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

Proceeding	91167207
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

ANITA DHALIWAL, an Individual	)	
	)	Opposition No. 91167207
Opposer,	)	Re: DVD WORLD
	)	Serial No.: 78495856
v.	)	
	)	
DVD WORLD PICTURES CORP.	)	
	)	
Applicant.	)	
	)	
	)	
	)	
	)	

**OPPOSER'S TRIAL BRIEF**

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Opposer Anita Dhaliwal (“Opposer” or “Dhaliwal”) hereby submits her Opening Brief in support of the opposition to Applicant DVD World Pictures Corp.’s (“Applicant”) application for trademark registration of DVD WORLD (in standard characters), Serial No. 78/495856, in International Classes 35 & 41.

## **I. INTRODUCTION**

In the world of DVD sells and rentals, the mark—DVD WORLD—is common and ubiquitous. DVD WORLD, which can be understood to broadly mean the world of digital video disks, is descriptive of goods and services pertaining to DVDs. It is thus not surprising that there are countless businesses that sell or rent DVDs using some variation of the unremarkable name DVD WORLD. In addition to brick-and-mortar stores all over the country that call themselves DVD WORLD, there are well over 200 domain names based on the same mark. In fact, the mark is so ubiquitous that Applicant states in its advertising flyer that it had to change its own name “Due To the Numerous Amounts of International Stores That Were Saying They Were ‘DVD WORLD’ But Weren’t.” See Testimony of Edwin Papetti (“Papetti Testimony”), Exh. 3. Applicant can hardly claim exclusive rights to a mark that it admits is widely used by others.

Moreover, amidst the widespread usage of DVD WORLD in the marketplace, Applicant itself does not use the mark in any way to identify its own particular goods and services. The Applicant is DVD World Pictures Corp., but this company has no advertising or website using the mark at issue to uniquely identify its own goods and services. As set forth below, DVD World Pictures Corp. does not sell DVDs online. *Id.* at 15:10-22, 19:6-8, 35:8-20, and 53:15-17.

Because DVD WORLD is a weak mark, widely used by others, and not used by Applicant in connection with its designated goods and services, Applicant should not be granted the exclusive rights attendant with registration, which would enable it to mount a campaign to exclude others who have been long using the same mark.

## **II. DESCRIPTION OF THE RECORD**

Pursuant to Trademark Rule 2.122(b), 37 CFR 2.122(b), the evidence of record consists of the application file at issue, Ser. No. 78495856, and the pleadings in this proceeding.

In addition, Opposer submitted the following evidence:

- The testimonial deposition of Dave Lahoti, and exhibits thereto.
- The testimonial deposition of Edwin Papetti, and exhibits thereto.

Applicant submitted the following notices of reliance and testimony:

- Applicant's First Notice of Reliance, and exhibits thereto.
- Applicant's Second Notice of Reliance, and exhibits thereto.
- Applicant's Third Notice of Reliance, and exhibits thereto.
- The testimonial deposition of Anita Dhaliwal, and exhibits thereto.

## **III. STATEMENT OF FACTS**

Opposer Dhaliwal is the owner of the domain name [www.dvdworld.com](http://www.dvdworld.com). In partnership with her brother, Dave Lahoti ("Lahoti"), Dhaliwal purchased the domain name at an Internet domain name auction on or about December 2, 2004 for \$20,010. *See* Testimony of Anita Dhaliwal ("Dhaliwal Testimony") at 28:21 – 30:9; *see also*, Testimony of Dave Lahoti ("Lahoti Testimony") at 6:25 – 7:9. Dhaliwal purchased the domain name with the intent of using it to sell DVDs (or, in the

alternative, to resell the domain name to others). *Id.* Dhaliwal also owns and operates other Internet sites, including [divavillage.com](http://divavillage.com), a site offering a potpourri of features, such as beauty products, celebrity news, etc. *See* Dhaliwal Testimony at 25:21 - 26:11.

