

This Opinion is Not a  
Precedent of the TTAB

Mailed: July 18, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Vox Media, Inc.*  
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Serial No. 87099703  
—

Jason J. Mazur and Danielle W. Bulger of Arent Fox LLP  
for Vox Media, Inc.

In Pyo Lee, Trademark Examining Attorney, Law Office 114,  
Laurie Kaufman, Acting Managing Attorney.

—  
Before Cataldo, Wolfson and Lykos,  
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Vox Media, Inc. (“Applicant”) seeks registration on the Principal Register of the  
mark **CODE** (in standard characters) for:

Educational services, namely, arranging, organizing, and  
conducting educational events, conferences, seminars, and  
symposia in the fields of media, technology, business,  
commerce, consumer products, entrepreneurship, startup  
businesses, enterprise technology, digital technology, and  
mobile platforms

in International Class 41.<sup>1</sup>

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Registration No. 4828407 for the mark **CODE2040** for, *inter alia*:

Educational services, namely, providing internships and apprenticeships in the fields of engineering and technology; educational services, namely, providing workshops, classes, and retreats in the fields of leadership, business, entrepreneurship, technology, engineering, design, job searching, job interviewing skills, and professional networking

in International Class 41.<sup>2</sup>

The Examining Attorney also refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark, when used on or in connection with Applicant's educational services, merely describes a characteristic, purpose, or subject matter of Applicant's services.<sup>3</sup>

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<sup>1</sup> Application Serial No. 87099703 was filed on July 11, 2016, under Section 1(a) of the Trademark Act, based upon Applicant's allegation of first use and first use in commerce of January 31, 2014. Applicant claims ownership of Registration No. 4837400.

<sup>2</sup> Registered on the Principal Register on October 6, 2015. The registration includes services in International Classes 35 and 36 that have not been cited as a basis for refusal.

<sup>3</sup> In its Reply Brief, Applicant requests leave "to divide the application to amend to the Supplemental Register." 7 TTABVue 11. To the extent Applicant seeks a remand, its request should have been filed as a separate document, not buried in its reply brief. *In re HerbalScience Group LLC*, 96 USPQ2d 1321, 1323 (TTAB 2010) ("The Board does not read appeal briefs prior to final decision, and therefore a request that is included within a brief will normally not be noted."). In any event, we do not find "good cause" for remand, and the request is denied. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1209.04 (June 2018) (request for remand must include a showing of good cause).

After the Examining Attorney made the refusal final, Applicant filed a Request for Reconsideration that was denied. Applicant then appealed to this Board. The case is fully briefed.

### **I. Likelihood of Confusion**

We turn first to the Section 2(d) refusal, which prohibits registration of a mark “which so resembles a mark registered in the Patent and Trademark Office, ..., as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). Unlike the prohibition against the registration of merely descriptive marks under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), which may be overcome under Section 2(f) if an applicant can show that the proposed mark has acquired distinctiveness, the Section 2(d) prohibition stands as an absolute bar to registration. We therefore begin our analysis with a consideration of likelihood of confusion under Section 2(d). If we affirm the refusal under Section 2(d), there will be no need to consider the descriptiveness refusal.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, though not exclusive, 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); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

#### **A. Similarities Between The Services; Trade Channels**

We first compare the similarities between Applicant's and Registrant's services, including their respective channels of trade and classes of purchasers. Our determination regarding the similarity of the services, channels of trade and classes of purchasers is based on the services as they are identified in the application and registration, respectively. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 17893, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

In this case, the educational services in Applicant's application and the cited registration, as recited, are legally identical in part: each provides education in various formats in the fields of technology, business and entrepreneurship. We acknowledge that the "workshops, classes, and retreats" identified in the cited registration represent different formats from Applicant's "educational events, conferences, seminars, and symposia." Nonetheless, both identify educational services in overlapping fields.

Applicant argues that Registrant provides "internships/apprenticeships and workshops primarily relating to job placement and careers" while Applicant provides "conferences relating to media and technology" and that such services are not in the

same markets.<sup>4</sup> However, the question of likelihood of confusion must be determined by an analysis of the marks as applied to the services identified in the application vis-a-vis the services recited in the registration. An applicant may not restrict the scope of the services covered in the cited registration by argument or extrinsic evidence. *In re I-Coat Co., LLC*, 126 USPQ2d 1730 (TTAB 2018); *In re Midwest Gaming & Ent. LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) (“[I]t is well established, as noted above, that it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the goods.”). Thus, any specific differences between the actual nature of the services beyond the scope of their identifications are irrelevant in our analysis.

Applicant further argues that “where the goods and services are broadly encompassed in the same field or class, the Board and courts routinely find no likelihood of confusion,” relying on *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992); *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 21 USPQ2d 1388 (Fed. Cir. 1992); and *In re Massey-Ferguson Inc.*, 222 USPQ 367 (TTAB 1983). Unlike in the present case, however, none of the cited cases involved identical or legally identical goods or services.<sup>5</sup>

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<sup>4</sup> 4 TTABVUE 11.

