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

Proceeding	77980028
Applicant	Mixed Message Media, Inc.
Applied for Mark	LAMPOONTANG
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Date	05/23/2011

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

In re Application of:	:	International Class 41
MIXED MESSAGE MEDIA, INC.	:	
Serial Numbers 77860990, 77980028	:	Examiner: Kevon Chisolm
Filed: May 23, 2011	:	Law Office 103
For: LAMPOONTANG	:	

APPELLANT'S SUPPLEMENTAL REPLY

INTRODUCTION

Appellant, Mixed Message Media Incorporated, (hereinafter the "Applicant," the "Appellant," or "Mixed Message") hereby files this supplemental reply in response to the Examining Attorney's (hereinafter the "Examiner") Opposition brief.

Examiner refused registration of Appellant's mark LAMPOONTANG because, in the Examiner's opinion, the proposed mark is disparaging to women and presents a likelihood of confusion with another registered mark, LAMPOON. Appellant disagrees with both the Examiner's factual and legal determinations, and requests that the Board reverse the Examiner's decision.

ARGUMENT

In addition to the arguments set forth in Appellant's Reply Brief, Appellant objects to the Examiner's continued insistence that LAMPOONTANG's registration creates a likelihood of confusion with LAMPOON. Contrary to the Examiner's arguments, LAMPOONTANG is more than merely "LAMPOON + TANG," but it is an entirely new word creation that is not likely to be confused with LAMPOON. Moreover, LAMPOONTANG is not likely to be confused with LAMPOON within the marks' respective channels of trade. Examiner has not offered any evidence to support his position, but only argument – and unpersuasive argument, at that.

A. There is No Likelihood of Confusion Under Section 2(d)

1. The Appellant's Mark Is Dissimilar from the Existing Mark, LAMPOON, and Does not Bear a Likelihood of Confusion on its Name Alone.

Appellant's mark, goods and services, and trade channels are meaningfully dissimilar from the LAMPOON trademark. First, the marks are not identical, as they were in *Opus One*,

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removing this from the realm of close cases where more searching inquiry is needed. LAMPOONTANG and LAMPOON are, on their faces, dissimilar marks.[1]

The mere inclusion of "lampoon" in "lampoontang," if Examiner's dissection of the mark is accepted, is an insufficient basis for this Board to affirm the Examiner's refusal to register Appellant's mark. The competing marks must be considered in their entireties when analyzing them for a likelihood of confusion, and should not be dissected.[2] Even identical names can be validly registered as trademarks without any risk of confusion so long as they are for different goods and services, as identified in the Appellant's application and registrant's registration.[3] The Board has previously held that use of a common term such as "broadway" can keep several marks distinct, even if the marks relate to similar goods and services.[4]

In cases involving common terms, consumers look to other elements of the mark to distinguish them, eliminating the likelihood of confusion and justifying their registration.[5] Analysis of the marks' similarity must consider their appearance, sound, meaning and commercial impression; increasing dissimilarity between the two reduces the likelihood of confusion precluding registration.[6] While adding a term to a registered mark does not *per se* preclude a likelihood of confusion,[7] Appellant's mark does not merely add new terms to a registered mark, but is a new mark entirely.

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[1] *Opus One*, 60 USPQ2d at 1812, citing *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

[2] *In re Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (holding that "marks tend to be perceived in their entireties" and should be evaluated as such); *Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 851 23 USPQ2d 1471, 1473 (Fed. Cir. 1992) (finding that when the public will evaluate the entire mark, then the marks must be considered in their entirety under a likelihood of confusion analysis).

[3] *Opus One*, 60 USPQ2d at 1812, citing *Canadian Imperial Bank of Commerce*, 811 F.2d at 1490, 1 USPQ2d at 1813.

[4] *In re Broadway Chicken, Inc.,* 38 USPQ2d 1559, 1565-66 (TTAB 1996).

[5] *Id*.

Lampoon is a similarly common, pervasive term. Though the registered mark, LAMPOON, refers to The Lampoon, a printed humor publication associated with Harvard University, lampoon is also used to identify National Lampoon, a producer of humorous printed matter and videos. Lampoontang, to the extent it can be said to incorporate this word, creates *pornographic* content, unlike The Lampoon and National Lampoon, and is available solely online, rather than through print or other audiovisual media. This matrix of facts renders it distinct from the registered mark, LAMPOON, and other existing uses of the word "lampoon." If the disparity in these brands' names is not sufficient to alert consumers that they are not one in the same, the difference in the goods and services associated with them will be.

2. Appellant's Mark Does Not Compete in the Same Marketplaces as Existing Marks, and is of a Dissimilar Nature, Obviating any Confusion in the Channels of Trade.

