

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Hearst Communications, Inc. :
Serial No. 87/196735 : Examiner: Marco Wright
Filed: October 7, 2016 : Law Office: 120
Mark: COSMOPOLITAN :
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RESPONSE TO OFFICE ACTION

This is Applicant's response to the Office Action dated December 2, 2017 for the Trademark COSMOPOLITAN, Application Serial Number 87/196735.

REMARKS

Applicant's Mark Is Not Likely To Be Confused With The Cited Registration

The examining attorney has partially refused Applicant's mark COSMOPOLITAN for use in connection with "dried flowers" in International Class 31 pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the premise that registration of the Applicant's mark is likely to cause confusion with Registration No. 3,300,000 for the word mark COSMOPOLITAN BOUQUET owned by 1-800-FLOWERS for use in connection with "live flower arrangements" in International Class 31 (the "Cited Mark").

Applicant respectfully argues that there is no potential likelihood of confusion between Applicant's mark and the Cited Mark. The Examiner argues that "Applicant and registrant's goods are related because they often emanate from a single source". Applicant's goods would be sold under the COSMOPOLITIAN brand, therefore, any potential likelihood of confusion is negated by the residual goodwill and consumer recognition Applicant has already established in the COSMOPOLITAN mark in connection with its well-known women's magazine. Further, the goods in International Class 31 covered by the Applicant's proposed mark are not (i) sold in the same channels of distribution as the goods covered by the Cited Mark and (ii) targeted at the same consumer base covered by the Cited Mark. Applicant respectfully submits that the term COSMOPOLITAN suggests sophistication, experience, culture and style and is used to name lines of collections for various products. See Exhibit A for examples of such use of Cosmopolitan in the marketplace. The Cited Mark should therefore be given a scope of protection that is limited to the source and consumer base.

In testing for likelihood of confusion under Section 2(d), the court in *In re E.I. DuPont de Nemours & Co.* 476 F2d 1357, 177 USPQ 563 (CCPA 1973) cited factors relevant to the evaluation of whether or not source confusion is likely. The following factors are considered material and relevant by the Applicant in this *ex parte* matter:

- 1) The similarity or dissimilarity of the marks in sound, appearance, meaning or connotation and commercial impression.
- 2) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.

Applying these factors to the subject issue, Applicant believes that any analysis balances in favor of Applicant.

The likelihood of confusion in the marketplace as to the source-origin of the relevant products is, at the very most, *de minimis*. The undersigned believes it necessary for the Examining Attorney to review the history, popularity and extensive growth of Applicant's COSMOPOLITAN brand.

Applicant's Mark Already Has A Loyal Consumer Base As The Mark Represents A Product Extension Based On Several Prior Registrations And Years Of Use

Applicant's *Cosmopolitan* magazine launched in 1886. *Cosmopolitan* magazine has consistently been one of the top 20 best selling magazines in the United States and one of the top 5 best selling women's magazines. *Cosmopolitan* is the best selling young women's magazine in the U.S., a bible for fun, fearless females that reaches more than 17 million readers a month. *Cosmopolitan* delivers the latest news on men and love, work and money, fashion and beauty, health, self-improvement and entertainment. Cosmopolitan.com reaches over 35 million unique users a month and has a social media following of nearly 15 million. In addition to the U.S. flagship edition, *Cosmopolitan* is published in more than 80 countries around the world. See Exhibit B for *Cosmopolitan's* Media Kit. Additionally, Applicant has had a licensing program covering a broad range of products in place for the *Cosmopolitan* brand for decades.

These COSMOPOLITAN branded products and activities are the subject of national advertising campaigns and receive coverage by third party media outlets. Through the pages of the magazine and through its extensive licensing program, the COSMOPOLITAN brand is widely recognizable to its likely-purchasing customer.

The logo on any product's packaging, labels and/or tags (including the subject of this application) is the same as the *Cosmopolitan* magazine logo. In other words, the products are merely a logical product extension based on the goodwill and brand awareness generated by *Cosmopolitan* magazine that shares the same trademark. Consumers are already very familiar with the source of these goods. See Exhibit C for screen shot of Applicant's global licensing agent.

The Applicant's And The Cited Marks Are Not Likely To Be Confused And Are Sold Through Very Different Channels Of Trade

We point out that the goods covered by the Cited Marks are targeted to different customers through different channels of trade than the Applicant's Mark.

