IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
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VOX MEDIA, INC.	:	Trademark Attorney
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Serial No. 88/495661	:	David A. Brookshire, Esq.
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Filed: July 1, 2019	:	Law Office 114
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Mark: BANNER SOCIETY	:	

RESPONSE TO OFFICE ACTION

This is in response to the Office Action dated July 29, 2019, in which the Office refused registration of Applicant's mark BANNER SOCIETY under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on an alleged likelihood of confusion with the marks in U.S. Registration Nos. 4403460 (BANNER & Design) and 4692899 (BANNER COLLECTIVE).

As set forth in more detail below, Applicant submits that consumer confusion is unlikely and, as such, respectfully requests that the Office withdraw the refusal to register and approve the application for publication.

I. AMENDMENT TO IDENTIFICATION OF SERVICES

Concurrently with the filing of this Response, Applicant has amended its identification of services to delete "*production and distribution of videos, audio, ongoing programs, and multimedia content*" to further distinguish Applicant's services from those in the cited registrations. Applicant's amended services are below and relate solely to the provision of sports content—services that are targeted to individuals looking for sports information and news—and not the provision of video and film production services, which are specialized and sophisticated services that are entered into after consideration and study and that are targeted to a different segment of consumer.

> *Providing information, news, and commentary in the field of sports; providing a website featuring entertainment information in the field of sports; providing online non-downloadable articles, audio, videos, images, and multimedia content in the field of sports; entertainment services, namely, providing podcasts in the field of sports; providing online newsletters in the field of sports; online journals, namely, blogs in the field of sports; providing online non-downloadable videos in the field of sports; entertainment services, namely, providing an ongoing online video series in the field of sports; educational and entertainment services, namely, a continuing program about sports accessible by radio, television, satellite, audio, video, and computer networks.*

II. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARKS

The Office has cited the following registrations as obstacles to registration of Applicant's mark on the grounds of alleged confusion:

Mark	Reg. No.	Services
	4403460	"Media production services, namely, video and film production" in Class 41
BANNER COLLECTIVE	4692899	"Media production services, namely, video and film production" in Class 41

Under *In re E.I. DuPont de Nemours & Co.*, the Office must consider several factors to determine if a likelihood of confusion exists between marks. 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). In the present case, no likelihood of confusion exists between Applicant's mark and the cited marks for the following reasons:

- the marks differ visually, phonetically, and connotatively;
- the services are different, travel in different trade channels, and are targeted to different classes of consumers;
- the services in the cited registrations are purchased by sophisticated and discriminating professionals after deliberation and under different purchasing conditions; and
- the cited marks are weak and subject to narrow protection since they coexist with other BANNER-formative marks.

A. Applicant's mark and the cited marks are different in appearance, sound, and connotation.

Under § 1207.01 of the Trademark Manual of Examining Procedure, the Office must analyze the marks in their entireties—by comparing their appearance, sound, connotation and overall commercial impression—to make a complete consideration of the similarity or dissimilarity of the marks. *See also In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Here, when viewed in their entireties, Applicant's mark and the cited marks differ visually, phonetically, and connotatively.

Applicant's mark is different both visually, aurally, and in overall commercial impression because it has a distinguishable element that the cited marks lack. Specifically, Applicant's mark includes the word "SOCIETY" immediately after "BANNER," whereas the cited marks do not contain this term. Additionally, the cited mark BANNER (U.S. Reg. No. 4403460) contains stylization and design elements that Applicant's mark does not possess.

Applicant's mark, furthermore, is connotatively distinct from the cited marks. A mark's distinctiveness must be evaluated in relation to the particular services for which registration is sought. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300 (Fed. Cir. 2012). Here,

Applicant's services relate to the provision of sports content. In the context of Applicant's services, the word "BANNER" suggests team identity and team spirit, which is a connotation that does not exist with respect to the cited marks for production services. The overall impression of Applicant's BANNER SOCIETY mark is of an athletic club or organization, while the cited marks do not have such a commercial impression.

