

ESTTA Tracking number: **ESTTA289457**

Filing date: **06/12/2009**

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

Proceeding	92050895
Party	Defendant AFC Network Private Limited
Correspondence Address	AFC Network Private Limited 9 Temasek Boulevard, #23002 Suntec Tower Singapore, 038989 SINGAPORE
Submission	Motion to Dismiss - Rule 12(b)
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Date	06/12/2009
Attachments	AFC-MTD.pdf ( 17 pages )(850365 bytes )



<u>Mark:</u>	<u>Reg. No. &amp; Date</u>	<u>Goods/Services</u>
THE FOOD CHANNEL [“food” disclaimed]	1,524,769, 2/14/1989	Consulting services in the field of television and radio advertisements for the food industry (Class 35)
 [“food” disclaimed]	1,619,809, 10/30/1990	Newsletters on subjects of interest to the food marketing industry (Class 16)
 [Partial Section 2(f) as to “Food Channel”; “internet” disclaimed]	2,297,214, 12/7/1999	Providing on-line information via a global communications network on topics of general interest (Class 42)
THE FOOD CHANNEL [Section 2(f) claimed]	2,357,879, 6/13/2000	Providing on-line information via a global communications network on topics of general interest (Class 42)
 [Section 2(f) claimed; “food” disclaimed]	3,343,834, 11/27/2007	Providing on-line information via a global communications network on topics of food (Class 43)

Registrant is a Singapore entity that operates a cable television network featuring programming related to food and cooking, which is currently carried in Singapore, Malaysia, the Philippines, Hong Kong and Indonesia. Registrant holds three Singapore trademark

<sup>2</sup> Petitioner also holds two pending applications, Serial No. 77/714,133 for the mark THE FOOD CHANNEL for use in connection with “Broadcasting of video and audio content and programming via a global communications network; providing access to video and audio content and programming via websites,” and Serial No. 77/353,955 for the mark THE FOOD CHANNEL [& design] for use in connection with “Providing information and news via a global communications network on topics of food and beverages (Class 42)”, but these applications were not filed until well after the filing date of the opposed application. In the Notice of Opposition, Petitioner also claims ownership of a number of less similar marks, such as INTERNATIONAL FOOD FUTURISTS and FOOD WIRE, which it defines as “Related Marks” but never explains how they are “related.”

registrations, Nos. TO6/26897B, TO6/26898J and TO6/26899I, all issued December 7, 2006, for the word mark ASIAN FOOD CHANNEL for various services in Classes 35, 38 and 41.

On April 9, 2007, Registrant filed the subject application pursuant to sections 1(b) and 44(e) of the Act, for the following services (as subsequently amended during prosecution):

Advertising, marketing and promotional services; production of television commercials; provision of advertising space by electronic means and global information networks; rental of advertising space or advertising material on communication media; business management, consultancy and advisory services; marketing management, consultancy and advisory services; market research and analysis; conducting business research and surveys, namely, pricing surveys and analysis; market opinion polling studies; compilation of mailing lists and compilation of computerized databases for business directories; compilation of trade and business price and statistical information; compilation of information into computer databases; preparation and publication of publicity texts; creating, updating and dissemination of advertising matter; business advice and commercial information services; dissemination of business advice and commercial information; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with an awards program, a sports competition and sporting activities; contests and incentive award programs to promote the sale of products and services for others; organization and business supervision, on behalf of others, of exhibitions, trade fairs and trade shows for commercial or advertising purposes; direct marketing and telephone marketing services, not selling; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise catalogue by mail order or by means of telecommunications; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail store selling culinary related products; the bringing together, for the benefit of others, of a variety of goods in the field of general consumer merchandise, through a television shopping channel, enabling customers to conveniently view and purchase those goods by means of telecommunications; data processing services, namely, retrieval of data and information from a computer stored network (Class 35);

