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

Proceeding	91120453
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I

INTRODUCTION

Applicant, Cosmo Charles Browning Wilson¹, (“Cosmo”, “Cosmo Wilson” or “Applicant”) hereby submits his trial brief in opposition to Opposers Hearst Communications, Inc. and Hearst Magazines Property, Inc.² (“Hearst” or “Opposer”) application to prevent registration of the trademark “Cosmo.com” by Applicant.

II

BACKGROUND

Applicant, Mr. Cosmo Wilson, respectfully refers this board to Opposer’s trial Brief, which contains an accurate description of the procedural history and background of this matter, with the exception of the facts and circumstances below, which Applicant hereby submits in order to clarify any discrepancies in Opposer’s trial Brief.

Cosmo Wilson is a well known lighting technician with an extensive resume of international tours with some of the largest musical and performing acts of the last twenty-five years, including, The Rolling Stones, AC/DC, Genesis, Motley Crue, Rod Stewart and Black Sabbath (Docket 63, Exhibit “A”). He has been known in the concert touring industry by the moniker “Cosmo” since in

¹ Applicant changed his legal name to “Cosmo Charles Browning Wilson” in or about April 2003.

² Opposer has unilaterally removed co-Opposer HEARST MAGAZINES PROPERTY, INC. from the caption on it’s trial brief without making application to this Board or requesting applicant’s written consent. Applicant has no objection to this alteration but has utilized the original caption and further considers Opposer’s actions to be the equivalent of a voluntary discontinuance with prejudice of all claims against Applicant by HEARST MAGAZINES PROPERTY, INC.

or about 1984 (Docket 62, ¶3). Applicant purchased the domain “cosmo.com” from an entity known as “DD King” on January 8, 1998. Docket 62, ¶¶7-9; Docket 66, Exhibit L). Cosmo Wilson has, at all times, utilized cosmo.com as a portal for providing information to the general public, such as local entertainment listings, tourist attractions and restaurant reviews. Cosmo Wilson ran his website for approximately 18 months without receiving any communication from Opposer. He filed U.S. trademark application serial number 75810043 on October 18, 1999 for “cosmo.com”, on a pro se basis, claiming use in International Class 41 for “Providing on-line information on available entertainment in various cities”. This trademark application was approved for publication on February 9, 2000 and published for opposition on May 30, 2000.

Opposer’s initially commenced the herein proceeding by Notice of Opposition, dated September 26, 2000, specifically claiming that Applicant’s mark infringed upon: (1) U.S. Registration 630,028 for “COSMOPOLITIAN” for a “Magazine or periodical” in International Class 16; and (2) U.S. Registration 1,843,656 for “COSMO” for “cosmetic bags, sold empty, umbrellas, leather key fobs, key cases, credit card holders and traveling bags” in International Class 18. (Docket 1, ¶¶2, 3). Opposer also referenced the fact that it possessed an internet website domain at www.cosmomag.com in its Notice of Opposition, but did not indicate any date of first use in commerce for such internet domain, only the date of registration of said domain (Docket 1, ¶4). At no time did Opposer reference any specific infringement of any “common law” trademarks by Applicant in its Notice of Opposition.

After filing of this proceeding, Opposer failed to file its Section 8 application for U.S.

Registration 1,843,656, and as a result, said registration was subsequently cancelled. No efforts have been made by Opposer to renew such registration, and Opposer has further admitted that Registration 1,843,656 has been cancelled for reasons that were not identifiable by Opposer (Docket 68, ¶4). As such, Opposer has failed to present any reasonable basis for its failure to maintain the trademark registration which was the primary basis for its opposition to the herein application.

However, Opposer subsequently attempted to enhance its rights to the ‘Cosmo’ mark by filing a new trademark application which attempted to re-register the phrase ‘Cosmo’ under application serial No. 77137373. Applicant was able to locate such application prior to completion of publication, and Applicant filed Opposition Proceeding No. 91182891 in a timely manner to prevent Opposer from obtaining a U.S. registration for ‘Cosmo’ in the field of electronic communication prior to disposition of this proceeding.³

For the reasons set forth herein, Applicant hereby requests that the herein opposition proceeding be dismissed in its entirety.

