

From: Tanner, Michael

Sent: 8/10/2015 11:22:12 AM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85153592 - COSMOS COUNTRY - N/A - SU - Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 38

Files: x-search cosmos current.jpg, 76571129P001OF003.JPG, 76571129P002OF003.JPG, 76571129P003OF003.JPG, 76700977P001OF002.JPG, 76700977P002OF002.JPG, 76700978P001OF004.JPG, 76700978P002OF004.JPG, 76700978P003OF004.JPG, 76700978P004OF004.JPG, 77618275P001OF003.JPG, 77618275P002OF003.JPG, 77618275P003OF003.JPG, 77618318P001OF003.JPG, 77618318P002OF003.JPG, 77618318P003OF003.JPG, 77618548P001OF003.JPG, 77618548P002OF003.JPG, 77618548P003OF003.JPG, 77618607P001OF003.JPG, 77618607P002OF003.JPG, 77618607P003OF003.JPG, 77618621P001OF003.JPG, 77618621P002OF003.JPG, 77618621P003OF003.JPG, 77618733P001OF002.JPG, 77618733P002OF002.JPG, 77618746P001OF002.JPG, 77618746P002OF002.JPG, 77618772P001OF002.JPG, 77618772P002OF002.JPG, 85153592P001OF002.JPG, 85153592P002OF002.JPG, 85666541P001OF002.JPG, 85666541P002OF002.JPG, 86136195P001OF002.JPG, 86136195P002OF002.JPG, 85153592.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85153592

MARK: COSMOS COUNTRY



CORRESPONDENT ADDRESS:

SARAH M ROBERTSON

DORSEY & WHITNEY LLP

51 WEST 52ND STREET

NEW YORK, NY 10019-6119

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Cosmos Soccer Club LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

ny.trademark@dorsey.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/10/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated February 3, 2105 is **MAINTAINED**

and CONTINUES TO BE FINAL: the ornamental refusal under Sections 1, 2 and 45 of the Trademark Act. See TMEP §§715.03(a)(ii)(B), 715.04(a). See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, the applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue contained in the final Office action.

In its request, the applicant claims the final Section 1, 2, and 45 refusal is faulty because the mark somehow operates as a secondary source indicator. According to the applicant, the "non-ornamental use of the [applied for] mark as shown in connection with services other than the Class 25 goods in [sic] issue, namely, a soccer team engaging in exhibitions and game-related services in Class 41, clearly indicate that the mark as shown COSMOS COUNTRY serves a source-identifying function".¹ Not only is the applicant's reliance on *In re Paramount Pictures Corp.*, and TMEP §1202.03(c) improper in this case, but its statement concerning the non-ornamental use of the mark is a mere legal conclusion without any evidentiary support.

The Office notes that TMEP §1202.03(c) clearly states that in order to show that a proposed mark that is used on goods in a decorative or ornamental manner also serves a source-indicating function as a "secondary source," the applicant must demonstrate: (1) ownership of a U.S. registration on the Principal Register of the *same mark* for other goods or services based on use in commerce under §1 of the Trademark Act; (2) ownership of a U.S. registration on the Principal Register of the *same mark* for other goods or services based on a foreign registration under §44(e) or §66(a) of the Trademark Act for which an affidavit or declaration of use in commerce under §8 or §71 has been accepted; (3) non-ornamental use of the [applied for] mark in commerce on other goods or services; or (4) ownership of a pending use-based application for the *same mark*, used in a non-ornamental manner, for other goods or services. See TMEP §1202.03(c).

In this case, the applicant has not submitted any evidence that would support its secondary source assertion. While unstated, it appears the applicant is premising its secondary source claim on numerous other active registrations and applications it has that contain the term COSMOS. The applicant's attempt to base its secondary source claim on these current active registrations or use-based applications is a gross misinterpretation of TMEP 1202.03(c) as well as the holding of *In re Paramount Pictures Corp.*, and its progeny.

