

THIS DISPOSITION IS NOT  
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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Detroit Educational Television Foundation

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Serial No. 75/156,938

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Robert A. Woods of Schwartz, Woods & Miller for Detroit  
Educational Television Foundation.

Daniel P. Vavonese, Trademark Examining Attorney, Law  
Office 109 (Deborah Cohn, Managing Attorney).

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Before Hanak, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Detroit Educational Television Foundation filed an  
intent-to-use application to register the mark AMERICAN  
BLACK JOURNAL on the Principal Register for "educational  
and entertainment services in the nature of on-going  
television programs and television programming services  
featuring news, current events, public affairs and cultural

affairs of interest to African Americans".<sup>1</sup> The Examining Attorney refused registration based on two grounds --(i) under Section 2(d) of the Trademark Act that there is a likelihood of confusion with a registered mark, and (ii) under Section 2(e)(1) of the Trademark Act that the mark is merely descriptive of applicant's services. In addition, the Examining Attorney pointed out that applicant could amend the application to seek registration on the Supplemental Register, noting that although such an amendment "overcomes the merely descriptive refusal, it has no effect on the likelihood of confusion refusal." (November 21, 1996 Office action, p. 3).

On May 22, 1997 applicant filed both an amendment to allege use (in which the claimed dates of first use are November 1, 1996), and a response to the November 21, 1996 Office action, including an amendment to the Supplemental Register. On July 29, 1997, the Examining Attorney accepted applicant's amendment to allege use; and specifically stated that he "accepted the Applicant's amendment to the Supplemental Register and [he] has withdrawn the Section 2(e)(1) refusal" (p. 1).<sup>2</sup> In

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<sup>1</sup> Application Serial No. 75/156,938, filed August 28, 1996, wherein applicant alleges a bona fide intention to use the mark in commerce.

<sup>2</sup> Applicant stated in its brief that it "is seeking registration of the mark on the Principal Register" and applicant "has also

addition, he issued a final refusal under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified services, so resembles the previously registered mark AMERICAN JOURNAL for "entertainment in the nature of on-going television programs and television programming services featuring news and current events,"<sup>3</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed<sup>4</sup>, and applicant did not request an oral hearing. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont<sup>5</sup> factors.

Applicant essentially contends that the addition of the word BLACK in applicant's mark distinguishes the mark and changes the entire commercial impression of the mark;

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sought registration on the Supplemental Register." (Brief, p. 2). There is nothing in the record to show that applicant offered the amendment to the Supplemental Register in the alternative. Rather, applicant's amendment to the Supplemental Register was unequivocal, and it was clearly accepted and entered by the Examining Attorney. Thus, this application is one for registration on the Supplemental Register.

<sup>3</sup> Reg. No. 1,825,973, issued March 8, 1994. The claimed dates of first use and first use in commerce are September 6, 1993. The word "AMERICAN" is disclaimed apart from the mark as shown.

<sup>4</sup> On page 12 of applicant's brief there is an apparent typographical error referring to the refusal to register under Section 2(e)(1) of the Trademark Act. It is clear in this record that the refusal is under Section 2(d) of the Trademark Act, and it was so argued by applicant and the Examining Attorney.

<sup>5</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

that the two marks are "facially distinguishable" when viewed in their entireties; that the registered mark consists of two "highly descriptive" terms; and that applicant and registrant actually provide different services which are offered through different channels of trade. Specifically, applicant contends that its weekly news program focuses on the issues and personalities of particular interest to African Americans, and it is intended to inform and educate; that it is produced for broadcast solely over noncommercial stations and it is currently not distributed beyond the reach of applicant's public television station in Detroit, Michigan; and that applicant's audience is select, discriminating, loyal and sophisticated. Conversely, applicant asserts that registrant's television program is a daily syndicated news-magazine program which covers sensational news and current event stories; that it is carried on commercial and cable television stations; and that registrant's audience is less sophisticated and more impulsive. Finally, applicant points out that it is unaware of any instances of actual confusion in the sixteen months applicant's mark has been in use.

In support of its arguments, applicant submitted photocopies of printouts of computer screen pages from

applicant's website, photocopies of printouts of computer screen pages from the cited registrant's website, and a two-page listing of several third-party registrations and applications<sup>6</sup>.