³ The parties have stipulated and agreed to suspend Opposition Proceeding No. 91182891 pending disposition of this proceeding.

III

ARGUMENT

A. GRANTING OPPOSER'S APPLICATION WILL NOT PREVENT APPLICANT'S CONTINUING USE OF THE "COSMO.COM" DOMAIN BECAUSE OPPOSER HAS FAILED TO COMMENCE AN INFRINGEMENT PROCEEDING IN A TIMELY MANNER.

It is most critical to note that Applicant has owned the cosmo.com domain since January, 1998 and Opposer has never undertaken any efforts, such as commencing an action in Federal District Court and/or a Uniform Domain Name Dispute Resolution Policy proceeding before The Internet Corporation for Assigned Names and Numbers, therein seeking to prevent Applicant from continuing use of the cosmo.com domain (Docket 73, Questions 1-9).

1. OPPOSER CLAIMS OF TRADEMARK INFRINGEMENT ARE BARRED BY THE STATUTE OF LIMITATIONS

It is well settled that there is no specific statute of limitations contained within the Lanham Act, however various states have applied their own limitation standards under a laches theory to create a state level statute of limitations for trademark infringement suits. *See Audi AG v. D'Amato*, 469 F.3d 534, 81 U.S.P.Q.2d 1108, (6th Cir. 2006). Applicant has, at all times relevant herein, been a resident of the State of Florida. According to the Eleventh Circuit Court of Appeals, which has jurisdiction over the State of Florida, the statute of limitations issue for trademark infringement claims in Florida under section 43(a) of the Lanham Act is four years. *See Ambrit, Inc. v. Kraft, Inc.*,

812 F.2d 1531, 1546 (11th Cir. 1986), in which the eleventh Circuit stated, in pertinent part:

“Indeed, the Court of Appeals for the Sixth Circuit recently held that, because the Lanham Act does not contain a statute of limitations, the period for analogous state law claims is to be used as a touchstone for laches. **The pertinent limitations period for this type of action in Florida is four years**, over twice the length of time in issue here.” [emphasis supplied; footnotes omitted]

As a result, irrespective of the determination of the Board in this current proceeding, Applicant’s use of the cosmo.com domain will continue since Applicant has operated the cosmo.com website since 1999 and Opposer has failed to undertake any efforts against Cosmo Wilson, with the exception of this proceeding, for more than nine years. Opposer has never delivered a cease and desist letter nor any other communication which asserts any superior trademark rights or other rights relating to Applicant’s ongoing and continuing use of the cosmo.com domain and website during the applicable limitations period. Accordingly, regardless of the outcome of this opposition proceeding, Applicant will be entitled to continue to own and operate his website utilizing the www.cosmo.com domain since Opposer has failed to commence an action for trademark infringement during the applicable limitations period.

2. OPPOSER HAS FAILED TO UNDERTAKE ANY EFFORTS TO PROTECT ITS PURPORTED COMMON LAW TRADEMARKS

Under such circumstances, all of Opposer’s claims in this proceeding must be considered in light of the common law doctrines of laches and estoppel due to Opposer’s failure to undertake any

efforts whatsoever to protect its purported 'common law' rights to the phrase 'Cosmo'. The essential elements of laches are well-defined by common law, and there are three affirmative requirements: (1) a substantial delay by a plaintiff prior to filing suit; (2) a plaintiff's awareness that the disputed trademark was being infringed; and (3) a reliance interest resulting from the defendant's continued development of good-will during this period of delay. N.A.A.C.P. v. N.A.A.C.P. Legal Defense & Educational Fund, Inc., 753 F.2d 131, 243 U.S.App.D.C. 313, 225 U.S.P.Q. 264, (DC Cir 1985); *See* McCarthy on Trademarks and Unfair Competition §§ 31:1 -31:2, 31:33 - 31:36, et seq. (4th ed.). In the present matter, Opposer has never filed suit, but was clearly aware of the use of the cosmo.com domain since in or about 1996. See (Docket No 63, Ex K). Regarding prejudice to the defendant, Cosmo Wilson would clearly be prejudiced if his investment of time and personal savings to build the goodwill of the cosmo.com website was reduced by refusing registration of his trademark application. As such, the laches analysis in this matter is clearly in favor of Cosmo Wilson.

