

## **ARGUMENT IN SUPPORT OF RESPONSE TO OFFICE ACTION**

### **I. INTRODUCTION**

Applicant A Medium Corporation (“Medium”) seeks to register ZORA. Applicant proposes to amend its recitation of services as follows:

Providing information, news and commentary in the field of current events relating to opinions, relationships, and self-care for and about women of color, excluding topics relating to the author Zora Neale Hurston.

The Examining Attorney believes that there is a likelihood of confusion with the registered mark “ZORA!” for printed brochures, newsletters and books, and a festival about the late author Zora Neale Hurston. Applicant respectfully requests that the refusal to register be withdrawn. There is no likelihood of confusion because the goods and services, channels of trade, and consumers are different.

Registrant’s historical books, newsletters and books related to a festival dedicated to celebrating the life of the late author Hurston. By contrast, Medium provides digital online publication with contemporary news, commentary and current events about opinions, relationships and self-care. The services and channels of trade are unrelated and dissimilar. Medium provides dynamic, constantly updated content and commentary on current events relating to opinions, relationships and self-care. Registrant provides historical, static information on the very narrow topic of a specific deceased author. It is unlikely that consumers will be confused.

Medium requests that the refusal to register Medium’s mark be withdrawn. As shown below, it is not likely that there will be confusion between the marks.

### **II. THERE IS NO LIKELIHOOD OF CONFUSION**

#### **A. Legal Background**

In general, registration should be denied only when the applicant’s mark “consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052. In determining the likelihood of confusion, some of the factors that must be considered are:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made.

*See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

In this case, an analysis of the factors demonstrates that the goods and services, channels of trade, and consumers are different. As a result, confusion is unlikely between the Applicant and Registrant's marks.

**B. Confusion Is Unlikely Because Registrant's And Applicant's Services Are Unrelated.**

The second DuPont factor, the similarity or dissimilarity and nature of the goods and services, weighs in favor of finding that confusion is not likely because Medium and Registrant provide different goods and services. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

Medium provides an online website with a number of publications featuring "ideas and perspectives you won't find anywhere else." Declaration of Siobhan O'Connor ("O'Connor Decl."), submitted herewith, Exh. A. Medium taps into the brains of the world's most insightful contemporary writers, thinkers and storytellers to bring fresh thinking and unique perspectives on a wide variety of topics. *Id.* ¶ 2. The topics include tech, culture, food, politics, parenting, business and life. *Id.* Medium's website is subscription-based, which allows a reader access to unlimited stories with a monthly subscription fee. *Id.* Medium uses the ZORA trademark in connection with an online publication on the Medium platform that provides information, news and commentary in the field of current events relating to opinions, relationships, and self-care for and about women of color. *Id.* ¶ 3. The content is written by and for women of color, which includes not only African American women, but also other women of color. Current articles include:

The Coronavirus Outbreak Is Not an Excuse to Be Racist

Why I Abandoned the American Dream and Followed My Puerto Rican Dream Instead

Your Weekly ZORAscope

ZORA Explains: Super Tuesday

Lena Waithe's 'Twenties' Signals LGBTQ + Progress at BET and Beyond

'Crazy Rich Asians' Will Not Liberate Us

Overpolicing Poses a Serious Threat to Women and Girls of Color

How to Keep Your Relationship Hot and Be a Doting Parent

The Complicated Colorism of Latina Actresses in Film

O'Connor Decl., Exh. B. The articles relate to current topics such as Coronavirus, the presidential election, and current movies. *Id.* ¶ 3. Medium's publications are only provided online. *Id.* ¶ 4. Medium does not provide printed publications. *Id.* Medium does not publish printed newsletters, informational brochures, programs or books. *Id.*

By comparison, Registrant provides a festival dedicated to the history and writings of the late author Zora Neale Hurston. Registrant has registered ZORA! for brochures and books and educational services relating to a festival in Hurston's honor. The goods and services set forth in the registration are as follows:

Class 16: Printed material, namely, newsletters, informational brochures, programs and books featuring information about the life and writings of Zora Neale Hurston; posters; calendars; decals, all intended to promote the life and writings of Zora Neale Hurston

Class 41: Educational and entertainment services, namely, conducting classes, symposia, lectures and discussion groups about the life and writings of Zora Neale Hurston; educational and entertainment services in the nature of live poetry and book readings for educational and entertainment purposes; educational and entertainment services, namely, organizing live poetry and book readings for educational and entertainment purposes and community festivals featuring a variety of activities and primarily music performances, films and book readings for educational and entertainment purposes and also food, flea and heritage markets, and art and memorabilia exhibitions; entertainment and educational services, namely, providing a website featuring biographical information about Zora Neale Hurston and featuring information about the literary works of Zora Neale Hurston

