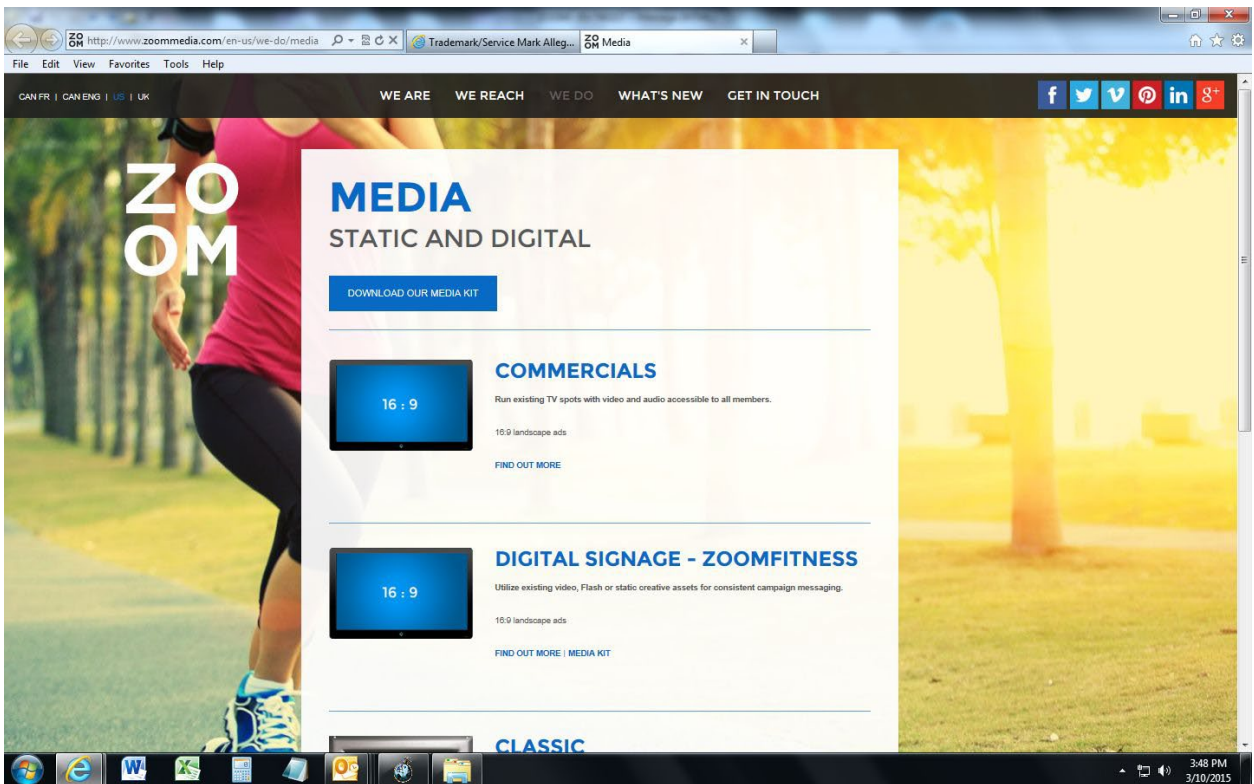
the fourth and eighth *DuPont* factors are neutral. We now turn to the specimen refusal.