Despite regular communication between the parties in this proceeding for over eight years, no action of any nature has been taken by Opposer which sought to prevent or preclude Applicant's use or continuing use of the cosmo.com domain. This is obviously because Cosmo Wilson has adopted the 'Cosmo' trademark in good faith and has never attempted to "Cybersquat" the domain or to post materials on the website which would give the impression that Hearst was the owner of the cosmo.com domain. Given Opposer's significant resources, it is therefore difficult to comprehend the underlying basis for the Opposer's arguments in this proceeding indicating that Cosmo Wilson's website is causing any form of confusion and/or harm to Opposer's goodwill and

reputation with its customers, and/or how this opposition to Applicant's trademark application will obviate any purported potential continuing confusion between the parties products and/or services.

In fact, Opposer has been actively aware that the cosmo.com domain was in the possession of third-parties since 1996. At that time, the domain was still in the possession of the "Domain Dealer", a third-party whose sole intent for purchasing the domain was to re-sell same. Opposer was well aware of this situation, as evinced by Exhibit "K" to Applicant's Notice of Reliance, an article, dated November 25, 1996, issued by ZDNet, (currently an online affiliate of CBS Networks), which directly quotes Opposer's attorney, Bonnie Fuller, who states that Opposer was aware of the domain ownership situation and had "referred the matter to its attorneys"(Docket No 63, Ex K). Despite such express knowledge of the situation, and further despite the fact that Opposer engaged in direct negotiations with the "Domain Dealer" (See Applicant's declaration, Docket 62 ¶7), Opposer's failed to act in any manner against Applicant and/or the "Domain Dealer" which would be consistent with the obligations of a trademark owner to protect and/or enforce its trademark rights. Opposer never issued a 'cease and desist' letter to Applicant at any time regarding any purported act of trademark infringement by Applicant or asserting any "common law" trademark rights belonging to Opposer. Moreover, after transfer of the domain Opposer never contacted Cosmo Wilson to advise him of any claim of trademark rights. Opposer simply acquiesced, then filed its Notice of Opposition in this proceeding..

These indisputable facts demonstrate the Opposer's continuing failure to appropriately review and enforce its purported "common law" rights to the 'Cosmo' phrase, thereby supporting

Applicant's argument that Opposer cannot demonstrate superior rights to the 'Cosmo' trademark. As such, it is submitted that the herein opposition should be dismissed.

B. OPPOSER HAS NOT PRESENTED SUFFICIENT PROOF TO SUPPORT ITS CLAIM OF SUPERIOR RIGHTS OR PRIORITY TO THE 'COSMO' TRADEMARK.

Opposer has also failed to provide sufficient proof in admissible evidentiary form which supports its assertions regarding the priority and distinctiveness of its purported common law trademarks. During the eight year history of this matter Opposer never conducted surveys of the general and/or relevant consuming public in order to provide actual evidentiary support to the bald-faced statements made by Opposer regarding the public's association of the word "Cosmo" with Opposer's magazine property "Cosmopolitan." Moreover, Opposer has failed to identify the basis for its claim of "common law" rights. Finally, as set forth above, Opposer did not act in any reasonable manner to protect any potential "common law" rights to same.

1. OPPOSER'S EVIDENCE HAS LIMITED PROBATIVE VALUE.

Review of the record in this matter demonstrates that the almost exclusive form of proof submitted by Opposer in this proceeding in support of its assertions regarding its purported superior common law trademark rights are: (1) Opposer's own self-serving statements made in its own affidavits; and (2) extensive copies of portions of its "Cosmopolitan Magazine" (Docket 30, 41, 51 and 52). While this evidence demonstrates that the phrase "Cosmopolitan" was clearly registered and used by Opposer for many years, Opposer's trademark claims to the phrase 'Cosmo' are both non-specific and diffuse, thereby obviating any perceived strength or distinctiveness that would

support Opposer's claim of superior trademark rights. Interestingly, as set forth in detail in Section "D" below, Opposer actually contradicts its own statements with regard to the extent of its claims for the phrase by indicating in trial testimony that its rights to 'Cosmo' were limited to the entertainment and publishing field, then arguing in its trial brief that it is entitled to rights under the Trademark Dilution Revision Act of 2006, which would thereby potentially all Opposer to prevent all other existing users from claiming rights to the 'Cosmo' mark. Moreover, at no time does Opposer indicate the extent of its claims to its of use of the 'Cosmo' trademark in any of the evidence submitted in this action, making it impossible for any party to determine the extent of Opposer's "common law" trademark claims.