Registrant has represented to the trademark office that it uses the ZORA! mark on printed brochures and books surrounding the festival in Hurston's honor. Declaration of Stacy E. Don, Exh. 2. Hurston was born 129 years ago on January 7, 1891. *Id.*, Exh. 1. She grew up in Eatonville, Florida. She started her career as a writer in the 1920's during the Harlem Renaissance. *Id.* The most popular of her four novels is *Their Eyes Were Watching God*, published in 1937. *Id.* Hurston died in 1960. *Id.* Hurston used Eatonville as the setting for many of her stories. *Id.* It is now the site of the Zora! Festival held in her honor. *Id.* Confusion is not likely because Registrant's Hurston festival is unrelated to Medium's contemporary online publication.

Registrant's goods and services are distinguishable and not likely to be confused with Medium's online current events articles on a variety of topics. Medium provides only a digital publication that can be read online. Medium does not sell or publish printed materials. Medium also does not provide festivals or the services of book readings. There are many online publications like Medium that provide current, short form articles on contemporary, up-to-date topics that do not produce a printed publication and do not provide educational services. Providing a printed publication or publishing a book is a different business model and different delivery of services. Moreover, Registrant itself does not provide a digital publication with current articles on up-to-date topics. It has a website that is an advertisement for its festival honoring the late Hurston and has static, biographical information about Hurston's life. The website features pictures of Hurston and her full name prominently so that it is clear that the website is about Hurston. The goods and services are different, distinguishable and there is no likelihood of confusion.

The goods and services of printed materials and online websites are unrelated and consumers are able to distinguish the difference. In addition, the mere fact that a mark is used on a website does not indicate that confusion is likely. Consumers are able to distinguish content on the internet. As demonstrated in the examples below, the USPTO has permitted marks sharing the same name to register to different owners for class 16 printed materials and for class 41 entertainment services. In addition, the USPTO has permitted marks sharing the same name to register to different owners for various class 41 entertainment services where the subject matter of the content is different.

Exhibit <sup>1</sup>	Mark 1	Mark 2
3.1	<p><b>DEXTER</b>  IC 016  Cook books; Novels; Series of fiction books.  Reg. No. <b>4745855</b>  <b>Owner:</b> Freundlich, Jeffry DBA Jeff Lindsay</p>	<p><b>DEXTER</b>  IC 041.  Entertainment services, namely, a continuing television series featuring drama, comedy, and general entertainment rendered through the media of television, cable, satellite, radio, telephone and broadband systems, and via the Internet, and portable and wireless communication devices; providing information in the field of entertainment and education rendered via the Internet, and portable and wireless communication devices.</p> <p>Reg. No. 3612095  Owner: Showtime Networks Inc.</p> <p>DEXTER  IC016  [ Series of fiction <b>books</b>, ] posters, trading cards, stickers, calendars, and temporary tattoos, excluding materials with religious themes, * all related to the television series Dexter *</p> <p>Reg. No. <b>4058635</b>  Owner: Showtime Networks Inc.</p>
3.2	<p><b>LANA</b>  IC 041  Cooking instruction; On-line journals, namely, <u><i>blogs featuring COOKING AND RECIPES; Publication of on-line RECIPES.</i></u>  Reg. No. 4730911  Owner: Knadian, Svetlana</p>	<p><b>LANA</b>  IC 041  Entertainment services, namely, wrestling exhibitions and performances by professional wrestlers and entertainers rendered live and through broadcast media including television and radio, and via the internet or commercial online service; Providing information in the fields of sports and entertainment via an online community portal; <u><b>Providing a website in the field of sports entertainment;</b></u> Fan club services; Organizing and staging social entertainment events with fan club members; <u><b>Providing online newsletters in the fields of sports entertainment; Online journals, namely, blogs, in the fields of sports entertainment.</b></u>  Reg. No. <b>5272110</b>  <b>Owner:</b> World Wrestling Entertainment, Inc.</p>
3.3	<p><b>NADIA G</b>  IC 016  Books in the field of cooking; posters; autographed pictures; stickers</p> <p>IC 041</p>	<p><b>NADIA KAY</b>  IC 041  Entertainment services, namely, personal appearances by an entertainer, personality, celebrity or model; entertainment services, namely, live, televised, movie, and theatrical</p>

<sup>1</sup> Trademark Electronic Search System (“TESS”) reports for the referenced marks are attached as Exhibits to the Don Declaration.

