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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Zoom Photo Ads, L.L.C.

Serial No. 78592712

Diane L. Gardner of Mastermind IP Law P.C. for Zoom Photo Ads, L.L.C.

Asmat Khan, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hohein, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Zoom Photo Ads, L.L.C. ("applicant") seeks registration on the Principal Register of the mark



for, inter alia, International Class 35<sup>1</sup> services ultimately identified as:

advertising services, namely, providing advertising space in a periodical featuring advertisements for recreational vehicles, parts, accessories, and related services of others; advertising periodical distribution; advertising recreational vehicles, parts, accessories and related services of others via electronic media in the form of classified advertisements; dissemination of advertisements and advertising material relating to recreational vehicles, parts, accessories and related services of others, in the form of leaflets, brochures and printed matter; dissemination of advertising of recreational vehicles, parts, accessories and related services for others via an online communications network; creating advertising material relating to recreational vehicles, parts, accessories and related services of others.

Applicant has claimed first use anywhere and first use in commerce on March 14, 2005 and has entered the following description of the mark: "The mark consists of [t]he word 'ZOOM' in 3-dimensional block letters such that the letters 'O' form the wheels of a motorcycle in motion."<sup>2</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark

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<sup>1</sup> While the application also includes goods in International Class 16, the examining attorney's refusal, discussed *infra*, is only directed to the services in International Class 36.

<sup>2</sup> Application Serial No. 78592712, filed March 22, 2005.



for "advertising services, namely preparing and placing advertisements for others on a variety of media including illuminated and non-illuminated billboards, postcards, postcard racks, posters, and illuminated signs; and dissemination of advertising for other[s] via an on-line electronic communication network[]" in International Class 35.<sup>3</sup> Registrant has entered a disclaimer of the term MEDIA.

Applicant has appealed the final refusal of the examining attorney. Both applicant and the examining attorney have filed briefs. As discussed below, the refusal to register is affirmed.

We first address one preliminary matter. Applicant sought to introduce into the record a large amount of evidence for the first time with its attorney's brief, to which the examining attorney has objected. With its reply brief, applicant filed a "Provisional Request for Suspension and Remand of Application," seeking suspension

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<sup>3</sup> Registration No. 2839338, issued May 11, 2004.

of this appeal and a remand to the examining attorney of the application for consideration of the evidence submitted with its appeal brief. The examining attorney's objection is sustained and applicant's request for suspension and remand is denied. As stated in Trademark Rule 2.142(d), 37 C.F.R. 2.142(d), in countless Board decisions, in TMEP § 710.01(c) (5th ed. 2007) and in TBMP § 1207.01 (2d ed. rev. 2004), the record should be complete prior to the filing of an appeal. Further, the evidence applicant seeks to enter for the first time is not newly discovered and thus could have easily been entered into the record earlier in this proceeding.<sup>4</sup> Moreover, the issues which are discussed in applicant's brief are the same as those discussed in applicant's responses to the examining attorney's Office actions. Additionally, to the extent that applicant requests that we take judicial notice of

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<sup>4</sup> Applicant asserts in its request that the examining attorney has raised a new issue in her brief consisting of a "new 'test'" regarding registrant's logical zone of expansion. However, the examining attorney previously raised the issue of a logical zone of expansion for registrant's services in her final Office action. Additionally, as demonstrated *infra*, any reliance by the examining attorney on a logical zone of expansion argument is unnecessary to our resolution of this appeal. See also, *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1854 (TTAB 2007) ("[W]e look [in an ex parte proceeding] at the question of the relatedness of the services identified in applicant's application and those in the cited registration based on whether consumers are likely to believe that the services emanate from a single source, rather than whether the Examining Attorney has shown that the registrant herein has or is likely to expand its particular business to include the services of applicant.")

this evidence, we decline to do so - such evidence is not the type of evidence of which the Board takes judicial notice. See TBMP § 1208.04 (2d ed. rev. 2004). Thus, we do not further consider any of applicant's evidence submitted for the first time with its brief.<sup>5</sup>

We now turn to the merits of the Section 2(d) refusal. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key 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). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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<sup>5</sup> Even if we had considered this evidence, our resolution of this appeal would not be any different. The evidence has little bearing on the issues in this appeal.

We first consider the *du Pont* factors regarding the relatedness of the services, trade channels and classes of purchasers. Applicant's services include the "dissemination of advertising of recreational vehicles, parts, accessories and related services for others via an online communications network" and registrant's services include the "dissemination of advertising for other[s] via an on-line electronic communication network[]."

Applicant's identification of services specifies the subject matter of the advertising and registrant's identification does not. Nonetheless, because registrant has not limited its services to a particular field, we must construe registrant's advertising as including the same subject matter as recited in applicant's identification of services, i.e., recreational vehicles, parts, accessories and related services. Thus, the services are in part legally identical.<sup>6</sup> And, because they are in part legally

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<sup>6</sup> Applicant has introduced into the record a printout of registrant's webpage which describes the nature of registrant's business and characterizes registrant's services as only involving signs, billboards, posters and postcards. The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the services recited in applicant's application vis-à-vis the services recited in registrant's registration, rather than what the evidence shows the services to be. See *Octocom Systems, Inc. v. Houston Computer Services 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 [services] set forth in the

identical, and there are no trade channel or purchaser restrictions in the identification of services, we find that the trade channels and classes of purchasers of applicant's and registrant's services are in part identical. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (if there are no limitations in the identification, the Board presumes that the registration encompasses all services of the nature and type described, and that the identified services move in all channels of trade that would be normal for such services.") The *du Pont* factors regarding the relatedness of the services, trade channels and purchasers hence are resolved against applicant and in favor of a finding of a likelihood of confusion.