The underlying legal basis for a 'common law' trademarks is never identified by Opposer in its brief or declarations. Common law trademarks arise from use under state law. Opposer fails to indicate the applicable standards necessary to obtain any common law trademark rights, nor does Opposer indicate in which state the Opposer's marks have obtained common law rights.

2. OPPOSER'S CLAIMS OF PRIORITY AND DISTINCTIVENESS ARE IN DISPUTE

Opposer claims in its trial brief that: (1) the priority of its trademarks are not in dispute (Docket 80, Page 17-18); and (2) the distinctiveness of the Opposer's trademarks are not in dispute (Docket 80, Page 19). Applicant disagrees with these assertions, and does, in fact, claim that these two critical issues are in dispute. Specifically, Opposer's sole support of its argument that the priority of use of the 'Cosmo' trademark is not in dispute are the statements of its own corporate representatives. As stated in Opposer's brief, ten (10) separate items are claimed are the proof of

Opposer's priority of use (Docket 80, Page 17-18). However, careful examination of this list demonstrates that only item number 3 specifically relates to "Cosmo" and not "Cosmopolitan" or "Cosmo Girl", and this particular item merely points to the testimony issued by Opposer's corporate representative in Docket 74 as support⁴.

Moreover, Opposer is unable to identify the date of first use of the phrase 'Cosmo' in commerce, thereby further diminishing its claim of priority of use (Docket 74, Page 3). As set forth in full below, Opposer has also attempted to modify the claimed date of first use in commerce on its application for "Cosmo" under serial number 77137373 to November, 1996 by submitting, as its sole support, an affidavit signed on April 14, 2008 by an unnamed and unidentified "Assistant Secretary". This 'proof' is dubious at best, and lacks necessary verifiable support in order for this Board to consider same in connection with Opposer's "common law" trademark claims.

Second, Opposer's sole support regarding the distinctiveness of its marks are the "numerous federal registrations of its marks" (Docket 80, Page 19). However, as previously stated herein, Opposer does not have any incontestible registered trademarks for "Cosmo", only "Cosmopolitan"⁵ and Opposer is attempting to obfuscate the clear difference between its use of these two phrases.

⁴ While this item also points to certain exhibits, Opposer has not and did not file any of these documents or exhibits with the Board in a timely manner despite this Board's order of June 19, 2008, which gave the parties an opportunity to correct the record. (See Docket 78).

⁵ Applicant recognizes that Opposer registered "Cosmo" for "Magazines featuring information on women's services, beauty, health, and human relationships" in International Class 16 under registration 3372644 in January, 2008. However, such mark will not be incontestable for many years, and further, Opposer's claim of use makes said registered mark irrelevant to the dispute between the parties as it relates to the area of commerce and manner of the parties use of the mark in question.

It is further notable that after its trademark U.S. Registration 1,843,656, was cancelled due to Opposer's acquiescence, and instead of seeking renewal of such trademark, Opposer filed a new registration for the 'Cosmo' mark on July 26, 2007 under serial number 77137373. Review of the PTO "Trademark Document Review" record for serial number 77137373 also demonstrates that on April 14, 2008, Opposer attempted to amend its claimed date of first use under such application from March 29, 2002 to November 30, 1996. This amendment is clearly improper as it was filed after said application was published for opposition and after commencement of Applicant's opposition proceeding 91182819. Therefore, it is submitted that the Opposer has not supplied admissible evidence proving priority of use.

Finally, as noted in: (1) Docket 53, Page 7-11; (2) Docket 74, Page 11-19; and (3) by recent search of the Patent and Trademark Office "TESS" database, there are currently over two hundred registered trademarks and/or 'live' applications with the Patent and Trademark Office that feature the phrase "Cosmo" within the trademark.