Since Applicant's mark contrasts visually, phonetically, and connotatively from the cited marks, consumer confusion is unlikely. Even where marks share a common element, confusion is unlikely if the marks create a different commercial impression. *See Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970). The Federal Circuit has held that the dissimilarity of the marks alone can support a finding that there is no likelihood of confusion. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998) (upholding the Board's dismissal of an opposition to CRYSTAL CREEK for wine filed by the owner of the registered mark CRISTAL for champagne).

Given the visual and phonetic differences between the marks and the differences in meaning and commercial impression, confusion simply is not likely.

B. The services are different, travel in different trade channels, are targeted to different classes of consumers, are neither complementary nor competitive, and are purchase by sophisticated consumers.

In addition to the differences between the marks, confusion is not likely because the services in the parties' respective filings are neither identical nor overlapping, and are directed towards different groups of consumers for different purposes. Applicant's services are targeted to consumers who want to learn sports information and news. The cited marks, on the other hand, are registered for video and film production services, which are services that are targeted to content creation companies looking for a partner to produce a film or video for them. The services at issue are distinguishable and are not competitive. A consumer wanting sports news will not look to hire a film production company to create a custom film on this topic; the services are distinct and serve different purposes.

If goods or services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then confusion is not likely. TMEP § 1207.01(a)(i). Goods or services "may fall under the same general product category but operate in distinct niches." "[T]o demonstrate that goods are related, it is not sufficient that a particular term may be found, which may broadly describe the goods." *In re The W.W. Henry Co., L.P.*, 82 USPQ 2d 1213 (TTAB 2007); *see also Harvey Hibbell Inc. v. Tokyo Seimitsu Co., Ltd*., 188 USPQ 517 (TTAB 1975). Rather, "when two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that customers are not likely to assume the products originate from the same mark." *See, e.g. Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc*., 269 F.3d 270, 288 (3rdCir. Oct. 19, 2001); *Information Resources Inc. v. X*Press Information Services*, 6 USPQ 2d 1034 (TTAB 1988). Moreover, the Board has held that differences in the functions or purpose of products or services may prevent likelihood of confusion. *See Aries Systems Corp. v. World Vook, Inc*., 26 USPQ 2d 1926, *21 (TTAB 1993).

Additionally, the cited registrations' film and video production services are specialized and sophisticated services that are not purchased on impulse but rather after consultation, collaboration, and study between the provider and customer. As such, the relevant consumer or prospective consumer is very unlikely to confuse film and video production with the provision of sports content. Consequently, a likelihood of consumer confusion does not exist.

Even where purchasers of goods and services are the same, their sophistication is important and often dispositive when determining likelihood of confusion because sophisticated consumers are expected to exercise greater care in making purchasing decisions. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp*., 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (no likelihood of confusion between marks E.D.S. and EDS, even though the two parties conduct business in same field and with some of same companies, because the purchasers were highly knowledgeable professionals who made purchasing decisions after careful consideration); *CMM Cable Rep. v. Ocean Coast Props., Inc*., 36 U.S.P.Q.2d 1458 (D. Me. 1995) (no likelihood of confusion found between PAYDAY CONTEST and PAYCHECK PAYOFF for radio promotions, where the marketing decision makers were sophisticated commercial purchasers who spend large amounts of money after careful consideration). The deliberation with which professionals purchase the cited registrant's film and video production services makes it highly unlikely that any confusion would arise. In light of the degree of care involved in the purchasing decision, the likelihood is remote that the registrant's services would be confused with the services for which Applicant is seeking registration.

Even in cases involving identical or nearly-identical marks where the goods and services are broadly encompassed in the same field or class, the Board and courts have routinely found no likelihood of confusion. *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp*., 23 USPQ 2d 1460 (TTAB 1992) (EDS and EDSA, both for goods and services involving computer programs, found not confusingly similar); *Electronic Design & Sales Inc. v. Electronic Data Systems Corp*., 21 USPQ 2d 1388 (Fed. Cir. 1992) (EDS and E.D.S. found not confusingly similar, even though two parties conduct business in same field and with some of same companies); *In re Massey-Ferguson Inc*., 222 USPQ 367 (TTAB 1983) (ECOM not confusingly similar to E-COM, both for goods and services involving computers).