<sup>5</sup> In *Elec. Data Sys.*, the Board found no likelihood of confusion between EDS for computer data processing programming/information management services and EDSA for computer programs for electrical distribution system analysis and design. In *Elec. Design & Sales*, the Court found that applicant’s trademark EDS for battery chargers and power supplies was not likely to be confused with opposer’s service mark EDS for computer programming services. And in *Massey-Ferguson*, the Board found no likelihood of confusion between the mark E-COM for “parts order services in the field of farm and industrial machinery and

Because of the overlap in services, we need not consider whether the other recited services are related. Likelihood of confusion must be found with respect to a class of goods or services in an application if there is likely to be confusion with respect to any item that comes within the identification of the goods or services in that class. *In re Wacker Neuson SE*, 97 USPQ2d 1408, 1409 (TTAB 2010) (citing *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Turning to the respective trade channels, since the services in the application and the cited registrations are legally identical in part, we must presume that the channels of trade and classes of purchasers are the same. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical [services], the channels of trade and classes of purchasers are considered to be the same); *see also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

Accordingly, the second and third *du Pont* factors regarding the services, and the trade channels and classes of purchasers to whom the services are offered, favor a finding of likelihood of confusion.

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providing parts availability, location and routing information by means of a computer” and the mark ECOM for “magnetic core memory systems for electrical computers and data processing systems.”

**B. The Marks**

We next consider the first *du Pont* factor, that is, whether Applicant's mark CODE and Registrant's mark CODE2040 are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *See Stone Lion*, 110 USPQ2d at 1160 (quoting *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, we are mindful that where, as here, the services are in-part identical, the degree of similarity between the marks necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

The test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016); *In re Mr. Recipe*,

*LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Applicant's mark is CODE. The cited mark is CODE2040. Because the marks share the term "code," they are similar in appearance and somewhat similar in pronunciation. While "it is well-established that it is improper to dissect a mark, and that marks must be viewed in their entireties," *Coach Services*, 101 USPQ2d at 1721, "one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Id.* (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); see also *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here 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.").

Because the cited mark is composed of a set of letters followed by a set of numbers, and because the letters spell the word "code" and the numbers the date "2040," there is a natural break in the mark between the two.<sup>6</sup> In determining whether either term is more significant than the other, we are mindful of the fact that "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897

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<sup>6</sup> Corroborating the division between the two terms is Registrant's use of its mark on its website as "Code2040," emphasizing the two parts of the mark.



(TTAB 1988); *see also Palm Bay Imports* 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because it is the first word in the mark and the first word to appear on the label); *Russell Chemical Co. v. Wyandotte Chemicals Corp.*, 337 F.2d 660, 143 USPQ 252 (CCPA 1964) (SENTOL and SENTROL confusingly similar); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009) (PALOMA and PALOMITA); *Hercules Inc. v. National Starch and Chemical Corp.*, 223 USPQ 1244, 1246 (TTAB 1984) (NATROL and NATROSOL; “the clearly dominant aspect of both marks is that the first four letters and the final two are the same”). Because “CODE” is the first term in Registrant’s mark, it is more likely to be impressed upon the mind of a purchaser and remembered, particularly where “2040” serves the informational purpose of identifying a date referred to by Registrant on its website as “the start of the decade when the US will be majority people of color.”<sup>7</sup>

The term “CODE” also comprises Applicant’s entire mark. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (applicant’s mark ML is similar to registrant’s mark ML MARK LEES); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (applicant’s CAREER IMAGE marks are similar to registered mark CREST CAREER IMAGES); *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479, 480 (TTAB 1983) (LIL’ LADY BUG for toy doll carriages and LITTLE LADY for doll clothing).

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<sup>7</sup> Applicant’s April 27, 2017 Response to Office Action at TSDR 9.

With respect to their connotations and overall commercial impressions, Applicant argues that the two words in the cited mark create a “symbolic expression of the distant future (the year 2040),” and that “[t]he 2040 portion of the Cited Mark may indeed reference the cited registrant’s desire to achieve a certain goal at some point in the future ... .”<sup>8</sup> However, Applicant’s specimen of use, a page from Applicant’s website filed at the time of application, also incorporates dates in association with its mark CODE. The specimen advertises several dated events sponsored by Applicant, such as the CODE COMMERCE SERIES: OCT 2016; the CODE MEDIA 2017; and the CODE CONFERENCE 2017. We may look to how Applicant uses its mark to determine the commercial impression sought to be created. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984); *American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 796 (TTAB 1986) (“[W]e may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression.”); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) (“Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.”).

The specimen is reprinted below:

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<sup>8</sup> Reply Brief, 7 TTABVUE 5.

# EVENTS

## CODE COMMERCE SERIES: OCT 2016

OCTOBER 25, 2016 LAS VEGAS  
#CODECOMMERCE

Hosted by **Recode** senior editor Jason Del Rey, the second installment of the invitation-only **Code Commerce Series** will be held in conjunction with the Money20/20 conference, on October 25, 2016 in Las Vegas.

