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

Proceeding	91120453
Party	Plaintiff Hearst Communications, Inc. and Hearst Magazines Property, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hearst Communications, Inc.,)
)
 Opposer,)
) Opposition No. 91120453
v.)
)
Charles Browning Wilson,)
)
 Applicant.)

OPPOSER’S TRIAL BRIEF

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DESCRIPTION OF THE RECORD

Pursuant to a stipulated motion between the parties, the Board authorized the submission of trial testimony through declaration testimony and responses to written cross-examination, rather than through deposition transcripts. In accordance with Rule 2.128(b) of the Trademark Rules of Practice and T.B.M.P. § 8.01.03, Opposer Hearst Communications, Inc.¹ provides the following description of the resulting record:

The record includes Opposer’s trial testimony and evidence, consisting of:

Testimony	Date	Record Cite Reference
Opposers’ Notice of Reliance	July 10, 2003	Docket No. 30
Supplement to Opposer’s Notice of Reliance	April 20, 2004	Docket No. 40
First Declaration of Stephen Rodgers	May 18, 2006	Docket No. 52 – First Rodgers Decl.
Part I of Opposers’ Second Notice of Reliance	May 18, 2006	Docket No. 52 – Opposers’ Second Notice
Part II of Opposers’ Second Notice of Reliance	May 18, 2006	Docket 51
Opposers’ Responses and Objections to Applicant’s Written Cross-Examination	September 11, 2006, verified by a submission to the Board on January 11, 2008	Docket No. 74
Verification of Opposers’ Responses and Objections to Applicant’s Written Cross-Examination	January 11, 2008	Docket No. 74 – Verification

Two aspects of Opposers’ trial testimony and evidence may merit clarification. First, after its filing with the Board, Opposers’ Second Notice of Reliance appears to have been divided into two parts. The first part was affixed to the end of the First Declaration of Stephen Rodgers, and the combination of those two documents has been assigned Docket No. 52. Accordingly, to distinguish between them, citations in this brief to the First Declaration of Stephen Rodgers are styled as “Docket No. 52 – First Rod-

¹ The original Notice of Opposition was filed in the names of both Hearst Communications, Inc. and Hearst Magazines Property, Inc. During the pendency of this litigation, however, all relevant marks and registrations owned by Hearst Magazine Property, Inc. were assigned to Hearst Communications, Inc. in a transaction recorded at reel and frame no. 3034/0151. (Docket No. 52 ¶ 2; Docket No. 52 – Opposers’ Second Notice Exs. 1-8.) Accordingly, although the parties’ earlier pleadings frequently refer to “opposers,” Hearst Communications, Inc. remains the sole opposer in interest.

gers Decl.,” while citations to the first part of Opposers’ Second Notice of Reliance are styled as “Docket No. 52 – Opposers’ Second Notice.” The second part of Opposers’ Second Notice of Reliance has been assigned Docket No. 51 and is referred to as such.

Second, two pleadings submitted by Opposer, namely (1) Opposers’ Responses and Objections to Applicant’s Written Cross-Examination and (2) the Verification of Opposers’ Responses and Objections to Applicant’s Written Cross-Examination, have been consolidated and assigned Docket No. 74. To distinguish between them, this brief refers to Opposers’ Responses and Objections to Applicant’s Written Cross-Examination as “Docket No. 74” and to the Verification of Opposers’ Responses and Objections to Applicant’s Written Cross-Examination as “Docket No. 74 – Verification.”

The record also includes Applicant’s trial testimony and evidence, consisting of:

Testimony	Date	Record Cite Reference
Declaration of Charles Browning Wilson	April 5, 2007	Docket No. 62
Applicant’s Notice of Reliance	April 5, 2007	Docket No. 63
Applicant’s Responses and Objections to Opposer’s Written Cross-Examination	July 6, 2007, verified by a submission to the Board on July 7, 2008	Docket No. 79

Finally, the record includes Opposer’s rebuttal testimony and evidence, consisting of:

Testimony	Date	Record Cite Reference
Second Declaration of Stephen Rodgers and exhibits	August 20, 2007	Docket No. 68
Opposers’ Responses to Applicant’s Second Written Cross Examination	December 3, 2007	Docket No. 73

STATEMENT OF THE ISSUES

(1) Whether Applicant’s mark is likely to be confused with the marks making up Opposer’s COSMOPOLITAN and COSMO family of marks; and

(2) Whether Applicant’s mark is likely to dilute the distinctiveness and fame of the marks making up Opposer’s family of COSMOPOLITAN and COSMO marks.

I. INTRODUCTION

Opposer Hearst Communications, Inc. (“HCI”) owns a number of trademarks and service marks based on or incorporating either the word COSMOPOLITAN or its common abbreviation, COSMO. These marks make up one of the most famous and recognizable families of marks in the magazine publishing industry. HCI, its predecessors-in-interest, and its licensees have used the COSMOPOLITAN mark for over 120 years, since 1886. HCI spends over \$16 million annually advertising its family of COSMOPOLITAN and COSMO marks in a variety of media, including print and on the Internet. In addition, HCI has published over half a billion *Cosmopolitan* and *Cosmo Girl!* magazines since 1991 alone. HCI also enjoys widespread use of its COSMO and COSMOPOLITAN marks on its websites, *www.cosmopolitan.com*, *www.cosmomag.com*, and *www.cosmogirl.com*, all of which it has used since before Applicant’s filing date.

Applicant Charles Browning Wilson (“Applicant”) has applied to register the mark COSMO.COM for “providing on-line information on available entertainment in various cities” in Class 41. The evidence and testimony of record – including substantial evidence of pervasive actual confusion produced by Applicant himself – demonstrates that Applicant’s mark is confusingly similar to and likely to dilute the distinctiveness of HCI’s family of COSMOPOLITAN and COSMO marks. HCI is therefore entitled to prevail under 15 U.S.C. §§ 1052(d) and 1125(c), and the Board should sustain this Opposition and deny registration to Applicant’s mark.

II. PROCEDURAL AND FACTUAL BACKGROUND

A. HCI Enjoys Prior Use Of Its COSMOPOLITAN And COSMO Marks For Publications

HCI is a publisher of magazines and other printed materials and a provider of online content. Among its other activities, HCI publishes the *Cosmopolitan* and *Cosmo Girl!* magazines and is the owner of the federally registered COSMOPOLITAN, COSMO GIRL! and COSMO trademarks and service marks. (Docket No. 52 – First Rodgers Decl. ¶ 3.) HCI’s *Cosmopolitan* and *Cosmo Girl!* magazines discuss topics of interest to young women and girls, including shopping, health and beauty care, dating ad-

vice and stories, advice and information on career paths, personal growth, and entertainment news. (*Id.*) *Cosmopolitan* magazine cultivates an image of its readership as “fun, fearless females” between the ages of 18 and 34; *Cosmo Girl!* relies on girls between the ages of 12 and 17, and it uses the slogan “Born to Lead” to describe its readership. (*Id.*)

Cosmopolitan magazine was introduced in 1886, and HCI has submitted documentary evidence of the actual use of the COSMOPOLITAN mark dating back to 1895. (*See generally* Docket No. 30 ¶ C & Tabs 3-11 to Ex. C; Docket No. 52 – First Rodgers Decl. ¶ 4.) As of 2006, *Cosmopolitan* was published in over 25 languages and is sold in more than 41 countries, making it the largest monthly magazine franchise in the world. (Docket No. 52 – First Rodgers Decl. ¶ 4.) *Cosmo Girl!* magazine was introduced in 1999. (*Id.* ¶ 5.) In 2000, it was named “Startup of the Year” by ADWEEK magazine and was named to ADVERTISING AGE’s “A List,” which designated it among the top three magazines of 2003. (*Id.*) In 1998, the year before Applicant filed his application, *Cosmopolitan* magazine had a monthly average circulation in excess of 2,675,000 in the United States alone. (*Id.* ¶ 6.) In 2000, *Cosmo Girl!* had a monthly average circulation of 604,000 in the United States alone. (*Id.*) Since 1991, HCI and its predecessors have circulated in excess of half a billion copies of *Cosmopolitan* and *Cosmo Girl!* magazines. (*Id.*) In addition to revenue generated by sales of *Cosmopolitan* magazine itself, HCI generates revenue through sales of advertising for a wide variety of goods and services, many of which are sold online. (*Id.* ¶ 8; Docket No. 52 – Opposers’ Second Notice Exs. 11-15.)

COSMO often is used as a shorthand reference to *Cosmopolitan* magazine and, indeed, abbreviation of the COSMOPOLITAN mark to COSMO began well prior to the Internet era. (*See generally* Docket No. 74 Resp. No. 5 & Exs. A-C.) As reflected in the cover of the April 1964 *Cosmopolitan* magazine and Contents page, which lists “Cosmo Shopper” as one of the sections in the magazine, HCI itself was using the COSMO mark as a reference to *Cosmopolitan* magazine over three decades before Applicant’s claimed date of first use. (Docket No. 30 ¶ C & Tab 8 to Ex. C; Docket No. 74 Resp. No. 5 & Ex. B.) Copies of *Cosmopolitan* magazine covers and contents pages since 1964 to the present confirm HCI’s continuing and present use of the COSMO mark in this context. (Docket No. 30 ¶ C & Tabs 8-9 to Ex. C;

Docket No. 74 Resp. No. 5 & Exs. A-C.) HCI has also used the COSMO mark in connection with advertising and promoting special events associated with or endorsed by HCI. (*Id.* Resp. Nos. 5, 21 & Ex. F.)

Of equal importance, the public also routinely abbreviates both the COSMOPOLITAN mark and the title of *Cosmopolitan* magazine to COSMO – indeed, the current definition of “Cosmopolitan” found in the online encyclopedia Wikipedia refers to “Cosmo Magazine.” (Docket No. 68 ¶ 9 & Ex. B.) Although HCI has been unable to determine the earliest public reference to COSMO in connection with *Cosmopolitan* magazine, such third-party uses occurred at least as early as 1974 and extend to the present time. These include the uses behind Tabs 12 and 25-75 of Exhibit C to Docket No. 30 and Exhibits 9-15 to Docket No. 52 – Opposers’ Second Notice. Likewise, attached as Exhibit A to Docket No. 52 – First Rodgers Decl. are abstracts of representative examples of third-party articles published in 1974 referring to *Cosmopolitan* magazine as COSMO.² Furthermore, both HCI and the general public often refer to the magazines’ readership as “Cosmo Girls.” (Docket No. 30 ¶ C & Tab 12 to Ex. C; Docket No. 52 – First Rodgers Decl. ¶ 7.) Indeed, the immediate success of *Cosmo Girl!* magazine was in substantial part due to the close association of the term COSMO with *Cosmopolitan* magazine and with HCI. (*Id.*) The public therefore associates the term COSMO with HCI. (*Id.*)

Beginning over a hundred years ago, HCI and its predecessors in interest have expended considerable sums of money into developing consumer brand recognition for their family of COSMOPOLITAN and COSMO marks. (*Id.* ¶ 14.) HCI and its licensees market and promote these marks through extensive advertising. The scope of HCI’s advertising is evidenced in part by its annual advertising budget. In 2005 alone, HCI and its licensees expended in excess of \$16,230,000 promoting the sale of goods and services under HCI’s family of COSMOPOLITAN and COSMO marks. (*Id.*) In 1998, the year before the filing of Applicant’s application, that figure was approximately \$11,540,000. (*Id.*)

The COSMO GIRL mark is the subject of Registration No. 2,527,954 for a “general interest magazine for girls and young women,” which is owned by HCI. The COSMOPOLITAN mark is the sub-

² HCI believes that the materials attached to its notices of reliance are self-authenticating; they are in any case authenticated by the testimony of Stephen Rodgers. (*See* Docket No. 52 ¶ 7.)

ject of Registration No. 630,028, issued for a “magazine or periodical published monthly or at other intervals,” which is also owned by HCI. (*Id.* ¶ 9.)