¹ See applicant's Request for Reconsideration filed on August 3, 2015.

The applicant's attempt to rely on its other active registrations or use-based applications is improper because the respective marks at issue are not the same.² It is well settled that an applied-for mark is considered the same mark if it is the ***legal equivalent*** of a previously-registered mark. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); TMEP §1212.04(b). To be legal equivalents, the applied-for mark must be indistinguishable from the previously-registered mark or create the same, continuing commercial impression such that the consumer would consider them both to be the same mark. *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1423 (TTAB 2010); *In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010); see *In re Dial-A-Mattress Operating Corp.*, 240 F.3d at 1347, 57 USPQ2d at 1812; *In re Binion*, 93 USPQ2d 1531, 1539 (TTAB 2009); TMEP §1212.04(b).

Given the obvious differences in sight, sound and commercial impression, the applied-for mark "COSMOS COUNTRY" cannot be the legal equivalent of any of the applicant's active prior registrations or applications that contain the term "COSMOS" or "NEW YORK COSMOS". The addition of the distinctive term COUNTRY to the term COSMOS clearly creates a mark that has a different commercial impression vis-à-vis the wording "COSMOS" or "NEW YORK COSMOS" appearing alone. Accordingly, the Office finds that the relevant case law precludes the applicant from basing any secondary source assertion on its active prior registrations or applications. Furthermore, the record in this case does not contain any evidence of non-ornamental use of the mark COSMOS COUNTRY on other goods or services—a finding which also precludes a secondary source claim under TMEP §1202.03(c).

In sum, the applicant's analysis and arguments are not persuasive, nor do they shed new light on the issues raised in the Final Office Action dated February 3, 2015. In essence, the applicant's Request for Reconsideration is a mere legal conclusion without any evidentiary support. Accordingly, the applicant's reconsideration request is hereby **DENIED**.

If the applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP

² For a list of all of the applicant's active registrations and applications, the examining attorney refers to the attached x-search summary from the Office's database showing that it has eleven (11) active registrations and three (3) active applications—none of which contain the wording COSMOS COUNTRY (other than the application at issue). For purposes of completeness a copy of those active applications and registrations are attached for review.

§715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

If the applicant or its appointed attorney has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Michael Tanner/

Michael Tanner

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85153592
 COSMOS COUNTRY

Text to Search Plurals

1 not dead[15]

#	Hits	Status	Search term
1	24		"cosmos_soccer"[cn]
2	14		1 not dead[15]

Goods and Services

IC 025. US 022 039. G & S: Headgear, namely, hats and caps. FIRST USE: 20130831. FIRST USE IN COMMERCE: 20130831

Mark Drawing Code

(2) DESIGN ONLY

Design Code

- 01.11.02 - Moons, crescent, Moons, half, Partial moons, including half moons and crescent moons (not a moon with craters)
- 26.01.01 - Circles as carriers or as single line borders
- 26.01.20 - Circles within a circle
- 26.01.21 - Circles that are totally or partially shaded.

Serial Number

76700977

Filing Date

December 23, 2009

Current Filing Basis

1A

Original Filing Basis

1B

Publication for Opposition Date

January 11, 2011

Registration Number

4522112

Registration Date

April 29, 2014

Owner Name and Address

(REGISTRANT) COSMOS SOCCER CLUB LLC LIMITED LIABILITY COMPANY DELAWARE 75 GREENE STREET 2ND FLOOR NEW YORK NEW YORK 10012

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

3451687;3642933;3642942

Description of Mark

Hit List | Tag List | All Tagged | Browse | Strategy |

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<input type="checkbox"/>	2	85153592	20101015	V	COSMOS COUNTRY
<input type="checkbox"/>	3	85646541	20120702	V	NEW YORK COSMOS
<input type="checkbox"/>	4	77618772	20081120	VB	COSMOS
<input type="checkbox"/>	5	77618746	20081120	VB	COSMOS
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<input checked="" type="checkbox"/>	14	76700977	20091223	VB	