Not long after Dhaliwal purchased [www.dvdworld.com](http://www.dvdworld.com), she received on or about December 22, 2004 an email from The DVD World Company, which claimed ownership of the domain name [www.dvdworldonline.com](http://www.dvdworldonline.com) and alleged exclusive rights to use the words "DVD WORLD" in connection with the online retail sales of DVDs. *See* Lahoti Testimony, Exh. 1. The email falsely alleged trademark infringement against Dhaliwal for the mere registration of the inactive domain name [www.dvdworld.com](http://www.dvdworld.com) and demanded transfer of that domain name to The DVD World Company. *Id.*

The Applicant—*i.e.* DVD World Pictures Corp.—is a New York corporation owned and operated by Edwin Papetti. *See* Applicant's First Notice of Reliance, Exh. 5; *see also*, Papetti Testimony at 8:7-12, 16:13-15. According to Papetti, DVD World Pictures Corp. was "formed to finance major motion pictures." *Id.* at 18:20-22; Exh. 33 (p. 3). It is also involved in live event recording and DVD creation. *Id.* at 14: 17-25. However, DVD World Pictures Corp. does not sell commercial DVDs. *Id.* at 15:10-22, 19:6-8, 35:8-20, and 53:15-17.

Instead, Papetti sells DVDs through The DVD World Company, a sole proprietorship (not a corporation). *See* Papetti Testimony at 16:2-12. In addition, Papetti operates hundreds of domain names. *Id.* at. 21:15-19, 89:14. Of these, the Applicant claims to sell DVDs on-line primarily through the website

www.dvdworldonline.com, which is owned by The DVD World Company. *Id.* at 21:15–22:3.

On October 6, 2004, the Applicant filed the instant federal trademark application for the word mark DVD WORLD (Serial No. 78495856). The Applicant claimed a first date of use of the mark in commerce of November 19, 1998 for online retail store services and distributorships of DVD movies in International Class 35 and for motion picture production and distribution in International Class 41. The specimen submitted in support of the claimed usage for both classes is a digital image of a webpage having the domain: thedvdworldcompany.com.

Applicant also holds a federal trademark registration for the composite mark DVD WORLD (Registration No. 2,912,970), with a registration date of December 21, 2004.<sup>1</sup> *See* Papetti Testimony, Exh. 44. The composite mark is comprised of a disk overlaid with a map of the world bearing the words DVD WORLD. *Id.* Both the composite mark and the word mark at issue are alleged to have the same scope of goods and the same dates of first use and first use in commerce.

### **III. ARGUMENT**

Applicant should be denied registration of the mark DVD WORLD, not only because it is merely descriptive, but also because Applicant has failed to use DVD WORLD as a source identifier for its claimed goods and services. Therefore, the opposition must be sustained.

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<sup>1</sup> At the time Dhaliwal purchased the domain name in 2004, Applicant did not have the U.S. Registration 2,912,970 for the composite mark DVD WORLD.

**A. Applicant's Application for Registration of DVD WORLD Must Be Denied Because the Mark Is Descriptive**

**1. The Test for Descriptiveness**

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982).

As the Board has long noted, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

In other words, **"[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them."** *In re Tower Tech Inc.*,

64 USPQ2d 1314, 1317 (TTAB 2002) (emphasis added); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Assoc. of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990). Thus, “[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

## 2. DVD WORLD Is Descriptive

The question here is whether consumers, knowing that the goods at issue are DVDs, would immediately understand that DVD WORLD directly conveys information about DVDs, such as their sale and distribution. Put differently, if consumers know that Applicant’s goods are DVDs, then the question is: how does DVD WORLD *not* describe the stated goods and services?

The term “DVD” itself is generic. *In re Thomas W. Sherwood*, 2003 WL 22245936 (TTAB 2003)(noting generic nature of the term “DVD”). Indeed, Applicant has disclaimed any exclusive right to DVD apart from the mark.<sup>2</sup>

The word “WORLD”<sup>3</sup> merely indicates that Applicant sells DVDs “across the world.” See Papetti Testimony, Exh. 23; see also, *id.* at 34:20-25. In discovery, the Applicant stated that it “sells it’s [*sic*] products to everyone in the world...There is not one country DVD World does not ship to or sell to...DVD World sells across the

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<sup>2</sup> See Applicant’s Response to Office Action, submitted February 27, 2004.