B. HCI Enjoys Prior Use Of Its COSMOPOLITAN And COSMO Marks On The Internet

As a communications company, HCI is very active on the Internet. (Docket No. 52 – First Rodgers Decl. ¶ 11.) In particular, HCI has continuously operated websites at the addresses *www.cosmopolitan.com* and *www.cosmogirl.com* since 1996 and 1999, respectively. (*Id.*) HCI has submitted documentary evidence from *www.archive.org* showing use of the COSMO mark on Opposer’s *www.cosmomag.com* web site in connection with entertainment-related content at least as early as 1996,³ years before the October 18, 1999 filing date of Applicant’s intent to use application. (Docket No. 74 Resp. No. 5 & Exs. D, E.) The same evidence additionally shows the online use of COSMOPOLITAN, THE COSMO QUIZ, and COSMO ASKS YOU marks for other content appearing on the site. The websites have continuously featured these marks since the websites’ inception. (Docket No. 52 – First Rodgers Decl. ¶ 13.)

Consistent with these online uses from as early as 1996, HCI’s websites currently feature online service mark uses of the COSMO, COSMOPOLITAN, and COSMO GIRL! marks in connection with shopping, shopping sprees, beauty, health, and other areas of interest. (Docket No. 52 – First Rodgers Decl. ¶ 13; Docket No. 74 Resp. No. 5 & Exs. D-E.) These uses include such features styled as CONFESS TO COSMO, COSMO SURVEYS, COSMO EXCLUSIVE, and COSMO FASHION, the first of which also appears in the print edition of HCI’s *Cosmopolitan* magazine. (Docket No. 52 – First Rodgers Decl. ¶ 13; Docket No. 52 – Opposers’ Second Notice Exs. 16-17.) The web sites have continuously used these marks since the web sites’ inception, which was prior to the filing date of Applicant’s application. (Docket No. 52 – First Rodgers Decl. ¶ 13.) HCI’s websites have also featured the following sections,

³ Specifically, these exhibits show the use of THE COSMO INTERVIEW in connection with interviews of actors Christian Slater, “now 31, still single, and starring in a major summer blockbuster, [who] opens up about matters of Hollywood and his heart,” and Jennifer Anniston, whom “TV made . . . rich and famous.”

titles and uses: COSMO QUIZZES, COSMO FAQs, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, FREE STUFF FROM COSMO, COSMO EXCLUSIVES, COSMO FOR YOUR GUY, GET COSMO HEADLINES, CONFESS TO COSMO, MAKE COSMO YOUR HOMEPAGE, TELL COSMO ABOUT YOUR HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSpace, GET COSMO UPDATES, COSMO MOBILE, COSMO RADIO, FREE STUFF FROM COSMO, COSMO PROMO HOT SPOT, COSMO MEDIA KIT, and EVERYTHING COSMO. (Docket No. 74 Resp. No. 5 & Ex. 9; Docket No. 74 – Verification ¶ 3.)

HCI is the owner of two registrations covering computer services: (1) Reg. No. 2518660 of COSMOPOLITAN.COM, issued on December 11, 2001 (with a priority date of January 20, 1999) for “computer services, namely providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network”; and (2) Reg. No. 2407134 of COSMO GIRL!, issued on November 21, 2000 (with a priority date of January 20, 1999), for “providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network.” (Docket No. 52 – Opposers’ Second Notice ¶ A & Tabs 1, 3 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 12.)

C. HCI’s Other COSMOPOLITAN and COSMO Marks and Registrations

In addition to HCI’s registrations for online services, HCI also owns a registration for COSMO GIRL (Reg. No. 2,527,954) for a “general interest magazine for girls and young women,” and COSMOPOLITAN (Reg. No. 630,028) for a “magazine or periodical published monthly or at other intervals.” (Docket No. 52 – First Rodgers Decl. ¶ 9.) HCI also is the owner of the following registrations:

Mark	Goods & Services	Date of Registration
COSMOPOLITAN Reg. No. 1,685,161	Pre-recorded video tapes and video cassettes on the subjects of exercise and beauty in International Class 9	May 5, 1992
COSMOPOLITAN Reg. No. 1,911,389	Books of general interest in International Class 16	August 15, 1995
COSMOPOLITAN Reg. No. 1,855,579	Eye glasses and eye glass frames in International Class 9	September 27, 1994
COSMOPOLITAN Reg. No. 2,235,977	Brushes in International Class 21	March 30, 1999

(*Id.* ¶ 10.) Certified copies of these registrations have been submitted as part of Exhibit A to Opposers' Notice of Reliance. (Docket No. 30 ¶ A & Ex. A.)

Taken together, HCI's COSMOPOLITAN, COSMO, COSMO GIRL, COSMO GIRL!, COSMO QUIZ, COSMO SURVEYS, COSMO EXCLUSIVE, COSMO FASHION, and COSMOPOLITAN.COM marks constitute a family of COSMOPOLITAN and COSMO marks. (*See* Docket No. 52 – First Rodgers Decl. ¶ 15.)

D. Applicant's Use of COSMO.COM for Online Services

Applicant Charles Browning Wilson has been a professional lighting technician for rock and roll tours since 1979. (Docket No. 62 ¶ 2.) According to Applicant, in or around 1984, while working on the Miss USA Pageant, he received "Cosmo" as a nickname. (*Id.* ¶ 3.) In 1986, Applicant requested the crew of another tour refer to him as "Cosmo" to distinguish him from another employee who was also named Charles. (*Id.*) According to Applicant, he is "commonly identified as Cosmo through the concert tour industry ever since 1986." (*Id.*)

In December 1997, Applicant entered into negotiations with a company called "The Domain Dealer" to purchase the cosmo.com domain name. (Docket No. 62 ¶ 7.) On January 8, 1998, Applicant purchased the *cosmo.com* domain name from the Domain Dealer. (*Id.* ¶ 9.) In March 1998, shortly after purchasing the domain name, Applicant launched his website, which includes information about travel and entertainment in various cities in the United States. (Docket No. 79 Resp. Nos. 1, 21.) Since 1998, Applicant has allegedly invested approximately \$200,000 to maintain the website; however, he has not expended any sums whatsoever on advertising or promotion the COSMO.COM mark. (Docket No. 62

¶ 14; Docket No. 79 Resp. No. 37.) Rather, most of the \$200,000 represents “server fees, web developer fees, legal and accounting fees and general advertising and promotion.” (Docket No. 62 ¶ 14.)

Applicant describes his target audience for the website as the “general public, including, but not limited to individuals who enjoy travel and entertainment.” (Docket No. 79 Resp. No. 22.) Applicant’s website provides tour schedules for a variety of bands and various sports teams’ schedules as well. (*Id.* Resp. No. 21.) Applicant offers shopping and dining information for various cities and a section where users can post comments and classified ads for items for sale. (*Id.*) Applicant also provides a link to cnn.com. Since its initial launch, Applicant has begun providing a “Road Diary” under the moniker ON THE ROAD WITH COSMO. (*Id.*; Docket No. 62 ¶ 11; Docket No. 63 Ex. M.) This section of the *cosmo.com* website chronicles Applicant’s experiences and jobs on tour with various bands. (Docket No. 79 Resp. No. 21.)

Since its launch, Applicant has allegedly been receiving approximately 10,000 hits per day. (*Id.* Resp. No. 24.) Applicant also began offering an e-mail service operating with the address, “@cosmo.com,” which currently has approximately 36,000 registered users. (*Id.* Resp. Nos. 3, 21.)

Applicant provides advertising space on his website and receives revenue from advertisers, including Amazon.com for such advertising. (*Id.* Resp. No. 25.) In addition to such advertisements, Applicant also features a section on his website called the “Travel Mall,” on which he offers for sale a variety of goods organized by category, including magazines. (*Id.* Resp. No. 26.) Until 2007, subscriptions to HCI’s *Cosmopolitan*, among other magazines, were available for purchase on *cosmo.com*, and at least one subscription of *Cosmopolitan* was sold on Applicant’s website in 2005. (*Id.* Resp. Nos. 26, 29.)

E. Applicant’s Use Of COSMO.COM Is Causing Rampant Actual Confusion

Within a short period of time after the launch of Applicant’s *Cosmo.com* website, his use of the COSMO.COM mark generated high levels of confusion. Specifically, Applicant produced in discovery numerous e-mails he received that were unmistakably intended for HCI. (Docket No. 30 ¶ E & Ex. E; Docket No. 40 ¶ F & Ex. F.) For example, Applicant’s production included myriad instances of consumers mistakenly complaining to Applicant about delivery of their *Cosmopolitan* magazines:

I have not received my MAY issue of cosmo. This has happened before. I would appreciate a MAY issue sent to me as soon as possible.

(Docket No. 30 Ex. E unnumbered page 63.)⁴

I would like to subscribe to cosmopolitan magazine.would i be able to do that on-line over the computer or only by mail. If it is possible to order on-line what site would I have to go on?

(*Id.* unnumbered page 64.)

Just a small note to whom ever takes care of this sort of thing.
I read my Cosmo faithfully every month, the next issue always hits the shelf about a week before the new month starts, so when I subscribed to Cosmo I thought that is when I would be receiving it. I was wrong. The first month I received it two weeks into the month, so I thought they would start it the next month. I went out and bought one. Well this month I bought one off the shelf on the 10th, and received it in the mail on the 12. If this is the earliest I can get it in the mail then I will just cancel my subscription and buy it earlier. Right now ordering it doesn't seen like I'm saving money at all.

(*Id.* unnumbered page 65.)

I am a Cosmo subscriber and have recently moved. How do I get my magazines mailed to my new address?

(*Id.* unnumbered page 78.)

I would like to know if I can place an order or if you can tell me where I can find the March 2000 edition of cosmo.

(*Id.* unnumbered page 79.)

Dear Cosmo,
I need to change my address with you....
Please let me know when you receive this message.

(*Id.* unnumbered page 80.)

I subscribe to Cosmo and I love it! I do have a shopping questions, though—in the May 2000 issue, you featured these cool rubber band bracelets on page 319, in the Cosmo Weekend section. Where else can I get them? Thank you!

(*Id.* unnumbered page 84.)

