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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NOS. 86040643, 86040656

**MARKS:** JAWS, JAWS DEVOUR YOUR HUNGER



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**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

**APPLICANT:** Mr. Recipe, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

23457.041

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant, Mr. Recipe, LLC (hereinafter "applicant") has appealed the trademark examining attorney's final refusal to register the trademarks JAWS and JAWS DEVOUR YOUR HUNGER under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(d). Registration was refused on the Principal Register on the grounds that the applicant's marks are likely to be confused with the mark JAWS of U.S. Registration No. 2276097.

## FACTS

On August 16, 2013, applicant applied to register the standard character marks JAWS<sup>1</sup> and JAWS DEVOUR YOUR HUNGER<sup>2</sup> based on an intent to use the mark in commerce under Section 1(b) of the Trademark Act in connection with “entertainment services, namely, an on-going series featuring food, spices, and cooking provided through television and video media; entertainment services in the nature of an on-going reality based television program; entertainment services, namely, providing ongoing programs in the field of food, spices, and cooking provided through television, video, and internet media; entertainment services, namely, a multimedia program series featuring news and demonstrations in the field of food, spices, and cooking; entertainment, namely, production of shows and programs for television, internet, and video; entertainment, namely, a streaming Internet channel providing programming related to cooking.”

In Office actions issued on December 10, 2013, registration was refused under Section 2(d) of the Trademark Act based on U.S. Registration Nos. 2276097 and 3911508 and U.S. Application Serial Nos. 85647186, 85725922, 85725930, 85849541, and 85849546 were referenced as earlier-filed pending applications with respect to U.S. Application Serial No. 86040643 for JAWS and U.S. Application Nos. 85647186, 85725922, and 85725930 were referenced as earlier-filed pending applications with respect to U.S. Application Serial No. 86040656 for JAWS DEVOUR YOUR HUNGER. A requirement for an acceptable identification was also made along with the requirements for a multiple class identification.

In responses filed on June 10, 2014, applicant argued against the Trademark Act Section 2(d) refusal and the potential Section 2(d) refusal based on the referenced earlier-filed pending applications and amended the identifications of services to “entertainment, namely, streaming of audiovisual material via an Internet channel providing programming related to cooking” in International Class 38.

Office actions were issued on July 1, 2014 in which the Trademark Act Section 2(d) refusal was withdrawn with respect to U.S. Registration No. 3911508, the reference to the earlier-filed pending applications was withdrawn, and the amended identification of services was accepted. The refusal under Section 2(d) of the Trademark Act was maintained and made final with respect to U.S. Registration No. 2276097 for the mark JAWS used in connection with “video recordings in all formats all featuring motion pictures” in International Class 9.

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<sup>1</sup> U.S. Application Serial No. 86040643

<sup>2</sup> U.S. Application Serial No. 86040656

Applicant filed Notices of Appeal on January 2, 2015 and submitted appeal briefs on March 3, 2015.

On April 2, 2015, the trademark examining attorney filed a Motion to Consolidate the appeals for U.S. Application Serial Nos. 86040643 and 86040656, which motion was granted on April 8, 2015.

### **ISSUE ON APPEAL**

The sole issue on appeal is whether applicant's proposed use of the marks JAWS and JAWS DEVOUR YOUR HUNGER in connection with "entertainment, namely, streaming of audiovisual material via an Internet channel providing programming related to cooking" creates a likelihood of confusion with the registered mark JAWS in U.S. Registration No. 2276097 used in connection with "video recordings in all formats all featuring motion pictures."

### **ARGUMENTS**

#### **LIKELIHOOD OF CONFUSION**

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567. The examining attorney addresses in turn the factors that are relevant to the instant case.

#### **I. THE MARKS CREATE CONFUSINGLY SIMILAR COMMERCIAL**

##### **IMPRESSIONS.**

###### **A. U.S. Application Serial No. 86040643 - JAWS**

The applied-for mark JAWS is identical to the registered mark. Where the marks of the respective parties are identical, the relationship between the relevant goods and services need not be as close to support a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); TMEP §1207.01(a).

**B. U.S. Application Serial No. 86040656 – JAWS DEVOUR YOUR HUNGER**

The proposed mark JAWS DEVOUR YOUR HUNGER and the registered mark JAWS each include and begin with the identical term JAWS. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii).

The fact that the marks begin with the same term is significant, as consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Although the applied-for mark includes additional wording relative to the registered mark, adding a term or terms to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Because the first and therefore most dominant term in the applied-for mark is identical to the registered mark, the marks create confusingly similar commercial impressions. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

## **II. APPLICANT HAS FAILED TO SHOW THAT JAWS IS DILUTED OR WEAK.**

Applicant argues “...the record is clearly [*sic*] that consumers have dealt with multiple ‘JAW’ marks for goods and services involving audio-visual material and have not had any difficulty discerning between them.” (applicant’s appeal brief at page 5, hereinafter, “(App. Br. at \_\_\_\_\_)”). In support of this contention, applicant cites two earlier-filed pending applications that were referenced in the December 10, 2013 non-final Office actions, stating “[t]he record contains no suggestion whatsoever that the presence of both these marks in the marketplace has caused any confusion.” *Id.* at 6. But there is also no evidence that either of these marks has ever been registered, with the application for one of the marks, U.S. Application Serial No. 85647186, having been abandoned prior to the issuance of the final Office actions on July 1, 2014. See Final Office actions, issued July 1, 2014. Accordingly, applicant has failed to show that the marks in the earlier-filed referenced applications are, or were ever, present in the marketplace for a likelihood of confusion to arise and thus has failed to show that JAW or JAWS is weak or diluted.

