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

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| Proceeding | 91120453 |
| Party | Plaintiff Hearst Communications, Inc. and Hearst Magazines Property, Inc. |
| Correspondence Address | THEODORE H. DAVIS, JR KILPATRICK STOCKTON LLP 1100 PEACHTREE St, NE, STE 2800 ATLANTA, GA 30309-4530 UNITED STATES TDavis@KilpatrickStockton.com |
| Submission | Rebuttal Brief |
| Filer's Name | Lauren T. Estrin |
| Filer's e-mail | bfitzpatrick@hearst.com, mwanamaker@hearst.com, tdavis@kilpatrickstockton.com, lestrin@kilpatrickstockton.com, kteilhaber@kilpatrickstockton.com |
| Signature | /Lauren T. Estrin/ |
| Date | 11/13/2008 |
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I. INTRODUCTION AND REVISED DESCRIPTION OF THE RECORD

In its opening trial brief, Opposer Hearst Communications, Inc. (“HCI”) described the procedural history and background of this matter, both of which Applicant Charles Browning Wilson accepts as accurate on page 1 of his responsive brief. Applicant also does not dispute HCI’s description of the record in this action.

The “Background” section of Applicant’s responsive brief *does* describe additional facts that he believes are necessary “to clarify ... discrepancies in Opposer’s trial Brief.” HCI questions both the legal significance and relevance of these facts, but, with one exception, does not take issue with the accuracy of that recitation. The sole exception is the claim in footnote 1 of Applicant’s brief that Applicant has legally changed his name, which HCI submits is not supported by record evidence or testimony.

HCI also respectfully seeks leave to advise the Board of a change in the facts underlying this action that has occurred since the close of the parties’ testimony period and the submission of HCI’s opening brief. For reasons unrelated to this proceeding, HCI is suspending publication of its *Cosmo Girl!* magazine on December 1, 2008. No decision has been made regarding the future use of the COSMO GIRL mark in that context, and, indeed, all other uses of the COSMO GIRL mark described in HCI’s testimony and exhibits continue, including the publication of online content under that mark. Nevertheless, HCI invites the Board to resolve this matter without any reliance on the use-based rights to the COSMO GIRL mark for printed publications established by HCI’s evidentiary submissions.

Subject to the two qualifications set forth above, HCI respectfully submits that the parties agree on the facts underlying this action and that there are no evidentiary disputes that might preclude its resolution at this time. Accordingly, HCI respectfully requests the Board to sustain HCI’s opposition and deny registration to Applicant’s mark.

II. ARGUMENT

A. Applicant Has Not Established The Affirmative Defenses Of Laches Or Acquiescence

Applicant's affirmative defenses of laches and acquiescence are without merit because they confuse the right to *register* a particular mark with the right to *use* that mark. Specifically: (1) HCI timely filed its notice of opposition prior to the deadline for doing so, and Applicant therefore cannot demonstrate that HCI unreasonably delayed in asserting its rights; (2) Applicant has not alleged, much less carried his burden of proving, cognizable prejudice resulting from any delay by HCI; (3) HCI has never affirmatively represented to Applicant that HCI would not object to the registration of Applicant's mark; and, in any case, (4) the inevitable confusion between the parties' marks and the public's interest in avoiding that confusion would trump any laches that Applicant might have been able to prove.

1. Applicant Has Not Made A Prima Facie Showing of Either Laches or Acquiescence

The affirmative defenses of laches and acquiescence¹ require proof of related elements. "The defense of laches in a trademark proceeding ... requires a showing of undue delay in asserting rights against a claimant to a conflicting mark and prejudice resulting therefrom." *Nat'l Cable Television Ass'n v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 1580 (Fed. Cir. 1991); *accord Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992). A party claiming acquiescence must demonstrate that (1) the senior party actively represented that it would not assert a right or claim; (2) the delay between the active representation and assertion of the claim was not excusable; and (3) the delay unduly prejudiced the junior party. *See Coach House Rest., Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1558 (11th Cir. 1991). Of compelling significance to this proceeding, even if laches or ac-

¹ Applicant obliquely mentions the concept of acquiescence only a single time, on page 7 of his brief. In light of Applicant's failure expressly to brief the issue, HCI respectfully submits that the Board need not consider it. *See Linville v. Rivard*, 41 U.S.P.Q.2d 1731, 1733 n.5 (T.T.A.B. 1996), *aff'd*, 133 F.3d 1446 (Fed. Cir. 1998). Nevertheless, for the reasons set forth in this brief, Applicant has in case failed to establish a prima facie case of acquiescence.

quiescence exists as to a party's use of an opponent's mark, that does not prevent a challenge to the mark's registration. See generally *Salem Commodities, Inc. v. Miami Margarine Co.*, 244 F.2d 729, 732 (C.C.P.A. 1957); see also *Fitzpatrick v. Sony-BMG Music Entm't, Inc.*, 86 U.S.P.Q.2d 1216, 1220 (S.D.N.Y. 2008) (holding that opposer's failure to bring a civil action did not bar later pursuit of opposition).