I have moved and have not yet received my cosmo magazines. I have received my bill forrwarded to my new address and the bill tells me that cosmo has sent two additions of the magazine. My old address was....

⁴ The misdirected e-mails quoted here were produced by prior counsel for Applicant without page numbers and were then filed by prior counsel for HCI in the same condition.

My new address is.... I wonder if you have not received my magazines back to you? If my bill is forwarded where are magazines?

I seems that i am going to be paying for magazines i am not getting. There was no phone number on my bill for me to contact anyone by phone. So what do i do now?

(Id. unnumbered page 96.)

I just have one question. I will be moving soon and I have a subscription to cosmo. I was just wondering if you had a change of address form or if I'm supposed to give you guys a call. If you would please let me know that would be great. Thank you very much.

Keep up the good work.

(Id. unnumbered page 99.)

I have emailed Cosmo on several occasions, with regard to receiving my issues. I have paid for my issues, but have not received them. I know the new issue is out, and would like to receive it promptly. If there is a problem with sending me my issues, please issue a refund for the monies I have sent to you for the next 12 months.

(Id. unnumbered page 104.)

I have a subscription to Cosmo Magazine. i have not received a magazine since May. Could please send me my magazines.

(Id. unnumbered page 105.)

Dear Cosmo – For Christmas I had a friend purchase a subscription for me. While I was waiting for the subscription to “kick in” I still purchased the current magazine off the rack. When the subscription did “kick in” I received three old issues already received. I continue to be unhappy with the subscription service. When the current issue is out, the subscription copy will arrive 1-2 weeks later. Could you explain these two items to me.

(Id. unnumbered page 110.)

I have a questions, I sent off for 12 months of Cosmopolitan well I am getting them. However I have never got the bill for it! And I need to find out how to change my address with you guys I have put in a change of address with the post office but they will not sent the Cosmopolitan to my new address. If you could please help me with this. My address that I get them to now is....My new address that I would like then sent to is....If you could let me know if you can help or how I can reach someone that can I would be very thinkfull.

(Id. unnumbered page 111.)

Dear sirs, I have a subscription to Cosmopolitan. A couple of months ago I started to receive two issues each month. I don't know why this is happening. Please check your records and correct the problem.

(Id. unnumbered page 117.)

I just got my bill from cosmo from the promotion for the december gift 12 issued for only \$18, but my bill came for \$36, why is this? also I am using my brother in law e-mail to write to your company since there is no phone number to contact you regarding this issue.can you please let me know the information asap,

(Id. unnumbered page 119.)

How do I get ahold of someone at Cosmo to ask about my subscription... I have moved twice in the last year, and I think it's gotten lost. Please advise.

(Id. unnumbered page 128.)

I am 15 years old. I just purchased your Cosmopolitan Virtual Makeover. It didn't let me use the Start a new look, or anything like that. I am wondering what happened. Because so far I am NOT impressed. And if I can't get this to work then I'm telling all my friends not to get your product. Instead I'll go and get YM's makeover. A angry customer

(Id. unnumbered page 130.)

I have subscribed to cosmo hardcopy magazine for about 10 years and have experienced difficulty and problems when i changed addresses. After my last move, I waited until my name was officially changed and my address before renewing my subscription and when i wrote my check, i enclosed a note about my name and address change. I have yet to receive a magazine and i am very disappointed in this continuing problem. I would like to request a refund considering I have not received a magazine yet.

(Id. unnumbered page 136.)

My name is [] and I have a paid subscription to Cosmo. I got the first issue but have not received the issue of July or August. I recently went out and purchased the August issue. I love to read Cosmo. and would like to know what happened to me issues or my subscription.

(Id. unnumbered page 141.)

I am a subscriber to cosmo magazine. I havent received a bill that I can find or a magazine in a month can you please help me get my cosmo back.
Thank you-

(Id. unnumbered page 1.)

To whom it may concern,

Greetings to you and it has being so great reading about all the articles in your magazine (think the best so far).You don't know me and this may be a bit surprise to you cos you don't know me.I am a great fan of this mag and really loves reading it.I am [], 19 years of age and from the kingdom of Tonga here in the pacific..i don't know wheter you have heard of Tonga but i would really love to know more about your magazine co,I am currently a student at the royal school of science here in Tonga and really learnt a lot about life and fashion from your magazine.I would

really want to know more about the cosmo mag .Please let me know and we will be in touch.thank you...

(*Id.* unnumbered page 2.)

To Whom This My Concern,

I am a subscriber to Cosmo Magazine and I received a bill stating that i needed to pay in order to continue receiving my issues. I paid this bill with a money order of eighteen dollars. I am curious if I will be receiving the rest of my issues or not. Please write me back to let me know. Thank you for your time.

(*Id.* unnumbered page 3.)

to all cosmo staff keep u all the good work
stay cool and continue all the creativity work
you've all done.

(*Id.* unnumbered page 4.)

My friend moved and needs to update her new address for her cosmo subscription--how can she do this?

(*Id.* unnumbered page 17.)

Numerous confused customers also mistakenly sent e-mails to Applicant's website inquiring about employment with *Cosmopolitan* magazine as, for example, writers or models:

I would like to say that I find your magazine very informative. I like the stories and I find the latest makeup tips and applications there alone. I would like to know how to submit written material to the magazine for publishing. Please let me know how this is done.

(*Id.* unnumbered page 78.)

I am a photographer and was wondering what the criteria is to become a photojournalist for Cosmo. My E-mail address is []. My home address is as follows....Please send me information. Thank you.

(*Id.* unnumbered pages 22-23.)

My name is [] and I was wondering how to become a model. I'm a male and I'm 18. Could you send me and e-mail on how I could become a model. I live in []. . . .

(*Id.* unnumbered page 33.)

Hi, I was reading your magazine for being a model and it said that for more information go on to www.cosmo.com and I did and I can't seem to find it, Will you be able to help me? Thanks a whole lot.

(*Id.* unnumbered page 46.)

Hello my name is [] and I was wondering if by any chance you were looking for any models for your magazine [sic]? I am 17 years old and I had a two year contract before and I did not do that much work with it!

(Id.)

Applicant's production included numerous misdirected inquiries about products featured or advertised in Cosmopolitan:

Hi there A company that manufactures a product named "Body Sculpturing" states their product was in Cosmo – I would like to know if it was an ad or did Cosmo write a story regarding this product. If there was, in fact, an article written on this product, did anyone with Cosmo test it and what were the results?

(Id. unnumbered page 4.)

Dear Cosmo:
Please enter my name in the Neutrogena Cover Makeup Giveaway per the = February 2000 issue of Cosmo.

(Id. unnumbered page 29.)

Dear Cosmo,
I used to use Lori Davis shampoo and conditioner, as advertised by Cher. I cannot find the products anywhere and have no idea where to even inquire as to what happened to the product line. Any help in this matter would be greatly appreciated! Thanks so much,

(Id. unnumbered page 34.)

I was looking through the March issue, I found an ad that really interested me. It was an ad for the X-Bra by Lily of France on page 77. I would like more information on price and how to order one. If you could send me some information about it I would greatly appreciate it.

(Id. unnumbered page 47.)

In yet another category of misdirected e-mails, members of the general public mistakenly e-mailed Applicant about articles that appeared in COSMOPOLITAN magazine about fashion, beauty, and other topics that could only be meant for a women's magazine:

Regarding the article on women wanting to quit work and stay at home: I quit work after my husband and I were married. I thought I would live the life of leisure, but I quickly grew bored and restless. I went back to work after a year and both my husband and I are much happier that I did! My advice to women that want to quit work to stay at home, find lots of activities to do, as a lot of your friends and family will be at work! I was very lonely and there wasn't much to do or many to talk to! Good luck to any who try it, but prepare yourself to find out it's not as great as it may seem.

(*Id.* unnumbered page 67.)

Hi, last summer I read your article and it had a lot to do with what guys like when they are having sex, and it had a lot about girls pleasuring themselves and I was wondering if you had a copy of that, I know a few examples of what was in it, Please respond.

(*Id.* unnumbered page 77.)

To whom this concerns; Hello, I didn't know what e-mail address to go to with questions like this. I am a 21 year old with saggy breasts. Is this normal for someone my age? What can I do to get them back into shape? Thanks. P.S. Please don't put this in the magazine.

(*Id.* unnumbered page 126.)

awhile ago you had a small article talking about going without wearing nylons in a lot of offices in the summer. you had a statistic for it.
please email me this article. Thanx

(*Id.* unnumbered page 142.)

I have a question about my fiancee's and my sex life can you get me in touch with the writers for the column agony

(*Id.* unnumbered page 1.)

What's up with Reese Witherspoon in the pic of her and Ryan you have on page 43 of your January 2000 issue? It looks nothing like her and she looks so heavy, you would think she would have lost some of her baby weight. Well, keep in touch.

(*Id.* unnumbered page 12.)

I love your magazine, I especially love your quizzes and sex tips.=20

(*Id.* unnumbered page 19.)

I think your site is going great. I hope it keeps building to a even = better one. I love the runway site it's the best!! (fashion angel) I am = a reader of your mags and find that its wonderful to read and I do lots = of shopping. Thank you so much for the hard work=20 you and your employees do!!! I hope you have a Wonderful new year and = may ALL you wishes and resolutions come true. LOVE YOU ALL!!!

(*Id.* unnumbered page 24.)

hey cosmo!!
hi, I'm 13 years old... and my skin is like NEVER oily or dry or anything, but lately i've been like totally breaking out and i need something that will clear my skin up FAST!!! any tips or products? please write back ASAP!! I'm in desperate need!! thank you so much! a response would be greatly appreciated.

(*Id.* unnumbered page 31.)

I really enjoyed the 9 sizzling sex positions article in the February issue. I intend to try all of them with my husband.

(*Id.*, unnumbered page 32.)

I love your mag it rules! I read it all the time! Just thought i would let you know!

(*Id.* unnumbered page 51.)

Hello,

I am writing to you in hopes that you can answer my question. I am a very thin woman that has pretty muscular calves. I would like to start exercising regularly to tone them out but I do not want my calve muscles to become any larger. I used to kickbox for a while but I was unsure if that was just making my legs even bigger. Do you have any suggestions for exercises that would actually tone my legs out making them appear thinner? I really enjoyed kickboxing and I would like to return but I don't need to build up any more muscle in my legs than I already have. Help!!!

(*Id.* unnumbered page 52.)

Several of HCI's readers have mistakenly e-mailed Applicant sharing personal experiences and stories relating to very serious women's health and safety issues, such as sexually transmitted diseases, sexual assault, and rape:

Hi Cosmo, I've been reading your mag. for 4 straight years never missing 1 single issue. I love your magazine very much and I have used alot of your tips, and read all your articles etc....I only have 1 complaint (if you could callit that) I would like to be a part of your staticits. I would love to answer questions and tell you the wildest stunt I ever pulled to get a man etc.... Also, I have a few stories' I'd like to tell about myself. I'm a victim of childhood molestation, by a family member. I'd like to tell my story about how I over came it and how I stiiil deal with it. Please e-mail me back so I will be sure you recieved this.