Broadcasting and electronic transmission of data and information by cable television, computer terminals, electronic communications networks, fiber-optic networks, mobile and cellular telecommunications, over a global computer network, via satellite, television and wireless, communications; communications, by means of cable television, computer terminals, electronic communication networks, fiber-optic networks, mobile and cellular telecommunications, over a global computer network, via satellite, television and wireless means;

subscription, pay-per-view, video-on-demand and interactive broadcasting and transmission of data and information by cable television, computer terminals, electronic communication networks, fiber-optic networks, mobile and cellular telecommunications, over a global computer network, via satellite, television and wireless communications; interactive delivery of video over satellite, terrestrial signal, wireless or fiber-optic networks; interactive services for facilitating the pre-selection and recording of programs and data in the nature of video on-demand transmission services; telecommunication services for the electronic transmission of data and information from a computer stored network; an online electronic bulletin board for transmission of messages among computer users concerning topics of interest, namely, lifestyle aficionados including cooking, recipes, restaurants, entertaining, nutrition, the culinary arts, traveling and living, food and beverage growth, cookware, cutlery, glassware; news agencies, namely, the transmission of news items to news reporting organizations; transmission of news (Class 38); and

Consultation services in the field of entertaining, namely, the hosting of parties and special events in the field of cooking, recipes, restaurants, nutrition, the culinary arts, traveling and lifestyles, foods and beverages, cookware, cutlery and glassware; production and distribution of television programs for entertainment and education, live theatrical programs for entertainment and education, film documentaries, films, educational programs and entertainment programs distributed over cable television, computer terminals, electronic communications network, fiber-optic networks, mobile and cellular telecommunications, over a global computer network, via satellite, television and wireless means; educational services, namely, conducting courses of instructions in the field of cookery; entertainment services, namely, organizing of exhibitions, namely, competitions, contest, games, quizzes, fun days, sporting events, shows, road shows, reality TV shows, variety shows, documentaries, stage events, theatrical performances, concerts, live performances and audience participation events, all pertaining to or featuring instruction, entertainment, education and information relating to lifestyle aficionados including cooking, recipes, restaurants, entertaining, nutrition, the culinary arts, traveling and living, food and beverage growth, cookware, cutlery, glassware; providing information relating in the field of entertaining; theatrical booking agencies; viewing guide services in the nature of an on-line network, providing personalized, interactive information regarding television programs for use by consumers; publishing of books and magazines, information leaflets, fact sheets in the field of lifestyle aficionados including cooking, recipes, restaurants, entertaining, nutrition, culinary arts, traveling and living, food and beverage growth, cookware, cutlery, glassware; providing recognition and incentives by way of awards to demonstrate excellence in the field of the culinary arts, hostelry and hospitality services, public spaces and environmental maintenance and protecting public hygiene (Class 41).

In a first Office Action, the Examiner assigned to this case preliminarily refused registration under Section 2(d) as to Class 41 only, citing Petitioner's Registration No.

2,357,879, for the mark THE FOOD CHANNEL in Class 42. Registrant timely responded to the Office Action submitting argument and evidence that the marks in question were not confusingly similar, and the citation was withdrawn. Registration has also been refused under section 2(e) on the grounds that the mark was merely descriptive. Registrant amended the application to delete the section 1(b) claim and proceed directly to registration on the Supplemental Register under Section 44(e). Registrant's mark was subsequently registered on the Supplemental Register on March 10, 2009, and this cancellation proceeding ensued.<sup>3</sup>

### ARGUMENT

Registrant respectfully submits that the cancellation should be dismissed and its mark should proceed to allowance because its ASIAN FOOD CHANNEL mark is not sufficiently similar to any of the Petitioner's marks when the marks are viewed in their entirety and in light of the number and nature of similar marks used in connection with similar goods and services, and other factors enunciated by the court in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). Registrant further states that a claim of confusing similarity cannot be sustained when the only elements the marks have in common are descriptive terms which have been disclaimed and which are widely used in the industry.

A. The Marks are Distinguishable in Appearance,  
Sound and Overall Impression.

It is well settled that a likelihood of confusion may be said to exist only where (1) the Registrant's mark is similar to the Petitioner's mark(s) in terms of sound, appearance, or commercial impression *and* (2) the Registrant's goods or services are so related or the activities

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<sup>3</sup> Petitioner is simultaneously opposing Registrant's pending application for the companion mark AFC ASIAN FOOD CHANNEL [& design] (Serial No. 77/151,617, Opposition No. 91190024). Registrant has also moved

surrounding their marketing are such, that confusion as to their origin is likely. *See id.*; In re August Stork KG, 218 USPQ 823 (TTAB 1983); In re Int'l Telephone and Telegraph Co., 197 USPQ 910 (TTAB 1978). The first element of that test cannot be met here.

