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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Michael J. Cutino
v.
Nightlife Media, Inc.

Opposition No. 91186025
to Application Serial No. 77325174

Michael J. Cutino, *pro se*.

Kenneth S. McLaughlin Jr. of Law Offices of McLaughlin & Associates PC for
Nightlife Media, Inc.

Before Quinn, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Nightlife Media, Inc. (“applicant”) seeks to register NIGHTLIFE TELEVISION, in standard characters, for “Video-on-demand transmission services, Internet broadcasting services, broadcasting services, namely, broadcasting programs over a global computer network to mobile telephones and computers, Satellite television broadcasting, and Television broadcasting.”¹ Michael J. Cutino

¹ Application Serial No. 77325174, filed November 8, 2007, with TELEVISION disclaimed and a claim of acquired distinctiveness based on alleged first use dates of October 29, 2002.

(“opposer”) opposes registration. In his notice of opposition, opposer alleges prior use and registration of an alleged “family” of NIGHTLIFE marks used for magazines and television programming services, specifically NIGHTLIFE,² LONG ISLAND’S NIGHTLIFE (Stylized)³ and NEW YORK’S NIGHTLIFE.⁴ As grounds for opposition, opposer alleges that use of applicant’s mark is likely to cause confusion with opposer’s marks; and deceptiveness and false suggestion of a connection with opposer under Section 2(a). In its answer, applicant admits opposer’s ownership of the marks in his registrations, Answer ¶ 4, but otherwise denies the salient allegations in the notice of opposition, and asserts several defenses, including the “affirmative defense” of abandonment. Applicant has not counterclaimed for cancellation of any of opposer’s pleaded registrations, however.

Evidentiary Issues/The Record/Viability of Claims

Opposer attached to his notice of opposition printouts from an Office database showing the current status and title of two of his three pleaded registrations, specifically the registrations for LONG ISLAND’S NIGHTLIFE (Stylized) and NEW YORK’S NIGHTLIFE. While opposer also attached a soft copy

² Registration No. 1908411, issued August 1, 1995 based on dates of first use in commerce of 1980 for “magazines of general interest” and 1987 for “television programming services.” [Renewed; Section 15 affidavit acknowledged].

³ Registration No. 1324398, with LONG ISLAND disclaimed, issued March 12, 1985 based on a date of first use in commerce of March 1982 for “Monthly Magazine Dealing Primarily with Things to Do and See and Places to Go in the Long Island and Surrounding Areas and Also Featuring Other Articles of General Interest.” [Renewed; Section 15 affidavit acknowledged].

⁴ Registration No. 1207169, with NEW YORK’S disclaimed, issued September 7, 1982 based on a date of first use in commerce of December 1979 for “Monthly Magazine Dealing Primarily with Things to Do and See and Places to Go in the State of New York.” [Renewed; Section 15 affidavit acknowledged].

of his registration for the mark NIGHTLIFE to the notice of opposition, he failed to attach either a printout from an Office database showing the current status and title of this registration, or an “original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration.” Trademark Rule 2.122(d)(1). Therefore, opposer’s registration for the mark NIGHTLIFE is not of record by virtue of the soft copy being attached to opposer’s notice of opposition. *See, Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009); *Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1956-57 (TTAB 2008).

Opposer also failed to take any testimony or submit any other evidence during his testimony period, and, as a result, applicant filed a motion to dismiss for failure to prosecute. In its order of May 20, 2012 (the “Prior Order”), the Board denied applicant’s motion to dismiss because opposer’s proper introduction of two of his pleaded registrations under Trademark Rule 2.122(d)(1) “establish[es] opposer’s standing, and that opposer has priority,” and the registrations “are sufficient to make out a prima facie case.” Prior Order at 6. However, the Board pointed out that “[e]vidence not obtained and filed in compliance with [the Trademark Rules] will not be considered,” and that the materials opposer submitted after his testimony period closed were “untimely and otherwise inadmissible.” Prior Order at 4-5 (citing Trademark Rules 2.121(a)(1), 2.122(e), and 2.123(b), (d), (e) and (l)).

Since the Prior Order issued, opposer has continued to submit additional materials.⁵ Opposer's submission filed September 4, 2012 is construed as opposer's trial brief.⁶ Opposer's submissions filed December 10 and December 12, 2012, although captioned as opposer's "trial brief," are untimely, and have therefore been given no consideration. Trademark Rule 2.128(a)(1). Opposer's filings of December 31, 2012 and January 22, 2013 are: (a) inadmissible if intended as evidence for the reasons set forth in the Prior Order; (b) untimely if intended as opposer's trial or reply brief; and/or (c) denied if intended as a motion for reconsideration of the Board's December 13, 2012 order, because opposer has not established that the Board erred therein. Neither filing has been given any consideration. As a result, the record consists of:

- the pleadings;
- the file of the opposed application;
- opposer's pleaded Registration Nos. 1324398 and 1207169, which were properly submitted with the notice of opposition; and
- applicant's testimonial deposition of Gregory Phillips, its founder and sole shareholder and officer, and the exhibits thereto.

Because opposer has not submitted any evidence other than his registrations for the marks LONG ISLAND'S NIGHTLIFE (Stylized) and NEW YORK'S

⁵ The Board previously granted applicant's motion to strike opposer's filings of July 16 and August 1, 2012. Order of December 13, 2012.

