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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tera Media Corporation

Serial No. 75617075

Ashlyn J. Lembree of Wiggin & Nourie for Tera Media Corporation.

Tracy Cross, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hanak, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Tera Media Corporation (applicant) seeks to register TERA MEDIA CORPORATION and design in the form shown below for "blank recordable, removable optical and magnetic storage media." The application was filed on January 4, 1999 with a claimed first use date of July 15, 1998. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use MEDIA CORPORATION apart from the mark in its entirety.



Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark TERAMEDIA previously registered in typed drawing form for "computer hardware and software for multimedia communications and networks, namely, computers, monitors, projectors, keyboards, fingerprint scanners, cameras, microphones, switches, transmitters, servers, terminals, utility concentrators, power supplies, encoders and software therefor; and instruction manuals sold therewith." Registration No. 2,402,640. In addition, the Examining Attorney refused registration on the basis that applicant's mark, as applied to applicant's goods, is likely to cause confusion with a second TERAMEDIA registration owned by the same entity. Registration No. 2,386,989. This second registration is a service mark registration that involves

the installation and maintenance of hardware and software for multimedia communications (the goods set forth in the cited trademark registration), as well as "telecommunications services, namely, electronic transmission of video and data." However, in our likelihood of confusion analysis, we will focus on applicant's trademark application and the cited trademark registration, as the applicant and the Examining Attorney have done. If there is no confusion between the trademark application and the trademark registration, there likewise would be no confusion between the trademark application and the service mark registration. By way of analogy, if there is no confusion between an application whose goods are "automobiles" and a trademark registration whose goods are "commercial busses," then there would be, obviously, no likelihood of confusion between the application whose goods are "automobiles" and a service mark registration whose services are "the servicing and maintenance of commercial busses."

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, we find that while they are not identical, there are clear similarities. Marks are compared in terms of visual appearance, pronunciation and meaning. In terms of visual appearance, the marks are only somewhat similar. The registered marks consists of the one word TERAMEDIA, whereas applicant's mark not only breaks this one word into two words (TERA MEDIA), but more importantly includes a prominent design feature as well as the word CORPORATION which, while depicted in smaller lettering than TERA MEDIA, is nevertheless depicted in a manner that it is readily visible. In terms of pronunciation, the marks are quite similar. Whether TERAMEDIA is depicted as one word or two, its pronunciation is the same. Of course, it need hardly be said that the design in applicant's mark would not be pronounced. Finally, given the non-source identifying nature of the

word CORPORATION in applicant's mark, consumers may not even vocalize this word. Even if they did, the two marks would still be quite similar in terms of pronunciation. Finally, in terms of meaning or connotation, both marks begin with the arbitrary term TERA. Given the arbitrary nature of TERA as applied to applicant's goods and registrant's goods and services, we find that this factor causes both marks to be essentially arbitrary in nature.

Turning to a consideration of applicant's goods and registrant's goods, we note at the outset that both applicant and the Examining Attorney have referred to registrant's goods (blank recordable, removable optical and magnetic storage media) as blank recordable CDs and DVDs. This is perfectly permissible because the use of the term blank recordable CDs and DVDs in no way narrows or limits applicant's formal recitation of goods. Instead, it merely clarifies applicant's formal recitation of goods. In re Trackmobile, Inc., 15 USPQ2d 1152, 1154 (TTAB 1990).

Obviously, it is the burden of the Examining Attorney to show that there is a relationship between registrant's goods and applicant's goods in order to prove that there exists a likelihood of confusion. To cut to the quick, the Examining Attorney has simply failed to offer any evidence showing how applicant's blank recordable CDs and DVDs are

in any way related to registrant's goods, much less registrant's services. In her brief at unnumbered page 8, the Examining Attorney simply makes the following speculations: "Hence, the consuming public may mistakenly believe that the applicant's goods are to be used in conjunction with the registrant's goods and/or services. The applicant's discs may appear to be accessories for the registrant's line of goods and services." (emphasis added).

This Board deals in facts and not speculations. The Examining Attorney has simply failed to prove any relationship between applicant's goods and registrant's goods and services, and accordingly we find that there is no likelihood of confusion. To be clear, at unnumbered page 9 of her brief, the Examining Attorney makes the following statement: "Also, note that online retailers such as chumbo.com provide both storage media and software packages from various companies. See evidence made previously of record." The Examining Attorney attached to her brief three pages of a print-out from chumbo.com's website. This was properly made of record during the examination process. However, after a careful review of these three pages, we simply do not see how they support the Examining Attorney's contention. Moreover, even if they did, the fact that one major online retailer may

offer, to use the Examining Attorney's words, "both storage media and software packages from various companies," does not in any way prove that applicant's goods and registrant's goods are related. Large online retailers -- like large discount stores, department stores and home improvement centers -- carry a very large array of vastly different goods. This sole evidence in no way proves that applicant's goods and registrant's goods are related.

Decision: The refusal to register is reversed.