(*Id.* unnumbered page 15.)

This is in response to your question--"Do sexy clothes increase the risk of rape?" (I knowing the wording is not exact, but I don't have the magazine here with me.)

How can you even ask this question? Men rape for power not sexual satisfaction. What Chloe (the dancer) said is true. Rapists do target someone who is vulnerable, but clothing has nothing to do with it. The woman in the jeans and sweater may be walking with her head down and her shoulders slumped and the woman in the miniskirt may be walking like she owns the world. The rapist will almost always go for the woman who looks like she'll put up less of a fight, the woman he'll be able to overpower--in this case the woman in the jeans and sweater who appears to have very little confidence.

Studies have been done, rapists have been interviewed and the conclusion is that rape has much less to do with sexual hunger than it does with the hunger for power.

Please tell your readers that they shouldn't have to hide behind their clothes to avoid rape. This doesn't mean that women should throw caution to the wind by ignoring safety precautions such as not walking alone at night. But it does mean that women should be able to wear that tight black dress without worrying that they're inviting rape.

(*Id.* unnumbered page 58.)

I believe that I saw a column in your mag about itchy mole like bumps on your lips down there but I can't exactly remember what they were. See I have one and I showed it to my dr. and they had no idea of what it was. Please tell me what it might be so that I can tell them. Thank you! email me back if possible!

(*Id.* unnumbered page 145.)

This extensive record of consumer confusion comes from a variety of settings and circumstances. These e-mails consist of numerous misdirected inquiries from regular *Cosmopolitan* and *Cosmo Girl!* subscribers and readers and demonstrate the widespread actual consumer confusion in the marketplace that is the basis for HCI's opposition. (Docket No. 30 ¶ E & Ex. E; Docket No. 40 ¶ F & Ex. F.)

III. ARGUMENT

A. HCI's Priority Of Rights Is Not In Dispute

As a threshold matter, priority of use is not at issue in this case. The filing date of Applicant's intent-to-use application to register the COSMO.COM mark is October 18, 1999, and Applicant has not alleged an earlier date of first use. In contrast:

- (1) HCI has used the COSMOPOLITAN.COM mark for online services since 1996 and, on January 20, 1999, filed the application that became Reg. No. 2518660 of that mark (Docket No. 30 ¶ A & Tab 3 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 11);
- (2) HCI has used the COSMO GIRL! mark for online services since June 29, 1999 and, on January 20, 1999, filed the application that became Reg. No. 2407134 of that mark (Docket No. 30 ¶ A & Tab 8 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 11);
- (3) HCI has used the COSMO and COSMOPOLITAN marks for online services, including the provision of entertainment-related content, since 1996 at its *www.cosmomag.com* website (Docket No. 74 Resp. No. 5 & Ex. E);

- (4) HCI has used the COSMOPOLITAN mark for hard-copy magazines since 1886 and, on October 10, 1955, filed the application that became Reg. No. 630028 of that mark (Docket No. 30 ¶ A & Tab 30 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 9);
- (5) HCI has used the COSMO GIRL mark for hard-copy magazines since June 29, 1999 and filed the application that became Reg. No. 2527954 of that mark on January 20, 1999 (Docket No. 30 ¶ A & Tab 7 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 9);
- (6) HCI has abbreviated its COSMOPOLITAN mark and *Cosmopolitan* magazine title to COSMO since at least as early as 1964 (Docket No. 74 Resp. No. 5 & Exs. B & C);
- (7) HCI has used the COSMOPOLITAN mark in connection with pre-recorded videotapes since at least as early as 1988 and, on July 3, 1991, filed the application that became Reg. No. 1685161 of that mark (Docket No. 30 ¶ A & Tab 26 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 10);
- (8) HCI has been using the COSMOPOLITAN mark for books of general interest since at least as early as 1994 and, on August 31, 1994, filed the application that became Reg. 1911389 of that mark (Docket No. 30 ¶ A & Tab 22 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 10);
- (9) HCI has been using the COSMOPOLITAN mark for eye glasses and eye glass frames since at least as early as 1988 and, on August 16, 1993, filed the application that became Reg. No. 1855579 of that mark (Docket No. 30 ¶ A & Tab 31 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 10); and
- (10) HCI has been using the COSMOPOLITAN mark for hair brushes since at least as early as 1998 and, on January 31, 1995, filed the application that became Reg. No. 2235977 of that mark. (Docket No. 30 ¶ A & Tab 21 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 10.)

B. The Distinctiveness Of HCI's Marks Is Not In Dispute

There is no dispute that HCI's family of COSMOPOLITAN and COSMO marks are inherently distinctive, as they immediately identify HCI as the source of goods and services offered under these marks. *See Two Pesos, Inc. v. Taco Cabana Int'l, Inc.*, 505 U.S. 763 (1992); *see also* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:4 (4th ed. 2008). HCI's numerous federal registrations of its marks further demonstrates that the marks are presumptively strong and entitled to an expansive scope of protection. *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986) (“[R]egistered trademarks are presumed to be distinctive and should be afforded the utmost protection.”). In fact, several of those trademark registrations have become “incontestable” under 15 U.S.C. § 1115(b), and are thus “conclusive evidence” of HCI's ownership of the COSMOPOLITAN and COSMO marks as well as the mark's validity. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 192 (1985).

As explained in further detail below, HCI's marks are not only inherently strong, but have increased in strength due to its extensive use and promotion of the marks, and sales of goods and services under the marks for over a century, thereby developing a family of COSMOPOLITAN and COSMO Marks, entitled to a broad scope of protection. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464 (Fed. Cir. 1991).

C. Confusion Is Actual And Ongoing And Is Therefore Likely

Applicant's mark is not entitled to registration because actual confusion is pervasive in the marketplace, which removes the need to rely solely on the likelihood of confusion inquiry. Evidence of actual confusion is “highly probative, if not conclusive, of a high likelihood of confusion.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003). Nevertheless, examining the multi-factor likelihood of confusion test further confirms that Applicant's COSMO.COM mark is actually causing, and likely to cause further confusion with HCI's family of COSMOPOLITAN and COSMO Marks.

The issue of likelihood of confusion is governed by the factors described by *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973):

the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark). (10) The market interface between applicant and the owner of a prior mark (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether *de minimis* or substantial. (13) Any other established fact probative of the effect of use.

Id. at 1361. To prevail, HCI need not prove that all, or even most, of these factors favor a likelihood of confusion. *See id.* at 1362. The Board need only consider those factors for which the parties present evidence and “may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001). All factors on which there is record evidence favor HCI’s position.

1. The Use Of Applicant’s Mark Has Caused Significant Actual Confusion

Any discussion of the *likelihood* of confusion in this case is academic: Confusion here is *actual and ongoing*. HCI’s showing in this case consists in part of numerous misdirected e-mails – produced by Applicant himself and the authenticity of which is undisputed – demonstrating that consumers and subscribers of HCI’s magazines routinely contact Applicant under the mistaken impression that that they are contacting HCI. (*See generally* Docket No. 30 ¶ E & Ex. E; Docket No. 40 ¶ F & Ex. F.) Many of these e-mails were sent by HCI’s regular customers regarding their subscriptions to *Cosmopolitan* and/or *Cosmo Girl* magazines. (*See id.*) Applicant also received inquiries from fans of HCI’s magazines, either looking for products featured in *Cosmopolitan* or *Cosmo Girl!* or seeking employment opportunities from HCI as a model, photographer or writer. In other instances, confused readers shared stories or asked questions relating to topics that were very clearly meant for HCI. In many cases, these e-mails discussed personal women’s issues that could only be intended for *Cosmopolitan* or *Cosmo Girl!*. (*See id.*)

A showing of actual confusion is not necessary to a finding that confusion is likely. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983). Where it exists, however,

[t]here can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion. Moreover, reason tells us that while very little proof of actual confusion would be necessary to prove the likelihood of confusion, an almost overwhelming amount of proof would be necessary to refute such proof.

World Carpets, Inc. v. Dick Littrell's New World Carpets, 438 F.2d 482, 489 (5th Cir. 1971); *see also Morningside Group, Ltd. v. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 141 (2d Cir. 1999) (“[E]vidence that confusion has actually occurred is of course convincing evidence that confusion is likely to occur.”). Because of the highly probative nature of actual confusion, courts therefore have routinely upheld liability *as a matter of law* based on as few as two or four such instances. *See, e.g., Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1162 (11th Cir. 1982); *Roto-Rooter Corp. v. O'Neal*, 513 F.2d 44, 45 (5th Cir. 1975). Indeed, the Board previously has held that, because such evidence is so difficult to adduce, even a single instance of actual confusion is “illustrative of situation showing how and why confusion is likely.” *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. 469, 471 (T.T.A.B. 1975); *see also Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 832 n.17 (11th Cir. 1982) (finding one instance of actual confusion probative of liability); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 978 (11th Cir. 1983) (two instances); *Jellibears, Inc. v. Skating Clubs of Ga., Inc.*, 716 F.2d 833, 843-44 (11th Cir. 1983) (three instances); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1544 (11th Cir. 1986) (four instances); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1340 (2d Cir. 1975) (five instances).

Here, Applicant received over 50 misdirected e-mails from members of the public seeking to contact HCI. There is no dispute about the probative value of HCI's actual confusion evidence. As shown by the numerous e-mails mistakenly sent to Applicant instead of HCI, “[a] customer who is unsure about a company's domain name will often guess that the domain name is also the company's name.” *Cardservice Int'l, Inc. v. McGee*, 905 F. Supp. 737, 741 (E.D. Va.) (holding CARDSERVICE.COM was likely to be confused with CARD SERVICE, both on the Internet), *aff'd*, 129 F.3d 1258 (4th Cir. 1997). Thus,

misdirected inquiries are often considered “evidence of the most potent kind.” *Rockland Mort. Corp. v. Shareholders Funding, Inc.*, 835 F. Supp. 182, 198 (D. Del. 1993). They are common signs of public confusion as to the source of a trademark and probative evidence of actual confusion. *See, e.g., Int’l Kennel Club, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1090-91 (7th Cir. 1988); *Mustang Motels, Inc. v. Patel*, 226 U.S.P.Q. 526, 527 & n.1 (C.D. Cal. 1985).

The potential for confusion is even greater in light of the ubiquitous nature of the Internet and HCI’s prior presence on it. Applicant could expand his online business beyond the Internet to the brick-and-mortar context and offer a print publication. Even if Applicant does not actually do so, such an expansion would be a logical one expected by consumers. *See McDonald’s Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, 1899 (T.T.A.B. 1990) (“[A] trademark owner possess rights in its marks which are sufficient to preclude the subsequent registration of the same or a confusingly similar mark not only for like or similar goods, but for any goods which might be reasonably expected to emanate from it in the normal expansion of business under the mark.”); *Tiffany & Co. v. Parfums Lamborghini*, 214 U.S.P.Q. 77, 79 (S.D.N.Y. 1981) (finding that confusion is likely even without the present intention of TIFFANY jewelers to expand into perfume, because such entry is “a legitimate and logical expansion”). Given the actual confusion that has already occurred and the high probability that more consumer confusion will result from Applicant’s registration, this factor should be conclusive in the Board’s inquiry and in any event weigh heavily in HCI’s favor.