Exhibit <sup>1</sup>	Mark 1	Mark 2
	<p><b><u>Entertainment services in the form of continuing online comedy shows broadcast over the internet.</u></b> continuing online cooking shows broadcast over the internet, online non-downloadable music videos, online non-downloadable music, continuing cooking, comedy, renovation, travel, do it yourself (DIY), music, lifestyle, competition and talk shows broadcast over television, personal appearances by a celebrity, live cooking demonstrations, live music performances</p> <p>Reg. No. 4897013 Owner: B360 Media Inc.</p>	<p>appearances by an entertainer, personality, celebrity or model; fashion modeling for entertainment purposes; entertainment services, namely, providing a <b>website</b> featuring non-downloadable film clips, photographs, and other multimedia materials featuring entertainment; <b><u>providing a website featuring entertainment information; entertainment services, namely, live, televised and movie appearances by a professional entertainer and dramatic and comedic performances associated therewith;</u></b> fashion modeling for entertainment purposes; modeling for artists; entertainment services, namely, acting services in the nature of visual and audio performances by an actress, and personal appearances by a motion picture and television celebrity; entertainment services, namely, producing motion picture films and television programs; voice services, namely, providing voice services for entertainment and education purposes; voice over services, namely, providing voice over services for entertainment and education purposes; narration services, namely, acting as a narrator for entertainment and education purposes; spokesperson services, namely, acting as a spokesperson for entertainment and education purposes</p> <p>Reg. No. 4892748 Owner: Kalinina, Nadia</p>
3.4	<p><b>FRIDA (stylized)</b> IC 016 Almanacs; Calendars; Crayons; Desk mats; Document files; Note <b>books</b>; Pencil sharpeners, electric or non-electric; Rubber erasers; Scratch pads; Stickers; Travel <b>books</b>.</p> <p>Reg. No. <b>5569171</b> <b>Owner:</b> FridaCopenhagen ApS limited company (Ltd.)</p>	<p><b>FRIEDA B.</b> IC 016</p> <p>Series of fictional children's <b>books</b>, fiction and non-fiction <b>books</b>, workbooks, resource guides, and handouts in the fields of inspiration, imagination, motivation, self-esteem, potential, respect and anti-bullying, for children, teens, young adults and adults; blank journals, post cards, <b><u>note pads, printed pens and pencils,</u></b> letterhead paper, stationery and envelopes, <b><u>wall calendars,</u></b> printed award certificates, printed informational cards in the fields of inspiration, imagination, motivation, self-esteem, potential, respect and anti-bullying, for children, teens, young adults and adults, <b><u>stickers</u></b> and transfers, paper hang tags.</p> <p>Reg. No. <b>4669498</b> <b>Owner:</b> FRIEDA B., LLC</p>
3.5	<p><b>CHRIS</b> 016 PRINTED MATTER, NAMELY, BROCHURES, BOOKS, FORMS, PROSPECTUSES AND</p>	<p><b>CHRIS.W (stylized)</b> IC 016 Writing pads; Clipboards; Loose-leaf binders; Note <b>books</b>; Paper sheets in the nature of</p>

