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

U.S. APPLICATION SERIAL NO. 86242025

MARK: COZI TV



CORRESPONDENT ADDRESS:

TIRZAH LOWE

NBCUNIVERSAL MEDIA, LLC

100 UNIVERSAL CITY PLAZA

UNIVERSAL CITY, CA 91608

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: NBCUniversal Media, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/28/2015

This Office action is in response to applicant's communication filed on May 19, 2015 where applicant (1) argued against the Section 2(d) Likelihood of Confusion Refusal and (2) provided the required foreign translation statement.

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 Section 2(d) Likelihood of Confusion Refusal made final in the Office action dated November 20, 2014 is maintained and continues to be final. *See* TMEP §§715.03(a)(ii)(B), 715.04(a). The foreign translation statement requirement made final in the Office action is satisfied. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

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

SUMMARY OF ISSUES that applicant must address:

- Section 2(d) Refusal – Likelihood of Confusion

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The final refusal of registration of the applied-for mark continues to be final because of a likelihood of confusion with the marks in U.S. Registration Nos. 2531351, 3542030, and 3796655. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the registrations attached to the prior Office action.

The applicant has applied to register the stylized mark COZI TV for "Television broadcasting services; streaming of television programs, motion pictures and audio-visual material via global computer network and via mobile and wireless communication devices" in International Class 38.

U.S. Registration No. 2531351 is COSI for, in relevant part, "Telecommunications gateway services; telecommunications services, namely personal communication services; providing telecommunications connections to a global computer network; providing multiple user access to a global computer

information network” in International Class 38. U.S. Registration No. 2531351 is owned by Infocrossing, Inc.

U.S. Registration No. 3542030 is COZI for, in relevant part, “providing temporary use of nondownloadable software for task delegation and reporting, managing, viewing, and editing electronic mail messages, SMS messages, and private network and mobile communications network and global computer network communications; providing temporary use of nondownloadable software for use in transmitting, receiving, editing, storing and organizing still images and data and text” in International Class 42.

U.S. Registration No. 3796655 is a design mark with the literal element COZI for “providing temporary use of nondownloadable software for sending, transferring, sharing, collaborating on, managing, viewing and editing electronic mail messages, SMS messages, text messages, reminders and updates over electronic, optical or wireless communications networks; providing temporary use of nondownloadable software for editing, viewing and sharing pictures, still images and text” in International Class 42. U.S. Registration Nos. 3542030 and 3796655 are owned by Cozi, Inc.

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 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.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); TMEP §1207.01(b).

U.S. Registration Nos. 3542030 and 3796655

In the present case, the applied-for mark COZI TV is similar to the mark COZI in U.S. Registration Nos. 3542030 and 3796655 because the first word of each mark is the word COZI. As COZI is the entire wording of the registered marks and the first word of the applied-for mark, COZI will make the first impression on consumers. Consumers are generally more inclined to focus on the first word in any service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *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). The term COZI has no definition in the English language and thus has an equally arbitrary connotation and commercial impression. See *attached evidence from the Collins American English Dictionary*. Consumers will see the word COZI at the beginning of the marks and believe all of these marks emanate from the same source because they all begin with the word COZI.

The applied-for mark also includes the word TV, but applicant disclaimed the word TV as it is descriptive of applicant’s television broadcasting and streaming services. Disclaimed matter that is descriptive of or generic for an applicant’s services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat’l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). As the word TV in the applied-for mark is descriptive, it is less significant in terms of affecting the mark’s commercial impression, and renders the wording COZI the more dominant, source-indicating element of the mark.

Additionally, the mere addition of the term TV to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); TMEP §1207.01(b)(iii). In this case, the addition of the term TV does not obviate a likelihood of confusion because the use of the similar word COZI would confuse consumers. Consumers would see the word COZI at the beginning of the marks and believe that these services emanated from the same source because they would think that COZI TV is merely a variation of the COZI services. As a result, despite the addition of the term TV, there is a likelihood of confusion between the marks because of the use of the identical wording COZI.

The wording of the applied-for mark is stylized and U.S. Registration No. 3796655 also includes a design element at the end of the lettering COZI. The wording is the dominant element of the marks because it is at the beginning of the mark and will be the first element of the mark to make an impression on consumers. For a composite mark containing both words and a design, the word portion may be 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); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). 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)). When consumers request the services they will use the word COZI, which will cause a likelihood of confusion between the marks.

Thus, when looking at the various services identified in the marks, a consumer would be confused as to the source of the services because of the use of the word COZI. Therefore, the marks are confusingly similar.

