

**THIS DECISION IS NOT
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OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Comcast Corporation

Serial No. 76552342

Mitchell H. Stabbe and Kelly A. Donohue of Dow, Lohnes & Albertson, PLLC, for Comcast Corporation.

William H. Dawe III, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Hairston, Walters and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On October 17, 2003, Comcast Corporation (applicant) filed an intent-to-use application to register the mark FAN, later amended to THE FAN,¹ in standard-character form for services now identified as "entertainment services, namely providing access to articles, files and audio and

¹ In its brief applicant indicates that the examining attorney had not acted on its request to amend the mark, but the examining attorney's final refusal indicates acceptance by stating, "And the substitute drawing has been accepted and made of record." Final Refusal at 1.

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video clips in the fields of international, national and local news, entertainment, motion pictures, music, television and sports through an online multimedia player, In International Class 41."

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of Reg. No. 2117302, which issued on December 2, 1997, for the mark THE FAN in standard-character form for "radio broadcasting services" in International Class 38. The registration claims both first use and first use in commerce in July 1987. CBS Radio Inc. (registrant) has filed affidavits under Trademark Act §§ 8 and 15, 15 U.S.C. §§ 1058 and 1065, and those affidavits have been accepted and acknowledged.

The examining attorney issued a final refusal and maintained the refusal after reconsideration, and applicant appealed. Both applicant and the examining attorney have filed briefs. Applicant did not request an oral hearing. We affirm.

PROCEDURAL MATTERS

Before addressing the refusal we must attend to two procedural loose ends.

The first concerns the identification of goods. Applicant initially identified its services as "online

computer services, namely providing general and customized information and listings in the fields of news, entertainment, sports and games." In the first office action the examining attorney found the identification indefinite and required amendment. Applicant provided an amended identification in its response. In the final refusal, which followed, the examining attorney still found the identification unacceptable and required further amendment. In its request for reconsideration applicant provided a new amended identification.

In responding to the request for reconsideration the examining attorney said nothing about the identification of goods specifically. The examining attorney simply stated, "After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue." In our order forwarding the request for reconsideration to the examining attorney the Board had stated, "If the amendment [to the identification of services] is found unacceptable, the Examining Attorney should issue an office action indicating the reasons why the proposed amendment is unacceptable and return the file

to the Board which will then allow applicant time to file its appeal brief. (Footnote omitted.) However, if the examining attorney believes the problems with the proposed identification can be resolved, the Examining Attorney is encouraged to contact applicant, either by telephone or written office action, in an attempt to do so."

In the absence of either any mention of the identification of services or any attempt to resolve any remaining problem, applicant indicated in its brief that the proposed amendment had been accepted. In his brief the examining attorney advised applicant that the latest proposed amendment was still unacceptable.

In view of the totality of the circumstances, we conclude that the identification applicant offered with its request for reconsideration was accepted. The examining attorney failed to maintain his objection and otherwise failed to comply with the Board's instruction. Accordingly, the operative identification is, "entertainment services, namely providing access to articles, files and audio and video clips in the fields of international, national and local news, entertainment, motion pictures, music, television and sports through an online multimedia player" in International Class 41.

The second procedural issue concerns certain evidence applicant provided with its reply brief and a related request. With its reply brief applicant, for the first time, provided certain Internet web pages allegedly related to registrant and registrant's use of the cited mark. Applicant's purpose was to show that, "Registrant uses its mark in conjunction with an all-sports radio station," a more restricted identification of services than "radio broadcasting services" specified in the cited registration.

Applicant apparently recognized that this submission was late. Therefore, applicant asked that we either take judicial notice of the evidence or that we remand the case to enable applicant to submit this evidence. We decline to do either.

First, the evidence is not the type of material as to which we would take judicial notice. See TBMP § 1208.04 (2d ed. rev. 2003) and cases cited therein. Secondly, applicant's submission, provided with a reply brief, is manifestly untimely. Trademark Rule 2.142(d) requires that the record be complete prior to the filing of an appeal subject to certain exceptions not relevant here. Also, it is apparent that this evidence was available prior to the filing of applicant's appeal.

However, even if applicant had provided this evidence at the appropriate time, we would not consider it because it is offered for an impermissible purpose.² In determining likelihood of confusion, we must consider the services as identified in a cited registration and cannot consider extrinsic evidence regarding a registrant's actual use of its mark. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986)(extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected). Accordingly, we have not considered the evidence applicant provided with its reply brief, and we deny applicant's request for a remand.

