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Sent: 12/11/2015 9:03:26 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 86170852 - GREE - 381591-1/GTA - EXAMINER BRIEF

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Count: 1

Files: 86170852.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86170852

MARK: GREE



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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: GREE, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

381591-1/GTA

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant, Gree, Inc. applied to register GREE for providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general

interest; electronic transmission of messages and data, namely, documents, videos, images, music and other media via a global communication network on an intent-to-use basis pursuant to Trademark Act Section 1(b), 15 U.S.C. §1051(b). On April 28, 2014, an Office action was issued that refused registration under Section 2(d) of the Trademark Act and refused specific wording in the identification of services.

The Section 2(d) refusal was based on the grounds that applicant's mark, as used in connection with the services referenced above, was found to be confusingly similar to the registered mark GREE and design in U.S. Registration No. 4362969 for radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network; voice mail services. Applicant's identification of services was rejected because the wording "music" and "other media" needed further clarification so that the identification would include definite language.

Applicant's response dated October 22, 2014, included an acceptable amendment to the identification of services but failed to persuade the examining attorney that there would be no likelihood of confusion between its mark and the cited mark. On November 13, 2014, registration was finally refused under Section 2(d) of the Trademark Act of 1946 (as amended).

An appeal was filed on May 13, 2015, along with a request for reconsideration wherein applicant submitted an amendment to the previously accepted identification of services adding the wording "software applications" to the identification and deleting the fields of use which limited the on-line chat rooms and electronic bulletin boards services. The examining attorney refused the amendment because the wording expanded the scope of the services. Applicant's arguments that there was no likelihood of confusion were again found to be unpersuasive.

Accordingly, there are two issues on appeal before the Board: 1) whether there is likelihood of confusion between applicant's proposed mark and the cited mark; 2) whether the amended identification of services is acceptable. The examining attorney requests that the Board affirm both the Section 2(d) refusal and the refusal of the amendment to the identification of services.

PRELIMINARY OBJECTION

Applicant has attempted to amend the identification of services within its brief. The proper procedure for applicant to amend the identification of services would have been for applicant to "file a request for remand and a request to suspend proceedings in the appeal pending the Board's decision on the request for remand." See TBMP §1205.01. The proposed amendment is unacceptable as explained below and does not nullify the Section 2(d) refusal.

LIKELIHOOD OF CONFUSION

COMPARISON OF MARKS

The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation, and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

Applicant's proposed mark is GREE in standard characters. The standard character mark would enable applicant to use the mark without limitation as to a particular font or style. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011).

Registrant's mark also contains the word GREE in stylized letters with an abstract design element describes as a "stylized G." The dominant element in registrant's mark is the term GREE. Registrant's mark is entitled to a broad scope of protection because the term "gree" in the mark is a coined term representing the strongest of marks on the continuum of distinctive marks. *See e.g., In re Wilson*, 57 USPQ2d 1863, 1865 (TTAB 2001)("PINE CONE" used in connection with canned fruits and vegetables is an arbitrary and strong mark entitled to a broad scope of protection).

When individuals recall the sources of the services at issue in this appeal, they will rely on the word GREE found in each mark. Although a design element is present in the cited mark, the word portion is more likely to be impressed upon a purchaser's memory and to be used when requesting the services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Applicant has not disputed the similarities of the marks in its brief. Applicant contends that its ownership of Application Serial No. 85422099 for a similar mark associated with services that are similar to those services in the application on appeal, with an earlier filing date than the filing date of the cited registration, should permit its mark in this appeal to move forward. According to applicant, the mere ownership of another application not cited by the examining attorney who was assigned to the registered mark should permit applicant to obtain a registration of the mark free of a Section 2(d) refusal involving that same registered mark.

The existence of pending Application Serial No. 85422099 establishes nothing other than it was filed with the United States Patent and Trademark Office. *See In re Jack B. Binion*, 93 USPQ2d 1531, 1535 fn.3 (TTAB 2009). The determination under Section 2(d) is based on an analysis of all of the probative facts in evidence relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant was advised in a final Office action that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

In this case, applicant is relying on an application that has not registered as grounds for arguing that the Section 2(d) refusal should be reversed. In its brief, applicant erroneously contends that the mark in Application Serial No. 85422099 has been approved for registration. However, that application has not been approved for publication as of the briefing stage of this appeal. Applicant is asking the Board to reverse the Section 2(d) refusal based on another examining attorney's decision not to cite the mark in Application Serial No. 85422099 owned by applicant.

