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Sent: 10/15/2009 12:31:57 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 77534075 - WHAT'S NEXT? - N/A

Attachment Information:

Count: 1

Files: 77534075.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/534075

MARK: WHAT'S NEXT?



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TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

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EXAMINING ATTORNEY'S APPEAL BRIEF

OBJECTION TO EVIDENCE

The examining attorney objects to the evidence provided by Applicant as cited in its Appeal Brief as untimely on the grounds that this material is provided for the first time on appeal and was not made of record prior to this appeal. 37 C.F.R. §2.142(d). The specific evidence objected to by the examining attorney consists of all material in Applicant's Appeal Brief Exhibits A, B, C and D, as well as arguments pertaining and reference thereto in Applicant's Appeal Brief. The record prior to appeal did not include this evidence and therefore under 37 C.F.R. §2.142(d), it should be excluded from consideration by this Board for purposes of this Appeal.

FACTS

Registration is refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds that there is a likelihood of confusion between Registration No. 3208151 for WHAT'S NEXT! WHAT'S NEXT!! WHAT'S NEXT!!! in standard character for "Entertainment services in the nature of a continuing live television talk and variety show, featuring songs and music, comedy and satirical social commentary; Entertainment

services, namely, providing web sites featuring information, videos and music in the field of comedy and satirical social commentary”, and Applicant’s applied-for-mark WHAT’S NEXT? in standard character for “Entertainment in the nature of an on-going special variety reality show featuring lifestyle makeovers for middle aged people distributed by television, satellite and video media.” Applicant filed a Notice of Appeal dated June 8, 2009 with a Request for Reconsideration of a final office action dated December 9, 2008. The Request for Reconsideration was denied on June 29, 2009 and Applicant subsequently filed its Appeal Brief on August 17, 2009.

ARGUMENT

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

This two-part analysis is performed in the relevant context of whether it is likely or not that the classes of consumers, purchasers, sponsors and/or viewers of the live television talk and variety show entertainment services and of the special variety reality show entertainment services distributed by television, satellite and video media will be confused over source, sponsorship, affiliation or connection. *See, McCarthy On Trademarks And Unfair Competition*, § 23:5 (4th Ed. 2009). The marks in issue in this case clearly create the same overall impression and the services are the same, similar and/or highly related as specified in the cited registration and the instant application, therefore leading to the conclusion that confusion is likely for consumers, purchasers, sponsors and/or viewers of these services .

THE MARKS CREATE THE SAME OVERALL IMPRESSION

Applicant seeks to register the mark WHAT'S NEXT? in standard character over the cited registered mark WHAT'S NEXT! WHAT'S NEXT!! WHAT'S NEXT!!! in standard character. Applicant's applied-for-mark comprises wording that is identical to the wording in the cited mark, namely "What's Next." The punctuation differs in each mark and the wording "What's Next" is repeated three times in the registered mark, however, these are *de minimis* differences. These marks are without doubt similar in sight, sound and meaning, and are overwhelmingly likely to cast and/or create the same overall impression in the minds of relevant consumers, purchasers, sponsors and/or viewers.

This Board has held that similarity as to only one of these factors may be sufficient to support a finding of likelihood of confusion in the context of the whole record. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, n.4, 1987 WL 124020 (T.T.A.B. 1987). Here, all three factors are present: sight, sound and meaning. The wording "What's Next" is without doubt the dominant part of both marks. Therefore, there can be no doubt that these marks create the same overall impression.

Applicant argues that these marks are insufficiently similar as well as sufficiently dissimilar in appearance, sound and connotation or meaning. However, clear authority as cited by the examining attorney in *Lamson* supports a finding that the cited registered mark WHAT'S NEXT! WHAT'S NEXT!! WHAT'S NEXT!!! and Applicant's applied-for-mark WHAT'S NEXT? do create the same overall impression based upon the facts that the wording used in both marks is identical, dominant, has the same sound and the same meaning. The use of repetition in the cited registered mark serves only to emphasize the wording "What's Next", as illustrated by use of exclamation points, so that there can be no doubt that in the minds of relevant consumers, purchasers, sponsors and/or viewers this wording has a well-made and lasting impression.

Applicant's arguments that its mark and the cited registered mark share only a fragment cannot stand when subject to a review of the facts of this case. If these arguments were to be considered sound then their converse would apply as well, namely that the wording "What's Next" is not confusingly similar to the same wording repeated three times. This

type of reasoning is not supported by the facts. The facts of this case support that it does not matter which way one views it, the wording “What’s Next” and the wording “What’s Next! What’s Next!! What’s Next!!! are essentially the same wordings.