<sup>3</sup> According to Cambridge Dictionaries Online, “world” means, *inter alia*, “a group of things ... or an area of human activity.” See [http://dictionary.cambridge.org/dictionary/british/world\\_2](http://dictionary.cambridge.org/dictionary/british/world_2). The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); see also, *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

world.” *Id.* In particular, Applicant’s “websites clearly show that we ship everywhere.” *Id.*

The combination of the generic term “DVD” with the descriptive word “WORLD,” results in a composite phrase that is, at best, descriptive. DVD WORLD can readily be understood to indicate that Applicant sells and distribute its DVDs throughout the world. The combination of generic and descriptive terms, in such a way that each term retains its generic/descriptive significance in relation to the goods and services, makes the entire phrase descriptive. DVD WORLD directly and immediately inform consumers of the significant features of the goods and services set forth in the application, namely, that Applicant’s DVDs are available globally. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1997)(holding APPLE PIE merely descriptive of potpourri mixture); *In re American Greetings Corp., supra*, 226 USPQ at 366 (APRICOT is merely descriptive of apricot-scented dolls).

### **3. DVD WORLD Is Not Suggestive**

The addition of the word “WORLD” to DVD does not make the mark suggestive. A mark is suggestive only if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates. *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). Here, when consumers encounter DVDs under the mark, no multi-stage reasoning or imagination is required to determine the attributes of the goods and services indicated by DVD WORLD.

As noted, “DVD” is a generic term for digital video disks. In order for DVD WORLD to be suggestive, the word “WORLD” would have to be strongly suggestive

to overcome the genericness of “DVD”. But the word “WORLD” is not strongly suggestive. Aside from describing the fact that Applicant’s DVDs are available “across the world,” the word “WORLD” can also be understood according to its common meaning, denoting a sphere, realm, or domain—a ‘marketplace,’ as it were—for goods and services. Hence, DVD WORLD can be understood to indicate the world of DVDs, or a marketplace for DVDs, encompassing within its broad meaning the sort of goods and services designated in the application at issue.

This does not make the mark suggestive because the general public has to come to understand that “WORLD” is commonly used to denote a ‘marketplace’ of goods and services, as exemplified by the numerous examples of marks containing “world” cited by Applicant. *See* Applicant’s First Notice of Reliance, Exh. 3. By virtue of adopting the broadly-defined word “WORLD” as part of its mark, Applicant created a mark that is purposely broad and general, but weak, in its impression. Since “DVD” defines completely the nature of the goods at issue, “WORLD” adds little, if any, distinctiveness to the mark. It is precisely because DVD WORLD is so broad and so general that consumers can immediately recognize the goods and services that Applicant offers.

Because the Applicant’s goods and services are not in anyway incongruous in connection with the mark, consumers do not have to exercise multi-stage reasoning or otherwise strain their imagination to understand that DVD WORLD is about, among other things, the sale of DVDs. *In re H.U.D.D.L.E., supra*, 216 USPQ at 359 (a term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive;

rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services). Therefore, DVD WORLD does not create in the mind of the average consumer a “mental hiccup” (to borrow an expression previously used by this Board)<sup>4</sup> that would make the mark suggestive rather than descriptive.

**B. Third-Party Registrations of Marks Utilizing the Term WORLD Does Not Make Applicant’s Mark Likewise Registerable**

In an effort to demonstrate that DVD WORLD is suggestive, Applicant has submitted into the record examples of third-party registrations to show that other marks that include the word “WORLD” have been registered. *See* Applicant’s First Notice of Reliance, Exh. 3. This is of no probative value. It is well-settled that third-party registrations are not determinative on the issue of descriptiveness. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). Each case must be decided on its own merits. *Id.* Of course, this Board is not bound by previous decisions of examining attorneys to register other marks which may or may not be descriptive of the goods or services with which they are used. *In re Pennzoil Products, Co.*, 20 USPQ2d 1753 (TTAB 1991).

Regardless, while the use of “WORLD” in some of these examples may create unique, incongruous, or nondescriptive meaning, in this case, each component of Applicant’s mark, DVD WORLD, retains its descriptive significance and the combination as a whole is merely descriptive of the Applicant’s goods and services. For example, “Ferrari World” generally denotes all things relating to Ferraris, as

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<sup>4</sup> *In re TCL Govideo*, 2006 WL 2558017 (TTAB 2006).

indicated by the broad listing of goods and services on the registration of “Ferrari World”. *See* Applicant’s First Notice of Reliance, Exh. 3.<sup>5</sup> But whereas Ferrari is arbitrary or fanciful, DVD is not. Its utter genericness is what makes the mark at issue useless as a source identifier. Though “world” can be suggestive in certain contexts, in this case DVD WORLD merely describes Applicant’s goods and services relating to DVDs.

