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

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Applicant	Zoom Media Group Inc.
Applied for Mark	ZOOM
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF:

APPL. SER. NO.: 85/740,217

FILED ON: September 27, 2012

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OM**

FOR THE MARK:

**IN THE NAME OF: Zoom Media Group,
Inc.**

**Trademark Law Office: 104
Examining Attorney: Katina S. Jackson**

**APPLICANT'S APPEAL BRIEF
ALPHABETICAL INDEX OF CITED CASES**

Pursuant to 37 C.F.R. § 2.142(b), the cases cited herein are listed alphabetically as follows:

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I. BACKGROUND/INTRODUCTORY FACTS

Zoom Media Group, Inc. (hereinafter referred to as “Applicant”) hereby files its Appeal Brief in support of its Notice of Appeal filed on July 12, 2017 from a final office action dated January 12, 2017. The trademark examining attorney (“Examiner”) refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (the “Act”) for ZOOM & Design shown in Figure 1 below (the “Mark”).



Figure 1

Applicant filed an application to register the Mark on September 27, 2012. (Dkt. No. 35)¹ A Notice of Allowance was issued on September 16, 2014 (Dkt. No. 14), and Applicant submitted a statement of use on March 10, 2015 (Dkt. Nos. 12, 13). Examiner subsequently issued a suspension notice on April 16, 2015 (Dkt. No. 10), citing Appl. Ser. No. 85/202,100 for the mark shown below in Figure 2 (the “Citation”) owned by Bennett Coleman & Co, Ltd. (“Registrant”). The Citation was registered on the Principal Register on May 26, 2015, and the Examiner issued a non-final Office Action on May 19, 2016 in which she refused registration of the Mark under § 2(d) of the Trademark Act, citing similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services. (Dkt. No. 9). After a final office action issued on January 12, 2017,

¹ Throughout this brief, references to the application file for Appl. Ser. No. 85/740,217 reference the document number shown on USPTO TSDR Case Viewer. Page numbers, if given, refer to the page of the corresponding .pdf document downloadable from TSDR.

Applicant filed this appeal, along with a request for reconsideration (Dkt. No. 3), which was denied (Dkt. No. 1).



Figure 2

II. ARGUMENT

A. The marks differ in appearance, connotation, and commercial impression.

Examiner places too much emphasis on the identity of the literal element of the Mark and the Citation. Citing *In re I.Am.Symbolic, LLC*, 116 USPQ2d 1406, 1411 (TTAB 2015) the Examiner states: “The wording in these marks is identical in appearance, sound, and meaning, ‘and have the potential to be used...in exactly the same manner.’” (emphasis added)(Dkt. No. 9, pg 1) It is not clear from the Examiner’s use of “wording” whether she is referring to the literal element of the mark, or the stylized form. However, as can be readily observed in Figures 1 and 2 above, the marks in this case are not identical in appearance, notwithstanding the identity of their literal element, and because they are in stylized format they do not have the potential to be used in exactly the same manner. The application of *I.Am.Symbolic* is inappropriate here, since the marks at issue in *I.Am.Symbolic* were in standard word format, while both of the marks here are in stylized format. Accordingly, there was no analysis in *I.Am.Symbolic* on the impact that a stylized format would have on the likelihood of confusion analysis when the literal elements are identical.

Consideration of the stylized appearances of the marks is of great importance in this case. In her final refusal to register, Examiner merely stated that “the addition of a design element does not obviate

the similarity of the marks in this case”. (Dkt. No. 5, pg. 2) However, each case of likelihood of confusion is decided upon the particular facts of the case. *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). In *Shell Oil*, both the applied-for and the registered mark (shown below in [Figures 3](#) and [4](#), respectively) shared the same literal element, namely, RIGHT-A-WAY. However, in *Shell Oil*, the design elements—an arrow—were essentially identical as well.



Figure 3 (applied-for mark)

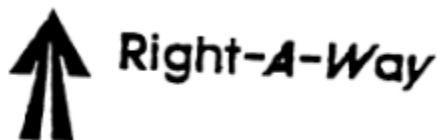


Figure 4 (registered mark)

In the present case, the marks are highly stylized and distinct, far more so than in *Shell Oil*.