The present case is even more compelling in that Applicant's services are more dissimilar than the goods or services at issue above where no confusion was found. The services in the cited registrations, and Applicant's services, are purchased by different classes of consumers for different purposes through different channels of trade. Since the services in Applicant's application and the cited registration are distinct and serve different purposes, and are neither complementary nor competitive, no reasonably prudent consumer would be confused as to source, sponsorship, endorsement, or affiliation. As such, confusion is not likely.

C. The cited marks are weak and entitled only to narrow protection.

Furthermore, the Office has already determined that consumer confusion is unlikely. Other trademarks incorporating the term "BANNER" co-exist for related services in Class 41 (see

examples below). As such, the Office has already acknowledged that consumers can distinguish between "BANNER" trademarks based even on minor differences in the marks or services.

Trademark	App.	Reg.	Status	Services	Owner
BANNER MUSIC Banner Music	**App** 77332929	**Reg** 3563260	Renewed (Registered) **USPTO Status:** Registered and renewed **USPTO Status Date:** 22-FEB-2019	**INT. CL. 41** MUSIC PUBLISHING SERVICES **First Used:** 20-DEC-1996 (IC 41) **In Commerce:** 20-DEC-1996	BANNER MUSIC
BANNERLORD **Cross References:** BANNER LORD BANNERLORD	**App** 79130604	**Reg** 4473173	Registered Section 66(a) (Madrid Protocol) - Filed Section 66(a) (Madrid Protocol) - Current International Priority Claimed Notice of First Refusal **USPTO Status:** Registered **USPTO Status Date:** 28-JAN-2014	**INT. CL. 9** MAGNETIC AND OPTICAL DATA CARRIERS FEATURING COMPUTER GAME SOFTWARE; COMPUTER GAME PROGRAMS AND GAME SOFTWARE RECORDED ON MAGNETIC AND OPTICAL CARRIERS; COMPUTER GAME CARTRIDGES; ELECTRONIC PUBLICATIONS IN THE NATURE OF BOOKS AND MAGAZINES IN THE FIELD OF COMPUTER GAMES, BOTH DOWNLOADABLE AND RECORDED ON MAGNETIC AND OPTICAL MEDIUMS; MAGNETICALLY CODED IDENTITY CARDS, FLASH MEMORY CARDS FEATURING COMPUTER GAME SOFTWARE, ELECTRONIC MAGNETIC AND OPTICAL CARD READERS WHICH MAY ALSO BE PURCHASED AT RETAIL STORES **INT. CL. 28** GAMES AND TOYS, NAMELY, INFLATABLE TOYS WHICH ARE USED DURING BATH AND SWIMMING, TOY ACTION FIGURES AND ACTION FIGURE ACCESSORIES, PLAYING CARDS, BOARD GAMES, ELECTRONIC GAMES CONSOLES FOR USE WITH AN EXTERNAL DISPLAY SCREEN OR MONITOR, MACHINES AND APPARATUS ADAPTED FOR USE WITH AN EXTERNAL DISPLAY SCREEN OR MONITOR, NAMELY, VIDEO GAME CONSOLES, VIDEO OUTPUT GAME MACHINES, AND ELECTRONIC INTERACTIVE BOARD GAMES; COIN-OPERATED AMUSEMENT MACHINES **INT. CL. 41** PREPARATION OF PUBLICATIONS, NAMELY, MAGAZINES, BOOKS AND NEWSPAPERS FOR PUBLISHING, NAMELY, COPY EDITING AND PUBLISHING OF ELECTRONIC PUBLICATIONS; MAKING PUBLICATIONS AVAILABLE FOR READERS, NAMELY, PROVIDING ONLINE PUBLICATIONS IN THE NATURE OF MAGAZINES, BOOKS	TALEWORLDS ENTERTAINMENT IKISOFT, YAZILIM BILGI VE ILETISIM, EGITIM TEKNOLOJILERI, VE HIZMETLERI ELEKTRONIK, SANAYI VE TICARET LIMITED SIRKETI (Turkey)