**C. Applicant Has NO Exclusive Rights to DVD WORLD Because Many Other Third-Parties Already Use DVD WORLD in Commerce**

Further, whatever slight distinctiveness DVD WORLD may have had is lost by its widespread use in the marketplace. Evidence of widespread use by others is evidence that the term does not function as a mark. *See, e.g., Data National Corp. v. BellSouth Corp.*, 18 USPQ2d 1862, 1865 (TTAB 1991) (“because the public is accustomed to seeing the walking fingers logo on all classified telephone directories, wherever it may encounter them, it will not regard the logo as a trademark but merely as an informational symbol which denotes yellow pages”).

That DVD WORLD has no distinctive weight as a source-identifying mark is demonstrated by the fact that there are numerous other entities using DVD WORLD. **There are at least 206 other domain names using DVD WORLD in interstate commerce for the retail sale of DVDs.** *See* Lahoti Testimony, Exh. 5. Some of these include, for example, *sonydvdworld.com*, *thedvdworld.com*, *musicdvdworld.com*, *mydvdworld.com*, *dvdworldusa.com*, etc. *Id.* Lahoti testified that he found “at least

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<sup>5</sup> The “Ferrari World” registration (no. 3,619,525) is labeled “Applicant 1031” in Exhibit 3.

half a dozen” companies that sell DVDs online using domain names containing “dvdworld”:

Q And did you determine whether any of these domain names with “dvdworld” in them were selling DVDs?

A Yes.

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Q Well, do you remember approximately how many sites were actually selling DVDs that contained “dvdworld” in the domain name?

A I think I must have encountered at least half a dozen, and then maybe I just pretty much stopped there and thought, well, that’s pretty much – I don’t – you know, I was pretty convinced it was a lot. So I must have encountered about a half dozen, at least.

\*\*\*

Q Okay. And did you determine that these were different businesses or all one business?

A Oh, they were all different – they were all different businesses, yeah. They’re not any one entity. Definitely, they were -- these were distinct addresses of business, based on the “Contact Us” information. They were unaffiliated with each other.

Q Okay. So the term “dvdworld” did not designate a single source; is that correct?

A Yes; that’s correct.

See Lahoti Testimony at 8:3 – 9:11.

In particular, Lahoti testified that he contacted one company based in Oregon advertising itself as DVD World. See Lahoti Testimony, Exh. 65. Its flier states that DVD World opened in November 2002. *Id.* Lahoti testified that he contacted this company:

Q And did you attempt to contact DVD World in Oregon?

A Yes.

\*\*\*

Q What was the result of that contact?

A I recall that they answered as “DVD World”...And so the person that answered the phone seemed to answer consistent with this advertisement.

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- Q And so did you determine whether this was an actual brick-and-mortar store?
- A At least I know that it's a brick-and-mortar store...

*See* Lahoti Testimony at 11:22 – 12:16.

Applicant does not and cannot dispute the evidence that DVD WORLD is widely used in the marketplace for exactly the kinds of goods and services that Applicant provides. Papetti himself testified that he is aware “of at least one other store” that was using DVD WORLD. *See* Papetti Testimony at 26:4-6. Most notably, Applicant stated in its own advertising flyer that it had changed its name to “DVD WORLD ONLINE” to avoid being confused with numerous others calling themselves DVD WORLD:

The Following Year Would Bring A Name Change To “DVD WORLD”, It Would Now Be Called “DVD WORLD ONLINE”. This Was Done Due To the Numerous Amounts of International Stores That Were Saying They Were ‘DVD WORLD’ But Weren’t.

*See* Papetti Testimony, Exh. 3; *see also, id.* at 25:8-25. This is objective evidence of abandonment. The unfettered use of DVD WORLD by others not only fatally weakened the mark, it caused Applicant to change its own name, thereby abandoning whatever rights it may have established in the mark. Applicant cannot now claim exclusive right to DVD WORLD when it changed its own name to avoid the myriad of other DVD WORLDS.