1800Flowers.com is a floral and gourmet foods gift retailer and distribution company. The term Cosmopolitan is used to describe a line or collection of flower arrangements sold by 1800Flowers.com. See Exhibit D. It is noted the line of Cosmopolitan flower arrangements by 1800Flowers.com is no longer available for sale.

Applicant's proposed use of COSMOPOLITAN on "dried flowers" are like the numerous other goods and services marketed under the COSMOPOLITAN name, and will be marketed to the target audience of Applicant's *Cosmopolitan* magazine. Goods or services of respective marks must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion of origin is likely. *In re August Stork KG*, 218 U.S.P.Q. 823 (TTAB 1983). There is 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." TMEP § 1207.01(a)(iv)].

Applicant's Mark Is Not Likely To Be Confused With The Prior Filed Application

The Examiner has referenced a prior filed application, COSMOPOLITAN JEWELS & Design, Applicant Serial Number 87/041381 ("COSMOPOLITAN JEWELS"), the filing of which proceeds Applicant's mark. The Examiner has graciously given the Applicant a chance to present an argument in support of registration by addressing the issue of the potential conflict between the two applications.

The Parties Marks Are Different

COSMOPOLITAN JEWELS would not be confused with Applicant's mark for the reasons outlined above. Further, support for the difference of Applicant's COSMOPOLITAN mark and COSMOPOLITAN JEWELS & Design is the distinct design element of the martini glass, which evokes another definition of the term COSMOPOLITAN, namely, the cocktail typically made with vodka, Cointreau, cranberry juice, and lime juice. The use of such design in connection with the COSMOPOLITAN JEWELS mark conveys a different meaning than Applicant's COSMOPOLITAN mark.

The Trademark Office has consistently permitted concurrent registrations where the cumulative differences in the commercial impressions of the marks have rendered confusion unlikely. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 U.S.P.Q 272, 276 (C.C.P.A 1974) (no likelihood of confusion found between the mark FIA FASHION INSTITUTE OF AMERICA & DESIGN and the marks FIT (Stylized) and FASHION INSTITUTE OF TECHNOLOGY due in part to the distinctive design of applicant's compound mark); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 179 U.S.P.Q. 45, 46 (C.C.P.A. 1973) (no likelihood of confusion between SILK (Stylized) for face cream and SILK 'N SATIN for beauty lotion and bath oil for hands and skin); *Color Key Corp. v. Color 1 Assocs., Inc.* 219 U.S.P.Q. 936, 943 (T.T.A.B. 1983) (variations in highly suggestive mark COLOR 1 and mark COLOR KEY 1 for identical goods and services relating to cosmetics served to render such marks distinguishable).

AMENDMENT OF GOODS

Applicant wishes to amend the subject Application's goods as follows:

International Class 6: metal hooks; statuaries made of non-precious metal; wall and shelf works of art, namely, alphabet initials made of non-precious and common metal.

International Class 14: jewelry holders and jewelry boxes; statuaries made of precious metal; jewelry organizer cases

International Class 16: desktop organizers; wall and shelf works of art, namely, alphabet initials made of paper

International Class 20: crates and other storage receptacles in the nature of nonmetal and non-paper storage containers; organizers, namely, drawer organizers, jewelry organizer displays, non-metal fabric hanging organizers, and non-metal fabric bin organizers; wall and shelf works of art, namely, alphabet initials made of wood, plastic, and plaster; shelves; shelving units, namely, shelves and brackets sold as a unit; non-metal hooks; desks; desk chairs; coat racks; desktop statuaries made of bone, ivory, plaster, plastic, wax, and wood; plant stands; accent tables; cabinets; wine racks; bar carts; magazine holders, namely, magazine racks and display stands; mirrors

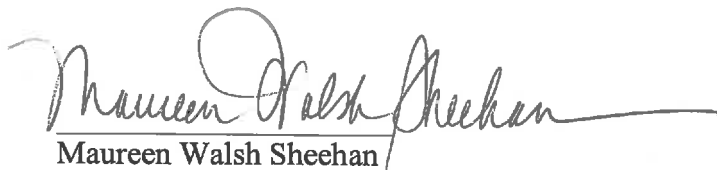
International Class 21: baskets for domestic use, laundry baskets; wall and shelf works of art, namely, alphabet initials made of ceramic and glass.

Examining Attorney has accepted International Class 31 description.

