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

Trademark Law Office 115
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Applicant: International Data Group, Inc.
Serial No. 78/624,612
Mark: **ENTERTAINMENT AT HOME**
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APPEAL BRIEF

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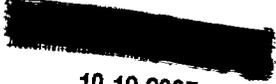

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INTRODUCTION

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based upon the section 2(d) of the Trademark Act.

THE RECORD

The record for this appeal consists of the application, two Office Actions and Responses.

THE EXAMINER'S POSITION

The Examining Attorney has maintained and made "Final" a refusal of registration based upon Registration Number 2996117 issued November 12, 2004 on the Supplemental Register for the mark HOME ENTERTAINMENT for "magazines in the fields of entertainment and consumer electronics."

THE APPLICANT'S POSITION

It is the Applicant's position that there is no likelihood of confusion between Applicant's mark and Registrant's mark because regardless as to any relationship between the parties' goods, the marks are different and the registered mark is weak in that it was issued on the Supplemental Register.

ARGUMENT

Similarity of the Marks

The marks at issue here are ENTERTAINMENT AT HOME and HOME ENTERTAINMENT.

The cited mark was issued on the Supplemental Register, and the applicant is seeking registration of its mark on the Supplemental Register.

The fact that both the present applicant and the registrant have recognized the inherently descriptive and weak nature of their marks is an important factor to be considered in determining whether there is a likelihood of confusion between the marks.

Applicant recognizes that even marks registered on the Supplemental Register may be cited under Section 2(d) of the Trademark Act. However, as indicated in TMEP Section 1207.01(b)(ix) “The Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a **narrower scope of protection** than an entirely arbitrary or coined word. *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006); *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984).

In *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975), the Board stated:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. (citation omitted.) This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as “weak” marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

In the present case, the marks are not substantially identical. Rather, they are only similar in that they are close to being transpositions (i.e., they are not even exact transpositions because of the inclusion of the word “AT” in the applicant’s mark).

It has further been consistently held that weak, descriptive marks are entitled to a limited scope of protection. In *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295, (CCPA 1958) the U.S. Court of Customs and Patent Appeals stated

It is unnecessary to cite the numerous other cases of this court wherein the scope to be given to weak trademarks was discussed. It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

In the present case, the applicant is entitled to “come closer” to the cited registered mark than otherwise allowed because the cited registered mark is a weak mark as evidenced by its issuance on the Supplemental Register.

The applicant’s mark is not a simple transposition of the registered mark.

CONCLUSION

In order to maintain a rejection under Section 2(d) it is not sufficient if confusion is merely “possible.” A higher standard is required. *Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) (“Likelihood of confusion requires that confusion be probable, not simply a possibility.”); *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) (“[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient.”).

The court in *Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation*, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (CAFC 1992) held that it was “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.”

In view of the foregoing, it is respectfully requested that the refusal of registration be reversed.

Respectfully submitted,

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