Given the widespread use of DVD WORLD by countless others for the same or similar goods and services, to grant Applicant exclusive right to the mark would undermine competition in the marketplace. In *In re Abcor, supra*, the former Court of Customs and Patent Appeals noted the reasons for refusing registration of a

merely descriptive mark are: “(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.” 588 F.2d at 813; 200 USPQ at 217. Here, Applicant has already tried to inhibit competition by demanding that Opposer stop using the domain name that Opposer rightfully purchased at auction. *See Lahoti Testimony, Exh. 1.* Threatening litigation, Applicant demanded that Opposer transfer the domain name without compensation. *Id.* It is clear from these sort of extortionary tactics that if registration were granted, it would open the door for Applicant to bring harassing suits against Opposer and countless others who are using the mark.

**D. Applicant Does Not Use the Mark as a Source Identifier**

Not only are there myriad of other users of DVD WORLD, but Applicant itself has failed to use the mark as a trademark indicative of source. It is a truism that trademark ownership inures to the legal entity who is in fact using the mark as a symbol of origin. The Supreme Court explained long ago that “the right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another’s product as his.” *See Buti v. Perosa*, 139 F.3d 98 (2d Cir. 1998)(quoting *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)). Here, Applicant has not used the DVD WORLD mark as a trademark to designate its goods and services as products of DVD World Pictures Corporation.

The sole Applicant in this proceeding is DVD World Pictures Corp., a legal entity incorporated in the State of New York. *See* Applicant's First Notice of Reliance, Exh. 5. As noted above, it is owned by Papetti, who is also the sole proprietor of The DVD World Company. *See* Papetti Testimony at 15:23 – 16:23. The DVD World Company has a division called HD DVD World. *Id.* at 15:12-22. To further confuse the matter, DVD World Company also owns DVD Destination, yet another sole proprietorship of Papetti, which is folded into HD DVD World. *Id.* at 17:15 – 18:7. But as Papetti testified, it is DVD World Pictures Corp. that is alleged to be "the trademark holder" of the DVD WORLD mark. *Id.* at 20:23-24.

**1. The DVD WORLD Mark Is Used as a Domain Name That Does Not Identify Applicant**

So how is the mark DVD WORLD used to identify the Applicant, DVD World Pictures Corp., and not one of Papetti's many other entities? There is no clear answer. Applicant has no brick-and-mortar presence; rather, substantially all of its business under the DVD WORLD mark for online retail distribution of DVD movies in International Class 35 takes place at the website [www.dvdworldonline.com](http://www.dvdworldonline.com). *See* Papetti Testimony at 34:1 – 35:20; *see also*, Exh. 23. In other words, its claim on the DVD WORLD mark for online retail sales of DVDs is entirely based on the site [www.dvdworldonline.com](http://www.dvdworldonline.com).

A domain name that serves the purely technological function of locating a Web site in cyberspace does not become a trademark unless it is also used to identify and distinguish the source of goods and services. *See, e.g., Data Concepts, Inc. v Digital Consulting, Inc.*, 150 F.3d 620, 627 (6<sup>th</sup> Cir. 1998)(Merritt, J., concurring:

“When a domain name is used only to indicate an address on the Internet and not to identify the source of specific goods and services, the name is not functioning as a trademark.”); *Brookfield Comm., Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1052 (9<sup>th</sup> Cir. 1999); *Newborn v. Yahoo! Inc.*, 391 F.Supp.2d 181 (D.D.C. 2005).

Here, Papetti testified that [www.dvdworldonline.com](http://www.dvdworldonline.com) is a domain name shared by other entities:

A We have over 107 domain names with the “DVD World” name in them **that go to the HD DVD World site**. The most prominent are DVD World Online, HDDVDWorld.Com, and the other 105 remaining domain names that contain the DVD World mark in them.

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Q So if I go to your website now, it’s called “DVD World”?

A No. It’s **“HD DVD World,”** and then it has the DVD World mark. The DVD World mark has always been present on all of our Websites.

See Papetti Testimony at 21:15 – 22:25 (emphasis added); see also, Exh. 23. As such, there is not even a designated site for DVD World Pictures Corporation.

