

This Opinion is Not a
Precedent of the TTAB

Hearing: October 15, 2019

Mailed: January 24, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hidive LLC
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Serial No. 87819793
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Erik M. Pelton and Julie Shursky of Erik M. Pelton & Associates, PLLC,
for Hidive LLC

Robert N. Guliano, Trademark Examining Attorney, Law Office 105,
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Before Cataldo, Wolfson and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Hidive LLC (“Applicant”) seeks registration on the Principal Register of the mark DUBCAST, in standard characters, for “Transmission and delivery of television programs via the internet; Transmission of information in the audiovisual field; Electronic transmission and streaming of digital media content for others via global and local computer networks; Video broadcasting and transmission services via the

Internet, featuring films and movies; Video-on-demand transmission services; Video-on-demand transmission services via the Internet” in International Class 38.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the typed² mark DUBLAB for “broadcasting programs via a global computer network” in International Class 38.³

When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied Applicant’s request for reconsideration, and the appeal was resumed. Pursuant to Applicant’s request, an oral hearing was held on October 15, 2019.

We affirm the refusal to register.

I. Analysis

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake, or to deceive. 15 U.S.C. § 1052(d). Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood

¹ Application Serial No. 87819793; filed March 5, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s claim of a bona fide intent to use the mark in commerce.

² A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (explaining that in 2003 there was a non-substantive change in nomenclature from a “typed mark” to a “standard character mark”).

³ Registration No. 261219; issued August 27, 2002.

of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015)); *see also In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant or for which there is evidence of record.⁴ *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *M2 Software, Inc. v. M2 Commc’ns., Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (within the *DuPont* list, only factors that are “relevant and of record” need be considered); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). We treat as neutral any *DuPont* factors for which there is no record evidence or argument.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and goods or services. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (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 and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record

⁴ In its first Office Action Response and Appeal Brief, Applicant makes passing reference to “sophisticated” consumers but Applicant has not specifically argued this factor. 8 TTABVUE 7. Nor is there evidence on this factor so we have not considered it.

evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)).

A. Similarity or Dissimilarity of the Services and Classes of Consumers

Applicant acknowledges that “both Applicant and Registrant perform broadcasting services,” but argues that its services and consumers are different from those of Registrant. Specifically, Applicant asserts that it offers a subscription broadcast service featuring anime television shows and films to “anime enthusiasts” whereas Registrant offers a free service for “enthusiasts of alternative and local musicians” to “listen-in live to its Internet radio broadcast, stream music from its library of pre-recorded music, or download the music and listen on the go” and for “underground or non-mainstream artists and musicians looking for a place to showcase their music.”⁵ These purported differences, however, are irrelevant because they are not reflected in the identifications of services. *Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Our determination of whether the services, trade channels, and consumers are related must be based on the identifications in the application and cited registration and not on any extrinsic evidence regarding how the marks are actually used. *In re*

⁵ Applicant’s Appeal Brief 8 TTABVUE 23-24; August 17, 2018 Office Action Response at TSDR 13.

Citations to the prosecution record are to the Trademark Status & Document Retrieval (“TSDR”) system by page number in the downloadable .pdf versions of the documents. All other citations are to TTABVUE, the Board’s online docketing system.

i.am.symbolic, LLC, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017); *See Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997); *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”).

The identifications of services in the cited registration and Applicant’s application are broad. Applicant’s services of “Transmission and delivery of television programs via the internet ... Electronic transmission and streaming of digital media content for others via global and local computer networks; [and] video broadcasting and transmission services via the Internet, featuring films and movies” are encompassed within Registrant’s service of “broadcasting programs via a global computer network.”⁶ Accordingly, the services are identical, in part.

⁶ We take judicial notice that “broadcast” means to “transmit.” Merriam-Webster.com at <https://www.merriam-webster.com/dictionary/broadcast> (last visited January 23, 2020). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

The Examining Attorney need not prove, and we need not find, similarity as to each service listed in the recitation of services. It is sufficient for a finding of likelihood of confusion if relatedness is established for any service encompassed in the recitation of services in a particular class. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Because the services in the cited registration are in part legally identical to Applicant's, and there are no restrictions or limitations in the respective identifications regarding the classes of consumers, we presume that the services travel to at least some of the same classes of consumers. *American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where services are legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same").

For these reasons, the similarities between the services and consumers weighs strongly in favor of finding a likelihood of confusion.