It is black-letter law that a determination of likelihood of confusion must be based on a consideration of the marks *in their entirety*. *See, e.g., Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100 (6th Cir. 1991) (marks must be viewed in their entirety and in context); In re National Data Corp., 753 F.2d 1056, 1058, 1060 (Fed. Cir. 1985); Aries Sys. Corp. v. World Book, Inc., 26 USPQ2d 1926, 1932 (TTAB 1993); Innovation Data Processing, Inc. v. Innovative Software, Inc., 4 USPQ2d 1972, 1974 (TTAB 1987); Interwoven Stocking Co. v. Crest Hosiery Mill, 134 USPQ 43, 44-45 (TTAB 1962). As the National Data Court said:

*The basic principle in determining confusion between marks is that marks must be compared in their entirety.... It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.*

National Data, *supra*, 753 F.2d at 1058 (citations omitted; emphasis supplied).

In this case, Registrant cannot dispute that the marks in question share the words FOOD and CHANNEL. Nevertheless, Registrant points out that the first elements in the marks – the simple article THE versus ASIAN – are distinct in sound, appearance, connotation and overall impression. Registrant further submits (and will discuss in detail below) that a cancellation

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to dismiss that proceeding on grounds similar to those asserted here.

cannot be based upon the shared use of terms which are descriptive and widely used in the industry. By ignoring the first words in each mark and focusing on the shared weak terms FOOD and CHANNEL, the Petitioner is cherry-picking points of similarity and engaging in an impermissible dissection of the marks.

It is well established that the first element of a mark is most likely to be impressed upon the mind of the purchaser and remembered. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895 (TTAB 1998). Although both Registrant's mark and the Petitioner's marks include the relatively weak words FOOD and CHANNEL, the first and clearly dominant element of the Registrant's Mark is the word ASIAN. ASIAN adds a very distinct and particular and immediately recognizable connotation to Registrant's mark which is not at all present in the Petitioner's marks. Registrant respectfully submits that it is the lead word ASIAN that makes the initial and strongest impact on the purchasing public, and is most likely to be remembered (since it identifies the specific niche Registration is seeking to serve). *See Long John Distilleries, Ltd. v. Sazerac Co.*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970) (holding "FRIAR JOHN" and "LONG JOHN" not likely to be confused, where second, shared term was commonly used in field, and marks have different overall sounds and appearances); *see also Playboy of Miami, Inc. v. John B. Stetson Co.*, 165 USPQ 686 (CCPA 1969) (holding that "PLAY BOY OF MIAMI" and "STETSON PLAYBOY" not likely to be confused because Stetson is a well known mark and the dominant portion of the mark STETSON PLAYBOY).

Apart from the visual and connotative differences, it also cannot be disputed that the marks sound different. The word ASIAN adds a syllable to the Registrant's Mark as well as distinct vowel and consonant sounds not present in any of the Petitioner's marks.

Accordingly, because Registrant's Mark and the Petitioner's marks are different in sight, sound, and overall impression, Registrant respectfully requests that the cancellation be dismissed.

B. A Determination of Confusing Similarity Cannot Be Based on the Shared Use of Common Descriptive Words Widely Used in the Industry.

Because marks must be considered in their entireties, the mere presence of a common, highly suggestive or descriptive portion is usually insufficient to support a finding of likelihood of confusion. Sears, Roebuck & Co. v. Hoffman, 46 CCPA 708, 258 F.2d 953, 119 USPQ 137 (1958); E.L. Bruce Co. v. American Termicide Co., 48 CCPA 762, 285 F.2d 462, 128 USPQ 341 (1960). As the Board stated in Cambridge Filter Corp. v. Servodyne Corp., 189 USPQ 99, 102-03 (TTAB 1975), "a proprietary right cannot be acquired in a ... term that has been so commonly used in the trade that it cannot function as the distinguishing feature of any one party's mark."

