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Hearing: 2/10/11 | Mailing: 7/26/11

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Anita Dhaliwal
v.
DVD World Pictures Corp.

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Opposition No. 91167207
to application Serial No. 778495856
filed on October 6, 2004

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R. Joseph Trojan of Trojan Law Offices for Anita Dhaliwal.

Erik M. Pelton of Erik M. Pelton & Associates for DVD World Pictures Corp.

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Before Quinn, Walters and Mermelstein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

DVD World Pictures Corporation filed an application to register the mark shown below (in standard characters)

DVD World

("DVD" disclaimed) for "online retail store services and distributorships of DVD movies" (in International Class 35), and "motion picture production and distribution" (in

International Class 41). The application asserts in each class first use anywhere on May 14, 1997, and first use in commerce on November 19, 1998. The application includes a claim of ownership of Registration No. 2912970 on the Principal Register of the mark shown below

("DVD" disclaimed) for "online retailing of DVDs" (in International Class 35).[1]

Anita Dhaliwal opposed registration on the grounds that applicant's mark, when applied to applicant's goods, is merely descriptive thereof under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); and that applicant has failed to use its mark in connection with the services identified in the application. (*see* "Issues" discussion, *infra*).

Applicant, in its answer, denied the salient allegations of the notice of opposition.

EVIDENTIARY OBJECTION

Applicant, in its brief, moved to strike an exhibit and testimony related thereto, as well as any discussion of the testimony and exhibit in opposer's briefs. More

[1] Office records show the acceptance of a Section 8 affidavit, and the filing of a Section 15 affidavit.

specifically, applicant moves to strike Exhibit 30 to the Papetti testimony, also submitted as Exhibit 65 to the Lahoti testimony, because, according to applicant, opposer first produced the evidence during testimony, despite opposer's denial that any such evidence existed in response to applicant's discovery requests, and despite opposer's failure to supplement its discovery responses prior to trial. The exhibit comprises an advertising flyer showing use of "DVD WORLD" by a third party in Corvallis, Oregon.

Applicant's Request for Production of Documents No. 26 requested the following: "All documents referring or relating to uses known to Opposer by persons other than itself of a mark or domain name containing the word 'DVD WORLD' or any variants thereof." Opposer responded as follows: "Subject to and consistent with all of its objections, Opposer hereby produces, where appropriate, non-privileged, responsive documents in its possession, custody and control." Nevertheless, during discovery, opposer neither produced the Corvallis advertisement nor informed applicant that the document existed. Further, opposer's response was never supplemented before the exhibit was introduced at trial. When the document was introduced during trial, applicant objected to the introduction on the basis that it was not produced during discovery in response to applicant's request.

Opposer, in her reply brief, does not directly dispute applicant's allegation that the document was not produced prior to trial. Rather, she states that since the disclosure of the document in November at a trial deposition, "Applicant had many months to conduct any necessary follow-up discovery, but failed to ask for further discovery or otherwise to take any step to investigate this issue. It is plainly disingenuous of Applicant to now argue that it did not have sufficient opportunity to conduct discovery." (Reply Brief, p. 16, n.5).

Documents not produced until after the start of trial generally are stricken when the documents are within the scope of documents requested but not produced during discovery. *See Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789 (TTAB 2009); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245, 1247 n.6 (TTAB 1987); and *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987). Inasmuch as the advertising flyer was encompassed within the scope of Document Request No. 26, and opposer did not produce the document prior to its introduction at trial, applicant's motion to strike is granted. Because discovery had closed and trial had commenced, we do not understand opposer's rationalization (i.e., faulting applicant for not taking follow-up discovery) for why the document should be

treated as properly part of the evidentiary record. The advertising flyer and testimony related thereto, as well as any reference to same in the briefs, have not been considered.

