

Section 2(E)(1) Refusal - Merely Descriptive

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

Applicant respectfully submits that the trademark is suggestive of the Applicant's services and content and not merely descriptive as contended by the examining attorney. If a consumer has to exercise "mature thought or follow a multi-stage reasoning process" to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 U.S.P.Q. 496, 498 (TTAB 1978) ("This association of applicant's mark with the phrase 'theater-in-the-round' creates an incongruity..." thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). See also, *Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 U.S.P.Q. 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers; suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968) (SUGAR & SPICE not merely descriptive

of bakery products; suggestive of nursery rhyme); *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 U.S.P.Q. 237 (2d Cir. 1954), cert. denied 347 U.S. 968, 101 U.S.P.Q. 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 U.S.P.Q. 610 (C.C.P.A. 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 U.S.P.Q. 159 (TTAB 1964) (finding RAPIDSHAVE for shaving cream suggestive, not descriptive).

Applicant believes it would assist the Examining Attorney to have a better understanding of the purpose and function of its services and content. OfflineTV is described as a show that is distributed online about a group of content creators who got their start in gaming and now live in a house together and make cool videos. A content creator is someone who is responsible for the contribution of information to any media and most especially to digital media. These particular content creators are popular streamers on websites such as Twitch and YouTube, and include popular content creators such as Scarra, Pokimane, LilyPichu, Disguised Toast, and Fedmyster.

Viewers normally are able to watch and interact with real time videos of the content creators playing video games. While playing the content creators also provide commentary alongside the video games that may be funny, tactical, or insightful to the viewers. This fosters a community that allows more people to communicate than typical media outlets as well as brings a sense of belonging to the viewers. OfflineTV was then created with the idea that it is more enjoyable to stream with like-minded people so the content creators assembled a team of streamers to live in a house together. OfflineTV is designed so that viewers may watch and interact with the content creators outside of their video game streams and take a behind the scenes tour into their daily life. For instance one episode may be about the content creators having fun while playing a party game such as Mafia

<https://www.youtube.com/watch?v=ugll3FZv7SA>

while another episode may be about the content creators' reactions to eating spicy foods

<https://www.youtube.com/watch?v=GU4a7PZrits>

With this in mind the word "Offline" used in the trademark "OfflineTV" does not mean that the programs are available for viewing offline, in fact it is much harder to watch these videos offline because videos that are downloaded on Twitch expire after some time and are deleted automatically while videos on YouTube require a paid subscription to be downloaded and viewed offline. Also watching the videos offline loses deprives the viewers of the interaction between them and the content creators whether it is the viewer sending messages while watching a live video of OfflineTV or interacting with other viewers in a comment section during or after watching a recorded episode. "Offline" as used in the mark means that viewers can watch their favorite content creators outside the content creator's normal channel of working "online" playing video games and watch them interact with other streamers in their every day life under the same roof. "Offline" as used here is more suggestive because though the videos and episodes are of the content creators intermingling and enjoying one another's company during their downtime, these videos are still meant to be viewed online. A viewer has to put some rational thought into that the reason the show is called "OfflineTV" is because content creators are not working at their normal "online" jobs, thus it is suggestive instead of descriptive.

If examiner is not swayed by this argument then applicant suggests at the least the term "offline" is a double entendre. A "double entendre" is a word or expression capable of more than one interpretation. For trademark purposes, a "double entendre" is an expression that has a double connotation or significance as applied to the goods or services. The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is

not merely descriptive in relation to the goods or services. TMEP 1213.05 A true "double entendre" is unitary by definition. An expression that is a "double entendre" should not be broken up for purposes of requiring a disclaimer. See *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) where the Board found inappropriate a requirement for a disclaimer of "LIGHT" apart from the mark "LIGHT N' LIVELY" for reduced calorie mayonnaise, stating as follows: The mark "LIGHT N' LIVELY" as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term "LIGHT" per se. That is, the merely descriptive significance of the term "LIGHT" is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole.

The term "Offline" is readily apparent to the public and especially those in the demographic who watch video game streams that "Offline" is a play on words, requiring rational thought on part of the viewer, pertaining to interacting and watching the content creators when they are not working online. Since one of the meanings of "offline" is not merely descriptive in relation to the goods or services, the mark should not be refused registration.

Section 2(D) Refusal– Likelihood Of Confusion With Respect To Classes 35 & 41

8750216 for Offline was abandoned April 15, 2019 because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. Examiner has rejected registration of the applied-for mark in Classes 35 and 41 because of a likelihood of confusion with the mark in U.S. Registration No. 5372709. The Lanham Act provides for rejecting registration of a mark that "so resembles a [registered] mark . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). The

section continues that if "confusion, mistake, or deception is not likely to result from continued use . . . of similar marks . . . , concurrent registrations may be issued." *Id.* As the examining attorney points out, the likelihood of confusion determination is assisted by applying the DuPont factors outlined by the Court of Customs and Patent Appeals, predecessor to the Federal Circuit. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The thirteen DuPont factors are as follows: (1) the marks' similarity in appearance, sound, connotation, and commercial impression; (2) the similarity of the goods and services covered by the marks; (3) the similarity of the channels of trade; (4) the sophistication of the typical consumer; (5) the distinctiveness (sales, advertising, length of use) of the registered mark; (6) the number of other, similar marks used for similar goods or services; (7) any evidence of actual confusion; (8) the length of concurrent use without evidence of actual confusion; (9) the variety of goods or services covered by the marks; (10) any discussions or agreements between the marks' owners; (11) the marks' current exclusivity in the marketplace; (12) the substantiality of potential confusion; and (13) any other evidence probative of concurrent use's effects on consumers. *Id.* at 1361. Because the likelihood of confusion determination is case specific, some factors may be more or less relevant in a given case. *Id.* at 1361-62; see also *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355-57 (Fed. Cir. 2011). The examining attorney asserts that the following factors are most relevant in this case: (1) similarity of the marks; (2) similarity and nature of the goods and/or services; and (3) similarity of the trade channels. However, applicant asserts that the existence of other, similar marks used for similar goods and services is additionally, especially relevant in this case. The determinative inquiry is whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973).

