

THIS OPINION  
IS NOT A PRECEDENT OF  
THE T.T.A.B.

Mailed: 9/14/07

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZONE Telecom, Inc.

Serial No. 78644185

Gerald E. McGlynn, III of Bliss McGlynn for ZONE Telecom,  
Inc.

Laura A. Hammel, Trademark Examining Attorney, Law Office  
116 (Michael W. Baird, Managing Attorney).

Before Quinn, Hairston and Zervas, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by ZONE Telecom, Inc. to  
register the mark shown below



("BROADBAND PHONE" disclaimed) for "providing  
telecommunication services, namely, providing business and

residential VOIP-based (voice-over-internet-protocol based) telephone-communication services."<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark shown below



("PHONE" disclaimed) for "telecommunication services, namely, personal communication services (PCS)"<sup>2</sup> as to be likely to cause confusion.

When the refusal to register was made final, applicant appealed. Applicant and the examining attorney filed

---

<sup>1</sup> Application Serial No. 78644185, filed June 6, 2005, alleging a bona fide intention to use the mark in commerce. The application includes the following description of the mark: "The mark consists of a design comprising a solid stylized 'Z' partially enclosed by a hollow, partial oval, which is enclosed by a solid, shaded oval and the word mark 'ZONE BROADBAND PHONE' located immediately and directly to the right of the design and including a tilde located over the letters 'ND,' wherein the lower half is shaded."

<sup>2</sup> Registration No. 2499309, issued October 23, 2001.

briefs.<sup>3</sup>

Applicant contends that there are "very strong differences" between the marks in sound and appearance. In arguing that the cited mark is weak, applicant relied on a list of third-party registrations and applications. Throughout the prosecution of its application, applicant has not disputed the examining attorney's finding that the services are related.

The examining attorney maintains that the involved marks are dominated by the identical term, ZONE, and that the marks, when considered in their entireties, are similar. The examining attorney also asserts that the services are similar telecommunication services that target the same consumers. In connection with this argument, the examining attorney relied upon third-party registrations listing both types of services, as well as excerpts of articles retrieved from the NEXIS database. Also of record are dictionary definitions of the terms "personal communication services" and "broadband."

Before turning to the merits, we first direct our attention to an evidentiary matter. Applicant's brief is

---

<sup>3</sup> The examining attorney has requested that the Board accept her late-filed brief. She indicated that the brief was filed one day late due to illness. In view of the circumstances set forth by the examining attorney, the brief is accepted as if timely filed.

accompanied by a printout of listings of third-party registrations and applications retrieved from the USPTO's TESS database. The examining attorney objected to the evidence as untimely submitted. Applicant responded by asserting that, contrary to the examining attorney's view, this evidence was introduced during the prosecution of its application.

Applicant, in its June 23, 2006 response, made a general reference to the existence of various third-party registrations, contending that the cited mark is weak and entitled to a narrow scope of protection.<sup>4</sup> In response, the examining attorney, in her final refusal dated August 2, 2006, quoted applicant's reference to the third-party registrations, but indicated that such evidence is entitled to little weight in the likelihood of confusion analysis. Applicant then submitted with its appeal brief a TESS printout listing third-party registrations, as well as third-party applications.

Applicant's mere general reference to the existence of third-party registrations clearly was insufficient to make any registrations of record. Rather than alert applicant

---

<sup>4</sup> The reference was to the total number of existing registrations; applicant neither gave registration numbers nor any other information. There also was no reference to third-party applications.

that this mere reference was insufficient at a point where applicant could have corrected the error, the examining attorney responded in kind, with a general statement that such evidence is entitled to little probative value. We therefore have considered applicant's general reference to the state of the register, but the mere reference is entitled to no probative value. TBMP § 1208.02 (2d ed. rev. 2004). As noted above, applicant then submitted with its appeal brief a printout listing third-party registrations and applications taken from the TESS database. This listing is insufficient to make the registrations and applications of record. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002). Nor can we deem the examining attorney to have waived any objection to the TESS listing by failing to advise applicant of the original insufficiency, since at the point that applicant filed the list it no longer had an opportunity to add to the record of the application. Accordingly, we have not considered the TESS listing. *See In re 1<sup>st</sup> USA Realty Professionals, Inc.*, \_\_\_USPQ2d\_\_\_ (Ser. No. 78553715, TTAB August 7, 2007). We hasten to add that, even if we were to consider the list, it has no probative value since it does not show the goods or services for which the marks are registered. In addition, the third-party applications have

no evidentiary value other than to show that they were filed. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992). Thus, even if considered, the list of third-party registrations and applications does not compel a different result in this case.

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, however, two key considerations are the similarities between the marks and the similarities between the 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).