We hasten to add, however, that even if considered, the testimony and evidence now stricken would not change the result in this case. One lone third-party use, especially in the absence of any corroborating evidence bearing on the extent of such use and exposure to consumers in the marketplace, is hardly the caliber of evidence necessary to diminish the distinctiveness of applicant's mark sought to be registered. *See No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 506-07 (TTAB 1985); and *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*,226 USPQ 169, 178-79 (TTAB 1985).

THE RECORD

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; and opposer's discovery responses to certain discovery requests propounded by applicant, third-party registrations and other official records, and excerpts of printed publications, all introduced by applicant's notices of reliance. Both parties filed briefs, and both were represented by counsel at an oral hearing held before this Board panel.

ISSUES

Opposer, in the notice of opposition, pleaded five grounds for relief, namely 1) that applicant's mark is merely descriptive; 2) that applicant has failed to use the mark in connection with the services; 3) that applicant committed fraud when it claimed use in connection with the Class 41 services; 4) that applicant misused the ® notice; and 5) that applicant failed to disclaim the merely descriptive designation "DVD" apart from its mark.

Claims 3, 4 and 5 identified above were not identified or otherwise raised by opposer in its brief; so as to be clear, opposer neither set forth these claims as "issues" to be decided, nor made any arguments relative thereto. Moreover, there was no trial, either express or implicit, of these issues. Further, claim 5 clearly has no basis in fact as the application includes a disclaimer of "DVD."

Accordingly, we agree with applicant's assessment in its brief, and we deem claims 3, 4 and 5 to be waived. In this regard, we note that opposer, in her reply brief, does not take issue with applicant's assessment. No consideration will be given to these claims.

In addition, opposer raised for the first time in her brief certain additional claims, namely 1) that opposer made false statements regarding dates of first use and actual use of the mark in connection with the sale of DVDs, that is,

the Class 35 services; 2) that the application is void *ab initio* because it was not filed in the name of the correct owner of the mark; and 3) that due to extensive third-party use, applicant has abandoned its mark.

These issues were not pleaded as grounds in the notice of opposition, and were raised for the first time in opposer's brief. Further, the parties did not try these issues, either expressly or implicitly.[2] Accordingly, we again agree with applicant's assessment; and as is the case with the waived claims discussed above, opposer, in her reply brief, did not dispute applicant's position that these issues should not be considered by the Board. In view of the above, we will not consider these issues on the merits.

In the face of applicant's objections, opposer, in her reply brief, listed only mere descriptiveness, and lack of use of the mark for the Class 35 services as the issues for our determination. As to the later issue, opposer described it in the following terms: "Applicant Failed to Use DVD WORLD as Trademark." (Reply Brief, p. 17).

In view of the above, the only pleaded issues tried and argued by the parties for our consideration are 1) whether

[2] We add also that pursuant to long-standing precedent, opposer's unpleaded argument that applicant provided false dates of first use in its application fails to state a claim. *E.g., L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1970 n.17 (TTAB 2007); and *Colt Indus. Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983).

applicant's mark is merely descriptive for its services, and 2) whether applicant has failed to use its mark in connection with its Class 35 services.

STANDING

Standing is an essential element of opposer's case which, if it is not proved at trial, defeats opposer's claim. To establish standing, opposer must show a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Generally, where a claim of mere descriptiveness is asserted (or, for that matter, that an applicant has failed to use the mark), it is sufficient for the plaintiff to establish that it has an equal right to use the mark at issue. *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060 (TTAB 2010); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, supra. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

Applicant invested a significant amount of effort in attacking opposer's standing. (Brief, pp. 16-27). The essence of applicant's attack is that opposer has not established her ownership of the "dvdworld.com" domain name; and that opposer has failed to prove that she is a competitor in the sale of the type of goods and/or services

involved herein. Applicant contends that "[t]he true owner of the dvdworld.com domain name is Dave Lahoti, an adjudicated cyber squatter who had motivation to conceal his involvement in this proceeding. The named Opposer...has demonstrated her complete lack of involvement with this Opposition." (Brief, pp. 20-21).[3] Opposer responds by asserting that she owned the domain name when she filed the notice of opposition, and that she continues to own 25% of the domain name; that her real interest is based on her partnership with her brother, Dave Lahoti, to use the domain name, and her role as "creative director" for their business activities; and that she is not required to demonstrate that she is a present competitor. (Reply Brief, pp. 2-12).