As a result, since Opposer has not submitted proof in admissible form of the priority and/or distinctiveness of its purported common law trademarks, and as such, Applicant's trademark should be allowed to proceed to registration.

C. OPPOSER'S 'PROOF' OF ACTUAL CONFUSION IS NOT CONCLUSIVE.

The only evidentiary proof of any actual or potential confusion submitted by Opposer other than a copy of its own magazine or an unsupported, bald-faced assertion contained in testimony

submitted by Opposer are the eight and nine year old emails that were produced by Applicant, written by various individuals to Applicant, regarding issues directed at Opposers magazine (Docket 52; Docket 80, pages 9-17). As set forth below, misdirected communications are not considered to be conclusive proof of actual confusion. It is notable that each and everyone of these emails was received by Applicant in the initial first year(s) of Applicant's ownership of the cosmo.com domain. This types of emails are no longer received by Applicant in the present day, except on rare occasions.

Also, all evidence of actual confusion presented by Opposer in this matter could be considered hearsay evidence, and must be evaluated as such, including the possibility of completely excluding all such evidence. *See Duluth News-Tribune, v. Mesabi Pub. Co.* 84 F3d 1093, 1098; *See also Fed R. Evid. § 801(c), Fed R. Evid. § 802; See also McCarthy on Trademarks and Unfair Competition § 23:15 (4th ed.).*

1. CARELESSNESS IS NOT CONFUSION

Misdirected communications have been held to be unreliable and inconclusive of actual confusion since there is no opportunity to examine the sender. *Duluth News-Tribune, v. Mesabi Pub. Co.*, 84 F.3d 1093, 1098 (8th Cir. 1996); *Lang v. Retirement Living Pub. Co., Inc.*, 949 F.2d 576, 582, 21 U.S.P.Q.2d 1041 (2d Cir 1991); *United States Blind Stitch Mach. Corp. v. Union Spec. Mach. Co.*, 287 F.Supp. 468, 159 U.S.P.Q. 637 (S.D.N.Y. 1968). This cases hold that the level of fact checking performed by the consumer prior to issuing the misdirected communication must be part of the analysis involved when considering whether this type of evidence constitutes proof of

actual confusion. See Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence, 2 Nw. J. Tech. & Intell. Prop. 1 (available at <http://www.law.northwestern.edu/journals/njtip/v2/n2/1>). The seminal treatise on trademark law, McCarthy on Trademarks and Unfair Competition (4th Ed.), is also particularly instructive on this issue, and states:

[E]vidence of actual confusion must be viewed in its evidentiary context. Confusion may not be causally related to the use of similar marks at all. For example, the courts have sometimes characterized evidence of actual confusion as mere “secretarial carelessness caused by a failure to check business addresses,” or due merely to “inattention and indifference,” or that misdirected mail and phone calls are caused by “mere carelessness” of the post office or persons looking in the phone directory. Sometimes, what appears at first glance to be evidence of confusion is merely evidence of consumer error not related to name confusion.

McCarthy on Trademarks and Unfair Competition § 23:13 (4th ed.)(citations omitted).

Accordingly, the purported evidence of actual confusion in this matter submitted by Opposer may be considered irrelevant in any analysis of potential likelihood of confusion in this proceeding.

Mere carelessness or inattentiveness does not constitute actual confusion caused by use of similar marks. Lang v. Retirement Living Pub. Co., Inc., *supra*; United States Blind Stitch Mach. Corp. v. Union Spec. Mach. Co., *supra*; Duluth News-Tribune, v. Mesabi Pub. Co., *supra*. Most of

the individuals who wrote Applicant were clearly customers of Opposer at the time these emails were issued. Therefore, the true identity and location of these purportedly ‘confused’ customers was, at all times, in the possession of Opposer. At no time did Opposer attempt to interview or otherwise investigate the reasons why these customer’s wrote emails directly to the @cosmo.com domain.

It has never been demonstrated if any of these individuals actually visited Applicant’s website, nor has it been shown whether any of the authors of these emails have actually been confused by Applicant’s use. It is safe to assume that these individuals simply guessed (back in 1999) that the cosmo.com domain was the property of Opposer. As noted by Opposer in its testimony, it has promoted its cosmomag.com and cosmogirl.com domains to its subscribers and by purchasing online advertising with many prominent internet search engines that ensures that search results for “cosmo” are directed to Opposer’s website (Docket 73, Question 11). Clearly, the carelessness and inattentiveness of these consumers must therefore be considered in weighing this evidence.