B. Strength of the Cited Mark

We next assess the strength of the cited DUBLAB mark considering both its conceptual strength based on the nature of the mark itself and its commercial strength based on the marketplace recognition value of the mark. *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."). Applicant relies on dictionary and Wikipedia definitions, third-party registrations, and third-party uses to argue that the prefix

“dub” is conceptually and commercially weak for “audiovisual entertainment services and broadcasting services” and therefore, the cited DUBLAB mark “is entitled to a narrow scope of protection[.]”⁷

“Dub” is defined as a verb meaning: (1) “to add (sound effects or new dialogue) to a film or to a radio or television production”; (2) “to provide (a motion-picture film) with a new soundtrack and especially dialogue in a different language”; and (3) “to make a new recording of (sound or video already recorded” also “to mix (recorded sound or videotape from different sources) into a single recording.”⁸ As a noun “dub” refers to “Jamaican music in which audio effects and spoken or changed words are imposed on an instrumental reggae background.”⁹ In addition, “dubstep” is a “genre of electronic dance music.”¹⁰ The term “lab” is an abbreviation for “laboratory,” which in turn is defined as “a place providing opportunity for experimentation, observation, or practice in a field of study” or “a place like a laboratory for testing, experimentation, or practice.”¹¹

When considered in its entirety, the cited DUBLAB mark evokes a place for experimenting and creating dubbed content and dub/dubstep or the broadcasting of

⁷ Appeal Brief 8 TTABVUE 11.

⁸ March 7, 2019 Request for Reconsideration 4 TTABVUE 51 (merriam-webster.com); September 7, 2018 Final Office Action at TSDR 205 (English Oxford Dictionary).

⁹ March 7, 2019 Request for Reconsideration 4 TTABVUE 51 (merriam-webster.com) September 7, 2018 Final Office Action at TSDR 205 (English Oxford Dictionary).

¹⁰ August 17, 2018 Office Action Response at 55 (Wikipedia.com).

¹¹ *Id.* at 61 (merriam-webster.com definition for “laboratory”). We take judicial notice of the dictionary definition of the term “lab.” Merriam-Webster.com at <https://www.merriam-webster.com/dictionary/lab> (last visited January 23, 2020).

experimental dubbed programs and dub or dubstep music. As such, the cited mark is suggestive of Registrant's broadcasting services falling in the middle of the spectrum of distinctiveness.

We now consider Applicant's evidence of third-party use and registration. Third-party registrations are relevant to show the sense in which a mark is used in ordinary parlance and third-party use of similar marks on similar goods or services can show that customers have been educated to distinguish between different marks on the basis of minute distinctions. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005) ("Evidence of third-party use of similar marks on similar goods [or services] is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.").

Applicant submitted 12 third-party use-based registrations¹² for marks incorporating the term "dub" and examples of how the registered marks are used as well as 11 common law "dub"-formative marks. The registrations underscore that

¹² August 17, 2018 Office Action Response at TSDR 66-78. In its Appeal Brief, Applicant references for the first time one additional registration: Registration No. 4621334 for the mark DUBSPOT. This registration is not of record so we have not considered it.

In its Appeal Brief, Applicant asserts that it submitted evidence of 13 third-party registrations, but in its August 17, 2018 Office Action Response, Applicant identified and submitted registration certificates for only 12 third-party registrations.

“dub” has a normally understood and well-recognized meaning with respect to goods and services falling under the broad umbrella of “entertainment.”

As to the third-party uses, they are not equally probative. The 7 most pertinent marks are DUBSET “DJ Defined Radio,” DUBSHOT RECORDS, JDUB RECORDS, DUB ROCKERS, DUBSEVEN RECORDS, and DUBATOMIC MUSIC for providing musical sound recordings on the Internet,¹³ and the mark SIMULDUB for English-language dubbed anime shows on the Internet. Less probative are marks for more removed goods and services, namely, 7 marks for social media software and mobile applications enabling users to create, edit and/or share content, DUBBLER, DUBSELF, DUBTV, MOBDUB, PIXDUB, DUBSQUAD, and DUBSMASH¹⁴, 2 marks for music content, namely, DUBATOMIC PARTICLES for an FM radio program¹⁵ and DEEDUB for a musical recording,¹⁶ 2 marks for music bands, INDUBWETRUST and GIANT PANDA GUERILLA DUB SQUAD¹⁷ and the mark DUBSPOT for electronic music education.¹⁸

The third-party uses are not of the quantity or type that would support a conclusion that customers have been conditioned to distinguish between different “dub”-formative marks in Registrant’s field of “broadcasting programs via a global

¹³ Applicant’s Appeal Brief 4 TTABVue 13, 23-25, 31, 43, 49, 57-59, 80, 82 and 88-90.

¹⁴ *Id.* at 15, 21, 27, 33-38, 55, 71, 75, and 84.

¹⁵ *Id.* at 69.

¹⁶ *Id.* at 29.

¹⁷ *Id.* at 45 and 47.

¹⁸ *Id.* at 41 and 86.

computer network” based on minute distinctions in the marks.¹⁹ *See In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (evidence of third-party use “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in [applicant’s] cited cases”); *Jack Wolfskin*, 116 USPQ2d at 1136 (discussing “voluminous evidence” of registration and use of paw print design elements); *Juice Generation*, 115 USPQ2d at 1674 & n.1 (referring to evidence of “a considerable number,” 26 third-party marks).

On balance, we find that the strength of the cited mark is neutral.