The facts of this case differ greatly from the facts of cases relied upon by the Applicant as authority for its arguments. Applicant’s reliance upon *Entrepreneur Media, Inc. v. Smith*, 279 F. 2d 1135, 1146 (9th Cir. 2002) is misplaced. Here, there is an identical wording that essentially comprises both marks that is in issue; in *Entrepreneur* the marks varied by different terms as well as meaning. Applicant improperly relies upon a dissection of the marks analysis that counts characters and syllables to attempt to establish differences between the marks in issue. However, this type of analysis must be considered as weak and non-supportive of the conclusions its attempts to draw since identical wording, identical sound and identical meaning as it exists in the marks in issue in this case must take precedence over merely counting characters and syllables.

The analysis of whether the marks in issue in this case create the same overall impression must be based upon the facts contained in this record as they apply to the issue of likelihood of confusion under Section 2(d). When these facts are considered in relation to the case law that applies to such analysis, it is clear that in this case the use of identical wording with identical sound and identical meaning unmitigatedly leads to the conclusion that the marks “What’s Next! What’s Next!! What’s Next!!! and “What’s Next” create the same overall impression.

THE SERVICES ARE RELATED

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51

USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see* TMEP §1207.01(a)(iii). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

In this case, the services in the cited registration are “Entertainment services in the nature of a continuing live television talk and variety show, featuring songs and music, comedy and satirical social commentary; Entertainment services, namely, providing web sites featuring information, videos and music in the field of comedy and satirical social commentary”, Applicant’s applied-for-services are “Entertainment in the nature of an on-going special variety reality show featuring lifestyle makeovers for middle aged people

distributed by television, satellite and video media.” The services in the cited registration comprise in part a “continuing live television talk and variety show, featuring songs and music, comedy and satirical social commentary” and Applicant’s services are solely “an on-going special variety reality show featuring lifestyle makeovers for middle aged people distributed by television, satellite and video media.” There is a readily discernible overlap in the nature and/or type of services specified in the cited registration and in the instant application, namely variety shows that are available to the viewing, purchasing and/or sponsoring public and/or markets that are viewable on television in the case of the cited registration and viewable by television, satellite and video media in Applicant’s case.

Clearly, these services are the same, similar and/or highly related services, namely variety shows viewable on the identical forms of media that compete for the attention of audiences, viewers and/or sponsors. It is important to note that the services in the cited registration are not limited to an age-specific group and/or audience, as in the Applicant’s case. Since there are no limits described in the cited registration as to the scope of audience, viewers and/or sponsors, it must be presumed that the services in the cited registration are available to all types of audiences, viewers and/or sponsors, including those in the Applicant’s more limited scope of audiences, viewers and/or sponsors.

The facts in this case are analogous to those in *Miss Universe L.P., LLLP v. Community Marketing, Inc.*, 82 U.S.P.Q.2d 1562, 2007 WL 458530 (T.T.A.B. 2007), where the Board found a likelihood of confusion found between the famous mark MISS UNIVERSE and the mark MR. GAY UNIVERSE, both for beauty pageants. There, the Board said that the issue was not whether the two pageants would be confused for one another, but whether the junior user's pageant would be seen as an offshoot of or affiliated with the senior user's famous pageant. Just as in *Miss Universe*, both marks in this case are for the same type of services, entertainment television-type variety shows with essentially the same format, and should be considered by this Board to be identical services offered in connection with the marks in issue for purposes of confusion analysis. The subject matters of these services are offered for the same essential purpose, namely,

variety entertainment, so that even though the content may slightly differ, they are competing for the same audiences, viewers and/or sponsors that make up the pool of audiences, viewers and/or sponsors for television-type entertainment variety shows.

In the market for these services as it presently exists, it is common for television shows to be made available to viewers and/or audiences via various broadcasting means, such as broadcast television, cable television, satellite television and television shows made available over the Internet. This present reality of the entertainment market is identified in both the description of services in the cited registration and in the Applicant's description of services. These facts lead to the conclusion that the normal channels of trade and classes of purchasers of the identified services in issue are the same.

Applicant argues that the services in issue are unrelated since they are incongruous in content yet the record shows that the services in issue are essentially the same, namely variety shows. While there is no *per se* rule that entertainment variety shows are related, the factual analysis in this case does lead to that very conclusion, since the classes of purchasers for these services, namely audiences, viewers and/or sponsors and the like, are the same. The facts in this record support the conclusion that the services in the cited registration and those in the instant application are competing for the same entertainment dollar market. The history of the entertainment variety show business certainly must admit to variety shows that started out "small" and became "big" due to growth in popularity over a period of time. It is not for this Board to second-guess which variety shows will be a hit, popular and/or well-known, as Applicant's arguments seem to suggest, but to determine whether based upon an existing registration, a subsequent application should register, particularly when the facts between the existing registration and subsequent pending application show that the marks are nearly identical and the services are of the same nature, type and/or genre.