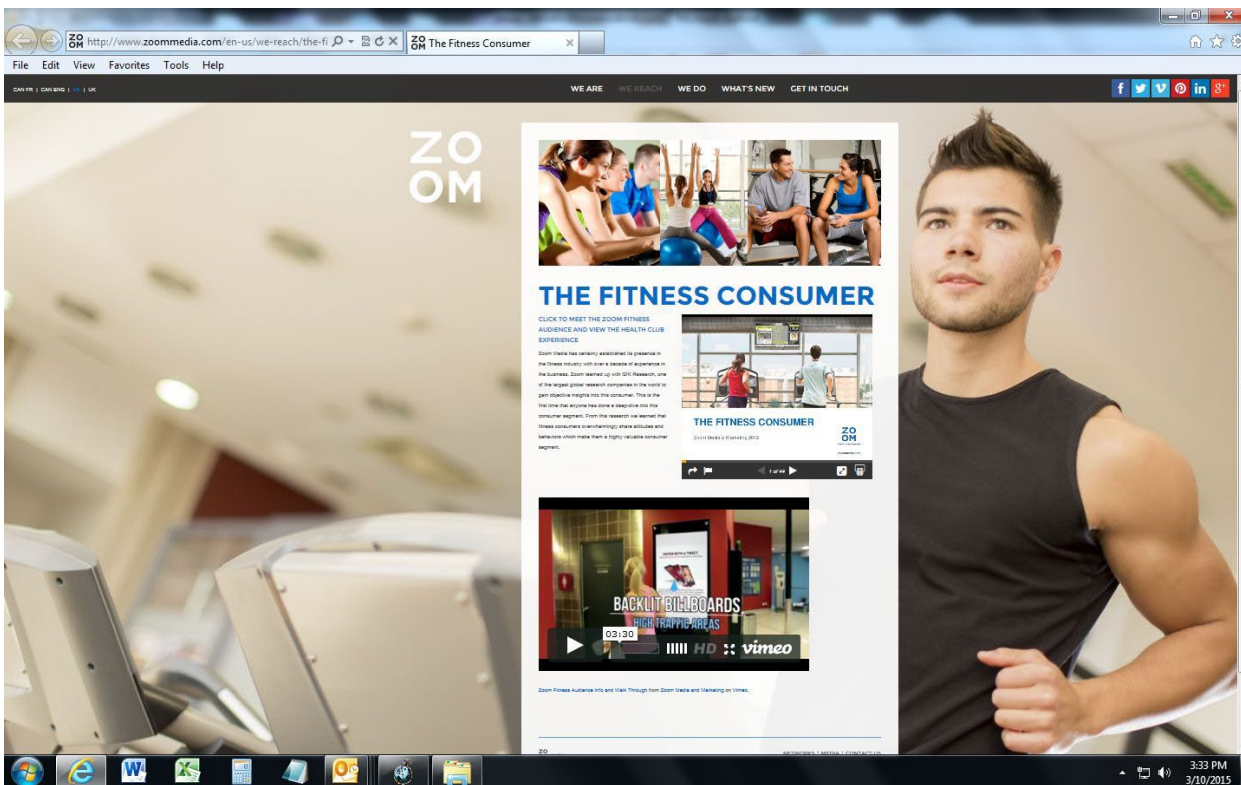
III. Failure to Show Use of the Mark for the Identified Goods and Services—Classes 16, 38, 40 and 41