Here, neither laches nor acquiescence can exist because HCI did not delay in opposing Applicant's application, much less delay unreasonably. On the contrary, not only did HCI timely file its notice of opposition following publication, it could not have done so before that time. See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:37 (4th ed. 2008) ("[I]n an opposition proceeding laches can only start running from the date when the challenged application was published for opposition."). As a matter of law, Applicant therefore cannot demonstrate its proffered defense: "[I]nasmuch as opposer promptly opposed registration of applicant's mark, applicant has no basis for the defenses of laches, estoppel, or acquiescence." *Callaway Vineyard & Winery v. Endsley Capital Group*, 63 U.S.P.Q.2d 1919, 1923 (T.T.A.B 2002); accord *Lincoln Logs*, 971 F.2d at 734; *Nat'l Cable Television Ass'n*, 937 F.2d at 1581-82; *James Burrough, Ltd. v. LaJoie*, 462 F.2d 570, 572-73 (C.C.P.A. 1972).²

Any claim of laches or acquiescence fails for the additional reason that Applicant cannot demonstrate that it has been prejudiced by HCI's having filed a notice of opposition in the period allowed. "There are two kinds of prejudice which can be asserted to support a defense of laches: (1) the delay has resulted in the loss of evidence which would support the defendants' position; or (2) the defendant has changed [its] position in a way that would not have occurred if the plaintiff had not delayed." *Fin. Co. of Am. v. BankAmerica Corp.*, 502 F. Supp. 593, 596 (D. Md. 1980). As Appli-

² Although not relevant to the disposition of Applicant's claim of laches in the registration context, HCI notes that Applicant would be unable to prove laches even in a district court challenge to the use of his mark. Specifically, the initiation of this opposition has tolled the time for HCI to file an infringement action: "Numerous courts have recognized that pursuing an opposition in the USPTO excuses delay in filing suit on a Lanham Act claim." *Gaudreau v. Am. Promotional Events, Inc.*, 511 F. Supp. 2d 152, 159 (D.D.C. 2007) (citing cases).

cant's papers are devoid of any sworn testimony or documentary evidence bearing on either type of prejudice, HCI is entitled to prevail for this reason as well. *See Charrette Corp. v. Bowater Commc'n Papers Inc.*, 13 U.S.P.Q.2d 2040, 2043 (T.T.A.B. 1989).

Finally, even if Applicant had demonstrated both unreasonable delay *and* prejudice, any claim of acquiescence would fail because of Applicant's failure to aver, much less establish, that HCI has ever affirmatively consented to the registration of Applicant's mark. Although Applicant asserts in this context that HCI was aware of the prior ownership of the *cosmo.com* domain by a third party, the documentary evidence cited by Applicant demonstrates that no affirmative consent occurred: On the contrary, page 7 of Applicant's brief cites to evidence that "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.'"³ Moreover, even if HCI had consented to the use of the same or similar marks by third parties, "[a]cquiescence is a personal defense not triggered by failure to sue others." 3 MCCARTHY, *supra*, § 31:43; *see also TMT N. Am., Inc. v. Magic Touch GmbH*, 124 F.3d 876, 885 (7th Cir. 1997) (noting that plaintiff's acquiescence only applies to defendant's use of the mark). Rather than being lulled into the belief that HCI would never assert a claim against it, Applicant therefore should have drawn the opposite conclusion, namely, that HCI might well choose to protect its rights and revoke the implied license that any acquiescence would represent. *See Menendez v. Holt*, 128 U.S. 514, 525 (1888).

2. Confusion Between the Parties' Marks Is Inevitable

Even if Applicant had proven each of the elements of its affirmative defenses by a preponderance of the evidence, HCI has adduced evidence of substantial actual confusion *from Applicant's own document production*. As the Eleventh Circuit has held, "the public interest in preventing confusion around the marketplace is *paramount*." *Coach House Rest., Inc. v. Coach & Six Rests., Inc.*, 934 F.2d 1551, 1564 (11th Cir. 1991) (emphasis added). As a consequence, a showing of inevitable

³ Ms. Fuller is actually *Cosmopolitan* magazine's former editor in chief, rather than an attorney.

confusion will trump any equitable defenses that junior users may claim. *See, e.g., id.* at 1564; *see also Ultra-White Co. v. Johnson Chem. Indus.*, 465 F.2d 891, 893-94 (C.C.P.A. 1972); *In re Avedis Zildjian Co.*, 394 F.2d 860, 862 (C.C.P.A. 1968). Because the quantum of actual confusion here exceeds that in cases recognizing the inevitable confusion doctrine, any equitable defenses that Applicant might assert any prior reported decision from the Board in which laches and acquiescence have been recognized, Applicant is not entitled to invoke the defenses. *See Angel Flight of Ga., Inc. v. Angel Flight Se., Inc.*, 424 F. Supp. 2d 1366, 169, 1371 (N.D. Ga. 2006) (finding confusion inevitable based on “several,” “four,” and “multiple” instances of actual confusion), *aff’d*, 522 F.3d 1200 (11th Cir. 2008).