We should note, at the outset of our consideration of the question of standing, that opposer's proofs hardly present a clear picture. Dates of certain events are imprecise (e.g., the specific date opposer bought the "dvdworld.com" domain name and the date opposer was repaid

[3] In connection with this accusation, applicant relies on the decision in *Lahoti v. VeriCheck, Inc.*, 636 F.3d 501, 97 USPQ2d 1878 (9th Cir. 2011), wherein the circuit court affirmed the district court's finding that David Lahoti (opposer's brother and business partner) exhibited a "pattern and practice of cyber squatting, including a pattern of abusive litigation practices." *Id.* at 1884 (affirming an award of fees under the Trademark Act based in part on Mr. Lahoti's "bad faith"). In an earlier opinion, the circuit court stated: "It is undisputed that Lahoti is a repeat cyber squatter who has registered hundreds of domain names resembling distinctive or famous trademarks and has been admonished by judicial bodies for doing so." *Lahoti v. Vericheck*, 586 F.3d 1190, 92 USPQ2d 1641, 1649 (9th Cir. 2009).

by her brother), as are the details about subsequent events relating to ownership of the domain name and activities undertaken by opposer through her partnership with her brother. Further, we certainly cannot commend the lack of attention given by opposer to this proceeding. Opposer testified essentially as to her utter lack of knowledge about who initiated this proceeding, and the purpose behind bringing the opposition. (Dhaliwal dep., pp. 38-40). In this connection, opposer also testified that Mr. Lahoti handled the business operations, including legal matters, of their partnership. Although we certainly have considered the judicial findings about Mr. Lahoti's cyber squatting activities, they are not fatal to his sister's standing to bring the present opposition.

Opposer purchased the "dvdworld.com" domain name "in the end of 2004," using her credit card to pay the $20,100 fee. (Dhaliwal dep. p. 28-30). "Within a month's time," Mr. Lahoti repaid his sister in full. (Dhaliwal dep., p. 31). Opposer maintains that she and her brother have had a partnership since the purchase of the domain name, based on a verbal agreement, for which she is the "creative director." (Dhaliwal dep., pp. 32-33, and 38; Lahoti dep., pp. 24-25). One of Mr. Lahoti's companies, Virtual Point, gained ownership of the domain name in 2007. In January

2010, opposer paid $1 consideration for a 25% ownership interest in the domain name.

We also have considered a cease and desist letter sent by applicant. As indicated by opposer, she purchased the domain name "dvdworld.com" with her credit card at "the end of 2004." Applicant sent a cease and desist letter dated December 22, 2004; the letter was addressed to "DN [Domain Name] Manager" and received by opposer. (Lahoti ex. no. 1). Although opposer was not mentioned by name, the letter indicated that "*you* registered the domain name www.dvdworld.com on 11/29/2004," and that "*your* use of the Marks and Registered Marks, including registration as a domain name, constitutes trademark infringement and unfair competition practices." (emphasis added). In the letter, DVD World Company (a related company to applicant) essentially stated that it owned the mark DVD WORLD, also making reference to its ownership of Reg. No. 2912970. Applicant demanded that "you" cease and desist any further use, and requested "that you transfer immediately the domain name www.dvdworld.com to [applicant]." Applicant concluded that if "you" failed to immediately comply with applicant's demands, applicant would file a complaint with the WIPO Domain Name Dispute Resolution Service, "and pursue all other remedies and seek recovery of all damages to which [applicant] is entitled."