The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990). In *Electrolyte Labs*, the goods were identical, and the literal elements of the marks—“K+” and “K+EFF”—were nearly identical. However, both marks were in stylized form ([Figure 4](#) below shows the applied-for mark, [Figure 5](#) the registered mark):

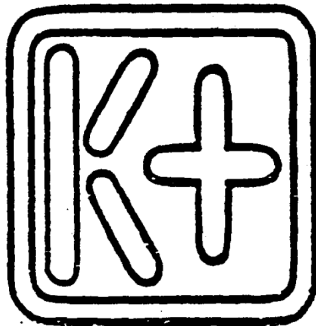


Figure 4



Figure 5

In reversing the Board's finding of likelihood of confusion in *Electrolyte Labs*, the Federal Circuit concluded that that Board erred in focusing entirely on the common literal element to the substantial exclusion of the other elements of both marks. "The spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods." It concluded by noting "A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark." Id. (emphasis added)

In this case, the stylized of the marks are different in appearance, commercial impression, and connotation. Referring to Figure 2 above, the Citation "consists of the word "ZOOM", with both letter "O"s as spheres, and the right sphere as larger than the left, somewhat resembling a cartoon character's eyeballs, evoking a playful, cartoonish motif. By contrast, the Mark shown in Figure 1 above, conveys a more formal and modernistic theme.

There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. *Electrolyte Labs*, 929 F.2d at 647. Taking into account the principle that the recollection of the average purchaser who retains a general, rather than specific recollection of a mark (see e.g. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975)), the mere identity of the literal elements alone, taken without any further consideration of their actual stylized appearance, is insufficient to support a finding of likelihood of confusion.

B. Relatedness of the goods and services

In order to find a likelihood of confusion, the goods and services of Applicant and Registrant must be related in such a way that the circumstances surrounding their marketing would result in relevant purchasers mistakenly believing that the goods originate from the same source. *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010). The goods and services are not related here. First, both Applicant’s and Registrant’s services are defined narrowly, with qualifying language that belies Examiner’s argument that there is actual overlap of services in Classes 38 and 41. Second, the evidence does not establish that relevant purchasers would mistakenly believe that the goods would originate from the same source. Third, the sophistication of the relevant purchasers and the care taken in the purchasing decision also weigh heavily against likelihood of confusion. Therefore, the unrelatedness of the goods and services in this case weighs against a likelihood of confusion.

1. Applicant’s and Registrant’s services are narrowly defined

Table 1 below is a complete side-by-side listing² of Applicant’s and Registrant’s goods and services.

<u>Class</u>	<u>Mark</u>	<u>Citation</u>
16	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	
35	Distribution of advertising and marketing materials to promote products and services, music, video; Advertising and marketing services for others,	

² Since Registrant’s listing of goods and services is extensive, Applicant has parsed the descriptions in the table for the Board’s convenience.

<u>Class</u>	<u>Mark</u>	<u>Citation</u>
	<p>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;</p> <p>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;</p> <p>rental services for others for advertising space;</p> <p>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;</p> <p>Production of advertising materials intended to be posted in any way or on any type of medium</p>	
38	<p>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;</p> <p>consultation related to broadcasting of advertising messages</p>	<p>Telecommunications, namely, broadcasting of television and radio programs related to the film industry via satellite, cable and the internet;</p> <p>news agency services for electronic transmission;</p> <p>transmission of motion pictures, television programs and other entertainment programs related to the film industry by satellite and via the internet;</p> <p>electronic transmission of entertainment media</p>