Applicant's reliance for its arguments on *Lemme v NBC, Inc.*, 472 F. Supp. 2d 433 (E.D.N.Y. 2007) is misplaced in this case. Although the marks in issue in *Lemme* were identical and/or nearly identical as they are in this case, the type of shows in issue were

completely different, unlike the facts here before the Board. In *Lemme*, the shows were on one-hand a program based upon factual circumstances of people living and/or succeeding in the “American Dream” and on the other hand a show about a fictional family that contained segments featuring popular musical acts. These were completely different types of shows. Here, in this case, the types of shows are the same, namely entertainment variety shows as explicitly described in the cited registration and in the instant application.

Again, Applicant’s reliance upon prior cases that involve identical and/or nearly identical marks as the name of a show is misplaced because the facts in the cases cited by Applicant clearly differ as to the types of services, namely the types of shows. Applicant cites *Chum Ltd. v Lisowski*, 198 F. Supp. 2d 530 (S.D.N.Y. 2002) for the same principle, namely that shows with the same or nearly the same name or mark were found not to be confusingly similar. However, once again the facts in *Chum* differ from the facts of the instant case. In *Chum*, one show was a journalism program and the other show a type of voyeuristic program. Applicant mistakenly argues that these were identical services when in fact the findings of the courts in both *Lemme* and *Chum* are to the contrary, namely, findings that the types of shows were dissimilar types of shows.

In this case, the shows in the instant case are the same types of shows, namely entertainment variety shows. Applicant’s arguments are not cogent because they fail to address this essential fact. The only evidence offered by the Applicant to support its arguments consists of two pages attached to its response to an office action dated November 17, 2008. At that time Applicant provided a copy of a web site promoting its show and a copy of a web site promoting a different mark allegedly owned by the owner of the cited registration. Applicant’s arguments at that time ignored as they do now, that because it has limited the scope of the subject matter of its entertainment variety show to lifestyle makeovers for middle aged people, the fact that the services in the cited registration are not limited to a particular age demographic. Although Applicant limited its services from the time of filing to exclude news, music and comedy from its description, it still remains that that the shows in issue are described as variety shows, so

that with the wording variety shows goes all of the scope of subject matter included within the scope of the wording “variety show” namely, a variety of types of entertainment. Further, Applicant’s commentary regarding aesthetics or supposed quality likewise does not merit a decision in its favor, since these are relative factors in the world of entertainment variety shows, and popularity among audiences, viewers and/or sponsors for variety shows are not driven by these concerns alone. Popularity is not the issue in this case before the Board and the evidence in the record does not support Applicant’s analysis of the issue. Rather, the issue is whether on its face, does the cited registration preclude registration by a subsequent applicant for a confusingly similar mark for the same, similar and/or related services.

Applicant’s arguments next make claims that the wording “What’s Next” is merely descriptive or suggestive of the services in the cited registration, as well as to secondary meaning and acquired distinctiveness, and these are simply not the issues before the Board. Applicant’s arguments in this part of its brief are apparently to try and establish that the cited registered mark is “weak” and entitled to a narrow scope of protection. However, this argument contravenes existing case law that is on point for the issue that is before this Board, namely, that a registered mark is entitled to the full scope of consideration when it comes to the possibility of subsequent registration of confusingly similar marks as well as the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), that use of the mark extends to all goods and/or services identified in the registration and also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services.

Further, even if this Board were to find the cited registered mark to be a “weak” mark, The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks

registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975).

The function and/or purpose of the wording “What’s Next” in the cited registered mark as well as in the instant application is as a service mark that serves to connect audiences, viewers and/or sponsors to the entertainment variety shows. Once again, the interests of audiences, viewers and/or sponsors of entertainment variety shows cannot be second-guessed as part of the analysis under Section 2(d) in this appeal as suggested by Applicant’s voluminous arguments in this vein. Rather, the tenets of analysis under Section 2(d) as cited by the examining attorney should alone serve as the foundation for a decision in this case.

CONCLUSION

For the reasons stated above, the final refusal to register Applicant’s mark on the grounds that there is a likelihood of confusion with Registration No. 3208151 should be upheld.

Respectfully submitted,

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