We find that the record is sufficient to establish that opposer has crossed the threshold for standing.

MERE DESCRIPTIVENESS

Opposer bears the burden of showing, by a preponderance of the evidence, that the designation sought to be registered is merely descriptive. *Goodyear Tire & Rubber Co. v. Continental General Tire Inc.*, 70 USPQ2d 1067, 1070 (TTAB 2003). A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and/or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). *See In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the qualities, features or characteristics of the goods and/or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981). *See In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

A term need not immediately convey information about each and every specific feature of the applicant's goods

and/or services in order to be considered merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods and/or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought, the context in which it is being used on or in connection with the goods and/or services, and the possible significance that the term would have to the average purchaser of the goods and/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). It is settled that "[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, 1316-17 (TTAB 2002). The "average" or "ordinary" consumer is the class or classes of actual or prospective customers of the parties' goods in this case. *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

There is often a fine line between merely descriptive marks and those which are just suggestive. These determinations are often subjective, this case being no exception. The determination of whether a mark is descriptive or suggestive is not an exact science. Our primary reviewing court has observed:

> In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public's perception of the term.

In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Applicant does not dispute that the designation "DVD" is merely descriptive, and applicant has disclaimed the designation apart from the mark. The dispute centers on the mere descriptiveness of the word "WORLD," and if descriptive, whether the mark as a whole is merely descriptive and, thus, unregistrable on the Principal Register absent a showing of acquired distinctiveness.

The word "world" means, *inter alia,* "a distinctive class of persons or their sphere of interest or activity;

the academic world; the digital world." (Merriam Webster's Online Dictionary (2010); www.m-w.com).[4]

Opposer has introduced a list of 206 domain names that contain the words "dvd" and "world." (Lahoti ex. no. 5). The list is entitled to very minimal probative value inasmuch as no information is given other than the domain name itself. The mere listing does not show that any of the domain names are used at all, let alone used in connection with the type of services involved herein, or that the domain names are even used in the United States (some include foreign country top level domains such as ".uk"). Applicant owns 107 domain names containing "dvd" and "world" (Papetti dep., p. 21), and opposer's list even includes some of the domain names listed by applicant. In sum, the record is devoid of any evidence showing actual use or promotion of any of the listed third-party domain names, or that they are used to describe specific goods and/or services.

Mr. Lahoti admitted that he did not examine each of the web sites that appear at each of the listed domain names, nor does he remember much of what he saw when he visited

[4] Applicant, in its brief, requested that the Board take judicial notice of this dictionary definition. Opposer, in her reply brief, did not object to the request, but rather she referred to the same definition, contending that it supported her claim that "world" is merely descriptive.
The Board may take judicial notice of dictionary definitions, and such notice may be taken at any stage of a Board proceeding. *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 n.5 (TTAB 1999).

approximately two dozen of them. (Lahoti dep., pp. 32-33). Mr. Lahoti conceded that some of the web sites may have been "Under Construction" or "Coming Soon." (Lahoti dep., p. 34). The deposition also includes the following exchange:

> Well, do you remember approximately how many sites were actually selling DVDs that contained "dvdworld" in their domain name?
>
> I think I must have encountered at least half a dozen, and then maybe I just pretty much stopped there and thought, well, there'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.

(Lahoti dep., p. 8).

Opposer's proofs fall short of proving that applicant's mark as a whole is merely descriptive. Rather, applicant's mark DVD WORLD, when considered as a whole, falls on the suggestive side of the line. The mark does not immediately describe a characteristic or feature of applicant's services with any degree of particularity. At most, the mark suggests that applicant's Class 35 services offer a wide breadth or range of DVDs.

It is not fatal that a mark is informational. One may be informed by suggestion as well as by description. *In re Reynolds Metals Company*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973). That is to say, the terms "descriptive" and "suggestive" are not mutually exclusive. There is some

description in any suggestion or the suggestive process does not occur. Applicant's mark is no exception.