Registrant respectfully submits that because the dominant terms shared between the two marks, FOOD and CHANNEL, are descriptive and generic respectively, and highly diluted, the general rule barring the mere addition of a word to another's mark does not apply to this case. "[An exception to the] general rule regarding additions or deletions to marks may arise if .... the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." TMEP §1207.01(b)(iii). See In re Shawnee Milling Co., 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); In re S.D. Fabrics, Inc., 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Thus, the mere fact that the Registrant's mark shares *disclaimed, generic and descriptive terms* with the Petitioner's marks cannot dictate the conclusion that the marks in their entireties are confusingly similar.

*i. The Terms the Marks Share are Highly Descriptive and/or Generic*

The only terms that the marks share are FOOD, which is descriptive of the subject matter of the parties' services, and CHANNEL, which is generic for a television network. Indeed, each of the Petitioner's marks features either a disclaimer of FOOD or a claim under Section 2(f), or both, which operates as an admission that the marks (or at least those words within the marks) are not inherently distinctive. For its part, rather than contest the descriptiveness refusal, the Registrant has accepted registration of its mark on the Supplemental Register, which operates as an admission that the mark is not inherently distinctive. As such, the shared words FOOD and CHANNEL, which indisputably lack inherent distinctiveness in both parties' marks, cannot form the sole basis of a Section 2(d) cancellation. Otherwise, the ultimate effect of this refusal would be to grant the Petitioner a monopoly in a term, "food channel," which the Office has more than once concluded (by refusing registration under section 2(e) in the present case and by requiring Petitioner to register its marks under Section 2(f) and to disclaim "food") is descriptive and lacking in inherent distinctiveness. Such a result would be contrary to the letter and spirit of Section 2(e)(1) of the Act.

According to the TMEP, "[i]f the common element of two marks is 'weak' in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion *unless the overall combinations have other commonality*" [emphasis supplied]. TMEP §1207.01(b)(ii). Here, there is no such "other commonality." To

the contrary, the non-common elements, namely the word ASIAN (in place of THE) in Registrant's mark, and the apple design elements in certain of Petitioner's marks, are clearly different in sight, sound and meaning from the Petitioner's marks, as discussed above. The marks in their entireties therefore cannot be considered confusingly similar. *See* TMEP §1207.01(b)(iii) (no likelihood of confusion where matter common to both marks is merely descriptive or diluted). Furthermore, the Petitioner's marks are relatively "weak" marks with only a narrow scope of protection. Each is registered under Section 2(f) and/or subject to disclaimers, indicating that they are not inherently distinctive, making confusion with Registrant's mark less likely. *See* TMEP §1207.01(b)(ix); *see also, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services).

*ii. The Words FOOD and CHANNEL Are  
Widely Used in the Relevant Industry*

Moreover, apart from being descriptive, the words FOOD and CHANNEL and their close equivalents are very widely used in the entertainment and education spaces, rendering their source-identifying capability highly diluted and weak. The prosecution record in this case includes evidence that a search of the TESS database conducted on January 24, 2008 for live marks in class 41 containing FOOD yielded 285 records. A search of the TESS database conducted on January 24, 2008, for live marks in class 41 containing CHANNEL yielded 378 records, indicating that FOOD and CHANNEL are extensively used in the entertainment field. (An update of those searches as of June 10, 2009, yielded 325 active FOOD marks in Class 41,

and 370 active CHANNEL marks<sup>4</sup> in Class 41.) While such search results are not evidence that the marks are actually in use, they do indicate that the words are in high demand for use in trademarks in this field of services.

More significantly, there is evidence that marks are used and have been registered which feature the words FOOD and CHANNEL or its synonym NETWORK *together*. A TESS search conducted on January 24, 2008 (in the prosecution record below), and updated on June 10, 2009, for live marks in class 41 containing the phrase “Food Channel” or “Food Network” disclosed over thirty pending and registered marks, not including the Petitioner’s marks, featuring the consecutive words or FOOD and CHANNEL or FOOD and NETWORK, including by way of example, the following:

**Mark**

SEAFOOD CHANNEL [& design]	Reg. No. 3,543,053
SEAFOOD CHANNEL	Reg. No. 3,542,241
FOOD NETWORK	Reg. No. 2,924,169
FOOD NETWORK	Reg. No. 2,771,532
FOOD NETWORK-HD	Reg. No. 3,319,967
FOOD NETWORK ON DEMAND	Reg. No. 2,926,822