2. CONSUMERS ARE NOT LIKELY TO BE CONFUSED BY APPLICANT’S WEBSITE

Opposer characterizes its own customers as “not very sophisticated” (Docket 80, page 34), as such, to the extent these emails may be admissible, they must be considered in light of same since actual confusion by sophisticated users is given significantly more weight than actual confusion by unsophisticated consumers. See McGregor-Doniger Inc., v. Drizzle Inc., 599 F.2d 1126, 202 U.S.P.Q. 81 (2d Cir 1979); McCarthy on Trademarks and Unfair Competition § 23:13 (4th ed.).

Therefore, any actual confusion attributable to Opposer’s admittedly unsophisticated consumers must also be considered in favor of Applicant when analyzing the standards of ‘Actual Confusion’ and ‘Sophistication of the Buyers’ in any determination of likelihood of confusion according to the standards set forth in Polaroid Corp. v. Polarad Electronics Corp., 182 F. Supp. 350, 125 U.S.P.Q. 57 (E.D.N.Y. 1960), aff’d, 287 F.2d 492, 128 U.S.P.Q. 411 (2d Cir. 1961), cert. denied, 368 U.S. 820, 7 L. Ed. 2d 25, 82 S. Ct. 36, 131 U.S.P.Q. 499 (1961). The Polaroid test enunciated by Judge Friendly wrote that the likelihood of confusion as to product source should be evaluated by balancing the following factors: (1) the strength of the prior owner's mark, (2) the similarity between the two marks, (3) the competitive proximity of the products, (4) the likelihood that the prior user will bridge the gap, (5) actual confusion, (6) the defendant's good faith, (7) the quality of the defendant's product, and (8) the sophistication of the buyers. This list is not exhaustive and “no single *Polaroid* factor is determinative.” W.W.W. Pharmaceutical Company, Inc., v. the Gillette Company, 984 F.2d 567, 572 (2d Cir 1993). In considering the Polaroid factors, it is notable that in addition to the ‘Actual Confusion’ and ‘Sophistication of the Buyer’s’ factors being in favor of Applicant, there is no dispute that Cosmo Wilson has demonstrated good faith in his use and adoption of the ‘Cosmo’ trademark since it has been his moniker for nearly twenty-five years and that he has changed his legal name to Cosmo⁶. Moreover, Cosmo Wilson has never made any efforts to pass his website off to consumers as the product of the Opposer. (Docket 62, ¶¶12-13) Finally, the quality of Cosmo Wilson’s website could not be confused with Opposer’s product since comparison of the cosmo.com website and the cosmopolitan.com website clearly originate from two separate sources. See Western Publishing Company, Inc., v. Industries, Inc., 910 F.2d 57, 15

⁶ See Footnote No. 1

U.S.P.Q.2d 1545 (2d Cir 1990). Therefore, it is difficult to accept Opposer's assumption that visitors to the Cosmo Wilson's website a likely to be confused into believing that it was authored by the Opposer.

As such, Opposer's claim that actual confusion has occurred, and the request for a resulting finding of likelihood of confusion, must be considered in light of the Poloroid factors which are in applicants favor. As a result, it is submitted that no likelihood of confusion exists in this matter, and accordingly, this opposition proceeding should be dismissed.

D. OPPOSER'S ARGUMENT IN ITS TRIAL BRIEF REGARDING RIGHTS ASSERTED UNDER THE TRADEMARK DILUTION REVISION ACT ARE CONTRADICTED BY SWORN STATEMENTS MADE BY OPPOSER IN ITS TRIAL TESTIMONY.