It is the Examining Attorney's position that the involved services are essentially identical, both being television programs and television programming; that even though applicant's identification of services is restricted to matters "of interest to African Americans", applicant's narrower services are encompassed within the cited registrant's services which are not so restricted; that any differences in the content of the actual programs, the television channels on which they appear, the target audiences, and/or the purported sophistication of applicant's audience, as argued by applicant are irrelevant because there are no such restrictions in either the

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<sup>6</sup> The Examining Attorney objected to applicant's proffered search report listing of third-party registrations/applications and he specifically noted that he was not considering the improper evidence. (Final Office action p. 4, and brief pp. 3-4). See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974); *In re Hub Distributing, Inc.*, 218 USPQ 285 (TTAB 1983); and *In re Hungry Pelican, Inc.*, 219 USPQ 1202 (TTAB 1983). See also, *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). The Examining Attorney's objection is well taken and the Board has not considered the list of third-party registrations. We note for the record that the list sets forth only the registration (or application) numbers and the purported marks. There is no information as to the goods or services involved (many of these registrations may cover publications, not television programs), or as to the ownership (many may be owned by the same entity), or as to disclaimers, Section 2(f) claims or any other such matters.

application or the cited registration with respect to any of these matters. Further, the Examining Attorney contends that the involved marks are similar in appearance, connotation, and commercial impression; that applicant's addition of the term BLACK to the cited registrant's mark AMERICAN JOURNAL does not alter the commercial impression because the term BLACK simply describes the focus of applicant's television program on issues relevant to African Americans; that actual confusion (or lack thereof) is not the test, rather the test is likelihood of confusion; and that doubt must be resolved against applicant.

The question before us is whether applicant's mark is so similar to the cited registered mark that when seen by purchasers<sup>7</sup> used in connection with the same or similar services it will be likely to cause confusion as to the source or origin of the services. See *Kangol Ltd. v.*

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<sup>7</sup> Both the Examining Attorney and applicant have treated the relevant "purchasers" to be the general viewing public. Based thereon, the Board will treat the relevant "purchasers" to be the general viewing public, even though it seems to us that television viewers do not generally purchase television programs, and television programming services. We note in this regard that our primary reviewing court has recognized non-purchaser confusion. See *Payless Shoesource Inc. v. Reebok International Ltd.*, 998 F.2d 985, 27 USPQ2d 1516, 1519 (Fed. Cir. 1993). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:7 (4th ed. 1999).

KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Turning first to a consideration of the involved services, in determining the question of likelihood of confusion in an ex parte case, the Board is constrained to compare the services as identified in the application with the services as identified in the cited registration. If the registrant's services and the applicant's services are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual services of the applicant and registrant are not similar. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990). See also, *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

In this case, both applicant's services and the services in the cited registration are on-going television programs and television programming services featuring news and current events. It is true that the identifications involved herein do not utilize precisely the same words. Specifically, (i) applicant's prefatory phrase is "educational and entertainment services," whereas the

registrant's is "entertainment"; (ii) applicant's list of the features in its television programming services includes two additional topics, namely, "public affairs and cultural affairs"; and (iii) applicant includes a restriction that its programs and programming cover matters "of interest to African Americans." However, applicant's minor addition of the topics of "public affairs and cultural affairs" and the general limitation that its programs are "of interest to African Americans" do not negate the essential identity of these services.<sup>8</sup> As identified, registrant's services encompass those of applicant.

Moreover, services (or goods) need not be absolutely identical or even competitive to support a finding of likelihood of confusion, if the services are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978). We find the respective services are identical in part, and are otherwise closely related.

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<sup>8</sup> We note that the record establishes that black persons, (e.g., Bo Jackson), have been interviewed on registrant's program.

Applicant's arguments regarding purported differences between the parties' actual channels of trade and purchasers is not convincing. There is no restriction in either parties' recitation of services regarding the frequency of the programs (e.g., daily versus weekly), the nature of the presentations (e.g., "sensational, provocative" versus "educational"), and/or the types of stations which broadcast the programs (commercial and cable versus educational not-for-profit). See the Canadian Imperial case, supra; and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985).

Further, there is no evidence of record to support applicant's argument that its television audience is "sophisticated," while registrant's television audience is "impulsive." The services set forth in both applicant's application and in the cited registration (identical in part) must be presumed to move through all normal channels of trade and are available to all potential customers. See In re Elbaum, 211 USPQ 639 (TTAB 1981). It is common knowledge that both commercial and educational television programs are available to all television viewers. We have no evidence on which to base a finding that general television viewers are either "sophisticated" and thus

watch only educational television or are "impulsive" and thus watch only commercial television.