Applicant has argued that the level of care undertaken by purchasers in making their purchases and the sophistication of purchasers favor applicant. We are not persuaded by applicant's arguments because they are not supported by any evidence. Also, applicant's assumption that registrant's services are "expensive" and for "mass-marketing" and "large-scale advertising on media such as illuminated billboards" based on the recitation of services

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application regardless of what the record may reveal as to the particular nature of an applicant's [services], the particular channels of trade or the class of purchasers to which the sales of [services] are directed.").

is ill-founded. Registrant's identification of services includes, e.g., preparing and placing advertisements for others on postcards, postcard racks or posters and does not specify that such advertising is on a large scale or for mass-marketing. The *du Pont* factor covering the sophistication of purchasers and the care with which purchases are made therefore is neutral.

Turning next to the marks, we consider the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. We keep in mind the Federal Circuit's guidance in situations where marks appear on virtually identical services, namely, that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The main point of contention between applicant and the examining attorney as reflected in their briefs concerns what weight to give the term ZOOM which appears in both applicant's and registrant's marks. The examining attorney maintains that "the literal portions [of the marks] are

generally the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion," citing *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Brief at unnumbered p. 4. Applicant maintains that the examining attorney "has not met the burden of establishing why, in this specific case" the literal portion of applicant's mark dominates; that the Federal Circuit has observed, "[i]n considering the mark as a whole the ... Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components," citing *In re Oppendahl & Larsen LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); that "[h]ere, the Examining Attorney has not performed a comparative weighing, but has merely arrived at a conclusion without any support"; and that "when the design portion of the mark is very distinctive, recognizable as a common article such as a motorcycle, and suggestive of the goods and services, consumers will be more likely to recall the design portion of the mark." Brief at pp. 9-10.

As to its mark, applicant points out that the "sheer size" of the motorcycle portion of its mark cannot be ignored; that the "wheels of the motorcycle design are 'borrowed' by the term 'ZOOM' as substitutes for the

letters 'O'; and that the design is an integral portion of the mark, rather than serving as a mere accessory or as background. Applicant concludes that "the large design portion of the mark, especially when compared to the remaining 'Z' and 'M' letters absent the design element, should be afforded great weight in determining whether a likelihood of confusion exists ...."

We find that when a purchaser views applicant's mark, the purchaser will, without hesitation, first perceive the word ZOOM. The letters forming ZOOM are larger than the motorcycle character, and extend from one end of the mark to the other, thereby forming the lateral boundaries of the mark. Also, the two "O"s in ZOOM which the motorcycle borrows for its wheels, are of the same size as the remaining lettering in ZOOM and are integral with ZOOM. Thus, to us, the mark appears more as the word ZOOM with the image of a person riding a motorcycle depicted above ZOOM, than as a rider on a motorcycle with the letters "Z" and "M" added next to the wheels of the motorcycle. Further, it has long been established that "[i]n a composite mark comprising a design and words, the verbal position of the mark is the one most likely to indicate the origin of the goods to which it is affixed." *W.B. Roddenbery Co. v. Kalich*, 158 F.2d 289, 291, 72 USPQ 138,

139-40 (CCPA 1946). We therefore find that the word ZOOM is the dominant element in applicant's mark.

Similarly, the word ZOOM is the dominant element in registrant's mark. The term MEDIA, which is merely descriptive of a feature of applicant's services, has been disclaimed; disclaimed matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). Also, the combination of letters "ZO" and "OM" in the upper portion of the mark, which in and of themselves have no meaning, would, with the aid of the wording at the bottom of the mark, be perceived as forming the word ZOOM. As for the design elements in registrant's mark, they would be viewed merely as background for the wording in registrant's mark.

The Federal Circuit has recognized that although the marks at issue must be considered in their entireties, 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. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We do so here, and find on balance, that the marks overall are more similar than dissimilar, and that they are similar at least as to

connotation, sound and commercial impression. The differences in appearance due to the design elements and the additional word MEDIA, as well as the letters "ZO" and "OM," are outweighed by the similarities in connotation, sound and commercial impression. We hence resolve the *du Pont* factor regarding the similarity between the marks in favor of a finding of a likelihood of confusion.

In short, we find that the marks are similar, and that, in part, the services, trade channels and purchasers are legally identical. Based on these findings under the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. To the extent that we have any doubt as to our conclusion in this regard, we must resolve such doubt in favor of the registrant. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d) is affirmed.<sup>7</sup>

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<sup>7</sup> Applicant has pointed out that a highly similar mark it owns has recently registered for the same services as those set forth in the present application. However, as stated in *In re Outdoor Recreation Group*, 81 USPQ2d 1392, 1399 (TTAB 2006), "neither the examining attorney nor this Board is bound by the decisions of prior examining attorneys, even in cases involving related marks and/or goods. While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable." (Citation omitted.)