CONCLUSION

Based on the foregoing remarks and amendment, Applicant respectfully submits that its mark COSMOPOLITAN is entitled to registration on the Principal Register.

Respectfully submitted by,

A handwritten signature in cursive script that reads "Maureen Walsh Sheehan". The signature is written in black ink and extends across the width of the page.

Maureen Walsh Sheehan

Attorney of Record

Dated: June 1, 2017

EXHIBIT A



Cosmopolitan

IMPRESSIONS MODERN



All American MATTRESS GALLERY

CHOOSE YOUR BED ABOUT US FEATURED REVIEWS CONTACT



The Springwall Cosmopolitan Spring Collection was developed to provide discriminating sleepers with comfortable, supportive and durable sleep systems without compromise. The Cosmopolitan Collection combines modern foam encased zoned and wrapped coils with specialty foams and old world fibers, wrapped in neo classical covers. These works of mattress art are more than just a pretty product. Each model is designed to achieve a particular surface comfort level without sacrificing proper support. Experience a true value in sleep, The Springwall Cosmopolitan Spring Collection.

The Cosmopolitan Spring Collection incorporates graphite/gel infused latex in every model. This unique comfort layer provides unparalleled durability and pressure relief. The addition of graphite aids with heat dispersion and the addition of gel beads enhances resilience and durability.



Our Cosmopolitan Foam Collection has been designed with an eye towards pressure relief, cool sleep and healthy support. Today typical memory foam mattresses can be difficult to move in and




The Cosmopolitan Collection

The Cosmopolitan Collection was designed in 2006. Elizabeth got the idea to design this signature look after she was given a necklace with similar taste, from her Grandmother. In Elizabeth's eyes her grandmother was the epitome of a Cosmopolitan lady. This collection is intended to speak to the empowered women on the go. No matter if you're walking out the door to work or headed to a playdate, you can always feel confident. Dress it up or dress it down, wear it layered or alone, you will love it and feel like you can conquer the day.

SORT BY: Featured ▾



EXHIBIT B



Cosmo is the world's largest young women's media brand, with more than 128 million brand touchpoints across print, digital, and social platforms.

Always absolutely real, open and entertaining, Cosmo's coverage dives into everything she cares about — beauty, fashion, work, health, relationships, culture, life.

Our mission is to empower young women to own who they are and be who they want to be, and we're focused on propelling her into her fun, fearless future. No excuses, no bull@#**%, no regrets.

COSMOPOLITAN FUN FEARLESS FEMALE

GOSMOPOLLITAN DEMOGRAPHIC PROFILE 2017

**TOTAL
ADULTS
17,133,000**

**TOTAL
WOMEN
14,449,000**

**READERS
PER COPY
(Adults) 5.81**

**READERS
PER COPY
(Women) 4.91**

WOMEN	AUDIENCE (000)	COMP (%)	INDEX
AGE			
18-24	3,209	22.2	186
25-34	3,801	26.0	153
18-34	7,010	49.0	166
18-49	11,035	76.4	142
HHI			
\$50,000+	8,244	57.0	98
\$75,000+	5,805	40.2	98
Median:	\$61,017		
EDUCATION			
Any college:	9,405	65.1	109
Currently Attending College:	2,275	15.7	195
EMPLOYMENT			
Total employed:	9,384	64.9	118
MARITAL STATUS			
Single:	6,078	42.1	165
Married:	5,439	37.6	74
OTHER			
Women w/ Children:	6,756	46.8	114
Women Working w/ Children:	4,546	31.5	123
Hispanic:	3,282	22.7	152
COUNTY			
A/B:	11,173	77.3	108
C/D:	3,275	22.7	80

GOSMOPOLITAN

EDITORIAL
CALENDAR
2017

JANUARY

Do You, Not New

This January we celebrate you in all your fun, fearless glory. Ditch the unrealistic and unattainable goals, and just LIVE.

DIGITAL:

- "Knockout the New Year" content series

SOCIAL:

- Custom shot Instagram posts with top fitness gurus
- Wellness and beauty-themed Snapchat edition

CLOSING DATE:

10/25

ON-SALE DATE:

12/13

FEBRUARY

Lip Service

From helping her find her voice at work and in relationships, to ultimate lip looks, this will be her go-to guide for everything she'll want to pay lip service to.