LIKELIHOOD OF CONFUSION

Turning to the refusal, Section 2(d) of the Act precludes registration of an applicant's 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 . . ." 15 U.S.C. § 1052(d). To determine whether there is a likelihood of confusion, we must consider all evidence of record bearing on the factors

² We regret any inconvenience to applicant resulting from the examining attorney's suggestion in his brief that this evidence might be considered.

delineated in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977). Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the services of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). In addition to those factors, we will also address applicant's and the examining attorney's arguments relating to other factors.

Comparison of the Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Applicant's mark and registrant's mark are both THE FAN; both marks are in standard-character form.

Applicant does not argue that the marks differ in appearance or sound. The simple fact is that the marks are identical in appearance and sound. In fact, applicant's only argument as to the marks is as follows: "THE FAN has different connotations as used by Applicant and by Registrant mitigating any likelihood of confusion. The Cited Mark is used for a sports radio station.

Accordingly, the Cited Mark is clearly intended to communicate a reference to sports fanatics or fans. In contrast, the Applicant's Mark is intended to communicate an image of a hand-held fan, an accessory used either as a costume piece or a cooling device." The examining attorney argues that applicant has not provided any evidence to support its contention that the connotations differ.

In support of its theory, applicant provided an example of a display it used or intends to use on a web page in connection with its services showing the mark, THE FAN. The display consists of a circle with "thumbnail" photos positioned at the outer band of the circle; the photos feature persons in the news, including entertainment and sports personalities. The thumbnails apparently provide links to related material. It is certainly arguable that this display resembles a hand-held fan.

However, in considering the connotation of the respective marks we cannot consider either the restricted identification of services applicant suggests with regard to registrant's services, nor can we consider the example applicant provides of one display of its mark. We must evaluate the connotation of applicant's mark based on the mark, as shown in its application, and applicant's services, as identified in its application. Likewise, we

must evaluate the connotation of registrant's mark based on the mark, as shown in the cited registration, and on registrant's services, as identified in the registration.

We cannot base our evaluation of applicant's mark and services on a specific display applicant used or intends to use. Vornado, Inc. v. Breuer Electric Mfg. Co., 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968) (" . . . the display of a mark in a particular style is of no material significance since the display may be changed at any time as may be dictated by the fancy of the applicant or the owner of the mark."). Here, the fan-like display is neither an element of the mark, nor is it dictated by the services, as identified.

Likewise, as we have indicated above, we cannot assume that registrant's services are more restricted than stated in the cited registration based on extrinsic evidence, as applicant urges us to do. In re Bercut-Vandervoort & Co., 229 USPQ at 764. Registrant's services are simply identified as "radio broadcasting services" and could include news, entertainment and sports, and all of the other subject matter applicant identifies. Registrant too could adopt a fan-like display in connection with the use of its mark.

When we consider the registered mark in view of the broad identification in the registration we conclude that it could yield a variety of connotations. The particular connotation would depend on the precise manner of use and the precise type of radio broadcasting service being provided by the registrant. Either may vary significantly. Accordingly, we must conclude that these connotations would include the connotations that would possibly be associated with applicant's mark. Both of the possible connotations applicant suggests with regard to the registered mark and its mark, that is, either that of a "fan" of a particular personality or activity or that of a hand-held fan, could be among the connotations either applicant's mark or the registered mark could project, depending on the circumstances.

Furthermore, even if we considered registrant's services to be restricted as applicant argues, and applicant's display of its own mark, as submitted, both could still connote a "fan" of a particular sports personality or sports activity. In fact, applicant's display includes sports items consistent with its identification of services.

Accordingly, we conclude that the connotations of both applicant's mark and registrant's mark could be identical.

Furthermore, on the same basis we conclude that the marks of applicant and registrant could also project identical commercial impressions. Finally, we conclude that the marks of applicant and registrant are identical in all respects.

Comparison of the Goods and Channels of Trade

With respect to the services, applicant argues:

In this case, Applicant Comcast and the owner of the Cited Mark provide their respective services through different media, namely, the Internet and radio, respectively, mitigating against there being a likelihood of confusion. Moreover, THE FAN radio station is directed to New York area sports fans within its broadcast area, while applicant targets Internet users seeking information on a wide variety of subjects. Indeed, Applicant's service is not even available to the general public; it is offered exclusively to Applicant's broadband customers when they log onto their Comcast Internet account.