Exhibit <sup>1</sup>	Mark 1	Mark 2
	<p>INSTRUCTIONAL, EDUCATIONAL AND TEACHING MATERIALS, ALL IN THE FIELDS OF PSYCHOPHYSIOLOGY, EXTRA-SENSORY PERCEPTION, SELF-AWARENESS, SELF-HELP, HOLISTIC AND TRADITIONAL MEDICINE, MASSAGE, PSYCHOTHERAPY, PSYCHOLOGY, PSYCHOPHYSICS AND BIOPHYSICS, NONE OF WHICH PRINTED MATTER CONCERNS WEIGHT MANAGEMENT.</p> <p>041 CONDUCTING WORKSHOPS, SEMINARS, EDUCATION AND TRAINING COURSES AND CORRESPONDENCE COURSES IN THE FIELDS OF PSYCHOPHYSIOLOGY, EXTRA-SENSORY PERCEPTION, SELF-AWARENESS, SELF-HELP, HEALTH CARE, HOLISTIC AND TRADITIONAL MEDICINE, MASSAGE, NUTRITION, PSYCHOTHERAPY, PSYCHOLOGY, PSYCHOPHYSICS BIOPHYSICS AND WITHDRAWAL TREATMENT FOR ADDICTS, NONE OF WHICH INVOLVES WEIGHT MANAGEMENT; PUBLICATION OF BOOKS AND OTHER PRINTED TEACHING AND INSTRUCTIONAL MATERIALS; CONDUCTING WORKSHOPS AND SEMINARS IN SELF-AWARENESS.</p> <p>Reg. No. 3952569 Owner: SCHENK, CHRISTINE</p>	<p>stationery; card holder, namely, desktop business card holders, Holders specially adapted for holding greeting cards; Plotting scale in the nature of plotting papers; Indexes, namely, index dividers; Files, namely, file folders, document files; Stands for pens and pencils; binding cover in the nature of bookbinding materials; binder pocket in the nature of file pockets.</p> <p>Reg. No. <b>5145452</b> <b>Owner:</b> Yang Fangli</p> <p><b>CHRIS KOCHAN</b></p> <p>041 Educational services, namely, conducting on-line classes, classes, on-line courses, on-line webinars, seminars, on-line programs, programs, on-line workshops, workshops, and forums in the field of personal branding, career strategy, social media marketing, marketing, entrepreneurship, mentorship, business, finance, health, wealth, love and happiness, and distribution of course and educational materials in connection therewith; entertainment services, namely, providing podcasts in the fields of personal branding, personal development, health, wealth, career strategy, social media marketing, marketing, entrepreneurship, mentorship, business, finance, health, wealth, love, happiness, self-improvement, financial success, career success, and self-motivation; educational and entertainment services, namely, providing motivational speaking services in the fields of personal branding, personal development, self-education, business, finance, career strategy, career success, financial success, self-improvement, self-motivation, health, wealth, happiness, marketing and social media marketing; educational and entertainment services, namely, providing speaking engagement services in the fields of education, business, finance, career strategy, career success, financial success, personal development, self-improvement, self-motivation, marketing and social media marketing; providing online non-downloadable e-books in the fields of personal branding, personal development, self-help, marketing, social media marketing, entrepreneurship, business, finance, mentorship, health, wealth, love, happiness, self-improvement, financial success, career strategy, career success, and self-motivation; providing online downloadable e-books in the fields of personal branding, personal development, self-</p>

Exhibit <sup>1</sup>	Mark 1	Mark 2
		<p>help, marketing, social media marketing, entrepreneurship, business, finance, mentorship, health, wealth, love, happiness, self-improvement, financial success, career strategy, career success, and self-motivation; providing a <b>website</b> featuring non-downloadable videos in the fields of personal branding, personal development, marketing, social media entrepreneurship, business, finance, mentorship, health, wealth, love, happiness, self-improvement, financial success, career strategy, career success and self-motivation; providing non-downloadable on-line videos featuring career strategy, personal branding, personal development, marketing, social media entrepreneurship, business, finance, mentorship, health, wealth, love, happiness, self-improvement, financial success, career success and self-motivation; entertainment services in the nature of development, creation, and production of non-downloadable online videos.</p> <p>Reg. No. 5713427 Owner: Kochan, Christopher K</p>

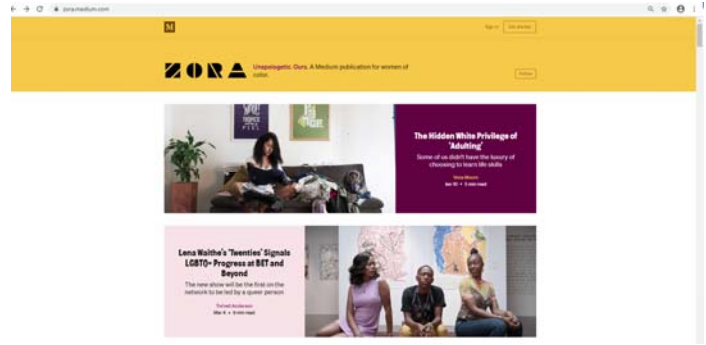
There are many instances in which the USPTO permitted different trademark owners to register marks that shared a common word. The application of the law must be consistent. The evidence of registrations in similar circumstances is relevant. Given the differences between the Registrant’s narrow and specific goods and services for a historical figure and the Applicant’s contemporary, dynamic publication on current events, the registrations above are relevant and show that the differences in the goods and services are sufficient to alleviate concerns of a likelihood of confusion. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (finding evidence of third-party use of similar marks on similar goods to show that customers have been educated to distinguish on basis of minute distinctions).