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### CALENDAR

- Code Commerce Series: Oct 2016**  
October 25, 2016
- Code Enterprise**  
November 15, 2016
- Code Commerce Series: Dec 2016**  
December 6, 2016
- Code Media 2017**  
February 13-14, 2017
- Code Conference 2017**  
May 30-June 1, 2017



## Code Enterprise


November 15, 2016 | San Francisco



Building on the success of last year's **Code Enterprise Series** events, **Recode** is launching a full-day conference, and it's not your everyday enterprise tech event. **Code Enterprise** features candid conversations with the enterprise leaders who matter most — from the biggest names in the business to the rising stars you need to know. And with **Recode's** signature hard-hitting, unscripted interviews, you'll get answers and insights that you can't find anywhere else.

Based on the above, we find that relevant consumers, upon encountering Applicant's mark CODE, are likely to recollect Registrant's CODE2040 mark and mistakenly believe Applicant's and Registrant's educational services emanate from a single source. The first *du Pont* factor favors a finding of likelihood of confusion.

### C. Third-party Registrations

Applicant argues that the cited mark is entitled to a narrow scope of protection because of the existence of nine third-party registrations for marks comprising the term CODE for educational services. We disagree. The “existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them,” *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Nonetheless, in determining the degree of weakness, if any, in the shared term CODE, “extensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)).

Here, Applicant has not presented evidence of use in connection with the third-party registrations and its evidence of nine third-party registrations falls far short of the “voluminous” and “extensive” evidence” presented in *Jack Wolfskin*, 116 USPQ2d at 1136; or of that in *Juice Generation*, 115 USPQ2d at 1673 n.1 (at least twenty-six relevant third-party uses or registrations of record). Consequently, we accord this evidence minimal weight. In addition, the marks in the registrations submitted by Applicant contain additional words or design elements that distinguish them from the cited mark, undercutting their probative value. For example, Reg. No. 5285215 for the unitary mark  contains a unique design feature and the

additional word “verse”; Reg. No. 5216639 for the mark  is depicted as a unitary mark with the “cubed” symbol; and Reg. No. 5240264 for the mark  contains an arbitrary term that distinguishes the overall commercial impression of the mark from the cited mark and would also be considered unitary. This evidence does not demonstrate that the mark CODE2040 is weak.

Nor does the fact that Applicant claims ownership of a prior registration for the mark RECODE<sup>9</sup> demonstrate that the mark CODE2040 is weak. To the extent the word “recode” means “to code again,”<sup>10</sup> any limited degree of similarity in the connotations of the two terms is outweighed by their dissimilarities in appearance, pronunciation and overall commercial impressions. Accordingly, the existence of Applicant’s registration and the third-party registrations does not demonstrate that the cited mark is weak or entitled to a narrow scope of protection.

#### **D. Sophistication of Purchasers**

Applicant argues that confusion is unlikely because the relevant consumers are “sophisticated and knowledgeable,”<sup>11</sup> but there is no evidence supporting this

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<sup>9</sup> Reg. No. 4837400, issued October 20, 2015 for *inter alia*, “educational services, namely, developing, arranging, organizing and conducting classes, seminars, conferences, workshops in the fields of media, technology, entertainment, mobile platforms, social affairs, culture, gaming, enterprise, commerce, healthcare, science, green technology, new and emerging technologies, products and services, privacy, government regulation and policy, startup businesses and companies, venture capitalists, venture investment and funding, and technology and information security, and distribution of course and educational materials in connection therewith.”

<sup>10</sup> See Merriam-Webster definition provided at <https://www.merriam-webster.com>, attached to Final Office Action at TSDR 13.

<sup>11</sup> Appeal Brief, 4 TTABVUE 10-11.

argument, and it is therefore not well-taken. Moreover, the consumers for educational services may include sophisticated IT specialists as well as unsophisticated and even first-time students who have no special knowledge and would not necessarily exercise heightened care. We must base our decision “on the least sophisticated potential purchasers” at issue. *Stone Lion* 110 USPQ2d at 1163 . This factor is neutral.

**E. Actual confusion**

Applicant argues that confusion is unlikely because the marks have been in simultaneous use for over four years without actual confusion.<sup>12</sup> However, the lack of evidence of actual confusion carries little weight in an ex parte context. See *In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 (“uncorroborated statements of no known instances of actual confusion are of little evidentiary value”); 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 this ex parte context, we also have no opportunity to hear from Registrant about its levels of sales and promotion, or of any incidents of actual confusion brought to Registrant’s attention. In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

This *du Pont* factor is neutral.

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<sup>12</sup> *Id.* at 11.

## II. Summary on Likelihood of Confusion

Applicant's mark and Registrant's mark are similar in appearance, pronunciation, connotation and overall commercial impression. The services are in part legally identical. Prospective consumers familiar with Registrant's CODE2040 educational services would be likely, when confronted with Applicant's CODE educational services, to believe that the services emanate from the same source.

### **Decision:**

The refusal to register Applicant's mark under Trademark Act Section 2(d) is affirmed. In view thereof, it is unnecessary for us to reach the refusal to register Applicant's mark under Trademark Act Section 2(e)(1).