With respect to the services, it is not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of

the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same entity. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). It is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services identified in the cited registration. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Where the services in the application at issue and/or in the cited registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of services encompasses not only all the services of the nature and type described therein, but that the identified services are offered in all channels of trade which would be normal therefore, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Applicant's services are identified as "telecommunication services, namely, providing business and residential VOIP-based (voice-over-internet-protocol based) telephone-communication services." Registrant's services are "telecommunication services, namely, personal communication services (PCS)." As shown by the record, "personal communication services (PCS)" are defined as "wireless communications services that use the 1900 MHz band." (www.computeruser.com). PCS involve the use of digital cellular technologies.

Applicant, throughout the prosecution of its application, has not disputed the examining attorney's finding that the services are related. Indeed, applicant has been entirely silent on this point. Lest there be any doubt regarding the close relationship between applicant's and registrant's services, the examining attorney introduced several use-based third-party registrations showing that each entity adopted a single mark for telecommunications services of the types involved herein. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and/or services are of a type that may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re*

*Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

The examining attorney also introduced NEXIS articles that serve to buttress her finding that the services are closely related.

Based on the close relationship between the services, we presume that the services would be rendered to the same classes of purchasers, including ordinary consumers.

The similarities between the services and the identity in the classes of consumers to whom the services are rendered weigh in favor of a finding of likelihood of confusion.

We next turn to compare the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected of the average purchaser, who normally retains a general rather than a specific impression of trademarks to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on

Ser No. 78644185

the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to comparing applicant's mark Z ZONE BROADBAND PHONE and design with registrant's mark THE ZONE PHONE and design, it is well settled that 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. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["There 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. Indeed, this type of analysis appears to be unavoidable."]

It is further well established that, in the case of a logo mark, the literal portion of a mark generally is the dominant feature because it is the element by which consumers will refer to and call for the goods. *In re Dacombe*, 9 USPQ2d 1813, 1814 (TTAB 1988). This is clearly the case with respect to applicant's and registrant's marks. We find that the literal portions ZONE BROADBAND

PHONE and THE ZONE PHONE dominate the involved marks, respectively.<sup>5</sup>

Descriptive matter generally is subordinate to source-identifying portions of a mark. For example, in the past merely descriptive matter that is disclaimed has been accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 41 USPQ2d at 1533-34; and *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) [Disclaimed matter is often "less significant in creating the mark's commercial impression"]. In the present case, applicant has disclaimed the highly descriptive/generic term "BROADBAND PHONE" while registrant has disclaimed the generic term "PHONE." See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, *In re National Data Corp.*, 224 USPQ at 752 ["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'"]. Further, the term "THE" in registrant's mark clearly has no source-identifying function. Thus, these

---

<sup>5</sup> In saying this we recognize that applicant's mark includes the letter "Z." This letter, however, is highly stylized and is unlikely to be used in calling for applicant's services.

terms play a very subordinate role, and each mark is dominated by the identical term "ZONE."<sup>6</sup>

Applicant's arguments that "the font differences and the tilde are more likely to be impressed upon a purchaser's memory than is the word 'ZONE' in [applicant's] mark" or that "the wording 'BROADBAND PHONE' is undoubtedly the dominant portion in [applicant's] mark" simply are ill founded, and are entirely unpersuasive.

We must do more, however, than compare the individual components of the mark; it is critical that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. The involved marks are similar because they are dominated by the identical term "ZONE." Because of the presence of the identical term "ZONE," the marks are similar in sound and appearance. As to meaning, although applicant states that the term "zone" is descriptive or suggestive, there is no evidence on this point. In any event, given the similarity between the services, it is

---

<sup>6</sup> Applicant agrees when it states that "the word 'ZONE' is undoubtedly the dominant portion in the registrant's word mark." (Brief, p. 6).

likely that the term, if suggestive, would convey the same suggestion or meaning. While we recognize the obvious differences between the marks, ultimately the similarities in appearance, sound, meaning and overall commercial impression outweigh the differences. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) [Court affirmed refusal to register the mark JOSE GASPAR GOLD in view of a prior registration of GASPAR'S ALE. The "Board had good reason to discount ALE, JOSE, and GOLD as significant differences between the marks."]. In comparing the marks, applicant engaged in a painstaking, detailed analysis. In finding that the marks are similar, however, we have kept in mind the fallibility of the average purchaser, who normally retains a general rather than a detailed, specific impression of trademarks encountered in the marketplace.

The similarities between the marks weigh in favor of a finding of likelihood of confusion.

We conclude that consumers familiar with registrant's personal communication services rendered under the mark THE ZONE PHONE and design would be likely to believe, upon encountering applicant's mark Z ZONE BROADBAND PHONE and design for business and residential VOIP-based (voice-over-internet-protocol based) telephone-communication services

**Ser No.** 78644185

that the services originate from or are associated with or sponsored by the same source.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.