<u>Class</u>	<u>Mark</u>	<u>Citation</u>
		<p>content via a global computer network, all related to the film industry;</p> <p>video-on-demand transmission services related to the film industry; mobile media and entertainment services in the nature of electronic transmission of entertainment media content related to the film industry;</p> <p>providing online electronic bulletin boards and chat rooms for transmission of messages among computer users concerning business and economic affairs and general interest topics related to the film industry;</p> <p>internet broadcasting services of real-time audio and audio-visual broadcasts relating to India and Indian culture</p>
40	Printing services for others of advertising material intended to be posted in any way or on any type of medium	
41	Distribution of television programs for targeted communal audiences	<p>Organizing sporting and cultural activities; entertainment services, namely, production of news shows;</p> <p>entertainment services, namely, production of television shows and audio and video recordings, all of the foregoing excluding providing information related to children's educational television series;</p> <p>providing ongoing television programs, ongoing radio programs, ongoing online news shows and ongoing programs on the internet, and films, the foregoing programs, shows and films featuring a wide range of cultural, business, economic, news, and entertainment topics;</p> <p>providing information in the fields of entertainment, motion pictures and music over computer networks and global communication networks, all of the foregoing not including providing information related to children's educational television series;</p> <p>providing online computer games; organizing exhibitions for entertainment, cultural, and sporting purposes relating to or featuring</p>

<u>Class</u>	<u>Mark</u>	<u>Citation</u>
		<p>quizzes and games designed to test general knowledge and relating to business, music, drama, film, art, comedy, general knowledge, games, information, news, television and radio programs including, events, sports, documentaries, history, fiction, non-fiction topics, science and technology;</p> <p>motion picture and television studio services, namely, providing recording studios for the production of motion pictures and television shows; rental of motion picture films;</p> <p>publishing the periodicals or printed matter, namely, newspapers and magazines, of others;</p> <p>distribution of television programming for others to cable, terrestrial or satellite television systems;</p> <p>news reporters services; news syndication for the broadcasting industry;</p> <p>providing an internet website portal in the fields of entertainment, cultural events and exhibitions, all of the foregoing not including providing information related to children's educational television series;</p> <p>rental of audio and video programs and television programs, all of the rented programs excluding providing information related to children's educational television series;</p> <p>production of audiovisual works in the nature of motion pictures, trailers and music;</p> <p>production of audiovisual works in the nature of television programming, all of the foregoing excluding providing information related to children's educational television series;</p> <p>entertainment services in the nature of ongoing series of shows relating to commentary, news, arts, fashion, lifestyles, sports, music, performances, conversation and advice, the foregoing distributed through the media of television, satellite, radio, audio and video media and via a global computer network</p>

Table 1

The nature and scope of a party's goods or services must be determined entirely on the basis of the goods or services recited in the application or registration. See, e.g., *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). If the cited registration describes goods or services broadly, and there is no limitation as to their nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009). However, as can be seen from Table 1 above, Applicant's and Registrant's services are defined narrowly, with significant qualifying descriptive language for their services. Accordingly, neither Applicant's nor Registrant's services broadly encompass broadcast services. Moreover, Applicant broadcasts "advertising material for others", "media advertising communications and mobile media services in the nature of electronic transmission of entertainment media content", while Registrant broadcasts, e.g. "television and radio programs related to the film industry". Thus, there is no actual overlap between Applicant's and Registrant's services.

2. Examiner's evidence fails to establish that the goods and services could originate from the same source

Since there is no direct overlap between the services, Examiner must prove that the relevant purchaser would view the listed goods or services as originating from the same source. To establish that the same entity commonly provides the relevant goods or services or that the relevant goods and services could be marketed under the same mark, Examiner has submitted evidence in the form of the following seven websites: ethicinc.com, wickmarketing.com, wamedia.com, multimediasonline.com, proforma.com, mediapulsetech.com, and brightimagesvideo.com. In addition, the Examiner has submitted evidence of third-party registrations for WILLIAMS LEA® (Reg. No. 3,046,562), TIME FLYS AR ATTENTION REQUIRED WORDS WORTH READING® (Reg. No. 4,653,107), NAPCO® (Reg. No. 4,412,317), PENTON® (Reg. No. 3,805,469), and the PENTON logo (Reg. No. 3,934,984).