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<sup>4</sup> Examples of registered Channel-formative marks owned by various third parties include among many others THE PHILOSOPHY CHANNEL, THE COMEDY CHANNEL, THE TRAVEL CHANNEL and most notably, SEAFOOD CHANNEL [& design] (Reg. No. 3543053, “Seafood Channel” disclaimed) and SEAFOOD CHANNEL (Reg. No. 3542241, Supplemental Register, “Channel” disclaimed). Third party applications are pending for other food or beverage-related “Channel” marks such as THE BAKERY CHANNEL (Serial No. 77/738,357), THE PASTRY CHANNEL (Serial No. 77/743,563) and THE DRINKING CHANNEL (Serial No. 77/564,462), all filed by different applicants.

In fact, registration was granted for two of the FOOD NETWORK marks, in connection with entertainment services in the field of cooking and culinary arts, in October of 2003 and February of 2005, and for the two SEAFOOD CHANNEL marks for similar services in December 2008, all after the Petitioner's marks were already registered. Thus the issuance of the registration in the current case was warranted as well, and consistent with precedent, given the presence of the widely-used terms FOOD, CHANNEL and NETWORK and the addition of distinguishing word ASIAN in Registrant's Mark.

*iii. No Likelihood of Confusion Can Be Found Between  
Marks Sharing Only Descriptive Terms*

Numerous decisions and scholarship support the position that there is no likelihood of confusion between marks whose common elements are merely descriptive. For example, in *In re Bed & Breakfast Registry*, 229 USPQ 818 (Fed. Cir. 1986), the Court of Appeals for the Federal Circuit found that the mark BED & BREAKFAST REGISTRY was not likely to be confused with BED & BREAKFAST INTERNATIONAL for virtually identical services. In particular, the Federal Circuit court stated that since the descriptiveness of the phrase “BED & BREAKFAST” is not contested, consumers were more likely to rely on the non-common portion of each mark, namely REGISTRY versus INTERNATIONAL. *Id.* at 819. The court concluded that the marks in their entirety were “not confusingly similar in either sound or appearance,” since “[t]he words ‘registry’ and ‘international’ do not have the same meaning, either alone or in combination with the term ‘bed and breakfast.’” *Id.*

Similarly, in *United States Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985), which involved a conflict between the marks CALIFORNIA COBBLERS and COBBLER'S OUTLET, the Trademark Trial & Appeal Board stated that “even though the goods of the parties are for our

purposes identical, the differences in the appearance, sound and meanings of the marks are sufficient to make confusion unlikely.” *Id.* The Board based its decision in part on the visual, aural and connotative differences between CALIFORNIA and OUTLET, which rendered the marks in their entireties too different to support a likelihood of confusion refusal. Again, this reasoning dictates the same conclusion here.

Commentators agree. While Petitioner claims that consumers will assume that Registrant’s mark is an affiliate or sub-brand of Petitioner, McCarthy notes that similar claims have been rejected, even where the goods or services were more similar than in the present case. For example, no likelihood of confusion was found between FLIP and FINAL FLIP, both for rodenticide, JET and AEROB-A-JET, both for sewage and waste-water treatment systems for homes, and PARENTS and PARENTS DIGEST. *See* J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition, § 23:57 (4<sup>th</sup> ed. Thomson West, 2007) (listing marks having similar parts, yet held no likelihood of confusion existed).

As such, the Petitioner’s marks are “at best, ...entitled to limited protection” and the likelihood of confusion is diminished. *See* Nabisco Brands, Inc. v. Quaker Oats Co., 547 F. Supp. 692, 699 (D.N.J. 1982). The public is well accustomed to seeing FOOD and CHANNEL (and/or close equivalents) in a variety of commercial contexts and uses, and particularly in the broadcasting and entertainment sectors; to contend that the public would be so easily confused as to attribute all of them to a single source is not a supportable deduction. *See* TNT Ltd. v. TNT Messenger Service, Inc., 724 F.Supp. 210, 207 (SDNY 1989) (the fact that the common element of the marks at issue was the “everyday” initials TNT rendered both marks weaker and confusion less likely; public was accustomed to seeing “TNT” in a variety of commercial and

non-commercial contexts); Empire Nat'l Bank of Traverse City v. Empire of Am., FSA, 559 F. Supp. 650, 655 (W.D. Mich. 1983) (finding no likelihood of confusion where more than 100 financial institutions used EMPIRE as part of their trademarks and noting that financial institutions in general tend to use similar names).