U.S. Registration No. 2531351

The applied-for mark COZI TV is similar to the mark COSI in U.S. Registration No. 2531351 because the words COZI and COSI are phonetically similar. The first syllable of the words is “ko” while the second syllable is “see.” The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). When consumers request the services, they will use the similar sounding wording COZI and COSI causing confusion between the marks.

Just as above, the descriptive wording TV in the applied-for mark is less significant when comparing the marks. As the word TV is descriptive and the word COZI in the applied-for mark will make the first impression on consumers, the most significant portion of the applied-for mark is the word COZI and likely to cause confusion with the phonetically similar wording COSI in U.S. Registration No. 2531351.

The applied-for mark appears in stylized form while U.S. Registration No. 2531351 appears in standard characters. A mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters generally will not avoid likelihood of confusion with a mark in standard characters because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). As U.S. Registration No. 2531351 could be presented with any stylization including the stylization in the applied-for mark, the stylization of the applied-for mark does not obviate a likelihood of confusion.

Thus, when looking at the telecommunications services identified in the marks, a consumer would be confused as to the source of the services because of the phonetically equivalent wording COZI and COSI. Therefore, the marks are confusingly similar.

Applicant’s Arguments

Applicant argues that the addition of the word TV in the applied-for mark as well as the differences between the words COZI and COSI in U.S. Registration No. 2531351 visually sets the applied-for mark apart from the registered marks. However, 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 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). As discussed above, despite the additional word TV in the applied-for mark or the difference in the lettering of COZI and COSI, the marks have a similar commercial impression because of the use of the identical word COZI or the phonetically similar words COZI and COSI. The overall recollection of the average purchaser would be the dominant element COZI or COSI. As a result, despite the addition of the word TV, a likelihood of confusion exists because of the use of the similar word COZI or COSI.

Applicant argues that the applied-for mark COZI TV has a different commercial impression than the registered marks COZI and COSI because the “use of the element COZI is meant to create a warm and fuzzy feeling among consumers” based on its phonetic similarity to the word “cozy.” Neither the word COZI nor the word COSI have any meaning in English and could be equally interpreted by consumers as a phonetic variation of the word cozy as applicant argues. *See attached evidence*. Contrary to applicant’s argument, the use of the phonetically similar wording COZI and COSI in the marks creates a similar commercial impression of the word cozy.

Applicant argues that the words COZI and COSI in U.S. Registration No. 2531351 are not phonetically similar. As discussed above, the first syllable of the words is “ko” while the second syllable is “see.” Applicant argues that instead the applied-for mark would be pronounced “KO-zee” while the registration would be pronounced “koh-SEE”. However, either first syllable could be pronounced “ko” or “koh” and either second syllable could be pronounced “see” or “zee”. Either mark could be pronounced “ko-zee” or “koh-see.” There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). As the marks could clearly be pronounced the same, they are likely to be confused.

Applicant argues that the words COZI and COSI in U.S. Registration No. 2531351 have different meanings due to their different meanings in foreign languages. However, neither COZI nor COSI have any meaning in English and thus have an equally arbitrary meaning in English in relation to the services. *See attached evidence.* The marks are not confusing because of their similar meaning, but because of their similarity in sound and the similar commercial impression that sound gives in relation to the word cozy. Even those familiar with any foreign meanings of the terms COZI and COSI are likely to be confused because, as discussed above, the marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. For example, when requesting the services consumers will use the similar sounding wording leading to a likelihood of confusion. Despite any difference in meaning in foreign languages, the marks COZI and COSI are similar because they are phonetically equivalent.

Applicant also argues that the commercial impression of the marks is different because the addition of the word TV to the applied-for mark gives the mark a commercial impression of entertainment services while the registered marks have no such impression. As the word TV in the applied-for mark is descriptive, it is less significant in terms of affecting the mark's commercial impression. *See In re Dixie Rests., Inc.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34; *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). As discussed above, despite the additional word TV in the applied-for mark that does not appear in the registered marks, the marks have a similar commercial impression because of the use of the identical word COZI or the phonetically similar words COZI and COSI.

Applicant also argues that the wording COZI and COSI are frequently used by third-parties. Applicant has included improper evidence of third-party registrations, in the form of a list of the registrations. The Trademark Trial and Appeal Board does not take judicial notice of registrations, and the submission of a list of registrations does not make these registrations part of the record. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974); TBMP §1208.02. To make registrations of record, copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from the USPTO's Trademark database) must be submitted. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). Therefore, the examining attorney objects to the improper evidence of a list of third-party registrations. *See* TMEP §710.03.

Applicant has also submitted printouts of two third-party registrations for marks containing the wording COZI and COSI to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* services. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937

F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Furthermore, the services listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the services at issue.