B. HCI Has Adduced Undisputed Evidence And Testimony Of Priority And Distinctiveness

Pursuant to a stipulation between the parties, the Board’s April 4, 2006 order authorized the parties to present evidence and testimony in written form. Each party did so, and each cross-examined the other’s witnesses at length through written questions. Particularly as the parties also availed themselves of a lengthy discovery period, there was ample opportunity for either to pursue testimony and evidence that could be used for impeachment purposes.

Where HCI’s prima facie showing of priority of rights and distinctiveness are concerned, however, Applicant has not identified any record evidence or testimony contradicting HCI’s case, but instead argues that HCI’s testimony should be disregarded because it consists of “the statements of its own corporate representative[.]” Because of the requirement that testifying fact witnesses have personal knowledge of the subject of their testimony, Fed. R. Evid. 602, there are no readily apparent third-party witnesses qualified to speak on the issues raised by HCI’s testimony, and, indeed, Applicant fails to identify any alternative candidates. Both the Board and courts alike have therefore consistently accepted testimony from party witnesses, and that result should hold here, especially as virtually all of the testimony of HCI’s witness is corroborated by documentary evidence. *See e.g., In re*

Owens-Corning Fibreglass Corp., 774 F.2d 1116, 1125 (Fed. Cir. 1985) (finding applicant’s mark distinctive based on employee testimony); *see also Am. Sci. Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 793 (9th Cir. 1982) (rejecting proposition that owner of descriptive mark must demonstrate secondary meaning through direct customer testimony or survey evidence). Moreover, as set forth below, the few attempts Applicant has made to take issue with HCI’s factual showings on the subject of prior use and distinctiveness are without record support and therefore do not place HCI’s factual showings in dispute.

1. HCI’s Long-Standing Prior Use of the COSMOPOLITAN and COSMO marks Are Not In Dispute

On pages 17 and 18 of its opening brief, HCI identified a total of 10 separate examples of its own use in commerce of either the COSMOPOLITAN and COSMO mark.⁴ Each of those was supported by undisputed sworn testimony and documentary evidence; several were additionally supported by certified copies of HCI’s certificates of registration. And, as set forth in those and the following pages, the priority date for each occurred prior to the October 18, 1999 filing date of Applicant’s intent to use application.

In response to this showing, Applicant has not alleged any use of its mark that (1) predates the filing date of its application or (2) predates any of the prior uses demonstrated by HCI. Rather, Applicant’s primary argument is that only one of HCI’s showings on this point should be considered – that of HCI’s prior use of the COSMO mark for online services since 1996.

Applicant’s argument confuses the separate and independent inquiries of priority and likelihood of confusion. As set forth in greater detail in HCI’s opening brief, “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. v. Nat’l Starch & Chem. Corp.*, 223 U.S.P.Q. 1244, 1246 (T.T.A.B. 1984) (NATROL confusingly similar to NATROSOL); *see also In re Energy Images, Inc.*, 227 U.S.P.Q.

⁴ As set forth in the revised description of the record on page 1 of this brief, HCI has withdrawn its claim of priority based on the fifth enumerated use on that list.

572, 573 (T.T.A.B. 1985) (SMARTSCAN confusingly similar to SMART); *Giant Food, Inc. v. Rosso & Mastracco, Inc.*, 218 U.S.P.Q. 521, 526-27 (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). Thus, even if they are spelled differently, marks can be confusingly similar if they create the same commercial impression. *See, e.g., Jellibeans, Inc. v. Skating Clubs of Ga.*, 716 F.2d 833, 846 (11th Cir. 1983) (confusion likely between LOLLIPOPS and JELLIBEANS when used in connection with competing skating rinks).