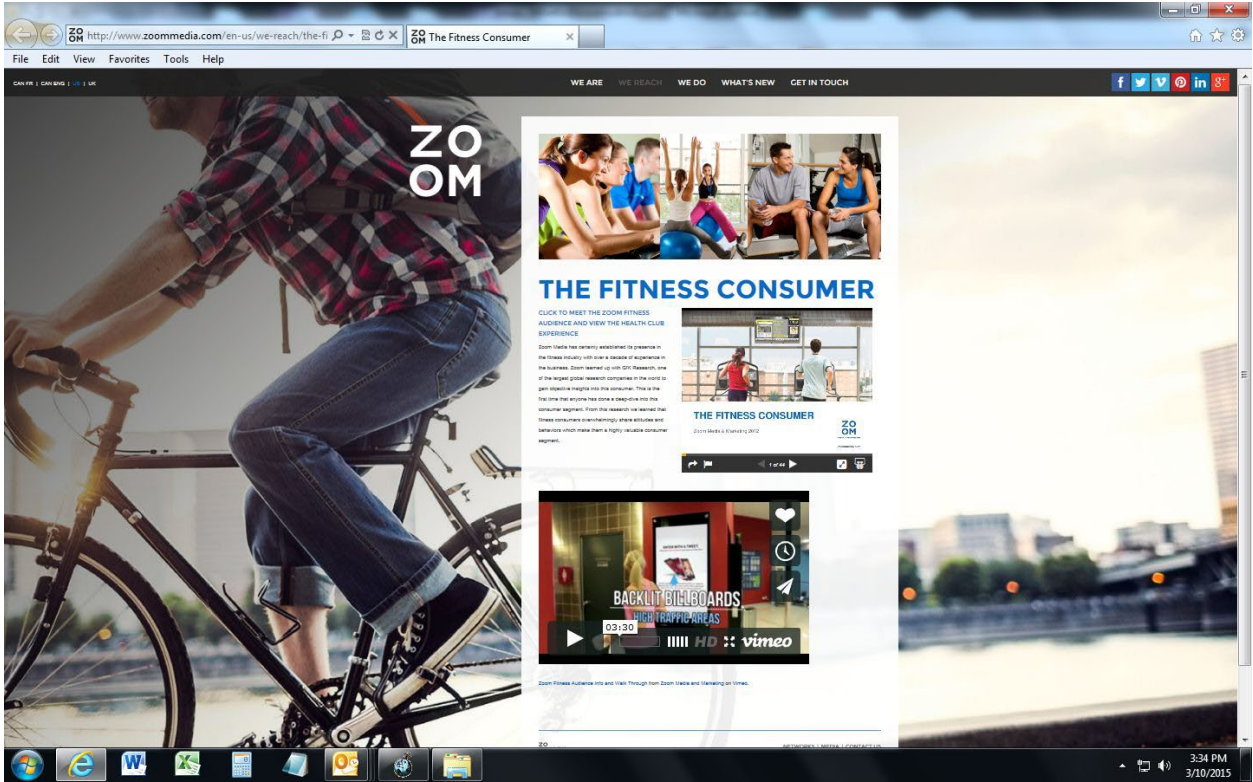
Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), requires an applicant to file a “specimen” or facsimile “of the mark as used in commerce.” *See also* Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a) (an applicant filing an intent-to-use application must file “one specimen ... showing the mark as used in commerce on or in connection with the goods or services.”).

Applicant submitted a Statement of Use consisting of five pages that appear to be

screenshots from Applicant’s website bearing Applicant’s mark . The five-page specimen is reproduced below:







In the Statement of Use, Applicant describes the first page of the specimen as “showing advertising for others through classic billboards” for the Class 16 goods; the second page as “showing distribution of advertising through digital signage” for the Class 35 services; the third page as “showing broadcasting of services through electronic transmission of media content” for the Class 38 services; the fourth page as “showing the mark for printing services for others through classic billboards and backlit billboards” for the Class 40 services; and the fifth page as “showing the mark through the distribution of television programs” for the Class 41 services.

The Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act on the ground that the specimens submitted for Classes 16, 38, 40 and 41 are unacceptable because, while they show use of the mark for Class 35

services, they do not show use of the mark for any of the goods identified in Class 16 or any of the services identified in Classes 38, 40 or 41.

Applicant argues that the references to “backlit billboards high traffic areas” on pages two through five are sufficient to support use for the “paper and cardboard posters [and] paper signboards” identified in Class 16 and the Class 40 “printing services for others of advertising material intended to be posted in any way or any type of medium.” Applicant also points to the fourth bullet, “Classic billboards in the locker rooms,” listed under the wording “Advertisers can use a variety of tactics to achieve their objectives in this environment” as additional evidence of use in Classes 16 and 40. As for Classes 38 and 41, Applicant argues that the wording “commercials” and “digital signage – ZOOMFITNESS” on the first page of the specimen shows use for the services in Classes 38 and 41, as the wording “specifically relates to ... transmission of media advertising communications ... and broadcasting of advertising material for others ... via ... television, ... videos and digital films.” Applicant also contends that the wording “commercials on the ZoomFitness Digital Network” “Digital Signage on the ZoomFitness Video Network” on page two shows use of the mark for the Class 41 “distribution of television programs for targeted communal audiences.” In particular, Applicant argues that “From the specimens, there is no doubt that ‘targeted communal audiences’ refer to fitness club patrons, and ‘television programs’ mean commercials and advertising content of the type shown by the specimens.” We turn first to the Class 16 goods.