The mark at issue, DVD WORLD, is typical of so many marks that consumers might encounter in the marketplace: a suggestive mark that tells consumers something general about the goods and/or services, without being specific or immediately telling consumers anything with a degree of particularity. The information given by the mark is indirect and vague, suggesting that the "sphere of interest" of applicant's services relates to DVDs. The mark here conjures up indirect mental associations in the consumer's mind; the thought process beginning with the mark DVD WORLD and leading to a characteristic or feature of the services is neither immediate nor direct.

In making this determination, we have considered Edwin Papetti's statement that applicant sells "across the world." (Papetti dep., p. 34; and ex. no. 23). We also have considered applicant's statements about its history:

> 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 Amount Of International Stores That Were Saying They Were "DVD WORLD" But Weren't.

(Papetti ex. no. 3). In connection with this document, Mr. Papetti testified that he was familiar with "at least one other store" using DVD WORLD as part of their name. Mr. Papetti also indicated that "the person who wrote this was

obviously being dramatic to promote the name of 'DVD World Online,' which was becoming our new online portal for everything DVD World related." (Papetti dep., p. 25-26).

This evidence is entitled to little weight. There is nothing to establish the extent of the purported third-party uses and, in any event, the "numerous amount" of other uses is described as being "international." Any foreign uses by third parties are irrelevant to whether the mark is merely descriptive in the United States.

We also have considered the forty-five third-party registrations of "WORLD" marks introduced by applicant, all registered on the Principal Register (without a Section 2(f) claim), but they are entitled to little probative value. A representative sample of the registered marks includes Reg. No. 3200757 of STAFFING WORLD ("STAFFING" disclaimed) for services related to employment and human resources; Reg. No. 2992295 of BRIDES WORLD ("BRIDES" disclaimed) for services related to weddings; Reg. No. 3056291 of WOMEN'S WORKOUT WORLD ("WOMEN'S WORKOUT" disclaimed) for clothing and health club services; Reg. No. 3474597 of BLACK BELT WORLD ("BLACK BELT" disclaimed) for training services in the field of martial arts; and Reg. No. 2538543 of DIGITAL MUSIC WORLD ("DIGITAL MUSIC" disclaimed) for on-line retail services in the field of computer software and games and music. Third-party registrations are not conclusive on the question of

mere descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). Further, as often stated, we are not bound by the prior actions of examining attorneys. *See In re Nett Designs Inc.*, 57 USPQ2d at 1566 ("Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."). Nevertheless, the similarly constructed "WORLD" registered marks are illustrative in suggesting that the Office on numerous occasions has not considered the word "WORLD" to be merely descriptive.

When confronting the mark DVD WORLD for applicant's services, the ordinary consumer will pause and reflect on the use of the mark before understanding anything specific about a feature or characteristic of the services. One must exercise thought or engage in a multi-step reasoning process to determine what attribute may be identified by the mark as a whole. The mark does not, in any clear or precise way, serve to immediately describe a particular characteristic or feature of the services with any degree of particularity. The mark DVD WORLD does not serve to directly tell consumers anything other than DVDs are involved.

We find, based on the record before us, that opposer has not established by a preponderance of the evidence that the mark DVD WORLD as a whole is merely descriptive of applicant's services.

NONUSE

Opposer argues that applicant has failed to use the mark DVD WORLD in connection with applicant's "online retail store services and distributorships of DVD movies" in Class 35.[5] Opposer does not take issue with applicant's use of the mark in connection with the services identified in Class 41, namely "motion picture production and distribution." (Opposer's Brief, pp. 3 and 18). Accordingly, with respect to opposer's allegation of nonuse, as pleaded by opposer and tried by the parties, the only question for us to determine