⁶ Opposer's trial brief consists of allegations unsupported by any evidence of record, as well as argument related to opposer's likelihood of confusion claim, which is addressed herein. *See Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n. 7 (TTAB 2010) (only evidence of record may be considered).

NIGHTLIFE, he has failed to pursue and therefore waived his claims of deceptiveness and false suggestion of a connection. In fact, he cannot establish the required elements of either claim. *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1723 (Fed. Cir. 2001) (setting forth elements of a deceptiveness claim, including that the defendant's mark is misdescriptive, that consumers are likely to believe that the misdescription describes the goods and that the misdescription is likely to affect purchasing decisions); *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010) (setting forth elements of a false suggestion claim, including that the defendant's mark points uniquely and unmistakably to the plaintiff, and that the plaintiff's fame or reputation "is of such a nature that a connection with such person or institution would be presumed"). Accordingly, we need only consider the remaining claim of priority and likelihood of confusion.

Standing and Priority

As set forth in the Prior Order, opposer's pleaded and properly-introduced Registration Nos. 1324398 and 1207169 establish opposer's standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); Prior Order at 6. And because those registrations are of record, and applicant has not counterclaimed for cancellation of either registration, priority is not at issue in this proceeding. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).⁷

⁷ Opposer failed to introduce any evidence that his marks "were used and promoted together ... in such a manner as to create public recognition

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 222 F.3d at 943, 55 USPQ2d at 1848.

We first consider the similarities and dissimilarities of the parties' marks in appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entirety that confusion as to the source of the goods and services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather

coupled with an association of common origin predicated on the 'family' feature" *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1218 (TTAB 1988) (quoting *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)). Accordingly, opposer has failed to establish that he owns a "family" of marks.

than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Here, while the parties' marks all include the at best suggestive term NIGHTLIFE, both of opposer's marks specify that they relate to a particular geographic location, i.e. Long Island or New York. And while the terms LONG ISLAND'S and NEW YORK'S are both disclaimed, and are both descriptive, they nevertheless make opposer's marks look and sound significantly different than applicant's mark, which includes its own descriptive and disclaimed term, TELEVISION. Moreover, the parties' marks convey much different meanings, with opposer's conveying the "nightlife" of a particular geographic location and applicant's conveying a television station or television programming focused on "nightlife" generally. And because the only term the parties' marks have in common, NIGHTLIFE, is at best suggestive of the parties' goods and services, the addition of even the descriptive terms LONG ISLAND'S, NEW YORK'S and TELEVISION is sufficient to distinguish the parties' marks. *See, Top Tobacco, LP v. North Atlantic Operating Co., Inc.*, 101 USPQ2d 1163, 1174 (TTAB 2011); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1316 (TTAB 2005).

Considering the parties' marks in their entireties, we therefore find that the dissimilarities between opposer's marks and applicant's mark outweigh the similarities. This factor weighs against a finding of likelihood of confusion.⁸

Turning to the parties' goods and services and channels of trade, we must consider the goods and services identified in applicant's involved application and opposer's registrations which are properly of record. *Cunningham*, 55 USPQ2d at 1846; *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1992). And because neither party's identification of goods and services includes trade channel restrictions, we must presume that the parties' products and services travel in ordinary channels of trade and will be marketed to the usual consumers of such goods and services. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Here, opposer uses his marks for monthly magazines focused on particular geographic areas, while applicant uses its mark for television and other broadcasting services. While both parties operate in the exceedingly broad media field, that alone is not enough to find that their goods and services are similar or related in the absence of any evidence establishing a relationship between them. *In re W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1215 (TTAB 2007) ("to demonstrate that

⁸ While applicant admits in its answer that opposer owns the mark NIGHTLIFE, Answer ¶ 4, that is as far as applicant's admission goes, and because the registration for this mark is not of record, opposer is not entitled to any of the presumptions which arise out of a registration. In other words, there is no evidence concerning when opposer used NIGHTLIFE, whether the mark is still in use or what goods or services are or were offered under the mark. Applicant's admission is therefore not enough for us to consider the NIGHTLIFE mark in connection with opposer's likelihood of confusion claim.

goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods”); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“the fact that both parties provide computer programs does not establish a relationship between the goods or services such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks”). Similarly, there is simply no evidence of record that the parties’ trade channels overlap. *See, Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

In short, opposer has failed to meet his burden to prove by a preponderance of the evidence that the parties’ goods and services are similar or related, or that the parties’ trade channels overlap. These factors therefore also weigh against a finding of likelihood of confusion.

In the absence of any evidence bearing on the remaining *du Pont* factors, we find that those factors are all neutral.

Conclusion

Opposer’s failure to properly introduce any evidence other than his registrations for LONG ISLAND’S NIGHTLIFE (Stylized) and NEW YORK’S NIGHTLIFE has left him unable to prove his likelihood of confusion claim. Indeed, all of the factors about which there is evidence -- the similarity or dissimilarity of

the parties' marks, goods/services and channels of trade – weigh against a finding of likelihood of confusion.⁹

Decision: The opposition is dismissed.

⁹ We need not consider applicant's "defense" of abandonment, nor may we do so because applicant has not counterclaimed to cancel any of opposer's pleaded registrations. Trademark Rule 2.106(b)(2)(ii).