2. HCI’s Marks Are Strong And Deserve The Highest Degree Of Protection

Confusion is likely because HCI’s marks are strong, and therefore entitled to a broad scope of protection. As explained above, HCI’s family of COSMOPOLITAN and COSMO marks is inherently distinctive, and therefore, subject to the strongest available protection. The strength and fame of HCI’s marks also derive from:

- incontestable federal trademark registrations;
- over 100 years of extensive use, promotion, and sales, indicating the marks’ commercial strength; and

- public recognition of a family of COSMOPOLITAN and COSMO marks.

As a result, the fifth, ninth, and eleventh *du Pont* factors suggest that the stronger the mark, the greater the scope of protection it will get. *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 352 (Fed. Cir. 1992) (“[S]trong marks enjoy a wide latitude of legal protection.”); *Frehling Enters. v. Int’l Select Group, Inc.*, 192 F.3d 1330, 1335 (11th Cir. 1999) (reversing judgment for defendant and holding that plaintiff established likelihood of confusion between marks).

a) HCI’s Broad Protection Extends To The Context In Which Applicant’s Mark Is Used

HCI’s marks are entitled to broad protection against the use of similar and, in particular, nearly-identical terms and designs. Indeed, the Federal Circuit has recognized that “[a] strong mark...casts a long shadow which competitors must avoid.” *Kenner Parker Toys*, 963 F.2d at 353 (finding a likelihood of confusion between PLAY-DOH and FUN DOUGH given the marks’ similarity in appearance, sound, and meaning). HCI’s rights certainly extend to Applicant’s use of a mark that incorporates COSMO as the first and prominent term. Not only is the “COSMO” portion of Applicant’s mark *identical* to HCI’s COSMO mark for services that are closely-related, but at a minimum, the marks are used for services that consumers very likely would attribute to or associate with HCI. *See, e.g. Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 U.S.P.Q.2d 1835, 1843 (T.T.A.B. 1989) (finding CLASSIC TIFFANY for automobiles confusingly similar to TIFFANY for jewelry, silver, and similar items); *R. J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 U.S.P.Q. 856, 860 (T.T.A.B. 1978) (holding SIR WINSTON & Design for tea likely to cause confusion with WINSTON for cigarettes).

b) In Addition To Being Inherently Strong, HCI’s Marks Have Acquired Distinctiveness

Because trademark rights are not static, widespread use and promotion serve to strengthen an already strong mark by solidifying consumer recognition of the trademark owner as the source of the goods or services offered under the mark. *See E. Remy Martin & Co., S.A. v. Shaw-Ross Int’l Imports, Inc.*, 756 F.2d 1525, 1533 (11th Cir. 1985) (citing “extensive promotion” as evidence of the mark’s strength).

The commercial strength of HCI's marks is indisputable. Successful advertising and promotional efforts have created strong recognition in HCI's marks among the relevant public. *See, e.g., President & Trustees of Colby Coll. v. Colby Coll-N.H.*, 508 F.2d 804, 808 (1st Cir. 1975) ("While secondary meaning is shown by the success rather than by the mere fact of an enterprise's promotional efforts, the normal consequence of substantial publicity may be inferred."). HCI has advertised in a variety of media and expended substantial sums promoting its *Cosmopolitan* and *Cosmo Girl!* publications and licensed goods, which further demonstrates the commercial strength of its COSMOPOLITAN and COSMO Marks. HCI spends significant sums each year promoting its goods and services. For example, in 2005 alone, HCI and its licensees spent over \$16 million advertising the sale of goods and services under the COSMOPOLITAN and COSMO family of marks. (Docket No. 52 – First Rodgers Decl. ¶ 14.) In 1998, the year before the filing of Applicant's application, that figure was still in excess of \$11.5 million. (*Id.*)

HCI's COSMOPOLITAN and COSMO goods and services have been advertised in its own *Cosmopolitan* and *Cosmo Girl!* magazines, both of which have an impressive national monthly distribution. HCI's circulation figures for its magazines and sales of other licensed goods sold under the COSMOPOLITAN and COSMO Marks further reinforce and increase the strength of the marks. *See Bose Corp.*, 293 F.3d 1367 (Fed. Cir. 2002) (finding sales numbers to be an indicia of fame); *see also Kenner Parker Toys*, 963 F.2d at 351 (\$30 million of PLAY-DOH sales in 1988, \$2 million in advertising expenditures that year); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675 (Fed. Cir. 1984) (\$12 million of sales of SPICE ISLAND products over 24 years, and several millions of dollars of advertising expenditures). For example, since 1991, HCI and its predecessors have circulated almost half a billion copies of its "Cosmo" publications. In 1998, the year before Applicant filed his application, *Cosmopolitan* had a monthly readership of 2,675,000; *Cosmo Girl!* had a monthly average circulation in 2000 of approximately 604,000 in the United States. More recent circulation figures for both magazines in the United States are as follows:

Cosmopolitan

Cosmo Girl!

Six Month Period	Circulation Figures
January-June 2000	2,709,496
July-December 2000	2,592,887
January-June 2001	2,642,886
July-December 2001	2,759,448
January-June 2002	2,963,351
July-December 2002	3,021,720
January-June 2003	2,925,028
July-December 2003	2,918,062
January-June 2004	2,996,093
July-December 2004	2,982,508

Six Month Period	Circulation Figures
January-June 2000	608,329
July-December 2000	601,531
January-June 2001	790,124
July-December 2001	838,964
January-June 2002	1,054,638
July-December 2002	1,069,904
January-June 2003	1,176,200
July-December 2003	1,238,325
January-June 2004	1,365,735
July-December 2004	1,380,320
January – June 2005	1,395,827

(Docket No. 30 Tabs 13-24 to Ex. C; Docket No. 51 Exs. 18-26.)

HCI also promotes its marks and the goods and services offered under those marks on its web sites at *www.cosmopolitan.com*, *www.cosmomag.com*, and *www.cosmogirl.com*. HCI’s extensive advertising activity provides undisputed evidence of the strength and widespread fame of the COSMOPOLITAN and COSMO Marks. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (“[W]e have consistently accepted statistics of sales and advertising as indicia of fame: when the numbers are large, we have tended to accept them without any further supporting proof.”).

c) HCI’s COSMO And COSMOPOLITAN Marks Have Been Promoted And Are Recognized By The Public As A Family Of Marks

HCI’s COSMOPOLITAN and COSMO marks have been consistently used, advertised, and promoted in connection with a variety of goods and services for over a century. (Docket No. 30 ¶ C & Tabs 3-11 to Ex. C.) As a result, HCI has established a family of marks, which further demonstrates that HCI’s marks are distinctive and entitled to a broad scope of protection. *See J&J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 1464 (Fed. Cir. 1991) (“[P]reference is accorded the prior user of a mark or family of marks, as against a newcomer.”).

To establish a family of marks, the trademark owner need not necessarily own a trademark in the common formative itself (although this is the case with respect to HCI’s COSMO Marks); instead, it must

show the common element is used in a consistent pattern such that the purchasing public recognizes the origin of the family. *See id.* at 1463. The undisputed evidence shows that HCI's COSMOPOLITAN and COSMO Marks have attained this public recognition, and thus constitute a family of marks under the relevant doctrinal test:

- (1) the marks containing the claimed “family” feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the family feature; . . . and
- (2) that the “family” feature is distinctive, (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark).

Marion Labs. Inc. v. Biochemical/Diagnostics Inc., 6 U.S.P.Q.2d 1215, 1218-19 (T.T.A.B. 1988) (finding TOXI-PREP mark confusingly similar to opposer's family of TOXI marks).

HCI's marks have been widely promoted, and include common elements that are recognized as family features, satisfying the first prong of the *Marion Labs* test.⁵ To begin with, the number of COSMO and COSMOPOLITAN marks HCI uses is more than sufficient to establish a family of marks. *See AMF, Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1404 (C.C.P.A. 1973) (four related marks sufficient to support finding of family). In addition to HCI's registered marks for COSMOPOLITAN, COSMO GIRL, and COSMOPOLITAN.COM, HCI also uses the following unregistered marks that contain the term COSMO, both in its print magazines and online: COSMO QUIZ, COSMO SURVEYS, CONFESS TO COSMO, COSMO EXCLUSIVE, and COSMO FASHION. (Docket No. 52 – First Rodgers Decl. ¶¶ 13-14). HCI's web site associated with the domain, *www.cosmopolitan.com*, demonstrates additional use of the COSMO mark, including in connection with the following sections and titles: COSMO QUIZ, COSMO QUIZZES, COSMO FAQs, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, FREE STUFF FROM COSMO, COSMO EXCLUSIVES, COSMO FOR

⁵ In *Marion Labs*, the Board found that the opposer used and promoted the prefix TOXI- in such a manner as to create an association of common origin based on the “family feature.” *Id.* at 219. It came to this conclusion based on (1) approximately ten years of use of the prefix as a component of the opposer's marks; (2) widely distributed brochures and price lists that advertised several of the marks together; (3) testimony by a single witness that the trade identified the prefix with the opposer; and (4) the fact that all the goods on which the opposer used the marks were related to the same field—drug detection. *Id.*

YOUR GUY, GET COSMO HEADLINES, CONFESS TO COSMO, MAKE COSMO YOUR HOME-PAGE, TELL COSMO ABOUT YOUR HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSPACE, GET COSMO UPDATES, COSMO MOBILE, COSMO RADIO, FREE STUFF FROM COSMO, COSMO PROMO HOT SPOT, COSMO MEDIA KIT, and EVERYTHING COSMO. (Docket No. 68 ¶ 5; Docket No. 74 Resp. No. 5.)

Each of HCI's marks includes the word COSMO as its common "family" feature. (Docket No. 52 – First Rodgers Decl. ¶¶ 10, 13-14; Docket No. 68 ¶¶ 5, 7.) There is no dispute that through its predecessors and licensees, HCI has been using this common feature in its marks for over 100 years, including in connection with billions of magazines that predate any claim of priority that Applicant might make. Based on this widespread use and advertising, consumers have come to identify the COSMO feature with HCI. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464 (Fed. Cir. 1991 (“[P]reference is accorded the prior user of a mark or family of marks, as against a newcomer. The newcomer has the clear opportunity, if not the obligation, to avoid confusion with well-known marks of others.”); *see also Hans Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333 (Fed. Cir. 2001) (affirming finding of likely confusion between family of TRES- marks and TREVIVE NUTRIENTS FOR THE LIFE OF YOUR HAIR). Having satisfied the two prongs of *Marion Labs*, it is undisputed that HCI owns a family of COSMO and COSMOPOLITAN Marks entitled to broad protection.⁶

HCI's family of COSMOPOLITAN and COSMO Marks therefore are not only inherently strong but have increased in strength due to HCI's extensive use and promotion of the marks, and sales of goods and services under the marks. As a result, the fifth, ninth, and eleventh *du Pont* factors weigh heavily in favor of HCI.