Trademark	App.	Reg.	Status	Services	Owner
				AND NEWSPAPERS IN THE FIELD OF VIDEO GAMES; PUBLISHING OF ELECTRONIC PUBLICATIONS AND PUBLICATION OF MAGAZINES, BOOKS AND NEWSPAPERS THROUGH GLOBAL COMMUNICATION NETWORK; PRODUCTION OF FILMS, VIDEO FILMS, RADIO AND TELEVISION PROGRAMMES	
ABV A BANNER VISION 	**App** 88618159 Approved for publication		Pending **USPTO Status Date:** 24-SEP-2019	**INT. CL. 41** COMPOSITION OF MUSIC FOR OTHERS; MUSIC COMPOSITION FOR OTHERS; ENTERTAINMENT SERVICES IN THE NATURE OF RECORDING, PRODUCTION AND POST-PRODUCTION SERVICES IN THE FIELD OF MUSIC; ENTERTAINMENT SERVICES BY A MUSICAL ARTIST AND PRODUCER, NAMELY, MUSICAL COMPOSITION FOR OTHERS AND PRODUCTION OF MUSICAL SOUND RECORDINGS; ENTERTAINMENT SERVICES IN THE NATURE OF PRODUCTION OF MULTIMEDIA ENTERTAINMENT CONTENT; ENTERTAINMENT SERVICES IN THE NATURE OF DEVELOPMENT, CREATION, PRODUCTION, DISTRIBUTION, AND POST-PRODUCTION OF MULTIMEDIA ENTERTAINMENT CONTENT; ENTERTAINMENT SERVICES, NAMELY, MULTIMEDIA PRODUCTION SERVICES; MULTIMEDIA ENTERTAINMENT SERVICES IN THE NATURE OF DEVELOPMENT, PRODUCTION AND POST-PRODUCTION SERVICES IN THE FIELDS OF VIDEO AND FILMS; MULTIMEDIA ENTERTAINMENT SERVICES IN THE NATURE OF RECORDING, PRODUCTION AND POST-PRODUCTION SERVICES IN THE FIELDS OF MUSIC, VIDEO, AND FILMS **First Used:** 09-SEP-2014 (IC 41) **In Commerce:** 30-JAN-2015	CAMP, LAVELL W. A BANNER VISION, LLC
DAVID BANNER DAVID BANNER	**App** 88396859	**Reg** 5891221	Registered **USPTO Status:** Registered **USPTO Status Date:** 22-OCT-2019	**INT. CL. 9** DOWNLOADABLE MUSIC FILES; DOWNLOADABLE VIDEO RECORDINGS FEATURING MUSICAL PERFORMANCES AND PRODUCTION; MUSICAL SOUND RECORDINGS; MUSICAL VIDEO RECORDINGS; VISUAL AND AUDIO RECORDINGS FEATURING MUSIC AND ARTISTIC PERFORMANCES; COMPACT DISCS FEATURING MUSIC; DIGITAL MUSIC DOWNLOADABLE FROM THE INTERNET; DOWNLOADABLE MUSICAL SOUND RECORDINGS; DOWNLOADABLE RING TONES AND GRAPHICS FOR MOBILE PHONES; DOWNLOADABLE RING TONES FOR MOBILE PHONES;	A BANNER VISION, LLC CRUMP, LAVELL W.