On the other hand, the examining attorney argues, "The registrant's radio broadcasting services are related to the various types of entertainment services in the fields of news, movies, television and sports provided via the Internet. (Footnote omitted.) Therefore, the services of the parties are related because they pass through the same trade channels." The examining attorney then refers to certain third-party registrations he made of record to establish that, ". . . radio broadcasting services appear with various types of entertainment services in the fields

of news, motion pictures, music, television and/or sports, including said services offered over the Internet."

First, we acknowledge, as the examining attorney argues, the importance of the fact that the marks are identical in comparing the services of applicant and registrant. In such cases, the services of applicant and registrant need not be as closely related to find a likelihood of confusion compared to cases where the marks differ. Amcor, Inc. v. Amcor Indus., Inc., 210 USPQ 70, 78 (TTAB 1981).³

Secondly, here again applicant's argument rests on a restrictive reading of the services identified in the registration. As we have stated, we must assume that registrant's services include all services logically included within "radio broadcasting services" and not merely an all-sports radio station, as applicant suggests. In re Bercut-Vandervoort & Co., 229 USPQ at 764. Nor can we assume that registrant's services are confined to the New York market, as applicant suggests. There are no geographic restrictions in either the cited registration or the application. Amcor, Inc. v. Amcor Indus., Inc., 210

³ We note that this is not a case like the case cited by applicant where the marks are identical, but applicant and registrant have entered into a consent agreement. In re Sears Roebuck and Co., 2 USPQ2d 1312, 1313 (TTAB 1987).

USPQ at 77. We also have no reason to conclude that "radio broadcasting services" cannot be offered nationwide.

Indeed, as we discuss below, radio broadcasts are now "streamed" over the Internet nationwide and beyond.

Applicant also rests its argument on a restrictive reading of the services identified in its own application. That is, applicant argues that its services are provided only to its subscribers. Applicant did not limit its identification of services to services offered through subscriptions. Even if it had, we do not believe that such a limitation would alter the analysis here. We have no basis on which to conclude that subscription services and nonsubscription services, which are otherwise related, could not be offered under the same mark and reach the same consumers.

As the examining attorney correctly points out, in considering the services, and the channels of trade, we must consider the services as identified in the application and registration and, in the absence of any restrictions, assume that the services include all services identified and that those services travel in all trade channels appropriate for such services. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1981).

Applicant identifies its services as "entertainment services, namely providing access to articles, files and audio and video clips in the fields of international, national and local news, entertainment, motion pictures, music, television and sports through an online multimedia player."⁴ The services identified in the registration are "radio broadcasting services."

The examining attorney has offered several third-party registrations which include services of the type applicant identifies as well as services of the type identified in the cited registration to support his conclusion that the services are related. These registrations have some probative value; specifically, they may indicate that the services are the types of services which may emanate from the same source. In re TSI Brands Inc., 67 USPQ2d 1657, 1659 (TTAB 2002); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993).

In fact, the third-party registrations do show that the same mark has been registered in connection with both radio broadcasting services and various Internet-based services, including entertainment, news and sports

⁴ Our conclusions would not change if we had considered applicant's original identification of services or its intervening proposed identification of services.

information services. The registrations also indicate that broadcasts, including radio broadcasts, are transmitted over the Internet. See, e.g., the BET registration below.

The following are examples of relevant third-party registrations⁵ provided by the examining attorney:

Reg. No. 2615865 for the mark BET, owned by Black Entertainment Television, Inc., for services including "television, radio and Internet broadcasting, narrow casting and cable casting services" in Class 38, as well as, "entertainment services, namely, ongoing television or radio programs in the fields of music, comedy, drama, news, live performances, health and fitness, lifestyle, travel, fashion, sports and topics of general interest distributed via cable, broadcast, satellite, the global computer network, audio and video media" in Class 41;

Reg. No. 2660469 for the mark WEATHERQUEST, owned by Weather Channel, Inc., for services including "radio broadcasting, television broadcasting, and cable television transmissions" in Class 38, as well as, "entertainment in the nature of on-going television programming, cable television programming, and radio programming in the fields of meteorology, news, travel, sports, science, and related contests distributed via broadcast television, cable television, radio, the Internet, telephones, WAP phones, personal digital assistants (PDAs), pagers and other electronic devices capable of receiving wire or wireless electronic communications" in Class 41;