Here, Applicant has failed to identify any record evidence or testimony contradicting HCI's factual showings that Applicant's COSMO.COM mark is substantially identical to HCI's prior-used COSMOPOLITAN.COM, COSMO GIRL, and COSMOPOLITAN marks, particularly as consumers and HCI alike routinely abbreviate "Cosmopolitan" to "Cosmo." (*See, e.g.,* Docket No. 68 ¶ 9 & Ex. B; Docket No. 30 ¶ C & Tabs 12 & 25-75 to Ex. C; Docket No. 52 – Opposers' Second Notice of Rel. ¶ B & Exs. 9-15; Docket No. 52 – First Rodgers Decl. ¶ 7 & Ex. A; Docket No. 30 ¶ C & Tab 12 to Ex. C.) As a consequence, HCI's prior uses of its COSMOPOLITAN and COSMO GIRL marks are just as much appropriate bases for its opposition as are its prior rights to COSMO by itself. Likewise, HCI is equally entitled to rely upon the public's abbreviation of its COSMOPOLITAN marks to COSMO to establish its priority, even if HCI itself had never used COSMO standing alone. *See generally Nat'l Cable Television Ass'n*, 937 F.2d at 1577-78 ("Such public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use 'by' that party in the sense of a use on its behalf."); *accord Johnny Blastoff, Inc. v. Los Angeles Rams Football Co.*, 188 F.3d 427, 434 (7th Cir. 1999); *Big Blue Prods., Inc. v. Int'l Bus. Machs. Corp.*, 19 U.S.P.Q.2d 1072, 1074-75 (T.T.A.B. 1991). Because Applicant has not placed HCI's prior use of

these marks in dispute, there is no basis for a finding that HCI does not enjoy priority of rights to them.⁵

Moreover, even the prior rights to the COSMO mark for online information services that Applicant acknowledges are relevant are not in dispute. As part of its prima facie case, HCI introduced sworn testimony and documentary evidence that it was providing online content under the COSMO mark, including the provision of entertainment-related content, as early as 1996 at HCI's *www.cosmomag.com* website. (Docket No. 74 Resp. No. 5 & Ex. E.) Although suggesting on page 10 of his brief that HCI has not identified the precise day in 1996 on which this use first occurred, Applicant has not identified any record evidence or testimony inconsistent with HCI's showing that it took place at *some* point in 1996. Because even a date as late as December 31, 1996 would still pre-date Applicant's filing date by at least two years, Applicant has failed to contradict HCI's showing of prior rights to this mark, just as Applicant has failed to call HCI's other showings of prior rights into question.⁶

2. Applicant Has Failed To Rebut HCI's Extensive Record That Its COSMOPOLITAN and COSMO Marks Are Strong And Deserve The Highest Degree Of Protection

Applicant's conclusory statements that "Opposer's sole support regarding the distinctiveness of its marks are the numerous federal registrations of its marks" and that "Opposer has not submitted proof in admissible form of the ... distinctiveness of its purported common law trademarks" reflect a misunderstanding of the distinctiveness inquiry. As to the former statement, 15 U.S.C. § 1057(b) provides that registrations less than five years old are prima facie evidence of the validity of the underlying mark, while 15 U.S.C. § 1115 provides that registrations for which declarations of incon-

⁵ This is particularly true where the marks, goods, and services covered by Reg. Nos. 2518660, 2407134, 630028, 1685161, 1911389, 1855579, and 2235977 are concerned, as Applicant, and not HCI, bears the burden of demonstrating priority. *See* 15 U.S.C. § 1057(b).

⁶ In an equally meritless argument, Applicant questions the accuracy of the amended date of first use recited in HCI's application Serial No. 77137373 to register the COSMO mark. That application has not been placed into evidence by HCI, and Applicant's allegations concerning it are therefore irrelevant.

testability have been filed are “conclusive” evidence of validity. This means that ownership of even a non-incontestable registration shifts the burden of proof on distinctiveness from the registrant to any challenger to the mark’s validity. *Emergency One, Inc. v. Am. Fire Eagle Engine Co.*, 332 F.3d 264, 269 (4th Cir. 2003) (noting that registration “shift[s] the burden of proof from the plaintiff ... to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff’s right to such [exclusive] use”); *Am. Throwing Co. v. Famous Bathrobe Co.*, 250 F.2d 377, 380 (C.C.P.A. 1957) (“Where, as here, however, appellee has, by its registrations, established a prima facie case, the burden of proceeding shifts to appellant and it becomes incumbent upon it to refute appellee’s prima facie case if it is to be successful in this proceeding.”). Thus, where the distinctiveness of its registered marks are concerned, HCI need not prove anything – the burden rests on Applicant to prove the contrary.

Of equal importance, the distinctiveness of HCI’s marks is beyond dispute in any event because the marks are inherently distinctive. COSMO, COSMOPOLITAN.COM, and COSMOPOLITAN are each arbitrary marks that do not communicate to consumers any inherent characteristics of, or have any descriptive relationship to, the goods and services associated with them. *See, e.g., John Allan Co. v. Craig Allen Co.*, 505 F. Supp. 2d 986, 1000 (D. Kan. 2007) (“Arbitrary marks use common words, symbols, and pictures that do not suggest or describe any quality or characteristic of the goods or services.”). As a consequence, these marks are presumed to be distinctive from the inception of their use, and no showing of acquired distinctiveness is necessary. *See generally Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

In any case, and despite a lengthy discovery period and the opportunity to cross-examine HCI’s trial witness, Applicant has failed to identify any record evidence or testimony impeaching HCI’s showing of the acquired distinctiveness of HCI’s family of COSMO and COSMOPOLITAN marks, including the circulation figures, revenue, and advertising expenditures set forth in paragraphs 3-6 and 14 of the Rodgers Declaration and at Tabs 12-33 of Exhibit G to HCI’s Notice of Reliance.