Papetti goes on to explain that, in fact, none of the sales that occur via [www.dvdworldonline.com](http://www.dvdworldonline.com) are actually sold through Applicant, DVD World Pictures Corp.:

Q Was it ever a purpose of DVD World Pictures Corporation to sell commercially available movies?

A No, because that’s handled by HD DVD World.

See Papetti Testimony at 19:6-8.

Q And are these the 107 domain names that you were referring to earlier?

A I believe this is some of them. I believe this is not all of them...

\*\*\*

Q Do any of them go to a different website that you run?

MR. PELTON: I object to the relevance.

THE WITNESS: The DVD World Company site would go to the DVD World Company website. DVD World Home Video domain names would go to DVD World Home Video websites. And DVD World Pictures would go to that specific website as well...

\*\*\*

Q Do any sales of DVD's that are sold on the website that I can access through DVDWorldOnline.Com - are any of those DVD sales sold through DVD World Pictures Corporation: yes or no?

A The DVD's are available through DVDWorldOnline.Com or HDDVDWorld.Com are commercially available titles. They are not created by DVD World Pictures.

Q **And none of the sales that occur on DVDWorldOnline.Com or HDDVDWorld.Com go through DVD World Pictures Corporation; correct?**

A **That's correct.**

See Papetti Testimony at 33:20 - 35:20 (emphasis added). In short, the DVD WORLD mark is not used to identify any goods of the Applicant, DVD World Pictures Corp., because DVD World Pictures Corp. does not sell the DVDs.

Q Has the DVD World Pictures Corporation website ever sold any DVD's?

A The actual site? No. No, it has not.

See Papetti Testimony at 53:15-17.

To confuse the matter further, [www.dvdworldonline.com](http://www.dvdworldonline.com) was merged with another domain that virtually led users down a rabbit hole.

Q And the DVD Destination site is the one that you reach by typing in "DVDWorldOnline.Com" or "HDDVDWorld.Com"; correct?

A The only time HDDVDWorld.Com pointed to DVD Destination was before the release of the HD DVD format, at which time HD DVD World had its own domain name and website. The DVD Destination site was pointed to by DVDWorldOnline.Com when we merged the DVD World Online and DVD Destination websites.

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Q When was DVDDestination.Com and DVDWorldOnline.Com merged?

A Based on this, sometime in 2006...

\*\*\*

Q Is DVD Destination – is that the name of the website?

A At this time, “DVD Destination” was in the left-hand corner, and “DVD World” appeared in the middle. You could get there by either going to DVDDestination.Com or DVDWorldOnline.Com. So it was DVD World or DVD Destination, whichever the person wanted to recognize. It was still, as noted in the left-hand corner, a division of the DVD World Company.

Q Has the DVD Destination site ever indicated that it was owned by DVD World Pictures Corporation?

A It’s not owned by DVD World Pictures Corporation. It’s owned by the DVD World Company, and it does reflect that and always did.

*See Papetti Testimony at 58:15 – 60:24.*

## **2. No Advertisements Using Mark to Distinguish Applicant**

Further still, there is no advertising to show that DVD WORLD is used to identify DVD World Pictures Corporation or otherwise to show that the mark is used to distinguish the Applicant from the other related entities. The scant advertisements in the record are for other entities. *See Papetti Testimony, Exh. 28.*

Papetti testified:

Q And can you tell me what they are?

A They’re various advertisements, and they are DVD cover art for DVD World Home Video recorded events.

\*\*\*

Q And these all relate to DVD World Home Video presentations; correct?

A Yes.

Q And none of these are sold on the DVDWorldOnline.Com site; correct?

A Correct.

See Papetti Testimony at 48:15 – 49:1. Moreover, the advertisements (featuring the composite mark) conflate the goods and services of Papetti’s various companies. *Id.*, Exh. 31.

Q Can you tell me what this is?

A This appears to be another advertisement for the company and its services.

Q So all of the things described on this page are things that DVD World Company does?

A Yes

Q Including tax services?

A Yes

Q And of the things listed on this page, which ones of them are done by DVD World Pictures Corporation, if any?

A That’s the video production and reproduction.

\*\*\*

Q Anything else?

A The rest would all be considered just under the general company, just like DVD World Pictures itself is.