Reg. No. 2882210 for the mark CLEAR CHANNEL, owned by Clear Channel Identity, L.P., for services including "radio and television broadcasting; Internet broadcasting services, namely the audio and video transmission of live and pre-recorded events over a global computer network and related audio and video entertainment" in Class 38, as well as, "production of

⁵ We have excluded from consideration any third-party registration which did not include a claim of use.

live entertainment events, namely, live concerts, festivals, theatrical shows, shows for the entertainment of children, magic shows, rib cook-offs, thrill shows, motor sports events, monster truck competitions, motorcycle competitions, drag racing events, and sporting events; production and distribution of television programs and network radio programming services; production and development of motion pictures; television and radio programming services for others; entertainment services in the nature of organizing musical, theatrical and family/variety tours and presentations; providing entertainment information related to national schedules of live entertainment events, entertainment news and personality profiles of touring talent available in print form and over a global computer network" in Class 41;

Reg. No. 2823862 for the mark FASTCAST, owned by FastCast Broadcasting, LLC, for services including "television, radio, cable television and computer on-line broadcasting services" in Class 38, as well as, "entertainment in the nature of on-going television programs in the field of current events, sports, local traffic and weather news and information" in Class 41;

Reg. No. 2649546 for the mark THIS IS BUSINESS, owned by Bloomberg L.P., for services including "Radio and television broadcasting; interactive electronic and audio and visual communication and information broadcasting over, by or through local or wide area computer networks, wireless communication networks, global computer information networks and other electronic communication networks" in Class 38, as well as, "Entertainment services in the nature of programming distributed over broadcast, television, radio, cable, and direct satellite in the fields of news, business, finance, current events, entertainment, sports, human interest stories, securities, securities markets and the energy and asphalt industries; entertainment services in the nature of producing and distributing programming distributed over broadcast, television, radio, cable, and direct satellite in the fields of news, business, finance, current events, entertainment, sports, human interest stories, securities, securities markets and the energy and asphalt industries" in Class 41;

Reg. No. 2893515 for the mark RADIO SAWA, owned by Broadcasting Board of Governors, for services including "communication services, namely, international radio broadcasting services and transmitting streamed sound and audio-visual material via the Internet" in Class 38, as well as, "news agencies, namely, gathering and international dissemination of news, news reporting services; entertainment, namely, providing programs in the field of local, national and international news, sports, health, education, arts, music, culture, and current events via radio and the Internet; production of international radio programs" in Class 41;

Reg. No. 2600176 for the mark SIGNALSTREAM.COM, owned by ITN Satellite Services, Inc., for services including "broadcasting via the Internet to desktop personal computers, programs containing multimedia content of others, featuring news, sports, entertainment, commercial, educational and corporate programming" in Class 38, as well as, "producing and creating audio, video and multimedia content in the fields of education, entertainment, news and sports, for delivery to personal computers via the Internet" in Class 41; and

Reg. No. 2747830 for the mark AIRIA, owned by AIRIA LIMITED, for services including "provision of broadcasting services to mobile users; provision of telecommunications connections to the Internet" in Class 38, as well as, "entertainment services, namely, providing television programming and streaming video content in the fields of sports, news, travel, history, geography, food, weather comedy . . ." in Class 41;

It is abundantly evident from these examples that the same mark has been registered, based on use, across numerous types of media, including both radio and the Internet, and that the content of such transmissions can include an infinite variety of combinations of subject

matter, including entertainment, news and sports.

Accordingly, we reject applicant's suggestion that "radio broadcasting services" stands apart from the entertainment services it identifies to be offered through the Internet. In fact, the evidence shows that even radio broadcasts are transmitted through the Internet, and that media companies have registered the same mark for use in a wide range of media, including both radio and the Internet. This circumstance demonstrates that consumers could believe that the services of applicant and registrant emanate from the same source.