[5] According to opposer, "[i]t 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." (Brief, p. 18). So as to be clear, however, opposer's belated claim that the application is void *ab initio* because the application was filed in the name of the incorrect owner of the mark is not at issue.
To the extent that opposer is asserting that applicant's mark does not function as an indicator of source because Mr. Papetti's various entities own and use variations of the mark on a range of goods and services, opposer has not shown that the public is even aware that the marks may be owned by different legal entities, let alone that the public is confused thereby. In any event, there is in fact a unity of control among applicant's various marks, since it is clear the Mr. Papetti personally controls all uses of the marks through his closely-held entities.

is whether applicant, DVD World Pictures Corp., has used the mark DVD WORLD for online retail store services and distributorships of DVD movies (in Class 35). As was the case with her mere descriptiveness claim, opposer bears the burden of proving nonuse by a preponderance of the evidence. We find that opposer's proofs fall short.

Opposer asserts that applicant's claim of use of its mark for online retail sales of DVDs is entirely based on applicant's website, "www.dvdworldonline.com"; that is, there is no designated website for the named applicant. Opposer alleges that no sales go through the specific applicant in this case, that is, DVD World Pictures Corp. Opposer also points to the purported lack of any advertising on behalf of applicant for any services.

As best we understand the argument, opposer essentially asserts that because applicant is DVD World Pictures, but use of DVD WORLD is made on "dvdworldonline.com, then any use must be by DVD World Online, and not applicant. This argument misses the mark. Applicant may very well own the dvdworldonline.com website, but even if it does not, there is no evidence to suggest that use of DVD WORLD on the website dvdworldonline.com does not inure to the benefit of applicant.

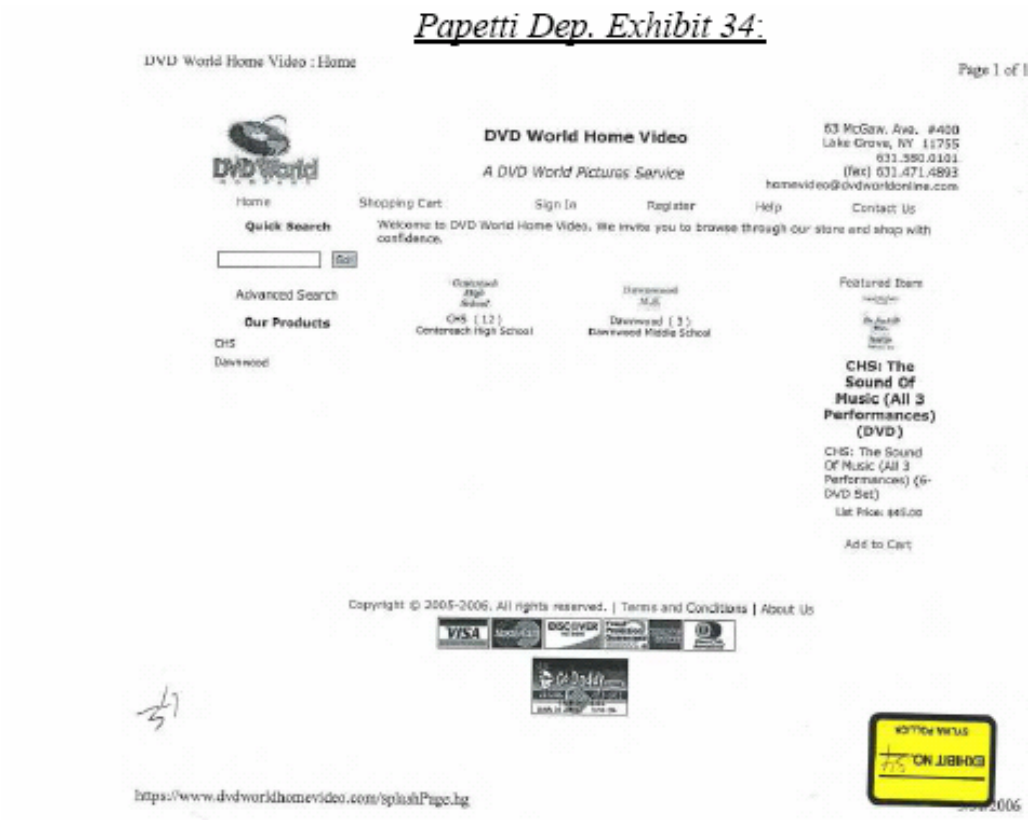
Mr. Pepetti testified that applicant offers commercially available movie titles at its websites

