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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77879157
Applicant	Source Interlink Magazines, LLC
Applied for Mark	ULTIMATE PUZZLE SOURCE
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Applicant: **Source Interlink Magazines, LLC**

Serial No.: **77/879157**

Filed: **November 23, 2009**

Mark: **ULTIMATE PUZZLE SOURCE**

Examiner: **James W. Ringle**

APPEAL BRIEF

I. Introduction

Source Interlink Magazines, LLC ("Applicant") hereby appeals from the Examining Attorney's final refusal to register the mark ULTIMATE PUZZLE SOURCE (the "Mark") in International Class 016 for "magazines containing puzzles." For the reasons set forth below, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's refusal to register the Mark.

II. Grounds for Refusal

The Examining Attorney refused registration of the Mark on the ground that it was likely to cause confusion with the mark THE ULTIMATE PUZZLE and design (Registration No. 3,103,446) for puzzles in International Class 028. The Examining Attorney principally relied on the fact that some companies have secured registrations in both Class 28 and Class 16 for physical puzzles and printed puzzles.

III. Background

Applicant owns and publishes approximately 75 major national magazines and a host of special interest publications, including a handful of magazines featuring puzzles. In the category of magazines featuring puzzles, Applicant owns the following registrations: (1) Registration No. 3902756 for the mark SUDOKU TO GO in Class 16; (2) Registration No. 3902760 for the mark WORD FIND TO GO in Class 16; (3) Registration No. 3902761 for the mark CROSSWORDS TO GO in Class 16.

By way of further background, Applicant included the term "SOURCE" in the Mark to create an association with Source Interlink and its family of magazines. For example, Applicant's parent company Source Interlink Media, LLC owns the mark SOURCE INTERLINK MEDIA. See Registration No. 3845621.

IV. Argument

A. Registration in One Class Does Not Extend to Other Classes

The International Classification of Goods and Services was created specifically to define the scope of a party's trademark rights by limiting a particular registration to the particular classes of goods and services covered by the registration. The current trademark system imposes on the trademark owner the obligation to file for protection in all classes in which a particular mark is in use and/or in all classes in which the trademark owner has a bona fide intention to use the applicable mark. A trademark owner cannot file and secure a registration in one class and then claim an exclusive right to use that mark in a class not cited in the registration. This conclusion flows from the fact that a trademark registration is prima facie evidence of the registrant's exclusive right to use the registered mark in the classes, goods, and services cited in the registration. See 15 U.S.C. § 1057(b).

The examining attorney cited a registration owned by Netisys Limited (based in Cyprus) for the stylized mark THE ULTIMATE PUZZLE in Class 28 for puzzles as a bar to registration of the Applicant's Mark. Notably, Netisys Limited has not filed for protection in Class 16. Netisys Limited could acquire the exclusive right to use the mark THE ULTIMATE PUZZLE in Class 16 only by applying for protection in Class 16. Netisys Limited has failed to apply for protection in Class 16, which means that this exact mark is available for use by others in Class 16. Therefore, the examining attorney erred as a matter of law in finding that a registration in Class 28 bars a registration in Class 16.

The examining attorney cited a number of third party registrations in support of the proposition that trademark owners frequently protect puzzle-related marks in both Class 28 and Class 16. This line of argument bears entirely no relevance to whether Registration Number 3103446 bars Applicant's mark in Class 16. It does not matter what other third parties have done in their trademark protection strategy with respect to trademarks not implicated in this office action - - it only matters what Netisys Limited has done in connection with its mark THE ULTIMATE PUZZLE. The simple fact remains that Netisys Limited did not secure protection in Class 16, which means as a matter of law that Registration 3103446 extends only to Class 28 and cannot be cited as a bar to a registration in Class 16.