⁶ Of course, even if HCI does not have a "family" of marks, Applicant's mark still is confusingly similar to most, if not all, of HCI's individual COSMO and COSMOPOLITAN Marks.

3. The Parties' Marks Are Closely Similar

a) The Parties' COSMOPOLITAN.COM And COSMO.COM Marks Are Virtually Identical

Even without addressing the likelihood of confusion between Applicant's mark and HCI's other marks, there can be no material dispute that HCI's COSMOPOLITAN.COM and Applicant's COSMO.COM marks are virtually identical in appearance, meaning, and connotation. HCI has adduced compelling evidence that members of the public view COSMOPOLITAN and COSMO as synonymous. (*See generally* Docket No. 52 – First Rodgers Decl. ¶ 7; Docket No. 68 ¶ 8 & Ex. B; Docket No. 30 ¶ C & Tabs 25-75 to Ex. C; Docket No. 52 – Opposers' Second Notice Exs. 9-15.) The Board therefore “need only compare the two symbols . . . and to mentally juxtapose the two word marks as they appear in print to . . . find that confusion is not only likely, but probable.” *Nat'l Ass'n of Blue Shield Plans v. United Bankers Life Ins. Co.*, 362 F.2d 374, 378 (5th Cir. 1966); *see also Maine Sav. Bank v. First Bank Group*, 220 U.S.P.Q. 736 (T.T.A.B. 1983) (finding likelihood of confusion on basis of similarity between dominant elements of marks); *In re Energy Images, Inc.*, 227 U.S.P.Q. 572 (T.T.A.B. 1985) (SMARTSCAN confusingly similar to SMART); *Hercules, Inc. v. Nat'l Starch & Chem. Corp.*, 223 U.S.P.Q. 1244, 1246 (T.T.A.B. 1984) (NATROL confusingly similar to NATROSOL); *Giant Food, Inc. v. Rosso & Mastracco, Inc.*, 218 U.S.P.Q. 521 (T.T.A.B. 1982) (finding likelihood of confusion between GIANT and GIANT OPEN AIR MARKET), *aff'd*, 720 F.2d 1263 (Fed. Cir. 1983).

b) The Presence Of “.COM” In Applicant's Mark Does Not Differentiate It From HCI's Other Marks

Confusion is likely because Applicant seeks to register a mark that captures a phonetically, visually, and conceptually similar form of HCI's remaining COSMO and COSMOPOLITAN marks. A junior user need not adopt a mark identical to that of a senior user to support a finding of likely confusion. *See, e.g., Fisons Horticulture, Inc. v. Vigoro Indus.*, 30 F.3d 466, 477 (3d Cir. 1994) (“[T]rademark infringement does not require exact copying of the trademark [M]arks need not be identical, only confusingly similar.”); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 296 (D.N.J.) *aff'd without opinion*, 159 F.3d 1351 (3d Cir. 1998) (“In order to constitute infringement, exact similarities are not required between the

allegedly confusing marks.”). As the Board has explained, “it is a fundamental tenant of our trademark law that exact similitude is not required to conclude that two marks are confusingly similar.” *Hercules, Inc.*, 223 U.S.P.Q. at 1246. “In adjudging a likelihood of confusion between a mark containing a domain name and conflicting mark, it is proper to give the top level domain [“TLD”] portion of the mark little weight because it is merely a generic indicator.” 2 MCCARTHY, *supra*, § 7:17.50. The Trademark Manual of Examining Procedure confirms that the examining attorney “generally should accord little weight to the TLD portion of the mark.” T.M.E.P. § 1215.09. For example, in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999), the Ninth Circuit found a likelihood of confusion between MOVIEBUFF and MOVIEBUFF.COM. The court explained:

Because many companies use domain names comprised of “.com” as the top-level domain with their corporate name or trademark as the second-level domain, the addition of “.com” is of diminished importance in distinguishing the mark. The irrelevance of the “.com” becomes further apparent once we consider similarity in meaning. The domain name is more than a mere address: like trademarks, second-level domain names communicate information as to source.... [M]any Web users are likely to associate “moviebuff.com” with the trademark “MovieBuff,” thinking that it is operated by the company that makes “MovieBuff” products and services.

Id. at 1055 (citations omitted). Numerous other courts and the Board, have found marks to be identical where a “.COM” suffix is the only distinguishing element. *See, e.g., Pub. Serv. Co. v. Nexus Energy Software, Inc.*, 36 F. Supp. 2d 436 (D. Mass. 1999) (ENERGYPLACE.COM essentially identical to ENERGYPLACE.COM); *Minn. Mining & Mfg. Co. v. Taylor*, 21 F. Supp. 2d 1003, 1005 (D. Minn. 1998) (POST-IT.COM essentially identical to POST-IT); *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 983 F. Supp. 1331, 1335 (D. Or. 1997) (“In the context of Internet use, [EPIX.COM] is the same mark as [EPIX.]”); *Planned Parenthood Fed. of Am. v. Bucci*, No. 97-0629 (KMW), 1997 WL 133313, at *8 (S.D.N.Y. Mar. 24, 1997) (PLANNEDPARENTHOOD.COM virtually identical to PLANNED PARENTHOOD), *aff’d*, 152 F.3d 920 (2d Cir. 1998). It follows that Applicant’s COSMO.COM mark is “essentially identical” to HCI’s COSMO and COSMOPOLITAN Marks because the “.COM” portion of Applicant’s mark has “no source-identifying significance and cannot serve any trademark purpose.” 2 MCCARTHY, *supra*, § 7:17.50.

In any case, even if the “.com” appended to Applicant’s mark were taken into consideration, the remaining dominant component of both parties’ marks is either COSMO or COSMOPOLITAN. As in *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369 (Fed. Cir. 2005), “[t]he presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar, especially in light of the largely . . . non-source identifying significance of the word[s]” following it. *Id.* at 1372-73 (internal punctuation omitted); *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (finding that it is the first part of a mark that is most likely to be impressed upon the mind of a purchaser and remembered).

“[T]he greater the similarity . . . of the trademarks, the greater the likelihood of confusion.” *Exxon Corp. v. Texas Motor Exch.*, 628 F.2d 500, 505 (5th Cir. 1980). Applicant’s mark incorporates HCI’s COSMO mark *in its entirety*. Applicant’s mark is also substantially identical to HCI’s COSMOPOLITAN, COSMO GIRL, COSMO GIRL!, COSMO QUIZ, COSMO SURVEYS, COSMO EXCLUSIVE, COSMO FASHION, and COSMOPOLITAN.COM marks. In light of the already existing widespread consumer confusion, there is no debating that the parties’ marks are confusingly similar in appearance, sound, connotation, and commercial impression, and as a result, this factor strongly favors HCI. Under these circumstances, “the [trier of fact], by inspection of the trademarks, may himself determine, and must determine, the likelihood of confusion,” a finding of likely confusion is appropriate on the existing record. *Beef/Eater Restaurants, Inc. v. James Burrough, Ltd.*, 398 F.2d 637, 639 (5th Cir. 1968).

4. Applicant’s Services Are Confusingly Similar To Goods And Services Offered By HCI

Confusion is likely because the parties offer identical or closely-related goods under their marks. Specifically, two of HCI’s incontestable registrations of COSMOPOLITAN.COM and COSMO GIRL! (Reg. Nos. 2,518,660 and 2,407,134, respectively) cover “providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of . . . *entertainment news*.” (Docket No. 30 ¶ A & Tabs 3, 8 to Ex. A; Docket No. 52 – First Rodgers Decl. ¶ 12 (emphasis added).) HCI also has been using the COSMO, COSMOPOLITAN, and THE COSMO IN-

TERVIEW marks in connection with the provision of online entertainment-related content on its *www.cosmomag.com* website since 1996. (Docket No. 74 Resp. No. 5 & Ex. E.) Applicant's application in turn covers "providing on-line information on available *entertainment* in various cities" (emphasis added).

The parties' respective goods and services need not be identical to support a finding of a likelihood of confusion. *Hercules*, 223 U.S.P.Q. at 1247. Rather, a likelihood of confusion may exist if the goods and services bear some relationship to another and could be encountered by the same persons in a manner or under circumstances suggesting a common source. *See Luzier, Inc. v. Maryln Chem. Co.*, 442 F.2d 973, 975 (C.C.P.A. 1971) (finding a likelihood of confusion between LUMAR for "powdered fabric softener" and LUMAR for "massage cream"); *Freedom Sav. & Loan Ass'n v. Fid. Bankers Life Ins. Co.*, 224 U.S.P.Q. 300, 304 (T.T.A.B. 1984) ("[I]t is not necessary as a matter of trademark law that goods or services be competitive or be sold together or through the same outlets if they can be shown to be related in some manner that would suggest to persons encountering them, even at different locations, sources, or offices, a likelihood of common sponsorship.") (finding likelihood of confusion between FREEDOM for insurance underwriting skills and FREEDOM for savings and loan association services, FREEDOM MORTGAGE for mortgage loan services, FREEDOM ACCOUNT for banking services, and FREEDOM CARD for banking services).

The key inquiry is whether the parties' goods and services are "related in some manner" such that they would give rise to the "mistaken belief that they originate from or are in some way associated with the same producer or provider." *In re Azteca Rest. Enters.*, 50 U.S.Q.P.2d 1209, 1210-11 (T.T.A.B. 1999); *see also On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000) (affirming Board's refusal to register a mark for Internet connection services because of a likelihood of confusion with a similar mark for closely related electronic content services). Here, the parties' services on the Internet are nearly identical, making confusion inevitable. *See On-Line Careline*, 229 F.3d at 1086 (finding likelihood of confusion between ONLINE TODAY and ON-LINE TODAY given "the services associated with both marks are related to the use of the Internet").

Moreover, even if its marks were not already used on the Internet, HCI would be entitled to prevail based on the zone of natural expansion available to its non-Internet uses. Under the expansion of trade doctrine, a trademark owner is entitled to protection against the registration of a similar mark on products or services it reasonably might produce in the normal expansion of the owner's business. *Frank Brunckhorst Co. v. G. Heileman Brewing Co.*, 35 U.S.P.Q.2d 1102, 1111 (E.D.N.Y. 1994) (finding "competitive proximity" between defendant's beer and plaintiff's meat and cheese products). HCI is therefore entitled to protection against Applicant's use of the COSMO.COM mark for online services, which is a natural extension of HCI's print magazines. *See Sheller-Globe Corp. v. Scott Paper Co.*, 204 U.S.P.Q. 329, 333 (T.T.A.B. 1979) ("[T]he rationale of the theory is that the purchasing public . . . would have thought at the time of [the junior user's] initial appearance on the scene that [the junior user's] mark signified a connection of its goods with [the senior user]."); *J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 963 (C.C.P.A. 1965) ("We agree with the board that the only question of substance herein is whether or not persons familiar with [the senior user's] use of 'HALLMARK' will mistakenly assume that 'HALLMARK' blank checks also originate with [the senior user]."). Consumers reasonably expect Applicant's services to emanate from HCI in the normal expansion of HCI's business under the famous COSMOPOLITAN and COSMO marks. *See S & L Acquisition Co. v. Helene Arpels Inc.*, 9 U.S.P.Q.2d 1221, 1226 (T.T.A.B. 1987).