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.”); *see also E. Remy Martin & Co. 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). Instead, Applicant simply invokes the specter of alleged third-party uses that allegedly have weakened and diluted the HCI’s marks.

Applicant has not, however, made a cognizable showing of third-party use. Although page 11 of Applicant’s brief asserts, without a supporting citation to the record, that there are active third-party registrations of, or applications to register, marks that include the word COSMO, such data have no probative value in the absence of evidence that the underlying marks actually are in use in the first instance, much less that they are used in the same context in which the parties here use their marks:

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

AMF Inc. v. Am. Leisure Prods., Inc., 474 F.2d 1403, 1406 (C.C.P.A. 1973); *see also In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949, 951 n.5 (T.T.A.B. 1986) (“[W]here a party to a proceeding, whether ex parte or inter parte, introduces copies of *third party* registrations,” such “copies of third-party registrations are incompetent, in and of themselves, to establish that the marks shown therein are in use, or that the public is familiar with them.”); *In re Great Lakes Canning, Inc.*, 227 U.S.P.Q. 483, 485 (T.T.A.B. 1985) (“[T]hird-party registrations are of little probative value because they cannot serve to establish that the marks shown therein are in use or that the public is familiar with them, nor can their existence justify the registration to an applicant of a mark which so resembles a registered mark as to be likely to cause confusion.”). Accordingly, Applicant’s papers fail to demonstrate that HCI’s marks are weak.

Finally, Applicant's argument that HCI's marks lack distinctiveness ignores the substantial evidence of actual confusion reflected in the record. *See, e.g., Am. Sci. Chem.*, 690 F.2d at 793 (reversing finding of no secondary meaning based on evidence of misdirected communications in trade); *see also Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78, 82 (3d Cir. 1982) (accepting survey evidence of actual confusion as probative of secondary meaning); *Brunswick Corp. v. Spinit Reel Co.*, 225 U.S.P.Q. 62, 64 (N.D. Okla. 1984) (same). Because "[e]vidence offered as to actual customer confusion, although also probative of likelihood of confusion, certainly tends to show that the relevant purchasing public associated [the plaintiff's] [mark] with [the plaintiff]," *Tools USA & Equip. Co. v. Champ Frame Straightening Equip.*, 87 F.3d 654, 660 (4th Cir. 1996), this consideration also demonstrates the distinctiveness of HCI's marks.

C. Applicant Has Failed to Rebut HCI's Showing of Likely Confusion Under the *DuPont* Factors

HCI has submitted arguments and evidence on all the factors identified by *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) that are relevant to this case. For its part, Applicant has ignored the *Du Pont* factors completely, choosing instead to rely upon the Second Circuit's (wholly inapposite) test for likely confusion. Even under that test, however, Applicant cannot prevail on the three considerations it has chosen to contest: (1) HCI's extensive evidence of actual confusion; (2) Applicant's putative good faith; and (3) the significance of the sophistication of the parties' customers. Noticeably absent from Applicant's brief is any discussion as to the strength of HCI's marks or the similarities of the parties' marks, goods and services, and/or channels of trade. Thus, the undisputed record evidence and testimony demonstrates that HCI is entitled to prevail because Applicant has conceded that these factors should weigh in favor of HCI. *Nat'l Football League Props., Inc. v. N.J. Giants, Inc.*, 637 F. Supp. 507, 518-19 (D.N.J. 1986) ("Defendant utterly failed to sustain its burden of proof at trial by failing . . . to rebut the presumption that there was a likelihood of confusion"); *Polo Fashions, Inc. v. Branded Apparel Merch., Inc.*, 592 F. Supp. 648, 650-52 (D.

Mass. 1984) (entering summary judgment of liability where plaintiff submitted sufficient evidence to establish likelihood of confusion and defendant offered no evidence to rebut this assertion). As to the remaining *Du Pont* factors, there can be no material dispute that the record demonstrates a likelihood of confusion between Applicant's mark and HCI's marks.