**C. Confusion Is Unlikely Because The Established, Likely-to-Continue Trade Channels Are Dissimilar.**

The third DuPont factor weighs in favor of finding confusion unlikely because Applicant’s and Registrant’s established, likely-to-continue trade channels are different. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Registrant uses the ZORA! mark in connection with a specific, narrow purpose, namely the festival in Hurston’s honor, held in Hurston’s hometown in Eatonville, Florida. Although Registrant and Medium both have websites, the websites overall look very different and the content is different. *Compare* Don Decl., Exh. 4 with O’Connor Decl., Exh. B.

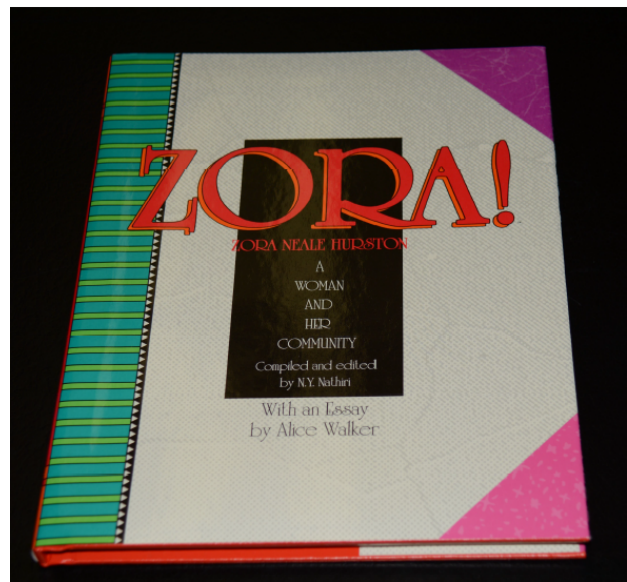
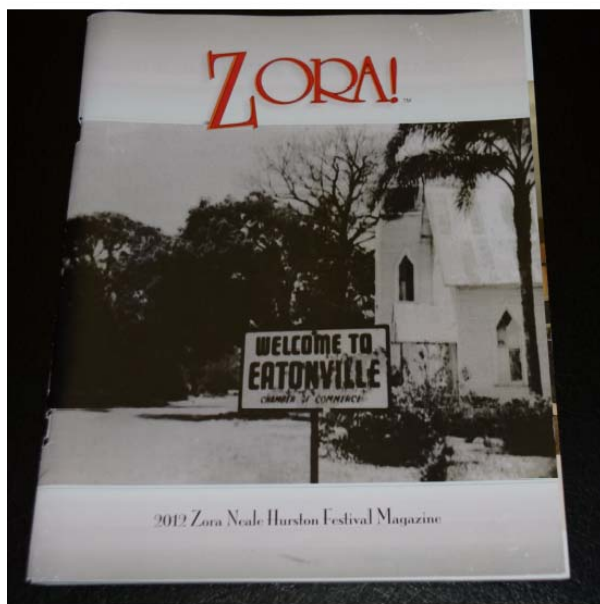


Registrant's website



Medium's website

Registrant's books and brochures are specific to providing information about the life and writings of Hurston. They appear to be programs and brochures that are handed out at the ZORA! Festival held in Eatonville. Potential consumers will be at the festival, or wanting information about the festival or about Hurston the author.



These potential customers are seeking a very narrow and specific purpose relating to the late author Hurston. The potential customers for the class 16 goods most likely will be present at the festival. The Applicant's and Registrant's trade channels are separate and different, and thus confusion is unlikely.



**D. Confusion Is Unlikely Because The Conditions Under Which And Buyers To Whom Sales Are Made Are Unrelated And Different.**

The fourth DuPont factor also weighs in favor of finding confusion unlikely because the conditions under which and buyers to whom sales are made are unrelated and different. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Medium is not a historical website dedicated to providing information about a specific individual. A visitor to Medium's website would be seeking contemporary content and opinions about current events, not about a singular, historical person. Subscribers to Medium's website would be seeking fresh opinions and from today's writers with unique perspectives. While Hurston was an African-American woman, its potential festival-goers or customers are a narrow and defined group of individuals who are interested in information about Hurston and her life and writings. By contrast, Medium's services are for those readers who are looking for current writings on current topics. Medium's publication does not provide information about Hurston or the festival. Given the very different circumstances under which a customer would seek out and buy Applicant's and Registrant's services, it is unlikely that customers will be confused.

**III. CONCLUSION**

Applicant requests that the application be approved for publication. Applicant invites the Examining Attorney to telephone or email the correspondent attorney should any issues remain outstanding.