In the request for reconsideration applicant submit three website screenshots of companies who have the word COSI in their business name. The first is for the Center of Science Industry which provides online activities for families and educators. The second is Cosi Consulting which offers business consulting services. The third is Cosi Productions which offers marketing, public relations, and software development services. Applicant argues that these three companies demonstrate the term COSI is weak or diluted for the registrants' services. U.S. Registration Nos. 3542030 and 3796655 do not contain the term COSI and thus this evidence does not show that wording of those registrations is weak or diluted. U.S. Registration No. 2531351 includes the word COSI, but identifies telecommunications services. None of the companies in the cited evidence provides telecommunications services and as a result, this evidence does not establish that that the term COSI is weak or diluted for telecommunication services. As a result, the evidence submitted by applicant does not establish that the wording of the registered marks is weak or diluted.

Thus, when looking at the various services identified in the marks, a consumer would be confused as to the source of the services because of the use of the word COZI or because of the phonetically equivalent wording COZI and COSI. Therefore, the marks are confusingly similar.

Comparison of the Services

The 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 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 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).

U.S. Registration No. 2531351

Applicant’s telecommunications services are related to the telecommunications services in U.S. Registration No. 2531351 because both identify telecommunications services common to telecommunications companies. For example, Verizon Fios, Cox Communications, AT&T U-verse, Time Warner Cable, Charter Communications, Cablevision Optimum, Bright House Networks, Suddenlink Communications, WideOpenWest, and Service Electric Cable TV & Communications provide internet access, television cable services, streaming video services, and broadcasting their own television channels. *See evidence attached to first Office action.* These services are similar to the services offered by applicant, namely, television broadcasting services and streaming of television programs. *See evidence attached to first Office action.* Verizon Fios, Cox Communications, AT&T U-verse, Time Warner Cable, Charter Communications, Cablevision Optimum, Bright House Networks, Suddenlink Communications, WideOpenWest, and Service Electric Cable TV & Communications also offer the connections and access to a global computer network services offered by registrant. *See evidence attached to first Office action.* This evidence establishes that the same entity commonly provides the relevant services and markets the services under the same mark and that the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant’s and registrant’s services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The trademark examining attorney has attached evidence to the record from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the

services listed therein, namely connections and access to a global computer network services and television broadcasting and streaming services, 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).

Thus, when confronted by applicant's services and the services in U.S. Registration No. 2531351, consumers would likely be confused as to the source of the services because applicant and registrant offer similar telecommunication services. Therefore, the services are closely related.

U.S. Registration Nos. 3542030 and 3796655

Applicant's telecommunications services are related to the non-downloadable software in U.S. Registration Nos. 3542030 and 3796655 because companies frequently provide both services in the same channels of trade to the same consumers. Verizon Fios, Cox Communications, AT&T U-verse, Time Warner Cable, Charter Communications, Cablevision Optimum, Bright House Networks, Suddenlink Communications, WideOpenWest, and Service Electric Cable TV & Communications offer temporary use of nondownloadable software for managing email and storing data online similar to the services identified by registrant as well as providing television broadcasting and streaming services identified by applicant. See *evidence attached to first Office action*. This evidence establishes that the same entity commonly provides the relevant services and markets the services under the same mark and the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d at 1202-04; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d at 1268-69.

Additionally, as the marks are highly similar, the lesser the degree of similarity between services of the respective parties is required to support a finding of likelihood of confusion. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). As both marks use the identical word COZI, the lesser the degree of similarity between services of the respective parties is required to support a finding of likelihood of confusion.

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar services as those of both applicant and registrant in this case. This evidence shows that the services

listed therein, namely applicant's telecommunications services and registrant's software services, 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).

Thus, when confronted by applicant's services and the services in U.S. Registration Nos. 3542030 and 3796655, consumers would likely be confused as to the source of the services because the services are commonly provided by the same companies in the same channels of trade. Therefore, the services are closely related.

Applicant's Arguments

Applicant argues that applicant is only using the mark in connection with broadcasting a television channel and targeting consumers of television shows while the registrants are offering telecommunications services for the retail community or software for organizing family life. Specifically, applicant argues that telecommunications companies provide the distribution network to allow customers to receive television while applicant only provides the television content. Applicant also argues that "Due to Applicant's fame, consumers will automatically assume that the mark is entertainment related."

Contrary to applicant's argument, applicant's identification does not identify television content services but instead identifies telecommunications services. Television content related services, television programming services, and all entertainment content services are classified in International Class 41. Applicant has not identified services in International Class 41 but instead has identified services in International Class 38 where the general heading of International Class 38 is telecommunications. The term "telecommunications" is defined as "the science and technology of communication at a distance by transmission of electrical impulses, electromagnetic waves, or optical pulses, as by telephone, radio, television, or computer network." See *attached evidence*. Applicant has identified broadcasting and streaming services in International Class 38. Broadcasting is defined as "to communicate or transmit (a signal, a message, or content, such as audio or video programming) to numerous recipients simultaneously over a communication network." See *attached evidence*. Applicant's identified broadcasting and streaming services are telecommunications services because they are services for the transmission of television programming. Contrary to applicant's argument, applicant has identified telecommunication services and not entertainment services.