C. Similarity or Dissimilarity of the Marks

The issue 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 goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning LLC*, 688 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *Geigy Chem. Corp. v. Atlas Chem. Indus.*,

¹⁹ The other third-party marks have little to no relevance because they are for business-to-business services that are distinguishable from the consumer-based services covered by the cited mark: (1) DUBLAB registered for application service provider services and used to identify a “managed turnkey mobile app platform” for “higher educational institutions to effectively deliver the critical information students need to succeed,” Request for Recon. 4 TTABVUE 19 and 73; (2) DUB SQUAD MUSIC, BMI, an “independent music publishing company,” *id.* at 65; (3) DUBSET MEDIA, a “technology solutions company for the music industry” that “aspire[s] to unravel the complexities associated with licensing and distribution of derivative content and change how it is monetized,” *id.* at 77-78; and (4) DEEDUB branding services, specifically research and strategy, and digital experience and real-world experience design services. *Id.* at 61-63.

Inc., 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). We do not predicate our analysis on a dissection of the involved marks; we consider the marks in their entirety. *Stone Lion*, 110 USPQ2d at 1160; *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.”).

The marks have different suffixes resulting in some differences in appearance, sound, and commercial impression. But where, as here, the services are legally identical in part, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Coach Servs. v. Triumph Learning*, 101 USPQ2d at 1722 (quotation omitted); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

Both marks consist of two-syllables and start with the prefix “dub” resulting in similarities in appearance and pronunciation. We acknowledge that “dub” is suggestive of Applicant’s and Registrant’s services, but as the first portion of the marks, “dub” is “likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988); *see also See In re Detroit Athletic Co.*, 128 USPQ2d at 1049 (“The identity of the marks’ initial two words is particularly significant because consumers

typically notice those words first.”); *Palm Bay Imps.*, 73 USPQ2d at 1692 (first word in the mark most prominent); *Century 21 Real Estate*, 23 USPQ2d at 1700 (upon encountering the marks, consumers will first notice the identical lead word). This is particularly true with respect to Applicant’s mark because the suffix “cast” meaning to “to transmit the sound and images of (something happening) in real time via the Internet”²⁰ is highly descriptive of Applicant’s services. Indeed, Applicant has acknowledged that the term “cast” in its mark “evokes a shortened version of the word ‘broadcast’ or ‘telecast[.]’”²¹ Accordingly, while we consider both marks in their entirety, we find that the descriptive suffix “cast” in Applicant’s mark is entitled to less weight in the likelihood of confusion analysis. *Stone Lion*, 110 USPQ2d at 1161 (It is not improper, for rational reasons, to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety); *In re Chatam Int’l*, 71 USPQ2d at 1946; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985)); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 823 F.2d 1560, 1566, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987) (“It is not error in articulating reasons en route to a conclusion to indicate that some features of a mark are more distinctive than others.”)

²⁰ We take judicial notice of the dictionary definition of “cast.” Merriam-Webster.com <https://www.merriam-webster.com/dictionary/cast> (last visited January 23, 2020).

²¹ Applicant’s Appeal Brief 8 TTABVUE 13-14.

As to commercial impression, Applicant's mark is highly suggestive of broadcasting "digital media content" featuring dubbed material or dub/dubstep music. The cited mark suggests a place where such broadcasts can be created or observed or the service of broadcasting experimental dubbed material or dub/dubstep music. It is foreseeable that consumers would mistakenly believe that Applicant's DUBCAST broadcasts are created in a DUBLAB or are otherwise related to or emanate from Registrant, particularly when we take into account the imperfect recollection of the average purchaser.

Applicant argues that the commercial impressions of the marks are different because "[i]n Applicant's industry of anime film and television, 'DUB' or 'DUBBING' commonly refers to the replacement of the actor's voices with those of different performers speaking another language" while "dub" in Registrant's mark "could be in reference to different genres of music such as Jamaican Reggae style music (i.e. Dub) or electronic style music (i.e. Dubstep)."²² This argument, is unpersuasive because, as discussed, Applicant's services are not limited to broadcasting anime and Registrant's services are not limited to broadcasting dub or dubstep music. The services in both the application and cited registration are broad enough to encompass broadcasting programs featuring dubbed content and/or dub/dub-style music. Accordingly, the prefix "dub" has the same suggestive meaning in both marks.

When we compare Applicant's DUBCAST mark and the cited DUBLAB marks in their entireties, we find that the overall similarities between the marks in

²² Applicant's Appeal Brief 8 TTABVUE 13.

appearance, sound, connotation, and commercial impression outweigh the differences in the marks. This factor favors a finding that there is a likelihood of confusion.

II. Conclusion

We find that confusion is likely between Applicant's mark and the cited mark. Applicant's services are in part identical to Registrant's services, the marks are similar overall, particularly with respect to commercial impression, and the record does not establish that the cited mark is so weak that Applicant's mark can coexist without a likelihood of confusion.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.