*Id.* at 50:10 – 51:6.

It is neigh impossible for the public to determine who is who, or who is doing what, among all these different entities. Given the changing faces of these different entities, all of which are using variants of the mark, Applicant’s usage of DVD WORLD can hardly be considered indicative of source.<sup>6</sup> Accordingly, Applicant is not entitled to registration as a matter of law.

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<sup>6</sup> As a side note, it is well established that if the applicant identified in the application is not the owner of the mark sought to be registered, the applicant may not be amended to substitute a different entity; the application is void *ab initio*, and a new application must be filed on behalf of the true owner. *See, e.g., Celanese Corp. of Am. V. Edwin Cruthcer*, 35 U.S.P.Q. 98 (Comm. Pats. 1937); *Richardson Corp. v. Richardson*, 51 U.S.P.Q. 144 (Comm. Pats. 1941); *Dunleavy v. Koeppl Steel Prods., Inc.* 114 U.S.P.Q. 43 (Comm. Pats. 1957).

**E. The Applicant Made False Statements in Its Application for Registration of the Mark**

**1. The Applicant Did Not Legally Exist at Time of Alleged First Use of the Mark**

The application for registration of DVD WORLD should be denied because it is based on out-right misrepresentations in violation of 15 U.S.C. § 1051(a)(3). In applying for registration of the mark on October 6, 2004, Applicant represented that it has used the mark in commerce as early as November 19, 1998. However, the Applicant—*i.e.* DVD World Pictures Corp.—did not exist in 1998. It was not incorporated until 2003. *See* Applicant's First Notice of Reliance, Exh. 5. Papetti admitted in testimony that DVD World Pictures Corp. did not exist at the time of the alleged first use in commerce:

Q Do you recognize what this is?

A Yes. It looks like my trademark papers.

\*\*\*

Q And if you look at the second page, it claims a date of first use of May 14, 1997, and a date of first use in commerce of November 19, 1998. Do you see that?

A Yes.

Q **And at those times we can agree that DVD World Pictures Corporation did not exist; correct?**

A **That's correct.**

Q And, in fact, DVD World Pictures Corporation was not created until 2002; correct?

A That's correct.

*See* Papetti Testimony at 64:12 – 65:5 (emphasis added).

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**2. The Applicant Does Not Engage in Services Identified in Its Application**

Further, at the time of its application in October 2004, Applicant claimed the mark for online retail and distribution of DVD movies (International Class 035). Yet DVD World Pictures Corp. does not actually rent, sell, or otherwise distribute DVDs.

Q Has the DVD World Pictures Corporation website ever sold DVD's?

A The actual site? No. No, it has not.

*See Papetti Testimony at 53:15-17. Given Applicant's deliberate and clear misrepresentations, its application for registrations should be denied.*

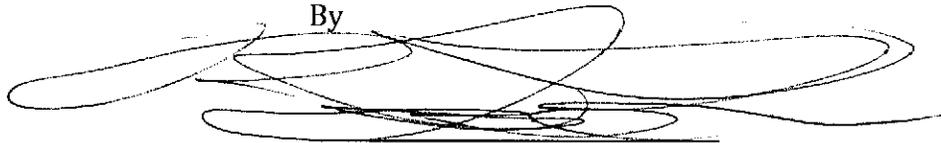
**IV. CONCLUSION**

For the foregoing reasons and based on the evidence of record, the Board should sustain this opposition and refuse registration of the mark DVD WORLD.

Respectfully Submitted,

TROJAN LAW OFFICES

By



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CERTIFICATE OF SERVICE

This is to certify that copies of the following documents in connection with the Opposition No. 91167207 re DVD WORLD, Serial No. 78495856, were served by mailing a copy thereof by first class mail, postage prepaid, to the following persons:

Erik M. Pelton, Esq.  
Erik M. Pelton & Associates, PLLC  
P.O. Box 100637  
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703-997-5349 fax

Documents served:

OPPOSER'S TRIAL BRIEF

Faxed and mailed this 9<sup>th</sup> of July, 2010

Respectfully Submitted,

TROJAN LAW OFFICES

By

A large, stylized handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the bottom.

Date: July 9, 2010

R. Joseph Trojan  
Attorney for Opposer,  
ANITA DHALIWAL