1. Confusion is Actual and Ongoing

In its opening brief, HCI identified extensive documentary evidence, from Applicant's own files and the authenticity of which is undisputed, of actual confusion generated by the use of Applicant's mark. *See generally In re Majestic Distilling Co.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003) (holding evidence of actual confusion "highly probative, if not conclusive, of a high likelihood of confusion."). Applicant does not dispute the existence of that confusion and, indeed, concedes on page 12 of its brief that the e-mails it received were "directed at Opposer's magazine" and that Applicant has continued to receive them, at least "on rare occasions." Rather, Applicant attempts to explain away HCI's showing by arguing that it is (1) hearsay evidence of (2) mere consumer carelessness, rather than confusion. Neither of these propositions can withstand scrutiny.

a. The Extensive Record of Actual Confusion is Not Hearsay

Applicant improperly suggests that HCI's overwhelming record of misdirected e-mails is inadmissible hearsay (App. Br. 12). To the contrary, the Board and numerous courts have repeatedly rejected Applicant's evidentiary objection and admitted actual confusion of all types, including misdirected e-mails, as submitted by HCI. *See, e.g., Armco, Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 1160 (5th Cir. 1982) (holding testimony of misdirected phone calls admissible under the state of mind hearsay exception); *Kraft Gen. Foods, Inc. v. BC-USA, Inc.*, 840 F. Supp. 344, 347-48 (E.D. Pa. 1993) (holding consumer statements admissible under the state of mind hearsay exception).⁷ As

⁷ *See also Conversive, Inc. v. Conversagent, Inc.*, 79 U.S.P.Q.2d 1284, 1292 (C.D. Cal. 2006) (holding confused consumer inquiries admissible); *Fruit-Ices Corp. v. Coolbrands Int'l Inc.*, 335 F. Supp. 2d 412, 426-27 (S.D.N.Y. 2004) (holding statements of confused consumer admissible); *Popular Bank of Fla. v. Banco Popular de Puerto Rico*, 9

the Second Circuit explained in *Fun-Damental Too, Ltd. v. Gemmy Industries*, with respect to testimony of actual confusion by the plaintiff's sales manager:

There is no hearsay problem. Hearsay is an out-of-court statement admitted for the truth of the matter asserted. The testimony in question was not offered to prove that Fun-Damental was actually selling to some retailers at lower prices, but was probative of the declarant's confusion. Further, Federal Rule of Evidence 803(3) allows statements, otherwise excluded as hearsay, to be received to show the declarant's then-existing state of mind.

111 F.3d 993, 1003-04 (2d Cir. 1997) (internal citation omitted). The mountain of evidence of actual confusion before the Board is therefore entirely admissible and probative evidence that confusion is likely to occur.

b. Misdirected Inquiries Are Conclusive Evidence of Actual Confusion

There is no indication, as Applicant argues, that the numerous misdirected inquiries HCI's customers mistakenly sent to Applicant were the result of carelessness. On the contrary, and in addition to subscription and billing matters, those communications address such topics as sexually transmitted diseases, sexual assault, and rape. (Docket No. 30 ¶ E & Ex. E; Docket No. 40 ¶ F & Ex. F.) In light of the serious nature of these issues, the originators of these e-mails cannot be considered cavalier or unconcerned about the recipient of their communications. Nor, having failed to conduct third-party discovery of these individuals, can Applicant argue otherwise. *See Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 762 (2d Cir. 1960) (“[I]t is difficult to understand on what basis the [district] court found that customers who were confused were careless or inattentive. None of such customers was produced as a witness at the trial.”).

Of equal importance, “[c]onfusion on the part of the careless or inattentive purchaser may not be disregarded.” *Id.* at 761; *accord Miller Brewing Co. v. Carling O’Keefe Breweries of Canada, Ltd.*, 452 F. Supp. 429, 448 (W.D.N.Y. 1978). Thus:

F. Supp. 2d 1347, 1360-61 (S.D. Fla. 1998) (same); *Freddie Fuddruckers, Inc. v. Ridgeline, Inc.*, 589 F. Supp. 72, 76 (N.D. Tex. 1984) (same), *aff’d without op.*, 783 F.2d 1062 (5th Cir. 1986).

the first comer's careless customers are as valuable to him as any others; and their carelessness can hardly be charged to him. Why they should be deemed more legitimate game for a poacher than his careful buyers, it is hard to see, unless it be on the ground that he should have made his mark so conspicuous that it would serve to hold even the most heedless. Surely that is an inadequate defence.

Am. Chicle Co. v. Topps Chewing Gum, Inc., 208 F.2d 560, 563 (2d Cir. 1953) (L. Hand, J.).