C. The Petitioner's Marks are Weak.

A crucial factor in determining likelihood of confusion is the strength of the prior mark. *See Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1315-16 (TTAB 2005) (finding that opposer's mark, ESSENTIALS, was highly suggestive and not likely to be confused with applicant's mark, NORTON MCNAUGHTON ESSENTIALS, where both marks were applied to clothing); *see also Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass'n*, 651 F.2d 311, 315, 211 USPQ 844, 847-48 (5th Cir. 1981). The strength of a mark depends on its distinctiveness in the mind and perception of the relevant consumers. *See* 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §11:85 at 11-144 (4th Ed. 1998); Lang v. Retirement Living Pub. Co., 949 F.2d 576, 581, 21 USPQ2d 1041, 1044 (2d Cir. 1991) ("Ultimately, the strength of the mark turns on its 'origin-indicating' quality, in the eye of the purchasing public."). The mere presence of a common, highly suggestive or descriptive element is usually insufficient to support a finding of likelihood of confusion. Sears, Roebuck & Co. v. Hofman, 46 CCPA 708, 258 F.2d 953, 119 USPQ 137 (1958); E.L. Bruce Co. v. American Termicide Inc., 48 CCPA 762, 285 F.2d 462, 128 USPQ 341 (1960).

D. The Parties' Services Can Be Distinguished

While Registrant does not dispute for purposes of this motion that certain of its services and the Petitioner's services are related in terms of overall subject matter, such a broad and

superficial connection is insufficient to establish a likelihood of confusion. See TMEP § 1207.01(a)(iv) and cases cited therein (“The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto”). Rather, where the parties’ products or services are somewhat related but not competitive, a finding of likelihood of confusion must depend on other factors. See Homeowners Group, Inc. v. Home Marketing Specialists, Inc., 931 F.2d 1100, 1108, 18 U.S.P.Q.2d 1587, 1593 (6th Cir. 1991). In the present case, such “other factors” lean against a finding of confusing similarity. Thus for example, in Information Resources, Inc. v. X\*Press Information Services, Inc., 6 U.S.P.Q.2d 1034, 1038 (TTAB 1988), the Board concluded that the mark X\*PRESS for a news service delivered over a computer network was not confusingly similar to EXPRESS for information analysis computer programs, after considering the differences in spelling between the marks, the differences between the goods on the one hand and the services on the other, the widespread third-party use and registration of the word in the same field, and the expensive and sophisticated nature of the products. 6 U.S.P.Q.2d at 1038-39. In the present case, most of those same factors also weigh against a finding of similarity.

Indeed, close inspection of the parties’ respective services would demonstrate that Registrant’s services include many things that are clearly distinct from and only tenuously related to Petitioner’s. It is noteworthy in this regard that the Examining Attorney assigned to Registrant’s application concluded that only one of Petitioner’s marks supported a section 2(d)

refusal, and that only as to Class 41. Registrant further notes that none of Petitioner's registrations cover the Registrant's core classes of 38 and 41.

E. Summary.

As discussed more fully above, the Petitioner's marks consist primarily of two highly descriptive and very widely used words which should be entitled to only a narrow scope of protection – a scope which should not reach Registrant's Mark, given the differences in the first words, the services claimed, and other factors discussed herein.

CONCLUSION

For all the foregoing reasons, or any of them, Registrant AFC Network Pvt. Ltd. respectfully requests that the Board enter an order dismissing the Cancellation and awarding Registrant such other and further relief as the Board deems just and proper.

Respectfully submitted,

AFC NETWORK PVT. LTD.,

By its Attorneys,



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Dated: June 12, 2009

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing document was served on June 12, 2009, upon counsel for Petitioner by first class mail, postage prepaid, addressed to:

Timothy D. Steffens, Esq.  
Polsinelli Shughart, P.C.  
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A handwritten signature in black ink, appearing to read "Timothy D. Steffens", is written over a horizontal line.