The websites cited by Examiner are not probative of the relatedness of the goods and services at issue in this case. The Board can easily discern from Applicant's listing of goods and services that Applicant is an advertising and marketing agency. All of the websites cited by the Examiner are for advertising and marketing agencies. As such, it is not surprising that all offer basically the same goods and services through the same channels, including broadcast media such as television, Internet, and radio. Therefore, all the websites submitted by examiner show is the fairly unremarkable fact that advertising and marketing agencies typically sell the same products and services and deliver these through similar channels, including certain broadcast channels.

However, Registrant is not an advertising and marketing agency—the word advertising or marketing do not appear anywhere in its description of services. Instead, Registrant's services description make clear that it is a multimedia content provider, i.e. a television station providing information on the film industry, news shows, audio and visual recordings, etc. None of the websites Examiner provided tend to show that a the relevant consumer would think that a multimedia entertainment content provider such as Registrant—who provides information relating to the film industry, news shows, audio and visual recordings, etc.—would also offer advertising and marketing services. Therefore, this evidence does not show that Applicant's and Registrant's services would originate from a single source.

The third-party registrations cited by the Examiner also fail to establish that Applicant's and Registrant's services could originate from the same source. WILLIAMS LEA is registered for an enormous variety of goods and services—all closely related to business and business administration—in Classes 9, 16, 35, 38, 29, 40, 41, and 42. However, “broadcast services” does not appear anywhere in the description. TIME FLYS AR ATTENTION REQUIRED WORDS WORTH READING does in fact enumerate broadcasting in its description of services, but only as part of an enormous list of goods and services spread across Classes 9, 35, 38, and 40. The diversity of the goods and services identified in these registrations significantly diminishes the probative value in establishing that any two items in the registration are related. *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509 (TTAB 2010).

NAPCO's enumeration of goods and services is significantly more concise, but this registration does not cite "broadcasting services" anywhere in its description. "Television programming" does appear in NAPCO's description, but only as qualifying language limiting the scope of the services offerings. Thus, NAPCO does not establish that broadcasting services and Applicant's advertising services could emanate from the same source.

Finally, the Examiner cited two registered marks owned by Penton Media, Inc., PENTON and a mark consisting entirely of a graphic element. Like the WILLIAMS LEA and TIME FLYS marks discussed above, the Penton Media marks feature extensive goods and services listings in Classes 9, 16, 35, 38, and 41. While "broadcasting" does appear in the description, the word is used as a qualifier limiting the scope of the services offering, not as a separate services offering itself. Therefore, the Penton Media marks do not show that the types of goods and services offered by Applicant and Registrant could originate from the same source.

3. Sophistication of customers and the degree of care used in purchasing also obviate likelihood of confusion

The relative sophistication and the corresponding degree of care used by the customers of Applicant and Registrant also weighs against likelihood of confusion.

Careful consideration of the goods and services listings of Applicant, and in particular the proliferation of the word "advertising" (it appears 18 times in Applicant's listing of goods and services), indicates that Applicant's business is advertising and marketing. It follows that the customer to whom Applicant's goods and services are targeted is a business enterprise seeking to reach particular customers, specifically those who patronize health and fitness clubs. (See Applicant's specimen of use, Dkt. No. 13, pgs. 2-3). Such a business enterprise is going to rely on Applicant to provide strategies and the means for reaching these particular customers.

By contrast, Registrant's services description indicates that it is a broadcast network focusing on specialized content primarily relating to the film industry, and in one particular case, on India and Indian culture. As a broadcast network, Registrant obtains most of its revenue from advertising. Therefore, the relevant consumer for purposes of determining relatedness of the goods and services in this case would be businesses and advertising and marketing agencies who seek to purchase advertising time on Registrant's network. The relevant consumers are, by virtue of their being business organizations, going to be more sophisticated purchasers than an individual person. Since the high cost of a good or service usually means that customers will use a high degree of care in making a purchase, the care used in making purchasing decisions in this case is very high because buying advertising time on a network can be quite expensive. See *In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546 (TTAB 2015).