Opposer's arguments asserting trademark rights under the Trademark Dilution Revision Act (15 U.S.C. 1125(c)) are directly contradicted by its own testimony in this matter. Specifically, in Applicant's Written Cross-Examination to Opposers (Docket 53 questions No 25 - 36), Applicant identified numerous registered and unregistered trademarks from the Patent and Trademark Office database which utilizes the phrase "Cosmo" in a clear and distinct manner. Opposer was asked to identify any efforts undertaken to oppose registration of such applications and/or to identify any other efforts undertaken to protect its purported rights to the 'Cosmo' mark. In response, Opposer's responses to Applicant's questions uniformly indicated that Opposer did not provide services in those particular areas of commerce, and therefore Opposer did not need to commence any efforts to prevent those other users from engaging in continuing use of the 'Cosmo' mark in commerce (Docket 74, Page 11-19). These sworn statements made during trial testimony completely contradict

Opposer's argument in its trial Brief that it is entitled to any protection under the Trademark Dilution Revision Act of 2006 ("TDRA") (Docket 80, Pages 36-42).

1. OPPOSER HAS NOT PROVEN THAT ITS TRADEMARKS ARE FAMOUS

Specifically, in Opposer's trial brief, Opposer first argues that the Opposer's "family" of marks are "famous", as defined by 15 U.S.C. 1125(c), et seq., then Opposer returns to its argument that its "Cosmopolitan" magazine trademark and the "Cosmo" phrase are synonymous, without providing any actual proof of the claimed "extraordinary degree of recognition" of the phrase "Cosmo" relative to the registered "Cosmopolitan" trademark. Opposer has also failed to submit evidence of any association in the minds of the relevant consuming public between the Opposer and "Cosmopolitan" versus the Opposer and "Cosmo" (Docket 80, Page 37). However, the standard for claims of a famous mark are extremely high, and should not be considered, as suggested by Opposer, relative to the standards applicable for proof of secondary meaning. I.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27 (1st Cir. 1998); *See* McCarthy on Trademarks and Unfair Competition § 24:70 (4th ed.). In I.P. Lund the First Circuit stated, "[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection." I.P. Lund Trading ApS v. Kohler Co., 163 F.3d at 47. *See also* Toro Co. v. Torohead, Inc., 61 U.S.P.Q.2d 1164 (TTAB 1997) (stating that, unlike in trademark infringement cases, doubts are not resolved in favor of the party claiming dilution). In the present matter Opposer indicates that the famousness of its "family of marks" can be assumed from the long term use of its "Cosmopolitan" trademark and from the size of Opposer's advertising budget. However, none of these assertions go towards the specific use of "Cosmo" by Opposer or the manner in which the

general consuming public associates this phrase with Opposer's products.

There is clear, long term and pervasive use of both the Cosmo and Cosmopolitan phrases by numerous third-party entities, in numerous areas of commerce, some of which pre-date Opposer's use⁷. Opposer cannot claim, under oath, that its failure to police its mark against the other registered users of the term 'Cosmo' results from the fact that Opposer's products are not in competition with other senior and junior users of its "Cosmopolitan" and "Cosmo" phrases, then argue to the contrary that its marks are so distinctive and famous that Opposer should be entitled to protection under the TDRA, which, if granted, could entitle Opposer to attempt to preclude continuing use in commerce by all other existing users of the "Cosmo" and/or "Cosmopolitan" phrases.

As a result, it is submitted that this Board closely examine the quality of testimony and level of admissible evidentiary proof submitted by Opposer regarding the perceived strength and purported distinctiveness of its registered and unregistered "common law" trademarks.

⁷ See www.cosmohotel.com, and http://www.hotelchatter.com/story/2008/2/13/16156/8206/hotels/Hotel_Historian_Loves_the_Cosmopolitan_Hotel which indicates the Cosmopolitan Hotel's date of first use in commerce is 1851.

IV

CONCLUSION

For the reasons set forth herein, it is respectfully requested that this Opposition proceeding be dismissed.

Respectfully Submitted,

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TRADEMARK TRIALS AND APPEALS BOARD

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HEARST COMMUNICATIONS, INC. and : Opposition No. 91120453
HEARST MAGAZINES PROPERTY, INC. :
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Opposers, : CERTIFICATE OF SERVICE
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v. :
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CHARLES BROWNING WILSON :
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Applicant :
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It is hereby certified that a true copy of the within Applicant's Trial Brief, was served upon counsel for Opposers on October 23, 2008, by first class mail, postage prepaid, at the address set forth below:

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October 23, 2008

/Robert Steckman/
Robert M. Steckman