Turning then to a consideration of the respective marks, applicant's mark AMERICAN BLACK JOURNAL and the registered mark AMERICAN JOURNAL are similar in connotation and appearance. The only difference between the marks is the term BLACK which, as noted in applicant's identification of services, refers to the focus of applicant's television programs on African American issues. In addition, we note that the term AMERICAN is descriptive, as the term is disclaimed in the cited registration and applicant seeks registration on the Supplemental Register.

As to the term JOURNAL, the Examining Attorney submitted Webster's II New Riverside University Dictionary definition of the word as follows:

"1.a A personal record of experiences and observations kept on a regular basis: diary. b. A record of daily events. c. An official record of daily transactions, as of a legislative body. d. A ship's log. 2.a Daybook 1. b. A book of original entry in a double-entry system, listing all transactions and indicating the accounts to which they belong. 3. A daily newspaper. 4. A periodical containing articles of interest to a particular group <a dental journal> 5. The part of a machine shaft or axle supported by a bearing.

While the term JOURNAL is highly descriptive or generic in relation to a newspaper or other published

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periodical, it is only highly suggestive of television programs and television programming services.

The mere addition of the word BLACK to the cited mark is not sufficient to overcome the likelihood of confusion. See *The Wella Corporation v. California Concept Corporation*, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and *In re South Bend Toy Manufacturing Company, Inc.*, 218 USPQ 479 (TTAB 1983). The commercial impression created by the marks involved herein is essentially the same.

Purchasers may assume that AMERICAN BLACK JOURNAL is just a variant of registrant's AMERICAN JOURNAL mark, used to identify a new line of television programs relating to a specific focus (e.g., AMERICAN BLACK JOURNAL, AMERICAN ASIAN JOURNAL, AMERICAN HISPANIC JOURNAL). That is, purchasers would assume that applicant's services come from the same source as registrant's services or are in some way sponsored by or associated with registrant. See *Paulist Productions, Inc. v. Anna Broadcasting Co., Inc.*, 199 USPQ 740 (TTAB 1978) (INSIGHT for educational radio programs featuring interviews on current and cultural affairs held confusingly similar to INSIGHT for television religious drama programs).

Applicant cites the cases of *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971);

and In re Richardson Ink Co., 171 USPQ 818 (TTAB 1971), for the proposition that applicant's application is not limited to the mark shown in any particular form, and that therefore it is appropriate to compare actual specimens of applicant's use of its mark with other allegedly similar marks. We find the cited cases inapposite here. Of course, when a mark is presented for registration in plain typed form, the applicant is not restricted or limited as to its use of that mark in any specific special form. See Trademark Rule 2.51(e). The Phillips and Richardson cases hold that when an applicant seeks to register a mark in typed form, in determining the question of likelihood of confusion, the Board and the Courts may look to the specimens of use to visualize in what other forms applicant's mark might appear. See also, INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992); Edison Brothers Stores v. E.B. Sport-International, 230 USPQ 530 (TTAB 1986); and In re Fisher Tool Co., Inc., 224 USPQ 796 (TTAB 1984). However, the Phillips and Richardson cases, cited by applicant, did not hold that an applicant can utilize differences in the appearance of the marks in actual use to justify registration of a confusingly similar typed mark on the basis that the cited mark and applicant's mark are actually used in different special forms.

Both the registrant and/or applicant could alter the actual presentation of its own mark at any time by altering the style and/or size of the lettering, or highlighting or capitalizing various words. For example, applicant may use the mark **AMERICAN BLACK JOURNAL** thereby increasing the emphasis on the two words which are common to both marks. See *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992).

Moreover, in looking at applicant's actual specimen of record, which is a June 1997 program guide for Detroit's public television station, applicant's mark appears not in special font but in plain typed form on pages 8, 12, 14, 15 and 16, essentially as a scheduled program entry airing every Wednesday. In this case applicant seeks to register its mark in typed form, hence, we need not consider the respective marks as they actually appear on the parties' websites or as they may appear on a television screen.

Applicant's argument regarding the lack of actual confusion is likewise not persuasive because the test is likelihood of confusion, not actual confusion. Further, applicant's mark has been in actual use for a short time in the Detroit, Michigan area; and of course, on an ex parte record, the Board has no information from the registrant on this question.

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While we are not free from doubt in this case, it is well settled that any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Decision: The refusal under Section 2(d) is affirmed.

E. W. Hanak

B. A. Chapman

D. E. Bucher  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board