"www.dvddestination.com" and "www.dvdworldonline.com." Applicant also offers at retail DVDs of applicant's own motion picture productions:

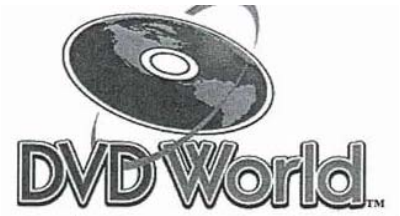
> Q. But, to be clear, the services offered with respect to the sale of DVD's are not services that are offered by DVD World Pictures Corporation on either the DVDDestination.com website or the DVDWorldOnline.com website; correct?
>
> A. As stated before, DVD World Pictures covers the retail and distribution of titles that we record, edit, and produce. The titles handled by DVDDestination.com, DVDWorldOnline.com and HDDVDWorld.com would be held under the DVD World Company, which is also the parent company of DVD World Pictures Corp.

(Papetti dep., p. 62).

Below is a screenshot of a webpage at one of applicant's websites, "www.dvdworldhomevideo.com," showing applicant's offer of DVDs of its own productions for sale to the general consuming public. According to Mr. Pepetti, "this particular website would sell the live event DVDs." (Papetti dep., p. 57). As is shown by the exhibit, DVD WORLD is used in no less than four instances on this webpage.



Further, a screenshot of a webpage at another one of applicant's websites, "www.dvdworldonline.com" (Papetti ex. no. 35), shows the following use of DVD WORLD:



The above evidence shows applicant's use of its mark DVD WORLD in connection with its Class 35 services.

Opposer also has pointed to Mr. Papetti's testimony below as evidence of nonuse.

> Q. Has the DVD World Pictures Corporation website ever sold any DVDs?
>
> A. The actual site? No. No it has not.

As explained above, however, the mark DVD WORLD has appeared on the websites of related companies, all owned solely by Mr. Papetti. Similar to the case with a "brick-and-mortar" store, the actual owner of the website through which the services are rendered is of little importance; the services here are provided in connection with applicant's mark and the use thus inures to applicant's benefit.

Mr. Papetti testified that applicant is owned solely by him through his sole proprietorship DVD World Company. Applicant, as well as Mr. Papetti's other entities, have used the mark DVD WORLD as related entities; there is a unity of control and ownership by Mr. Papetti (who is often the only person employed by his companies). Several of applicant's websites include the following statement:

> The "DVD World" name and design are either registered trademarks or trademarks of DVD World Pictures Corp., a division of the DVD World Company. Any use of the DVD World name or design without the permission of the DVD World Company is strictly prohibited.

That Mr. Papetti's various closely-controlled entities work together for mutual benefit is neither surprising nor particularly significant.

To reiterate, opposer bears the burden of proof to show that applicant has not used the mark DVD WORLD for "online retail store services and distributorships of DVD movies." Opposer's proofs fall short. Although applicant's business model is hardly a model of clarity, the record shows that applicant has used the mark DVD WORLD in connection with the Class 35 services through Mr. Papetti's entities (all owned solely by him).

Accordingly, this claim must fail.

CONCLUSION

In reaching our decision we have considered all of the evidence pertaining to the issues tried by the parties, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

We find that 1) applicant's mark is not merely descriptive; and 2) applicant has used DVD WORLD as a mark to identify and distinguish its services from those of others.

Decision: The opposition is dismissed.