Although not all du Pont factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

There is no likelihood of confusion based on the factors established in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) because Applicant OfflineTV does not provide the same type of content or sell its products in the same channels of trade as the other registered mark set forth in the response from the trademark examiner. In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers. *Packard Press, Inc. v. HewlettPackard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000).

Confusion is not necessarily likely simply because the goods or services can be described as being in the same category or field. See *Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, "[g]oods [and services] may fall under the same general product category but operate in distinct niches," thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001).

When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that consumers are not likely to assume the products originate from the same mark. See, e.g., *Commerce Nat'l Ins. Servs., Inc.*, 214 F.3d at 441 (holding marks held by company

operating in banking industry and company operating in insurance industry did not create consumer confusion because the two companies were involved in distinct highly regulated industries); Astra Pharm. Prods., 718 F.2d at 1207 (finding no product similarity in medical technology sold to different departments in hospital because " `the hospital community' is not a homogeneous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties' respective products."); Harlem Wizards, 952 F. Supp. at 1095 (finding no product similarity between professional competitive basketball team and "show basketball" team

Previously Registered Mark Owner's website <http://offline.global/> explains that "OFFLINE was created by Brad Wilder, Christopher Groove and Benjamin Sagan in the recent past. A simple meeting in a bar had produced an exchange of previously unspoken musical urges and desires that would prove you need some chalk with your cheese sometimes. It unravelled in the Groove Vienna HQ, a flickering thankfully fully soundproofed studio that was so smoke filled it made the Beijing smog look like a pleasant morning in the Maldives. Apparently the expensive acoustic treatment had factored this in and so it proved over these next fun filled weeks and months. Offline was conceived. Events, gigs, a record label and other stuff.

It would look beautiful and breathe quality. Direction and design that would be utterly distinctive. An abandoned puppy was rescued from the wintry streets and named Walter– it was the one occasion they had to walk to the takeaway as the phones had gone offline. Offline would be rather red with neon notes and look gorgeous whatever it put on display. An umbrella that would allow not only the partnership but the individuals to express and flourish – and loads of other stuff. A record label. Home cooked music to distract and to dance to. Freedom for and collaboration with fellow travellers. Music for sharing and evolving and stir frying with as little oil as possible.

Events that would also be quite red and look devastatingly good because of a cutting edge approach to design linked to a sound that went and was Offline. Smaller gigs and collaborations that stretch out somewhere else and unselfconsciously explore locations and opportunities. Groove & Wilder sums it up. Who needs a mission statement with those names? Get some people to build the thing and get on with it. There are no rules Offline. Apart from the no rules rule.

A video associated with Previously Registered Mark may be found on

https://www.youtube.com/watch?v=4_Wq1v5y0Tc.

Applicant's mark and Previously Registered Mark do not operate in overlapping business and are in separate and distinct segments of the overall field of entertainment. Applicant's sphere includes a behind the scenes look in the every day life of e-sports and video game enthusiasts in a episodic format. Previously Registered Mark Owner's sphere includes record and song producing providing highly professional music videos of musicians and acquiring venues for concerts around musicians working under Previously Registered Mark. Consumers will never find Applicant's mark in record stores, Spotify, or the Grammys, and Applicant has no interest in entering into this market using Applicant's mark, while Previously Registered Mark is not likely to be found on Twitch or at an e-sports tournament, thus the commercial impression on consumers precludes a finding of likelihood of consumer confusion.

As described above when marks fall under the same general category but operate in distinct niches, they avoid confusion. Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc. Applicant's Mark falls in just such a niche category—that of media in the field of e-sports and video games streaming and entertainment featuring those in the field of e-sports and video games

streaming. Providers of goods and services related to e-sports and video games tend to remain in the e-sports and video games industry. Similarly, record label producers tend to avoid the field of e-sports and video games streaming, with the only connection being that music is selectable within the video game themselves or video games created around the music. However since commentary and interactions with the content creators is one of the most important aspects and music may interfere or drown out the content creators' voices, the music is usually turned off or inaudible. Content creators also typically do not play music because of the licensing fees involved that can prove quite expensive. As such, consumers are unlikely to believe the music industry and e-sports and video game streaming industry are related.

Applicant and Previously Registered Mark Owner's content are also promoted at entirely different trade shows and events with Applicant's Mark being promoted or featured at conventions such as Anime Expo, Electronic Entertainment Expo, and PAX. Applicant and Previously Registered Mark's owner have target customers that generally belong to distinctly different groups. Applicant's demographic and prospective viewers are video game fans and aficionados, predominantly comprised of children and young teenagers. On the other hand Previously Registered Mark clearly is directed to target an older audience with idiosyncratic themes and language as well as graphic content including depictions of nude women. Applicant's mark and Previously Registered Mark Owner's content are not substitutes for each other. There is not much overlap when a viewers is looking for a slice of life comedy and drama about their favorite content creators or looking for new kinds of music to listen to. Applicant's Mark has been used in commerce for over a year now and has amassed over 600,000 subscribers and has multiple videos with over 1 million views and there has been no evidence of occurrences of actual confusion between Applicant's Mark and Previously Registered Mark. For these reasons there is no reason

for a likelihood of confusion between Applicant's Mark and Previously Registered Mark. The Previously Registered Mark also doesn't have the TV face of Applicant's Mark that further separates the marks from one another.