The consuming public expects HCI to expand into related media and industries as a natural and foreseeable result of its print magazine business. As a result, consumers undoubtedly expect HCI to expand its print magazines to offer an online version of its popular *Cosmopolitan* and *Cosmo Girl!* publications and otherwise provide related content on the Internet. *See, e.g., Nat'l Lampoon, Inc. v. Am. Broad. Co.*, 376 F. Supp. 733, 740 (S.D.N.Y.) *aff'd*, 497 F.2d 1343 (2d Cir. 1974) (finding it natural to foresee expansion of *National Lampoon* to national broadcast television); *see also Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 666 (5th Cir. 2000) (holding magazines to be within "natural zone of expansion" of POLO mark for clothing); *J.C. Penny Co. v. Sec. Tire & Rubber Co.*, 382 F. Supp. 1342, 1344-45 (E.D. Va. 1974) (senior user's expansion of its mark from bicycle to automotive tires was a

“logical one” to which it was entitled “even though [its] extension of its trade from bicycle tires to automotive tires began subsequent to [the junior intervening user’s] sale of automotive tires”). This expectation is most clearly demonstrated by the fact that numerous readers of *Cosmopolitan* magazine mistakenly turned to Applicant’s website to ask questions related to articles or other issues in connection with HCI’s print magazine and at least one consumer purchased a subscription to *Cosmopolitan* on Applicant’s website. (See Docket No. 30 Ex. E; Docket No. 79 Resp. Nos. 26, 29.)

The close similarity between Applicant’s COSMO.COM mark and HCI’s family of COSMO and COSMOPOLITAN Marks means that a lesser degree of similarity is required between the parties’ products or services to support a finding of likelihood of confusion. See, e.g., *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992); *Helene Curtis Indus. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618, 1624 (T.T.A.B. 1989). Here, however, Applicant’s services are nearly identical to those offered by HCI and are in HCI’s natural area of expansion, causing consumers to mistakenly conclude that Applicant’s services originate from or are authorized by HCI. As a result, this factor weighs strongly in HCI’s favor.

5. The Parties’ Channels Of Trade Overlap As A Matter Of Law

In *inter partes* proceedings involving unrestricted claims, the Board need not entertain the argument that the parties use or occupy different channels of trade. Rather, registrability is based on the “identification of goods set forth in the application regardless of what the record may reveal as to...the class of purchasers to which sales of the goods are directed.” *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990). Accordingly, the unrestricted nature of HCI’s registrations means that the parties are presumed to distribute their goods and services through the same channels of trade as a matter of law. See *J&J Snack Foods Corp. v. McDonalds Corp.*, 932 F.2d 1460, 1463 (Fed. Cir. 1991); *Helene Curtis Indus.*, 13 U.S.P.Q.2d at 1623.

Beyond this *legal* rule, the *facts* of this case mandate the same conclusion. To the extent Applicant’s (and not HCI’s) identification of services is limited to one channel of trade, the Internet, this only further demonstrates that confusion is inevitable in light of HCI’s incontestable registrations for on-line

services. *See On-Line Careline, Inc.*, 229 F.3d at 1086 (affirming the Board’s finding of likely confusion where both parties used the Internet to market and offer online services). Both HCI and Applicant offer their online services to the same consumers through the Internet. HCI also makes wide use of the Internet to sell and advertise its goods and services. As a matter of fact and law, therefore, an application of this factor weighs in favor of a finding of likely confusion.

6. Consumers Do Not Exercise Great Care When Surfing the Web, Making Confusion More Likely to Continue

Given that “many Internet consumers are not particularly sophisticated,” *Advance Magazine Publishers Inc. v. Vogue Int’l*, 123 F. Supp. 2d 790, 797 (D.N.J. 2000), there is a greater likelihood of confusion. *See also On-Line Careline, Inc.*, 229 F.3d at 1087 (“[B]ecause of the broad proliferation of computer and Internet use, there is no basis for concluding that Internet users are any more knowledgeable or sophisticated than the general public.”). At least one court has found that HCI’s target consumers, female magazine purchasers ages 12 to 19, “given their age, are not very sophisticated buyers,” making them more likely to be confused. *See Time Inc. v. Petersen Publ’g Co.*, 976 F. Supp. 263, 265 (S.D.N.Y. 1997).

In this case, the potential for continuing consumer confusion is further increased because consumers looking for goods and/or services on the Internet likely do not use a great deal of care when attempting to find the website for which they are surfing. *See Cardservice Int’l, Inc. v. McGee*, 950 F. Supp. 737, 741 (E.D. Va. 1997). It is widely recognized among courts that confusion is even more likely to occur on the Internet because it allows greater ease in navigating to websites rather than brick-and-mortar stores. *See Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029, 1042-43 (N.D. Ill. 2001) (citing cases). Based on the age of HCI’s target market, the fact that Internet users are not sophisticated consumers, and the low degree of care used when surfing the web, the likelihood of confusion arising from the use of similar trademarks is heightened. This factor also weighs in favor of HCI.

7. Bad Faith Is Not Required For A Likelihood Of Confusion

Proof of an intent to trade on another's goodwill is not required for an opposer to prevail under Section 2(d). *See Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891 (Fed. Cir. 1988). Here, however, a finding of likely confusion is appropriate under the principle that "[w]hen one party knowingly adopts a mark similar to another's, reviewing courts presume that the defendant will accomplish its purpose, and that the public will be deceived." *Acad. of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991); *see also Reader's Digest Ass'n v. Conservative Digest*, 821 F.2d 800, 804 (D.C. Cir. 1987) (holding striking similarity between the parties' marks evidence of intentional copying); 3 MCCARTHY, *supra*, § 23:20 ("Most businesspeople know enough not to adopt a mark identical to that already in use in the same market."). Although bad faith is not required to find a likelihood of confusion, *see Jewelers Vigilance Comm.*, 853 F.2d at 891, this factor nonetheless weighs against Applicant in the likelihood of confusion analysis.

8. Any Doubt Must Be Resolved Against Applicant

To the extent the Board harbors any remaining doubts as to the likelihood of confusion, these must be resolved in favor of HCI as the prior user. *See, e.g., TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1473 (Fed. Cir. 1997); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 909 (C.C.P.A. 1974). The Federal Circuit repeatedly has confirmed this principle:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises "but one inference – that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark," and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 676 (Fed. Cir. 1984); *see also Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989); *Kenner Parker Toys*, 963 F.2d at 350. Because this factor, like all others of record, favors a finding that confusion is likely, Applicant's mark should be refused registration under section 2(d).

D. Dilution Is Actual And Ongoing And Is Therefore Likely

Following passage of the Trademark Dilution Revision Act of 2006 (“TDRA”), HCI need only prove that Applicant’s mark is likely to dilute the fame and distinctiveness of the marks making up HCI’s family of COSMO and COSMOPOLITAN Marks. As set forth below, the record evidence establishes that Applicant’s mark is *actually* diluting HCI’s marks, which obviates the need to evaluate the *likelihood* of dilution. Nevertheless, under the statutory factors established by the TDRA, dilution is likely as well.

1. The Marks Underlying HCI’s Family Of COSMOPOLITAN And COSMO Marks Are Famous

The marks making up HCI’s family of COSMOPOLITAN and COSMO Marks are famous under the TDRA’s list of non-exclusive factors for evaluating fame. Those factors include:

- (a) the duration, extent, and geographic reach of advertising and publicity of the marks, whether advertised or publicized by the owner or third parties;
- (b) the amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (c) the extent of actual recognition of the mark; [and]
- (d) whether the mark is registered on the Principal Register.

15 U.S.C. § 1125(c)(2)(A)(i-iv) (2006). Under an application of these factors, HCI’s family of COSMOPOLITAN and COSMO Marks are “widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner,” *id.* § 1125(c)(2)(A), and the marks therefore are entitled to protection against dilution.

a) The Duration, Extent, And Geographic Reach Of Advertising And Publicity Of HCI’s COSMO And COSMOPOLITAN Marks Are Substantial

As documented in HCI’s testimony, HCI has used and promoted its COSMOPOLITAN and COSMO family of marks in connection with a wide variety of goods and services for over 100 years. (Docket No. 52 – First Rodgers Decl. ¶ 4.) HCI advertises the marks extensively using print, the Internet and event sponsorships. (*See id.* ¶¶ 7, 14; Docket No. 74 Resp. Nos. 5, 20, 21.) Not only do HCI’s advertising and promotional efforts span a variety of different media, but its promotional efforts also extend throughout the world and United States. (Docket No. 52 – First Rodgers Decl. ¶ 4.) HCI’s magazines are ubiquitous. The breadth of nationwide advertising featuring the COSMOPOLITAN and COSMO Marks

is further exemplified by event and sports sponsorship by Opposer's licensees. (Docket No. 74 Resp. Nos. 5, 20-21.)

b) The Amount, Volume, and Geographic Extent of Sales Under HCI's COSMO and COSMOPOLITAN Marks Are Extensive

Goods and services provided under the COSMO and COSMOPOLITAN Marks are as pervasive as advertising featuring them. As set forth above, HCI distributes millions of *Cosmopolitan* and *Cosmo Girl!* magazines each year. (Docket No. 30 ¶ D & Tabs 18-26 to Ex. D; Docket No. 52 – First Rodgers Decl. ¶ 6.) Not only do HCI's print publications have an expansive nationwide readership, but its online publications are limitless in geographic scope and used by consumers throughout the United States. (Docket No. 52 – First Rodgers Decl. ¶¶ 11, 13.)

c) HCI's Marks Enjoy Widespread Recognition

The widespread recognition of the COSMO and COSMOPOLITAN Marks also weighs against registration of Applicant's mark. Given that HCI's COSMO Marks have been in use for over 100 years, these marks enjoy an extraordinary degree of recognition throughout the United States. As already discussed, HCI's predecessors and licensees have spent millions of dollars advertising and promoting its COSMO and COSMOPOLITAN Marks to the public in/through a variety of different media. (Docket No. 52 – First Rodgers Decl. ¶¶ 7, 14.) Both online and print publications of HCI's *Cosmopolitan* and *Cosmo Girl!* publications are read by millions of individuals throughout the United States. (*Id.* ¶ 6; Docket No. 30 ¶ D & Tabs 18-26 to Ex. D.) The websites associated with those publications enjoy web traffic from millions of consumers, which further ensures that the COSMOPOLITAN and COSMO Marks are recognized and well-known throughout the country. (Docket No. 52 – First Rodgers Decl. ¶ 11; Docket No. 74 Resp. No. 5 Ex. E.)

d) HCI's Marks Are Registered on the Principal Register

Because HCI's marks are registered on the Principal Register (Docket No. 30 Ex. A; Docket No. 52 – First Rodgers Decl. ¶¶ 9, 12), this factor also weighs in favor of their eligibility for protection against dilution. *See, e.g., Gateway Inc. v. Companion Prods. Inc.*, 68 U.S.P.Q.2d 1407, 1423 (D.S.D. 2003),

aff'd, 384 F.3d 503 (8th Cir. 2004); *Times Mirror Magazines Inc. v. Las Vegas Sports News, L.L.C.*, 50 U.S.P.Q.2d 1454, 1458 (E.D. Pa. 1999), *aff'd*, 212 F.3d 157 (3d Cir. 2000).