COMPARISON OF THE SERVICES

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). To support a finding that the goods and/or services are related, it is sufficient to show that conditions surrounding their marketing, or because they are

otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

In a request for reconsideration dated May 13, 2015, applicant amended the services as follows:

providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest.

The Section 2(d) refusal applies to the following services in the cited registration:

Radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network; voice mail services.

In the record, there are copies of more than 20 use-based, third-party registrations showing that a single entity has registered one mark for services of the type identified in applicant's amended identification of services and those services found in the cited registration.¹ Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and services are of a type that may emanate from a single source. See *Mucky Duck Mustard*

¹ See attachments to the initial Office action dated April 28, 2014.

Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are “not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source”). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). Representative samples of these registrations include the following excerpted services (emphasis added):

Registration No. 3174386 for “communications and communications enhanced services, namely the provision of audio and video teleconferencing, telemessaging, voice mail services, electronic transmission of messages and data, electronic voice messaging namely, the recording, storage and subsequent transmission of voice messages by telephone, providing on-line chat rooms and on-line electronic bulletin boards for transmission of messages among computer and telephone users concerning voice personals, romance, traffic, horoscopes, adult entertainment, weather, medicine, politics and social relationships and providing multiple-user access to a global computer information network, and the provision of communications related information and electronic directory assistance in support of these enumerated services, all offered by means of public switched telephone networks, wireless networks and through the global packet switched computer network”;

Registration No. 3568975 for “Internet broadcasting services; Providing multiple-user access to a global computer information network; Providing private and secure real time electronic communication over a computer network; Providing telecommunications connections to a global computer network; Voice chat services; Voice mail services; Voice over internet protocol (VOIP) services; Streaming of video material on the Internet; Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; Providing on-line chat rooms for transmission of messages among computer users concerning poetry; Electronic exchange of data

stored in databases accessible via telecommunication networks; Transmission and reception of database information via the telecommunication network; Transmission of database information via telecommunications networks”;

Registration No. 3664274 for “Broadcast of cable television programmes; electronic message sending; communications by computer terminals; electronic, electric, and digital transmission of voice, data, images, signals, and messages; electronic mail services; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; providing telecommunications connections to a global computer network; providing multiple-user access to a global computer information network; providing Internet chatrooms; voice mail services”;

Registration No. 3697570 for “Audio and video broadcasting services over the Internet or other communications networks, namely, uploading, posting, showing, displaying, tagging and electronically transmitting information, audio and video clips; providing multiple user access to the Internet to allow users to access information, audio and video via websites, online forums, chat rooms, and blogs; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services and provision of telecommunication access to films and TV programs provided via a video-on-demand service; communications by television for meeting; Internet service provider; electronic mail services; communication services, namely, transmitting streamed sound and audio-visual recordings via the Internet; providing high speed access to area networks and global computer information networks; electronic on-line services providing a communications link to global interactive networks for the transfer and transmission of messages and data; Rental of access time to global computer networks; Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Rental of equipment for

telecommunications; Communication by electronic computer terminals; Providing telecommunications connections to a global computer network; Voice mail services; and Telecommunication services in the nature of providing telephone features, namely, call waiting, call identification, call forwarding, and message waiting”;

Registration No. 3229437 for, inter alia, “Telecommunication services, namely, wireless telecommunications services; electronic mail services; message sending and receiving services via a global computer network or the Internet; electronic communication and transmission services via a global computer network or the Internet; voice mail services; electronic transmission of data; providing online chat rooms and electronic bulletin boards for transmission of messages and data; providing multiple-user access to a global”;