Moreover, the third party registrations cited by the examining attorney actually undermine the examining attorney's argument. Each third party registration cited by the examining attorney is protected in both Class 28 and Class 16, which shows that it is incumbent on the trademark owner to protect its marks in various classes to secure the exclusive right to use that mark in such classes. Applicant is a national publisher of magazines and typically protects its magazine titles in both Classes 16 and 41 (on-line content). A registration in Class 16 would not give Applicant the exclusive right to use a mark in Class 41 even though Applicant could cite hundreds of third party registrations in which a publisher has chosen to protect its magazine titles in Class 16 and 41. In short, the classes, goods, and services cited in the registration define the scope of protection of the registration - - not the theoretical possibility that the trademark owner might want protection in a separate class not covered by the registration.

Similarly, the examining attorney's argument makes no sense when applied in the reverse. Applicant owns Registration No. 3902756 for the mark SUDOKU TO GO in Class 16 for magazines containing Sudoku puzzles. Does the fact that Applicant owns a registration in Class 16 give it the exclusive right to use this mark in Class 28 for puzzles? This question answers itself - - absolutely not. Applicant would have to apply for and secure a registration in Class 28 before it could claim an exclusive right to use SUDOKU TO GO in Class 28. This further illustrates why the examining attorney erred as a matter of law in relying on a registration in one Class to bar a registration in an entirely separate Class.

B. No Likelihood of Confusion Exists Between the Cited Registration and the Applicant's Mark

No likelihood of confusion exists between the Mark and THE ULTIMATE PUZZLE in Class 28. In the cited registration, the word "ultimate" is used in small font and is greatly overshadowed by the more prominent word "puzzle" and the stylistic components of the mark. In fact, the stylistic components of the cited registration plus the word "Puzzle" form the dominant part of the cited registration and the examining attorney erred in finding that the word "ultimate" is the dominant part of the cited registration. In cases where the registration consists of a composite mark containing both words and a design and the disputed mark contains only words, courts have held that no likelihood of confusion exists when there are slight differences in the words used. See Omaha National Bank v. Citibank, 633 F. Supp. 231 (D. Neb. 1986) (finding no likelihood of confusion on the ground that "[d]efendant's designations are mere words while plaintiff's composite mark is a combination of words and design"). Because the cited registration consists of a highly stylized mark with the word "ultimate" in very small font, it creates an entirely different overall commercial impression than Applicant's purely textual Mark from the vantage point of the average consumer.

Moreover, the similarity of marks in one respect – sight, sound or meaning – will not result in a finding of likelihood of confusion when the goods are different. For example, Applicant owns the mark SLAM and design (U.S. Reg. No. 2,967,311) in Class 25 for "sports apparel, namely, caps, shirts, sweatsuits, t-shirts." A third party owns the registration for the stylized mark SLAM (U.S. Reg. No. 3,283,187) in Class 25 for "clothing, excluding clothing used for playing sports, namely, shirts, pants, ties, suits, T-shirts, shorts, blouses, skirts, dresses, jumpers, jeans, socks, tights, coats, jackets, vests, hats, caps, scarves, gloves, and belts." By way of further example, PTO permitted the registration of the word mark VIVA CASINO (U.S. Reg. No. 3473703) in Class 041 for casino services excluding online gaming services after issuing a registration for the logo VIVA CASINO (U.S. Reg. No. 2785395 in Class 041 for "entertainment services, namely, providing on-line games of chance and casino-style gaming services rendered on-line." These two examples show compellingly that only slight differences in the appearance of a mark are required when the goods are different.

In this case, Applicant's text Mark in Class 16 for magazines containing puzzles creates a different overall commercial impression than the highly stylized mark THE ULTIMATE PUZZLE in Class 28 for puzzles. The dominant portions of the mark are substantially different and the goods are entirely different. Accordingly, the examining attorney erred as a matter of

law in finding that a likelihood of confusion exists between Applicant's Mark and the registration for the highly stylized mark THE ULTIMATE PUZZLE.

C. Conclusion

For the foregoing reasons, Registration No. 3103446 does not bar the registration of the Mark in Class 16 for magazines containing puzzles and the TTAB should reverse the Examining Attorney's refusal to register the Mark.