Here, Applicant's own files have yielded multiple examples of confusion, which are considerably more than "an occasional misdirected letter." See *Rockland Mortgage Corp. v. Shareholders Funding, Inc.*, 835 F. Supp. 182, 197 (D. Del. 1993) (finding confusion likely based in part on misdirected communications allegedly attributable to carelessness); see also *Morningside Group Ltd. v. Morningside Capital Group L.L.C.*, 182 F.3d 133, 141 (2d Cir. 1999) ("[It is] important to the actual confusion factor the evidence that consumers placed phone calls to the wrong party and mistakenly believed that plaintiff's and defendant's services were affiliated because of their similar names. That is precisely the type of evidence presented by [the plaintiff]."); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 978 n.20 (11th Cir. 1983) (rejecting defendant's attempt to discount misplaced order caused by information being entered on form "by mistake"); *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1166-67 (11th Cir. 1982) (reversing finding of no likelihood of confusion based on single misdirected letter and single misdirected customer inquiry); *Technicon Co. v. Erickson Tool Co.*, 116 U.S.P.Q. 97, 98-99 (Comm'r Pat. 1958) (affirming finding of likely confusion based in part on single misdirected letter and single misdirected telegram).⁸

Applicant's suggestion that the 2001 and 2002 dates of production of this evidence merit giving the evidence less weight is equally without merit. Page 5 of Applicant's trial brief recites that the

⁸ The quantum and nature of the undisputed evidence of significant actual confusion distinguishes this proceeding from the cases cited in Applicant's brief. For example, in *Lang v. Retirement Living Publishing Co.*, 949 F.2d 576 (1991), the plaintiff received phone calls intended for the defendant; however, the plaintiff could not provide that these calls were prospective purchasers of the plaintiff's products, and therefore, they were not considered by the court. Here, in contrast, Applicant received numerous e-mails that on their face demonstrate they are from HCI's current and prospective customers and, indeed, Applicant does not contend otherwise. The e-mails mistakenly sent to Applicant are also substantially different from the evidence of actual confusion submitted in *United States Blind Stitch Machine Corp. v. Union Special Machine Co.*, 287 F. Supp. 468, 471 (S.D.N.Y. 1968), which was caused by "the identical abbreviations of corporate names not attributable to the marks in question."

use of Applicant's mark began "in 1999." Even assuming that that use began on December 31, 1999, HCI has adduced documentary evidence of 131 examples of misdirected correspondence between January 1, 2000 and the July 19, 2002 date of Applicant's last production of documents responsive to HCI's written discovery requests alone. (Docket No. 30 Ex. E) Confusion did not magically end on the latter date, and, to reiterate, Applicant concedes that it has continued. Rather than demonstrating that actual confusion in this case is rare, the record shows that it was pervasive within the limited period of time covered by Applicant's production. As a consequence, that documentary evidence of that confusion ends in July of 2002 is probative of nothing more than the timing of Applicant's last document production.⁹

2. Applicant Admits HCI's Customers Are Unsophisticated

Applicant acknowledges that HCI's customers are unsophisticated, and therefore, more likely to be confused (App. Br. 14); rather, Applicant faults HCI for failing to identify sophisticated consumers among those actually confused. The existence of some sophisticated consumers among a larger population of unsophisticated ones, however, does not render the entire population less susceptible to confusion. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005) (affirming finding of likely confusion between marks used on competing sparkling wine on ground that "general consumers, not just connoisseurs, occasionally purchase champagne or sparkling wines on celebratory occasions, with little care or prior knowledge"). Contrary to Applicant's argument on this point, therefore, the age of HCI's target audience and lack of sophistication among Internet users make confusion more, and not less, likely.

⁹ Current counsel for both parties were retained after the discovery period in this action had closed.

3. Applicant's "Good Faith" Is Irrelevant Because His Name Is Still Confusingly Similar to HCI's Marks

Although evidence of bad faith adoption typically will weigh against an applicant, good faith adoption typically does not aid an applicant attempting to establish no likelihood of confusion. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1640 (T.T.A.B. 1988). This rule applies with full force in cases in which junior users seek to use or register their own names in the face of prior claims of rights to the same names. Thus, in *In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008), the Board denied registration to personal name mark with the observation that "[t]he fact that 'Sam Edelman' is an individual's name does not give applicant an unfettered right to use that name as a mark if it conflicts with a previously registered mark." *Id.* at 1217. Similarly here, the fact that Applicant may have legally added the word "Cosmo" to his formal name is inapposite. This does not excuse the pervasive confusion that his mark has generated in the marketplace.