2. Applicant's Mark Is Causing Actual Dilution By Blurring

The TDRA requires HCI to show only that Applicant's mark is likely to dilute the distinctiveness of the marks making up HCI's family of COSMOPOLITAN and COSMO Marks. As in the likelihood of confusion context, however, the Board need not address whether dilution is likely, because dilution here is actual and ongoing. Specifically: (1) Applicant's mark actually dilutes the distinctiveness of HCI's marks because of its virtual identity to those marks; and (2) Applicant's mark has caused actual confusion with those marks.

a) The Virtual Identity Of Applicant's Mark To HCI's COSMO And COSMOPOLITAN Marks Actually Dilutes The Distinctiveness Of Those Marks

In *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), the Supreme Court confirmed that an identity of marks is circumstantial evidence of actual dilution. *See id.* at 434 (“[D]irect evidence of dilution . . . will not be necessary if actual dilution can reliably be proven through circumstantial evidence – the obvious case is one where the junior and senior marks are identical.”). In applications of *Moseley*, lower courts have similarly explained that “where the competing entities are using marks that are identical, dilution may be reliably found using the circumstantial evidence of the identical marks.” *Scott Fetzer Co. v. Gehring*, 288 F. Supp. 2d 696, 702 (E.D. Pa. 2003) (finding dilution as a matter of law); *see also Savin Corp. v. Savin Group*, 391 F.3d 439, 452 (2d Cir. 2004) (“[W]here a plaintiff who owns a famous senior mark can show the commercial use of an identical junior mark, such a showing constitutes circumstantial evidence of the actual dilution. . .”).

Here, there is no material dispute that Applicant's COSMO.COM mark is indistinguishable from HCI's COSMO and COSMOPOLITAN.COM marks and is substantially identical to HCI's remaining COSMOPOLITAN marks. Under these circumstances, the dilution proscribed by 15 U.S.C. § 1125(c) is actual and Applicant's mark should be denied registration on that basis. *See, e.g., Nike Inc. v. Variety Wholesalers, Inc.*, 274 F. Supp. 2d 1352, 1372 (S.D. Ga. 2003) (entering summary judgment of dilution

“due to the identical or virtually identical character of the marks on the Accused Goods to the [plaintiff’s] trademarks”), *aff’d*, 107 Fed. App’x 183 (11th Cir. 2004); *see also Am. Honda Motor Co. v. Pro-Line Protoform*, 325 F. Supp. 2d 1081, 1085 (C.D. Cal. 2004) (“[W]hen identical marks are used on similar goods, dilution—the capacity of the famous mark to identify and distinguish the goods of the trademark holder—obviously occurs.”); *7-Eleven, Inc. v. McEvoy*, 300 F. Supp. 2d 352, 357 (D. Md. 2004) (“Though dilution claims require evidence of actual confusion, that requirement is satisfied when, as here, the defendant uses the plaintiff’s mark.”); *see NASDAQ Stock Mkt., Inc. v. Antartica S.r.l.*, 69 U.S.P.Q.2d 1718, 1737 (T.T.A.B. 2003) (holding NASDAQ & Design “effectively identical” to NASDAQ).

b) The Ongoing Actual Confusion Caused By Applicant’s Mark Actually Dilutes The Distinctiveness Of HCI’s COSMO And COSMOPOLITAN Marks

The rampant actual confusion in this case establishes not only that confusion is likely, but also that actual dilution has occurred. In applications of the more restrictive standard in place prior to the enactment of the TDRA, courts routinely concluded that a showing of actual confusion was probative evidence of actual dilution. *See, e.g., Horphag Research Ltd. v. Garcia*, 475 F.3d 1029, 1036-37 (9th Cir. 2007); *800-JR Cigar, Inc. v. GoTo.com, Inc.*, 437 F. Supp. 2d 273, 293 (D.N.J. 2006). As the Second Circuit has explained, “[c]onfusion lessens distinction. When consumers confuse the junior mark with the senior, blurring has occurred.” *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 221 (2d Cir. 1999), *overruled on other grounds, Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003). The record evidence of numerous misdirected e-mails in this case therefore mandates that Applicant’s mark be denied registration on this basis as well. (*See generally* Docket No. 30 Ex. E; Docket No. 40 Ex. F.)

3. Applicant’s Mark Is Likely To Cause Dilution By Blurring

Even in the absence of record evidence of actual dilution, Applicant’s mark is likely to cause dilution by blurring because it creates “an association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” 15 U.S.C. § 1125(c)(2)(B). Although it is possible for a finding of impermissible dilution of a plaintiff’s mark to occur in the absence of a likelihood of confusion, *see, e.g., Pillsbury Co. v. Milky Way Prods.*, 215

U.S.P.Q. 124 (N.D. Ga. 1981), a determination that confusion is likely is probative evidence that dilution is also likely. *See, e.g., Big Boy Rests. v. Cadillac Coffee Co.*, 238 F. Supp. 2d 866, 872, 875 (E.D. Mich. 2002); *Robarb Inc. v. Pool Builders Supply, Inc.*, 21 U.S.P.Q.2d 1743, 1754-55 (N.D. Ga. 1991). Indeed, “[a] trademark likely to confuse is necessarily a trademark likely to dilute.” *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274-75 n.16 (7th Cir. 1976).

That Applicant’s mark is likely to dilute as well as to confuse is borne out by the application of the statutory factors for evaluating blurring claims:

- (a) The degree of similarity between the mark or trade name and the famous mark;
- (b) the degree of inherent or acquired distinctiveness of the famous mark;
- (c) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- (d) the degree of recognition of the famous mark; and
- (e) whether the user of the mark or trade name intended to create an association with the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i-iv). Specifically:

a) Applicant’s Mark And HCI’s COSMO And COSMOPOLITAN Marks Are Similar In Appearance, Pronunciation, And Meaning

As in the likelihood of confusion context, HCI need not demonstrate that the parties’ marks are identical; rather, all that is necessary to show a likelihood of dilution is a “sufficient similarity so that, in the mind of the consumer, the junior mark will conjure an association with the senior.” *Nabisco*, 191 F.3d at 218. Nevertheless, as shown above in the discussion of the similarity of the parties’ marks, Applicant’s mark, COSMO.COM is identical to HCI’s COSMO marks, especially HCI’s COSMOPOLITAN.COM mark. *See, e.g., Porsche Cars N. Am. Inc. v. Spencer*, No. 00-S-00471 GEB PAN, 2000 WL 641209, at *3 (E.D. Cal. May 18, 2000) (finding that PORSCHE diluted by PORCHESOURCE.COM). The high degree of similarity between the parties’ marks supports HCI’s claim of blurring.

b) HCI’s Marks Are Highly Distinctive

Because HCI’s registered marks have achieved incontestable status, HCI enjoys the presumption that these marks are highly distinctive and cannot be challenged on this basis. *See Park ‘N Fly*, 469 U.S. at 205. The marks’ inherent distinctiveness is strengthened by HCI’s widespread use and promotion of its

marks. (Docket No. 52 – First Rodgers Decl. ¶¶ 4, 8, 14.) Indeed, there can be no reasonable dispute that HCI’s COSMOPOLITAN and COSMO Marks are anything but highly distinctive, strong marks that are entitled to protection from blurring.

c) HCI Is Engaging In Substantially Exclusive Use Of Its COSMOPOLITAN And COSMO Marks

For over a century, HCI has cultivated the strength of the COSMOPOLITAN and COSMO Marks through its exclusive use and promotion of the marks in connection with the famous *Cosmopolitan* and *Cosmo Girl!* Magazines. HCI enjoys exclusive rights to these marks in the publishing arena and has leveraged the strength of its marks to include a wide variety of other goods and services. (Docket No. 52 – First Rodgers Decl. ¶ 10; Docket No. 74 Resp. Nos. 5-6.) Although “absolutely exclusive use” is not required, *Nike, Inc. v. Nikepal Int’l, Inc.*, 84 U.S.P.Q.2d 1820, 1827 (E.D. Cal. 2007), HCI actively enforces its marks to ensure that it is substantially the sole user of its COSMOPOLITAN and COSMO Marks in any context in which the marks are used.

d) There Is Extensive Public Recognition of HCI’s COSMO and COSMOPOLITAN Marks

The notoriety and fame of the COSMO and COSMOPOLITAN marks have developed over a century of substantial, exclusive use and promotion of the marks. As explained above, HCI’s Marks are some of the most highly recognized marks in the United States for a women’s magazine, both in the print and online contexts. (Docket No. 52 – First Rodgers Decl. ¶¶ 4, 14.) The brand association and strength connected to HCI’s family of COSMO and COSMOPOLITAN marks further support its blurring claim.

e) There Is An Actual Association Between Applicant’s Mark And HCI’s COSMO And COSMOPOLITAN Marks

All that is necessary to show a likelihood of dilution is a “sufficient similarity so that, in the mind of the consumer, the junior mark will conjure an association with the senior.” *Nabisco*, 191 F.3d at 218. As shown by the numerous misdirected e-mails confused consumers sent to Applicant, there is no question that the public is drawing an association between the parties’ marks. (*See generally* Docket No. 30

Ex. E; Docket No. 40 Ex. F.) Because this factor, like all others, weighs in favor of a finding of dilution by blurring, registration of Applicant's mark should be denied.

IV. CONCLUSION

HCI owns a family of COSMO and COSMOPOLITAN Marks that are used in connection with a wide variety of products and services, including print and online magazine publications, which it has heavily promoted and widely provided to the public for over a century. The record testimony and evidence clearly shows that Applicant's mark is confusingly similar to HCI's family of COSMO and COSMOPOLITAN Marks and is to be used for identical services. HCI has shown that Applicant's mark is actually confusing and diluting HCI's family of COSMOPOLITAN and COSMO Marks. Under these circumstances, there can be no dispute that Applicant's mark is likely to be confused with, and likely to dilute the distinctiveness of, HCI's marks. HCI therefore respectfully requests the Board to sustain the opposition and deny registration to Applicant's mark.

This 25th day of July, 2008.

Respectfully submitted,

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Inc.

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

Hearst Communications, Inc.)	
)	
Opposer,)	
)	Opposition No. 91120453
v.)	
)	
Charles Browning Wilson,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

This is to certify that the attached **Opposer's Trial Brief** has been served upon Applicant's counsel by depositing a copy in the United States mail as first class mail, postage pre-paid, addressed as follows:

Robert M. Steckman, Esq.
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This 25th day of July, 2008.

/Lauren T. Estrin/
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