Registration No. 4368870 for “Communications services, namely, transmitting streamed sound and audio-visual recordings via the Internet, cable networks, wireless networks, satellite, or interactive multimedia networks; audio and video broadcasting services over the Internet; transmission of information in the audio-visual field; television broadcasting services; cable television broadcasting; satellite television broadcasting; mobile media services in the nature of electronic transmission of entertainment media content; podcasting services; webcasting services; video-on-demand transmission services; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest”;

Registration No. 4261787 for, inter alia, “Broadcasting and streaming of audio-visual media content in the fields of yearbooks, general information, entertainment, films, documentaries, television, radio, news, sports, music, comedy, drama, action, adventure, animation, music videos, celebrities, public figures, and video via a global computer network; Webcasting services; Providing access to online forums for transmission of messages and blogs over the Internet; Providing on-line electronic bulletin

boards for transmission of messages among computer users concerning yearbooks, general information, entertainment, films, documentaries, television, radio, news, sports, music, comedy, drama, action, adventure, animation, music videos, celebrities, public figures, and video; Web messaging services; Video-on demand transmission services; Providing online forums for transmission of messages among computer users concerning current and historical event reporting, yearbooks, general information, entertainment, films, documentaries, television, radio, news, sports, music, comedy, drama, action, adventure, animation, music videos, celebrities, public figures, and video; Providing an on-line searchable database featuring information in the field of retro TV and radio broadcasting”;

Registration No. 4020646 for, inter alia, “Audio and video broadcasting services over the Internet; Audio teleconferencing; Automated telephone call screening services; Automated telephone voice message services; Broadcast communication services, namely, transmitting e-mails, faxes, text messages and telephone voice messages to designated recipients for others; Call forwarding services; Call recording services; Call screening services; Cellular telephone communication; Cellular telephone services; Communication by mobile telephone; Communication services, namely, electronic transmission of data and documents among users of computers; Communication services, namely, providing electronic transmission of information stored in a database via interactively communicating computer systems; Communication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; Communications by telephone; Communications services, namely, transmitting streamed sound and audiovisual recordings via the Internet; Communications via multinational telecommunication networks; Computer telephony services; Computer transmission of online based services accessed via a network reference, namely, a URI, visual code, namely, barcodes, tag, namely, RFID, terminal, namely, pc or mobile device, or any combination thereof; Computer-aided transmission of messages; Computerized telephony services; Data transmission and reception services

via telecommunication means; Delivery of personalized greeting cards to others via electronic mail; Digital network telecommunications services; Electronic messaging; Fixed and mobile telephone services; Instant messaging services; Interactive delivery of video over digital networks; International telephone services; Internet telephony services; Local and long distance telephone services; Long distance telephone communication services; Message collection and transmission; Message sending and receiving services; Message sending via a website. Message sending, receiving and forwarding; Mobile telephone communication; Mobile telephone services; Mobile telephony; National and international telephone calling plan services; Network conferencing services; PBX dialing services; Prepaid local and long distance telephone services; Prepaid long distance telephone services; Providing telephone conferencing services; Provision of video conferencing services; Telecommunication services in the field of providing long distance service with audio advertising for others as a component of the long distance service; Telecommunication services, namely, call hunting; Telecommunication services, namely, local and long distance transmission of voice, data, graphics and video by means of broadband optical or wireless networks; Telecommunication services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions; Telecommunication services, namely, providing Internet access via broadband optical or wireless networks; Telecommunications services, namely, providing prepaid minutes for use on cell phones abroad; Teleconferencing and video conferencing services; Telephone telecommunications services provided via prepaid telephone calling cards; Telephony communication services; Text and numeric wireless digital messaging services; Transmission of short messages; Video broadcasting services via the Internet; Video conferencing services; Video teleconferencing; Video telephone services; Virtual chat rooms established via text messaging; Voice chat services; Voice mail services; Voice over Internet protocol (VOIP) services; Voice over IP services; Web messaging; Wireless digital messaging services;

Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; Worldwide switched text and message transmission services”;

Registration No. 4289611 for, inter alia, “Providing chat lines utilizing the Internet; providing Internet chat rooms; providing on-line forums for transmission of messages among computer users; providing access to a global computer network for the downloading of computer software, computer programs and information; electronic mail services; mailbox services, in the nature of voice mail services; electronic transmission of information and messages of all kinds in the form of images and sound on the Internet; mobile telephone services, including text messaging and voice mail services.”