A. Failure to Show Use of the Mark for the Identified Goods - Class 16

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a trademark is used in commerce when “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or the nature of the goods makes such placement impracticable, then on document associated with the goods or their sale” *See* Trademark Rule 2.56(a), 37 C.F.R. § 2.56(a) (“[A] statement of use under § 2.88 must ... include one specimen per class showing the mark as used on or in connection with the goods or services. When requested by the Office as reasonably necessary to proper examination, additional specimens must be provided.”); *see also* Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1) (“A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is impracticable to place the mark on the goods, packaging for the goods, or displays associated with the goods.”).

While the specimen shows the mark in connection with digital marketing and advertising services, and thus supports use in Class 35 (which is not subject to this refusal), it does not show the mark used on or with any of the printed advertising materials identified in Class 16, nor does it include any means to order the goods. *See In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1123 (Fed. Cir. 2009) (a web page that displays a product can constitute a “display associated with the goods” if it includes a picture or textual description of the goods, shows the mark in association with the goods, and provides a means to order the goods). The references to “backlit billboards

in the workout areas” and “classic billboards in the locker rooms” on page two, and to “backlit billboards high traffic areas” on pages three, four and five, merely indicate different types of media through which Applicant offers its advertising services, and do not show use of Applicant’s mark on the goods or displays associated with the identified printed advertising materials. *Id.*

B. Failure to Show Use of the Mark for the Services – Classes 38, 40 and 41

Section 45 of the Trademark Act specifies that “a mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of the services and the services are rendered in commerce” *See also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(2) (“A service mark specimen must show the mark as used in the sale or advertising of the services.”). Such use may be established by: (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed as a service mark in advertising the services, which encompasses marketing and promotional materials. *In re WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016).

An acceptable service mark specimen must show “some direct association between the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973); *WAY Media*, 118 USPQ2d at 1698. A specimen that shows the mark with no reference to, or association with, the services does not show service mark usage. *In re DSM Pharms. Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008) (LIQUIDADVANTAGE referred only to software


and did not identify and distinguish custom manufacturing services). “Essentially, the mark must be shown in a manner that would be perceived by potential purchasers as identifying the applicant’s services and indicating their source.” *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876 (TTAB 2017). Whether a mark sought to be registered as a service mark has been used “to identify” the services specified in the application is a question of fact to be determined on the basis of the specimens submitted by the applicant, together with any other evidence of record. *In re Adair*, 45 USPQ2d 1211, 1214 (TTAB 1997).


The first page of the specimen includes a section titled “Commercials” above the wording “Run existing TV spots with video and audio accessible to all members.” This page sufficiently demonstrates use of the mark in advertising Applicant’s “transmission of media advertising communications ... and broadcasting of advertising material for others ... via ... television, ... videos and digital films” in Class 38.

On the other hand, none of the five pages that comprise the specimen show use of the mark in the sale (including rendition) or advertising of any “printing services for others of advertising material intended to be posted in any way or on any type of medium” in Class 40 or “distribution of television programs for targeted communal audiences” in International Class 41. Nothing in the specimen “creates in the mind of the purchaser an association between the mark and the service activity.” *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994). Indeed, nothing on the specimen pages indicates, or even mentions, the recited Class 40 or Class 41 services,

nor does it seek to associate the proposed mark with such services. *See DSM Pharms.*, 87 USPQ2d at 1624 (“A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.”). In short, Applicant’s multiple page specimen does not associate the proposed mark with the recited services, such that the proposed mark would be perceived as a source-identifier for the Class 40 and 41 services. The specimen therefore is not sufficient to support use of the proposed mark in connection with Applicant’s Class 40 and 41 services.

C. Conclusion—Specimen

In sum, the Board finds the specimen acceptable to show use of  as a mark on or in connection with the services identified in Class 38, but not for the goods identified in Class 16 or the services identified in Classes 40 and 41.

Decision: The refusal to register Applicant’s mark  under Section 2(d) is affirmed for the services in Classes 38 and 41, and reversed for the goods in Class 16 and the services in Classes 35 and 40. The refusal to register under Sections 1 and 45 of the Trademark Act on the ground that Applicant has not submitted acceptable specimens of use is affirmed for the goods in Class 16 and the services in Classes 40

and 41, and reversed for the services in Class 38. The application will proceed to registration in Class 35 only.