As explained in detail above, the services of applicant and the registrants' are similar telecommunications and telecommunications software services because they are services offered in the same trade channels by the same companies. Telecommunications service providers Verizon Fios, Cox Communications, AT&T U-verse, Time Warner Cable, Charter Communications, Cablevision Optimum, Bright House Networks, Suddenlink Communications, WideOpenWest, and Service Electric Cable TV & Communications provide telecommunications services and telecommunications software services similar to those identified by registrants and also television broadcasting and streaming services. *See evidence attached to first Office action.* These companies do not simply provide under-the-ground cable distribution but also offer a host of services including television broadcasting of their own television channels and streaming services. *See evidence attached to first Office action.* Many of these companies are not large conglomerates that have many different subsidiaries offering a variety of services but instead are only telecommunications companies offering the relevant services.

Applicant also asserts that the examining attorney believes that applicant is Comcast. In the first Office action the examining attorney gave no such impression. Applicant is clearly identified as NBCUniversal Media, LLC. When discussing telecommunications services commonly offered by telecommunications companies, the examining attorney referenced Comcast as one example of a telecommunications company who offers services similar to applicant. Comcast and its Xfinity service provide internet access, television cable services, phone service, on demand video services, streaming video services, and broadcasting their own television channels. *See evidence attached to the first Office action.* Companies like applicant, the registrants, Comcast, and the companies discussed above all provide similar telecommunications and software services which is why the services of applicant and registrants are similar for the purposes of likelihood of confusion. Contrary to applicant's argument, the examining attorney does not believe that applicant is Comcast.

Applicant argues that applicant and registrant is targeting different consumers. Specifically, applicant is targeting television viewers while registrant is targeting large and mid-sized businesses. Applicant impermissibly reads limitations and restrictions into the scope of the registration and application that are not present therein. When analyzing an applicant's and registrant's services for similarity and relatedness, that determination is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Neither the application nor the registration limits the services to specific users. Applicant and registrant's identifications are broad enough to target similar consumers for their services which would create a likelihood of confusion between the services.

Applicant also argues the applied-for services and the registered services are used only by knowledgeable consumers. Neither the application nor the registration limits the services to certain sophisticated users and the identifications are broad enough to cover individuals who are not knowledgeable in the field. Even if registrant's or applicant's services are used by knowledgeable consumers, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). The knowledge of the consumers does not obviate a likelihood of confusion.

Applicant argues that the mere fact that two identical marks share related goods and services is not enough to establish a likelihood of confusion. Applicant cites to court cases related to the relationship between food goods and restaurant services and cases related to beauty products, perfume, and restaurant services. None of the cited cases refer to the types of services identified in the current application and do not establish the services at issue are related. Applicant also attached U.S. Registration Nos. 3803563 - GODDESS, 3383068 – SHEER GODDESS, 3330737 – GLOBAL GODDESS, and 3291803 – HEAVENLY GODDESS, each for cosmetics and personal care products. Applicant argues that because these marks co-exist other marks using similar wording can also co-exist. U.S. Registration Nos. 3383068 and 3330737 are both cancelled and thus serve no probative value for applicant's argument. *See* TMEP §1207.01(d)(iv). Two marks using the wording GODDESS for cosmetics goods does not establish that marks using completely unrelated wording for telecommunications services and telecommunications software services may be registered. Even if those marks were somehow related to the marks at issue in this case, 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). As explained in detail above, applicant and registrant provide similar telecommunications and software services and are similar for the purposes of likelihood of confusion.

Finally, applicant alleges that there has been no evidence of actual confusion between the marks during years of concurrent use. This argument is also unavailing. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ

390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984). Actual confusion between the applied-for mark and the registered marks is unnecessary for a likelihood of confusion to exist.

Thus, when confronted by applicant's and registrant's services, consumers would likely be confused as to the source of the services because they are services offered by the same companies. Therefore, the services are closely related.

Since the marks are similar and the services are related, there is a likelihood of confusion as to the source of applicant's services. Therefore, The Section 2(d) Likelihood of Confusion Refusal made final in the Office action dated November 20, 2014 is maintained and continues to be final. See TMEP §§715.03(a)(ii)(B), 715.04(a).

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

ASSISTANCE

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide

additional explanation pertaining to the refusal in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

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