Other evidence attached to the final Office action dated November 13, 2014, consists of webpages retrieved from www.clickmeeting.com showing a single source providing various audio and video conferencing services along with chat and electronic transmission services. Web pages retrieved from www.socialmedia.biz list numerous sources that provide chat and teleconferencing services as complimentary services. Further, web pages from www.cisco.com show that it is common for a single source to provide chat and conferencing services. All of this evidence collectively supports a finding that the services associated with each mark are related and travel in the same channels of commerce.

In applicant’s first response dated October 22, 2014, applicant argued that the services would not crossover because its services “are directed to and only accessible by users already having access to the Internet.” Applicant now argues in its brief that its services occur “only within the context of Applicant’s proprietary social network.” App. Brief at 8. Applicant would like the Board to believe that its “proprietary social networking websites” exist on a network not accessible to vast members of the public. However, applicant offers no explanation on how this “proprietary network” is so exclusive within the Internet whereby it prevents users of registrant’s services from associating registrant’s services with applicant’s services. Many social networking websites are proprietary networks accessible

to any individual who registers with the network. An individual using such a network is exposed to various services offered by other entities. His or her mere use of a social network would not insulate that individual from services offered within it or outside of it.

Applicant contends that the services of registrant are not identical to the services provided by applicant and therefore they are unrelated. As noted above, the fact that the services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular services, but likelihood of confusion as to the source or sponsorship of those services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01. Where the marks of the respective parties are essentially identical, the relationship between the relevant goods and/or 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 House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015). In this case, both marks share identical terms.

Turning to the amended identification of services in applicant's brief, the Board will find that the Section 2(d) analysis does not change. The amended identification of services in applicant's brief is the following:

“Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites; electronic transmission of messages and data, namely, documents, videos, images and digital music in the fields of social games, video games, and general interest, all via proprietary social networking websites” in International Class 38.

Despite the addition of the wording “via proprietary social networking websites,” the third-party registrations and websites of record show the relationship between applicant's amended services

and the services in the cited registration. By simply indicating that the services are “proprietary,” it does not automatically encase applicant’s services and thereby limit an individual’s exposure to the services included in the cited registration. Applicant’s conclusory statements do not rebut the third-party registrations and the third-party websites which show that the services in the application and registration are provided by one source.

IDENTIFICATION OF SERVICES

In a response dated October 22, 2014, applicant submitted the following acceptable amendment to the identification:

“providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest; electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network.” (emphasis added)

On May 13, 2015, applicant submitted a request for reconsideration that included an amendment to the identification of services as follows:

“Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest.”

The amended identification of services added “software applications” to the identification and deleted the wording “fields of social networking and general interest.” The examining attorney refused this

amendment on the grounds that it expanded the scope of the identification of services by adding software goods and also deleting the fields of social networking and general interest. It should be noted that on-line chat rooms and electronic bulletin boards are provided through websites and not through software applications.

“Once an applicant amends the identification of goods and/or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications and restricts the scope of goods/services to that of the amended language.” TMEP §1402.07(e). Amendments that add to or expand the scope of the recited services, as amended, are not permitted. *See e.g. In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm’r Pats. 1991). Applicant was advised in an Office action dated April 28, 2014, that adding to or broadening the scope of the services was not permitted. *See* 37 C.F.R. §2.71(a); *see also* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

The Board should note that the amended identification of services in applicant’s brief does not include software applications but still expands the scope of the services by omitting the social networking and general interest fields. The examining attorney requests that the refusal of the amendment to the identification of services be affirmed. Accordingly, the identification of services should read as follows: providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest.

CONCLUSION

There is nothing in the record suggesting that the registered mark is weak or diluted as used in connection with the services. The term GREE appearing in the mark is a coined term entitled to the strongest protection. The evidentiary record shows that the services at issue are offered by a single

source. As explained above, the amendment to the identification of services expands the scope of the previously accepted identification. For the reasons discussed herein, the trademark examining attorney respectfully requests that the refusal under Section 2(d) and refusal of the identification of services be affirmed.

Respectfully submitted,

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