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Second, precedent indicates that the dissimilarity in the Appellant's relevant marketplace and the existing mark's (LAMPOON) precludes the marks from being confusingly similar.[8] Logically, bare similarity is a prerequisite for competing marks to be *confusingly* similar. Examiner's refusal to register the mark on this basis is therefore flawed.

A side-by-side comparison of Appellant's mark and an existing trademark is not the appropriate test for finding likelihood of confusion.[9] The nature of goods or services and relevant marketplaces associated with the marks must also be considered within the scope of

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[6] *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1357.

[7] *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004).

[8] *Opus One*, 60 USPQ2d at 1812; *see also Canadian Imperial Bank of Commerce*, 1 USPQ2d at 1813.

[9] *Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc.*, 470 F.2d 1385, 1386 (C.C.P.A. 1972) (holding that the main consideration of trademark similarity must be on the consumers' "general recollection" of the mark, rather than a side-by-side comparison); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007 (C.C.P.A. 1971).

Section 2(d) analysis.[10] LAMPOONTANG's goods and services description delineates its relevant market, services and goods, and relevant trade channels as being solely adult in nature.

While the markets for similar marks are presumed to be overlapping where there are no restrictions within their goods and services descriptions,[11] LAMPOONTANG's goods and services description is restricted to adult content in the online market, and thus compels the opposite result. No matter how much or little depth is used to compare the marks in more than a mere side-by-side analysis the stark, obvious dissimilarities between the goods corresponding to LAMPOON and LAMPOONTANG obviates any potential for confusion, let alone a likelihood that one may exist. Because of the dissimilarities between their stated markets, goods and services and trade channels, there is no likelihood of confusion between LAMPOON and LAMPOONTANG.

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Examiner argues that the manner in which LAMPOONTANG will be used in the channels of commerce is relevant to whether a likelihood of confusion exists for LAMPOON. Yet, it is not. The dissimilarities between LAMPOONTANG and LAMPOON, in both trade name and goods offered, are so significant that any use in commerce will not result in likely or actual confusion. Because of LAMPOONTANG's sole position in the adult market, there is no relationship between it and LAMPOON. The goods and services represented by each mark therefore are not in the same relevant market, reducing the likelihood of confusion to nil.[12]

Indeed, there is no evidence whatsoever of a conceivable relationship between LAMPOONTANG and LAMPOON. Even applying the "something more" test found in *Opus*

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[10] *Geigy Chem.*, 438 F.2d at 1007.
[11] *In re Linkvest, S.A.*, 24 USPQ2d 1716 (TTAB 1992).
[12] *Opus One*, 60 USPQ2d at 1812; *see also Canadian Imperial Bank of Commerce*, 1 USPQ2d at 1813.

One and *Jacobs v. International Multifoods Corporation*, which requires a finding of an extremely arbitrary mark being used in relation to a similar or complementary good or service, the marks are unlikely to be confusingly similar.[13] Lampoon is not such an extremely arbitrary word, as it is defined in Merriam-Webster as "harsh satire normally directed against an individual,"[14] that it would make LAMPOONTANG an even more unique term than LAMPOON. Additionally, there is no complementary relationship between the two marks. LAMPOONTANG and LAMPOON serve different markets and with different services that cannot be regarded as related, unlike the wine and restaurant duo of trademarks at issue in *Opus One*.[15]

While LAMPOON is relevant to humor and satirical material in print and online, LAMPOONTANG – a completely new and arbitrary word – corresponds to adult entertainment services and commentary to be available exclusively online. The dissimilarities between these marks, the goods and services offered under them, and their relevant markets are substantial enough to ensure there will be no likelihood of confusion within the consuming public in whatever channel of trade they encounter the marks. Based on existing law, there is no risk of confusion as to any aspect of LAMPOONTANG and LAMPOON's goods, services or relevant markets under Section 2(d).

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CONCLUSION

Examiner's alternative basis for refusing the mark's registration in International Class 41, a likelihood of confusion under Section 2(d), does not withstand any meaningful review.

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[13] *Opus One*, 60 USPQ2d at 1812; *Jacobs v. Int'l Multifoods Corp.,* 688 F.2d 1234, 212 USPQ 642 (C.C.P.A. 1982).

[14] Merriam-Webster Online, Lampoon, http://www.merriam-webster.com/dictionary/lampoon (*last accessed* Aug. 22, 2010).

[15] *Opus One*, 60 USPQ2d at 1812.

LAMPOONTANG and LAMPOON are distinctly different in their goods and services, trade channels and the markets they serve – one being for general humor, and the Appellant's mark for adult entertainment. The Examiner's refusal to register the Appellant's mark constitutes a legal error. Appellant seeks for this Board to reverse the Examiner's refusal and order the registration of LAMPOONTANG to the U.S. Patent and Trademark Office's Principal Trademark Register.

Submitted May 23, 2011

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