## **III. THE REGISTERED MARK IS FAMOUS AND SHOULD BE AFFORDED A BROADER SCOPE OF PROTECTION.**

Famous marks are given a wider scope of legal protection “...since they are more likely to be remembered and associated in the public mind than weaker marks, and are thus more attractive as targets for would-be copyists.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). When present, the fame of a mark is “a dominant factor in the likelihood of confusion analysis...independent of the consideration of the

relatedness of the goods.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000).

Applicant contends “...with regard to the alleged fame of the mark, the evidence demonstrates at best a ‘niche’ level of fame insufficient to create a likelihood of confusion.” (App. Br. at 6). Applicant further contends “...truly famous marks are things like ‘Budweiser beer, Camel cigarettes, Barbie dolls, and the like,” where the brand name immediately calls to mind the object with which it is associated.” *Id.*, citing *Bd. of Repents. Univ. of Tx. Sys. v. KST Elec., Ltd.*, 550 F.Supp.2d 657, 679 (W.D.Tex. 2008).

However, “[w]hile dilution fame is an either/or proposition – fame either does or does not exist – likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Palm Bay Imps.*, 396 F.3d at 1375, 73 USPQ2d 1689 at 1694, citing *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 [68 USPQ2d 1059 ] (Fed. Cir. 2003).

Here, the evidence submitted in support of the fame of the registered mark JAWS, all of which was attached to the July 1, 2014 final Office action, shows

- the motion picture Jaws was the first to break the \$100,000,000 record in box office rentals and won three of the four Academy Awards for which it was nominated in 1977. See TCM Turner Classic Movies excerpt from [www.tcm.com](http://www.tcm.com).
- “...the film...was a worldwide hit and entered international popular culture.” See TV Guide excerpt from <http://movies.tvguide.com>.
- as of July 1, 2014, the motion picture Jaws was ranked number 72 on a listing of all-time USA box office sales with \$260,000,000. See excerpt from IMDB from [www.imdb.com](http://www.imdb.com).
- the film Jaws has been heralded one of the “top movies of all time” and “the greatest film of all time.” See FilmCrave.com excerpt from [www.filmcrave.com](http://www.filmcrave.com) and What Culture excerpt from <http://whatculture.com>.

It is submitted that although Jaws may be best known as a “...40-year-old thriller movie about a shark,” the fact that as of 2014, it was still making top movie lists and is still being proclaimed as one of the greatest movies ever made shows that at the very least, the registered mark has acquired a moderate level of fame and should thus be afforded a broader scope of protection. (App. Br. at 7).

#### **IV. APPLICANT’S SERVICES AND REGISTRANT’S GOODS ARE SUFFICIENTLY**

#### **RELATED AND SOLD THROUGH THE SAME CHANNELS OF TRADE SO**

**THAT CONFUSION IS LIKELY.**

The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In its brief applicant submits “[a]lthough Applicant concedes that it is not impossible for a motion picture to involve cooking, programming relating to cooking such as the application at issue here describes is generally understood to be separate and distinct from motion pictures, or movies.” (App. Br. at 5).

However, with respect to applicant’s and registrant’s goods and services, the question of likelihood of confusion is determined based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

Additionally, unrestricted and broad identifications are presumed to encompass all goods and services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the applications indicates that applicant’s streaming services feature “audiovisual material” and does not limit the audiovisual material to any particular format. The applicant’s streaming services thus may feature motion pictures or movies. Moreover, the

video recordings featuring motion pictures of the registrant are not limited to any particular subject matter. The registrant's video recordings thus may feature motion pictures in the field of cooking. Thus, the streaming services of the registrant may be used to stream the motion pictures of the registrant. Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); *see In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men's, boys', girls' and women's clothing likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

The trademark examining attorney has also provided sufficient evidence to show that the applicant's services and the registrant's goods are related, consisting of a number of third-party marks registered for use in connection with the same or similar goods and services as those of both applicant and registrant in this case. *See* the attachments to the December 10, 2013 and July 1, 2014 Office actions. This evidence shows that the goods and services listed therein, namely, video and audiovisual recordings and streaming of entertainment content are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

### **CONCLUSION**

Because of the similarity of the marks, the relatedness of the goods and services and the overlap of the trade channels therefor, confusion as to the source of the identified goods and services is likely. To the extent that the examining attorney may have had any doubt, such doubt was resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261,

1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

For the reasons stated above, it is respectfully requested that the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

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