Indeed, even if a junior user has the right to use the very same mark or designation as a prior user, the Lanham Act requires that the applicant must nonetheless take "every reasonable precaution" to prevent confusion with the use of the same designation by another. *See e.g., Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 121 (1938) (imposing obligation on multiple users of "SHREDDED WHEAT" mark "to use every reasonable means to prevent confusion"); *Sterling Drug Inc. v. Bayer AG*, 792 F. Supp. 1357, 1372 (S.D.N.Y. 1992) (Lanham Act applies even where both parties had contractual rights to mark); *Holiday Inns, Inc. v. Holiday Inn*, 364 F. Supp. 775, 784 (D.S.C. 1973) (defendant's right to coexist in limited geographic area "does not excuse the defendant from its course of conduct in infringing upon the plaintiff's trademarks."), *aff'd*, 498 F.2d 1397 (4th Cir. 1974).¹⁰

¹⁰ *See also Forschner Group v. Arrow Trading Co.*, 30 F.3d 348, 357-60 (2d Cir 1994); *P. Daussa Corp. v. Sutton Cosmetics (P.R.) Inc.*, 462 F.2d 134, 136 (2d Cir. 1972) (reversing denial of preliminary injunction, holding that even if defendant was entitled to use the identical mark as plaintiff, "to protect the public, each company would have to differentiate its product from that of the other company"); *Blinded Veterans Ass'n v. Blinded Am. Veterans*

Indeed, irrespective of Applicant's alleged nickname, his intent is clear: To trade off the heritage and good will that accompany the COSMO Marks by providing a web page at *cosmo.com*, irrespective of HCI's senior rights in those marks. With full knowledge of HCI's senior rights, Applicant has recklessly undertaken to trade on the over 100-year old heritage of the COSMOPOLITAN Marks. Given Applicant's knowledge of HCI's mark and adoption of its confusingly similar mark, a finding of likely confusion is appropriate under the principal 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." *Academy of Motion Picture Arts & Scis. v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991). Because "wrongful intent appears easy to infer where defendant knew of plaintiff's mark, had freedom to choose any mark, and 'just happened' to choose a mark confusingly similar to plaintiff's mark," 3 MCCARTHY, *supra*, § 23:115, this factor also weighs in HCI's favor.

D. HCI Has Presented Uncontested Evidence And Testimony Of The Fame Of Its COSMOPLITAN and COSMO Marks

Applicant's argument that HCI's showing of fame is limited to the COSMOPOLITAN mark is patently false. In its Trial Brief, HCI presented un rebutted evidence that HCI's family of both COSMOPOLITAN and COSMO Marks are famous under the TDRA's list of non-exclusive factors for evaluating fame. HCI's discussion of the relevant factors includes extensive evidence demonstrating that the COSMOPOLITAN and COSMO marks are famous based on HCI's longstanding use and promotion of these marks and the public's widespread recognition of these marks as a reference to HCI.

For example, as shown by HCI's testimony and in its Trial Brief, HCI has extensively advertised and used both the COSMOPOLITAN and COSMO marks in connection with a wide variety of goods and services for over 100 years. (Opposer's Br. 36-37; Docket No. 52 – First Rodgers Decl.

Found., 872 F.2d 1035, 1045 (D.C. Cir. 1989) (requiring junior user of even a generic term "to distinguish its product or to notify consumers explicitly that its product does not come from the original manufacturer").

¶ 4.) Contrary to Applicant’s assertion, HCI’s evidence of fame is not limited to the COSMOPOLITAN mark. HCI has submitted conclusive evidence demonstrating that its family of both COSMOPOLITAN and COSMO marks are promoted in nearly every media throughout the world and United States. (*See id.* ¶¶ 4, 7, 14; Docket No. 74 Resp. Nos. 5, 20, 21.) HCI has also shown extensive sales of goods and services sold under both its COSMO and COSMOPOLITAN marks. (Docket No. 52 – First Rodgers Decl. ¶¶ 11, 13.) As in the distinctiveness context, however, Applicant has identified no evidence or testimony placing HCI’s showing into dispute. The record of HCI’s use and promotion of its COSMO and COSMOPOLITAN marks confirms that they 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,” 15 U.S.C. § 1125(c)(2)(A), and therefore entitled to protection against dilution

III. CONCLUSION

Applicant has not overcome HCI’s record testimony and evidence, which 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. In the absence of record evidence or testimony to the contrary, HCI has also shown that Applicant’s mark is likely to dilute the distinctiveness of HCI’s family of COSMOPOLITAN and COSMO Marks. HCI therefore respectfully requests the Board to sustain the opposition and deny registration to Applicant’s mark.

This 13th day of November, 2008.

Respectfully submitted,

KILPATRICK STOCKTON LLP
1100 Peachtree Street, NE
Atlanta, Georgia 30309-4530
Tel: (404) 815-6500
Fax: (404) 815-6555

/Theodore H. Davis Jr./
Theodore H. Davis Jr.
Olivia Maria Baratta
Lauren T. Estrin

Attorneys for Opposer Hearst Communications, Inc.

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

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| v. |) | |
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| Charles Browning Wilson, |) | |
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| Applicant. |) | |

CERTIFICATE OF SERVICE

This is to certify that the attached **Opposer's Reply 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.
The Law Office of Robert Steckman, P.C.
111 John Street, 8th Floor
New York, New York 10038

This 13th day of November, 2008.

/Christy Flagler/
Christy Flagler