Moreover, businesses and advertising agencies purchasing advertising on a broadcast network such as Registrant's carefully consider the particular customer segments that that broadcast network serves. For example, Applicant previously submitted evidence indicating that Registrant is an "Indian glamour and entertainment television channel primarily covering Bollywood and based in Mumbai", "a one stop shop for everything relating to Bollywood", and is popular among young, urban audiences. (Dkt No. 8, pg. 20). Registrant's programming is distributed in the United States on DishTV Channel 715 (Dkt. No. 8, pg. 26) 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. Paragraphs 1 through 3 of the parties Canadian consent agreement (See Exhibit F, Dkt. No. 3, pgs. 6-13; discussed in greater detail in Part III below), are further evidence of the fact that Registrant in fact directs its programming services to the Indian community. Registrant's potential customers are going to be those with advertisements targeted at this particular demographic. Therefore, the purchase decisions of the relevant consumer in this case are carefully considered in advance; they are never impulse purchases.

Examiner's evidence consisting of third-party registrations and Internet evidence shows nothing more than that advertising entities such as Applicant share a variety of broadcast channels with

entertainment content broadcasting entities like Registrant. It does not establish, however, that the relevant consumers would consider both services to originate from the same source. The mere fact that Applicant and Registrant both use common means to broadcast their content is far outweighed by the sophistication of the consumers and the care used in making purchase decisions, both of which weigh heavily against likelihood of confusion.

C. No Actual Confusion Exists/Consent Agreement

The length of time during and conditions under which there has been concurrent use without evidence of actual confusion is one of the factors to be considered in determining likelihood of confusion. *In re E.I. Du Pont DeNemours & Co.* 476 F.2d 1357, 1361 (CCPA 1973). The Examiner disregarded the fact that there has been no documented actual confusion between the marks, despite a period of concurrent use. Applicant previously presented evidence to the Examiner that the Mark has been used for similar advertising services in similar form since at least May 1997, and that Applicant is the owner of former Reg. No. 2,839,338 (see Dkt. No. 8, pg. 27). Although this registration was cancelled on December 12, 2014, it claimed use of a logo very similar to that of the Mark for similar services that were in use in commerce at least as early as May 1997. The Citation claims actual use as early as February 10, 2011, so there are several years in which Applicant and Registrant concurrently used the marks in commerce, without any apparent actual confusion. Mr. Louis-Philippe Denis, Applicant's Vice-President of Legal Affairs and Secretary, attests in an affidavit previously provided by Applicant (Dkt. No. 8, pgs. 28-37), that there have been no instances of actual confusion between the Citation, the Mark, or any of Applicant's other registered and unregistered marks. The fact that there has been no documented actual confusion between the Citation and either the mark or Applicant's prior registration also supports a finding of no likelihood of confusion.

Moreover, a consent agreement already exists between Applicant and Registrant with respect to identical marks for identical goods and services in Canada. Applicant previously submitted into the record a consent agreement between Applicant and Registrant regarding the co-existence of the parties'

Canadian marks. (Dkt. No. 3, pgs. 6-13) Although the consent agreement only applies to the parties' marks in Canada, not the United States, the Canadian marks are identical to the marks at issue in this case, and the services are nearly identical. (See Dkt. No. 3, pgs. 6, 14, 16, 20, and 22-23). However, after Examiner's refusal to register the Mark, Applicant contacted Registrant to negotiate a consent agreement for the United States similar to that currently in effect in Canada. Registrant's counsel last informed Applicant that Registrant is discussing the matter internally. Applicant remains optimistic that a consent agreement regarding the parties' use of the Mark and the Citation can be reached with respect to the United States.

Despite the differences between U.S. and Canadian trademark law, both countries share the underlying policy of avoiding consumer confusion in the marketplace. Therefore, the existence of Applicant's and Registrant's Canadian consent agreement for marks that are identical to those in this case should be considered as a further factor against a finding of likelihood of confusion.

III. Conclusion

For the reasons given above, Applicant respectfully requests that the Board reverse Examiner's refusal to register its mark ZOOM & Design under § 2(d) of the Trademark Act.

Respectfully submitted,

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