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Mailed: July 18, 2002

Paper No. 10
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Media.Net Communications, Inc., by change of name
from XL Networks, Inc.¹

Serial No. 75/780,993

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Before Simms, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 20, 1999, Media.Net Communications, Inc., by
change of name from XL Networks, Inc. (a Delaware
corporation) filed an application to register the mark
MEDIA.NET COMMUNICATIONS on the Principal Register for
services identified, as amended, as "providing high

¹ Applicant's change of name is recorded with the Assignment
Branch of the USPTO at reel 2035, frame 0984.

bandwidth fiber optic network services to medium and large sized businesses in the entertainment industry, which enables them to create, produce, edit and distribute various entertainment and media products" in International Class 38. Applicant disclaimed the word "communications." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its identified services, so resembles the mark MEDIANET, which is registered for "communication services, namely, transmitting the data and messages of others between terminals, primarily via coaxial cable" in International Class 38,² as to be likely to cause confusion, or to cause mistake, or to deceive.

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have briefed the issue before us, and an oral hearing was not requested.

² Registration No. 2,118,639, issued December 9, 1997. The original applicant in this registration was Media General Cable of Fairfax County, Inc. (a Virginia corporation). Prior to registration, the application was assigned and the registration issued to Dymaxion Research, Ltd. (a Canadian corporation). See reel 1539, frame 0488.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We turn first to a consideration of the registrant's services and applicant's services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See *In re Martin's Famous Pastry*

Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001).

Further, it has been repeatedly held that in determining the registrability of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant argues that its services are fiber optic network services sold only to medium and large sized business in the entertainment industry, whereas registrant offers its network primarily by coaxial cable and it is in Fairfax County, Virginia only. Applicant submitted into the record the file history of the cited registration including the specimen contained therein. In the specimen registrant describes its MEDIANET services as "a broadband cable network" which "interconnects business firms, public offices, financial institutions and health care facilities in Fairfax County..."; and it also specifically states that

"the MEDIANET cable network will be supplemented with microwave links and/or fiber optic links" and registrant "will build dedicated coaxial cable or fiber optic links for customers, on request."

Even though applicant has restricted its identification of services to a fiber optic network, registrant's identified services are not solely restricted to coaxial cable, and in fact, registrant's identification specifically refers to "primarily" carried via coaxial cable, clearly implying that other methods of delivery are included. (Registrant's specimen makes clear that fiber optic is one of those other available delivery methods.) Also, applicant's identification of services sets forth a specific set of consumers, namely, "medium and large sized businesses in the entertainment industry." However, the cited registrant's services, identified as "communications services, namely transmitting the data and messages of others between terminals..." is not so limited, and therefore encompasses medium and large sized businesses in the entertainment industry. Thus, the cited registration's identification of services encompasses the more specific or limited nature of applicant's identified services. There is no restriction in the cited registrant's identification of services limiting same to Fairfax County, Virginia

businesses and residents. Applicant's and registrant's services are essentially the same or closely related services, except for the means of providing the services, with fiber optic being the more recent technology.

Based on the record before us, we readily conclude that applicant's services, as identified, are encompassed by and otherwise closely related to the cited registrant's broadly identified services, and would be sold through similar channels of trade to the same class of purchasers. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, supra, at 1787.

Applicant argues that the customers for both applicant's and registrant's services are careful, sophisticated purchasers, each seeking a specialized service, and these purchasers will fully understand and distinguish these services. Even if we assume that the purchasers of the services in question in the instant case are sophisticated purchasers, and that the purchase of the respective services is done after careful consideration, this does not mean that such purchasers are immune from confusion as to the origin of the respective services, especially when sold under similar marks. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

That is, even relatively sophisticated purchasers and users of these services, including people in medium and large businesses in the entertainment industry, could believe that these services come from the same source, if identified by substantially similar marks. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); and *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, footnote 17 (TTAB 1992).

Turning next to a consideration of the respective marks, it is well settled that marks must be considered in their entireties as to the similarities and dissimilarities thereof. However, our primary reviewing court has held that in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); and *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

In this case, both applicant's mark and registrant's mark share the term MEDIANET or MEDIA.NET, the former being registrant's mark in its entirety and the latter being the

dominant part of applicant's mark. Applicant acknowledges and agrees that the dominant portion of its mark is MEDIA.NET. (See applicant's brief, p. 3 and applicant's reply brief, p. 1.)

However, applicant contends that the "." in applicant's mark would be read as "dot" not simply as a "period"; and that applicant's mark then creates a different commercial impression being that of a domain name, while registrant's does not. We agree that the "." in applicant's mark is likely to be read as "dot." But, we do not find that this changes the connotation or commercial impression of applicant's mark significantly from that of registrant's mark, MEDIANET. In fact, purchasers familiar with registrant's services sold under the registered mark MEDIANET may, upon seeing applicant's mark MEDIA.NET COMMUNICATIONS on the same or closely related services, assume that registrant is now using its mark MEDIANET as a domain name, and that the services originate from the same entity.

Further, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general

overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). The differences in the marks (applicant's addition of a "." and the highly descriptive/generic word "communications") do not serve to distinguish the marks in issue here. That is, purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992); and *Edison Brothers Stores v. Brutting E.B. Sport-International*, 230 USPQ 530 (TTAB 1986).

We find that applicant's mark MEDIA.NET COMMUNICATIONS and registrant's mark MEDIANET, although obviously not identical, are similar in sound, appearance, connotation and commercial impression. Purchasers would assume that applicant's services come from the same source as registrant's services, or are somehow sponsored by or associated with registrant, when offered under these respective marks.

Finally, applicant argues that registrant's mark MEDIANET is "highly suggestive" of its "communications through the medium of a cable network," and is "only entitled to a narrow scope of protection." (Brief, p. 4.) Applicant offered no evidence to support its contention that registrant's mark should be afforded only a narrow scope of protection. Even if we were to assume that the mark MEDIANET is highly suggestive of registrant's services, which we do not, it is nonetheless a mark registered on the Principal Register and entitled to protection under the Trademark Act.

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