We also reject applicant's argument that registrant's potential use of the Internet would be restricted to the mere promotion of its services over the Internet, and therefore, the services of applicant and registrant are distinct. The circumstances here are in no way similar to the circumstances in the cases cited by applicant, such as, Bally Total Fitness Holding Corp. v. Faber, 29 F.Supp.2d 1161, 50 USPQ2d 1840, 1843 (D.C. Cal. 1998).⁶ This is not a case where the claim is that the services are related

⁶ In both its main brief and reply brief we note that applicant has both cited and discussed numerous cases from the district courts. These cases involve infringement and similar claims where the focus is the actual use of marks. These cases are of limited relevance here due to our focus in this proceeding on the application and registration, not actual use.

simply because both parties use the Internet. Here applicant and registrant identify services offered through related media featuring subject matter which is potentially the same and which could reach the same consumers.

Based on the evidence of record, we conclude that the services of applicant and registrant, as identified in the application and cited registration, are closely related.

Similar Marks in Use on Similar Goods

Applicant also argues that the registered mark is "diluted" and, as such, should be accorded a narrow scope of protection. This argument apparently addresses Du Pont factor (8) - "The number and nature of similar marks in use on similar goods." In re E. I. du Pont de Nemours & Co., 177 USPQ at 567. To support this argument applicant refers to eight third-party registrations for marks which include either FAN or THE FAN in some form.

We first note that applicant has referred to certain information related to the registrations, but applicant has not provided copies of the registrations. To make registrations properly of record, the Board requires the submission of copies of the USPTO paper records or copies directly from the electronic records of the USPTO. In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1456 n.2 (TTAB 1999); In re Duofold Inc., 184 USPQ 638, 640 (TTAB

1974). Furthermore, the Board does not take judicial notice of registrations. In re JT Tobacconists, 59 USPQ2d 1080, 1081 n.2 (TTAB 2001). In this case, because the examining attorney has discussed the evidence without objecting to the form, we will consider the information applicant provided for whatever probative value it possesses.

As applicant indicates, in appropriate cases, the Board has considered whether third-party registrations ". . . indicate that the word, feature or design is more suggestive than arbitrary in a particular field, and, therefore, such a registration for goods or services in the same or related field should be given a more restricted scope of protection." (Citations omitted.) On the other hand, the Court of Appeals for the Federal Circuit recently has urged caution in relying on third-party registrations for this purpose noting that registration alone does not establish that a term is weak and that the probative value of third-party trademarks depends entirely upon their usage. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d at 1693.

In this case, even if we give applicant the benefit of the doubt and assume that the marks in the third-party registrations are in use, we find the evidence insufficient

to establish that "THE FAN" is weak in the radio broadcasting and related fields. First, all of the marks applicant references use "FAN" in a very different form than the form in both the application and registration, specifically, STAN THE FAN, THE FAN CHANNEL, THE OFFICIAL CARD OF THE FAN, FANCASTER, NETS HOT SHOTS FAN CLUB, FAN PHONE, FIRST FAN BUZZ and F.A.N. The referenced marks not only differ from applicant's mark and the registered mark, but applicant's and registrant's marks are identical.

This is not a case like the case cited by applicant where there were over 150 examples of registrations, as well as several advertisements from the classified section of the telephone directory, to show that the common element at issue, a "pizza man" design, was weak. Pizza Inn Inc. v. Russo, 221 USPQ 281, 282 (TTAB 1983). Nor is this a case where the evidence is sufficient to "tip the scales" when weighed with other factors. In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1912 (TTAB 1998).

Accordingly, on this record we are not persuaded that the registered mark is weak, and therefore, only entitled to a limited scope of protection, as applicant argues.

Other Arguments

We have also considered and reject applicant's argument noting that the FCC permits radio and television

stations owned by different parties to use the same call letters. This is simply not relevant to our determination. The marks at issue are not call letters, and the Trademark Act, not FCC provisions, governs our actions here. Also, applicant's suggestion that call letters are not treated like other trademarks is not correct. See In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214 (TTAB 2001) and In re WSM, Inc., 225 USPQ 883 (TTAB 1985).

Also, we reject applicant's argument that we should permit registration here because registrations owned by different parties allegedly exist for "FOX" for television and cable broadcasting services and "FOX 97" for radio broadcasting services. Again, applicant has provided no records and no other information related to these marks. Nevertheless, ultimately we must decide each case on its own merits, and not based on actions taken on prior applications involving different facts. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

CONCLUSION

In sum, after considering all evidence of record bearing on the du Pont factors, we conclude that there is a likelihood of confusion in this case. We conclude so principally because the marks of applicant and registrant

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are identical and because the services of applicant and registrant are closely related.

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