Trademark	App.	Reg.	Status	Services	Owner
				DOWNLOADABLE RING TONES, GRAPHICS AND MUSIC VIA A GLOBAL COMPUTER NETWORK AND WIRELESS DEVICES; PHONOGRAPH RECORDS FEATURING MUSIC; SERIES OF MUSICAL SOUND RECORDINGS **INT. CL. 41** ENTERTAINMENT SERVICES BY A MUSICAL ARTIST AND PRODUCER, NAMELY, MUSICAL COMPOSITION FOR OTHERS AND PRODUCTION OF MUSICAL SOUND RECORDINGS; ENTERTAINMENT SERVICES IN THE NATURE OF LIVE VISUAL AND AUDIO PERFORMANCES, NAMELY, MUSICAL, VARIETY, NEWS AND COMEDY SHOWS; ENTERTAINMENT SERVICES, NAMELY, PROVIDING NON-DOWNLOADABLE PLAYBACK OF MUSIC VIA GLOBAL COMMUNICATIONS NETWORKS; ENTERTAINMENT SERVICES, NAMELY, PROVIDING NON-DOWNLOADABLE PRERECORDED MUSIC, INFORMATION IN THE FIELD OF MUSIC, AND COMMENTARY AND ARTICLES ABOUT MUSIC, ALL ON-LINE VIA A GLOBAL COMPUTER NETWORK; MULTIMEDIA ENTERTAINMENT SERVICES IN THE NATURE OF RECORDING, PRODUCTION AND POST-PRODUCTION SERVICES IN THE FIELDS OF MUSIC, VIDEO, AND FILMS; ENTERTAINMENT SERVICES IN THE NATURE OF LIVE MUSICAL PERFORMANCES; ENTERTAINMENT SERVICES IN THE NATURE OF LIVE AUDIO PERFORMANCES BY A MUSICAL ARTIST; ENTERTAINMENT SERVICES IN THE NATURE OF LIVE VISUAL AND AUDIO PERFORMANCES BY A MUSICAL ARTIST; ENTERTAINMENT SERVICES IN THE NATURE OF LIVE VOCAL PERFORMANCES BY A MUSICAL ARTIST; ENTERTAINMENT SERVICES IN THE NATURE OF PRESENTING LIVE MUSICAL PERFORMANCES **First Used:** 01-JAN-1992 (IC 09) **In Commerce:** 01-JAN-1992 **First Used:** 01-JAN-1992 (IC 41) **In Commerce:** 01-JAN-1992	
BANNERS OF FATE BANNERS OF FATE	**App** 86648938	**Reg** 4912676	Registered Section 44(D) **USPTO Status:** Registered **USPTO Status Date:** 08-MAR-2016	**INT. CL. 41** PROVIDING ONLINE COMPUTER GAMES	ALTIGI GMBH (Germany)

Trademark	App.	Reg.	Status	Services	Owner
NASHVILLE BANNER **NASHVILLE BANNER**	**App** 76716879	**Reg** 4827221	Registered **USPTO Status:** Registered **USPTO Status Date:** 06-OCT-2015	**INT. CL. 41** COMPUTER ON-LINE SERVICES, NAMELY, PROVIDING ON-LINE NON-DOWNLOADABLE NEWSPAPERS FEATURING GENERAL INTEREST NEWS AND INFORMATION REGARDING ISSUES AND EVENTS IN THE NASHVILLE, TENNESSEE AREA **First Used:** 15-SEP-2014 (IC 41) **In Commerce:** 15-SEP-2014	NASHVILLE BANNER, LLC

Evidence of the existence and status of these filings from the Office's database is attached as Exhibit A.

Because these marks peacefully coexist with one another and with the cited marks, consequently, the cited marks are entitled to a narrow scope of protection such that even minor contrasts in the marks or nature of services is sufficient to avoid a likelihood of confusion. Here, Applicant's mark is different, and Applicant's services are readily distinguishable from the specialized services for which the cited marks are registered. For these reasons, the cited marks are entitled to a narrow scope of protection, and Applicant's mark for different services is not likely to cause consumer confusion.

D. Doubts about registration should be resolved in Applicant's favor.

The statutes and regulations governing the issuance of trademark registrations allow any parties who believe they may be damaged to oppose an application. Persons in the best position to determine whether registration of a particular mark poses a risk of damage are those who are engaged in the relevant business. Thus, the Office should resolve any doubt about registration in the Applicant's favor and should withdraw its refusal to register under Section 2(d). *See In re Geo. Weston Ltd.*, 228 U.S.P.Q. 57 (T.T.A.B. 1985); *In re Geo. A. Hormel & Co*., 218 U.S.P.Q. 286 (T.T.A.B. 1983); *In re Grand Metro. Foodserv., Inc.*, 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994).

III. CONCLUSION

For the foregoing reasons, Applicant submits that there is no likelihood of confusion between Applicant's mark and the cited marks. As such, Applicant respectfully requests that the Office withdraw the refusal to register and approve the application for publication.