

## Response to Office Action

This is in response to the Office Action dated December 7, 2021, which the Examining Attorney issued in connection with Trademark Serial No. 90/665,166. The Application has been initially refused for the following reasons:

Section 2(d) Refusal – Likelihood of Confusion – Class 18 Only  
Specimen Refusal

The Applicant's response is set forth below.

### Specimen Refusal

The Applicant has submitted substitute specimens and believes the refusal has been resolved.

### Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the basis that the mark is likely to be confused with U.S. Registration No. 3955997. The Applicant submits that there is no likelihood of confusion between the applied-for mark and the cited registration when considering all relevant DuPont factors. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

The registrant's mark is ZOOM covering the following goods:

Class 18: Tote bags; duffel bags; luggage



The Applicant's mark is **zoom**, Zoom (stylized), and covers the following relevant goods:

Class 18: Backpacks; luggage tags; tote bags; wallets

#### 1. First DuPont Factor: The Similarity of the Marks in Their Entireties.

The Examining Attorney found that the marks are identical in appearance, sound and commercial impression. However, the applied-for mark contains distinguishable stylization which differentiates the mark in the mind of the consumer and creates a different commercial impression. This is enough to outweigh the similarities between the applied-for mark and the cited registration. *See Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks).

Although the Examining Attorney stated that the Applicant’s stylization is “minor,” this particular stylization is highly recognizable, and consumers appreciate that the stylized mark refers specifically to the Applicant. The Applicant has an incredibly high volume of active users of its videoconferencing services and software downloads, all of its services and products displaying the applied-for stylization of the Applicant’s mark. As of April 22, 2020, the total number of participants in meetings and webinars using the Zoom (stylized) mark was 300 million per *day*. From launch to March 2021, the Applicant’s video teleconferencing software was installed on over 198 million iOS devices and over 384 million Android devices, all displaying this specific Zoom (stylized) mark.

The applied-for trademark is prominently advertised on various social media platforms like Twitter, Facebook, Instagram, LinkedIn, YouTube and even TikTok. The Applicant’s Twitter handle is currently followed by 1 million people worldwide; the Applicant’s Facebook page is currently followed by over 600,000 people worldwide and liked by over 510,000 people worldwide; the Applicant’s Instagram page is followed by over 118,000 people worldwide; the Applicant’s LinkedIn page has over 412,000 followers; the Applicant’s YouTube Channel is followed by approximately 449,000 people worldwide, and the Applicant’s TikTok account is followed by over 327,000 followers and has garnered over 3 million likes. Printouts from the web pages are annexed herewith and marked **Exhibit A**.

The Applicant’s sales reached over \$4 billion dollars in its 2022 fiscal year, all of the products and services using this particular stylization of the word “Zoom”:

Fiscal Year (February 1 – January 31)	Worldwide Revenues
2017	\$60,817,000
2018	\$151,478,000
2019	\$330,517,000
2020	\$622,658,000
2021	\$2,651,400,000
2022	\$4,099,900,000

Excerpts from the Applicant’s Annual Report filings supporting the financial data is marked as **Exhibit B**.

Thus, even though both the applied-for mark and the cited mark share the word “Zoom,” the Applicant’s particular stylization is immediately recognizable as indicating the Applicant, not any other source. Additional weight should be placed on the impact of the commercial impression created by the distinctive stylization when conducting a likelihood of confusion analysis, and consumers’ familiarity with the Applicant’s particular stylization of its mark eliminates any potential likelihood of confusion between the two marks.

## 2. Ninth DuPont Factor: The Variety of Goods on Which a Mark Is or Is Not Used

As shown above, the Applicant and the applied-for mark are associated with and known for video teleconferencing services and software. Consequently, as can be seen from the Applicant's specimens, the products covered in this application, "Backpacks; luggage tags; tote bags; wallets," are merchandising goods, i.e., goods where the mark is used on a collateral product. *DC Comics Pan Am. Grain Mfg. Co. Inc.*, 77 U.S.P.Q.2d 1220 (T.T.A.B. 2005), citing *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945-1946 (TTAB 1996). In contrast, the specimen in the registrant's file wrapper shows that the mark is used as a product name. <https://tsdr.uspto.gov/documentviewer?caseId=sn85049255&docId=SPE20210424154103#docIndex=1&page=1>.

The Applicant's items are made specifically for, and purchased by, people who recognize the applied-for mark as being associated only with the Applicant – that is the very appeal of the products, they point singularly to the Applicant. Those seeking the registrant's goods, high quality luggage, are not going to believe that a backpack with **zoom** displayed on the flap is manufactured by the registrant. There is no likelihood of confusion when considering the types of goods for which each party uses their respective mark.

Therefore, this factor weighs in favor of the Applicant and cannot be omitted from the likelihood of confusion analysis.

## 3. Seventh and Eighth DuPont Factors: The Nature and Extent of Any Actual Confusion and the Length of Time During Concurrent Use Without Evidence of Actual Confusion

"[A]ctual confusion is obviously the best evidence of a likelihood of confusion, and the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring." *Cent. Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981).

The cited registration lists the first use date of the mark in the U.S. as June 2010. The Applicant has been using the mark in the U.S. since August 21, 2012, and in use with the class 18 goods at least as early as June 2015. The marks have overlapped for ten years and at least seven years in the U.S. market over the goods in question. During that time, the Applicant has not learned of any actual confusion between the applied-for mark and the registered trademark. The Applicant has also never been contacted by the registrant with any claim that the coexisting uses are confusing.

Therefore, because of the length of time of concurrent use with no evidence of actual confusion, these two factors weigh in favor of the Applicant and cannot be omitted from the likelihood of confusion analysis.

## CONCLUSION

Evaluating all of the above factors – the lack of actual confusion, the significant length of time of overlapping use, the consumer familiarity with the Applicant's particular and distinct stylization,

the overall commercial impression associated with the Applicant alone, and the nature in which the goods are used – the only conclusion is that there is no likelihood of confusion between the applied-for mark and the cited registration. Based on the foregoing, the Applicant respectfully requests that the Examining Attorney withdraw the 2(d) refusal and allow the application to pass to publication.