DIGITAL:

- Beauty + Empowerment-focused content series

SOCIAL:

- Lip-themed Snapchat takeover
- Facebook Live "Beauty Happy Hour"
- Insta-Lips Takeover on Instagram

CLOSING DATE:

11/22

ON-SALE DATE:

01/10

MARCH

All Eyes On You

In March, we'll feature eye-catching beauty trends as well as explore perspectives from how we see the world, to how we view ourselves, our bodies and our future.

DIGITAL:

- Beauty 101 + Eye Spy lifestyle content series

SOCIAL:

- Hyperlapse Instagram tutorial videos
- Eye-centric Instagram & Snapchat content

CLOSING DATE:

12/20

ON-SALE DATE:

02/07



COSMOPOLITAN

EDITORIAL
CALENDAR
2017

APRIL Spring Style & Hair

Hats off to Spring! Time to embrace warmer weather, the season's hottest trends, and of course, your best hair ever.

DIGITAL:

- Hair-focused + "Spring Forward" lifestyle content series

SOCIAL:

- Hair How-To hyperlapse Instagram videos
- Facebook Live "Happy Hour Hair Bar"

CLOSING DATE:
01/17

ON-SALE DATE:
03/07

MAY Cosmo Loves

This issue will be chock-full of all our faves, from our annual must-see, must-shop beauty awards, to the season's closet all-stars (best fitting jeans! Sexiest bra!), and much more.

DIGITAL:

- Beauty Re-Boot + Best of Everything content series

SOCIAL:

- Cosmo Loves Instagram posts
- Cosmo Loves "Best of" Snapchat edition

CLOSING DATE:
02/21

ON-SALE DATE:
04/11

JUNE Cosmo Confidential

Every BODY can be a beach BODY! From a big swim roundup, to fitness, nutrition and love advice, Cosmo will ramp her confidence wattage right up!

DIGITAL:

- Summer Bucket List + Confidence Booster content series

SOCIAL:

- Themed Instagram challenges all month
- Confidence-themed Snapchat edition

CLOSING DATE:
03/21

ON-SALE DATE:
05/09



GOSMOPOLITAN RATE CARD 2017

	COLOR	BAW
PAGE	\$276,590	\$221,255
2/3 PAGE	\$207,485	\$165,920
1/2 PAGE	\$186,660	\$149,345
1/3 PAGE	\$138,295	\$110,670
SECOND COVER	\$352,665	
THIRD COVER	\$304,215	
FOURTH COVER	\$373,405	

	CLOSING	ON-SALE
JANUARY	Oct. 24, 2016	Dec.13, 2016
FEBRUARY	Nov. 22, 2016	Jan. 10, 2017
MARCH	Dec. 20, 2016	Feb. 7, 2017
APRIL	Jan. 17, 2017	Mar. 7, 2017
MAY	Feb. 21, 2017	Apr. 11, 2017
JUNE	March 21, 2017	May 9, 2017
JULY	April 18, 2017	June 6, 2017
AUGUST	May 23, 2017	July 11, 2017
SEPTEMBER	June 20, 2017	Aug. 8, 2017
OCTOBER	July 18, 2017	Sep. 5, 2017
NOVEMBER	Aug. 22, 2017	Oct. 10, 2017
DECEMBER	Sep. 19, 2017	Nov. 7, 2017

Rate base 3,000,000.
All rates are net.
Notes: Minimum
cover discount
is 25%.

Materials are
due 7 days after
closing date.

See Terms &
Conditions on the
following page.
All specs available
on ads.hearsst.com



SIMPLY INCREDIBLE REACH

THE MOST VITAL WOMEN'S MAGAZINE

BRAND FOOTPRINT (000)



EXHIBIT C

COSMOPOLITAN

Cosmopolitan

The "Cosmo Girl" is ambitious, independent, liberated, fun-loving and sexy. The undisputed leading woman's magazine in the world. Cosmopolitan is the fun, fearless female's expert guide to beauty, health, romance, careers, pop culture and men.

Brands and Clients

Worldwide
The Americas
Europe, The Middle East & Africa
Asia & Australasia

Cosmopolitan

Cosmopolitan inspires with insights on relationships and romance, tips on fashion and beauty, frank talk on sex and advice on women's health and wellbeing.

By far the best selling magazine in its category, Cosmopolitan has 64 international editions, is published in 35 languages and is distributed in over 100 countries, making it one of the best known and trusted women's brands in the world.

[Click here to become a Cosmopolitan Licensee](#)



“Cosmopolitan is the lifestyle bible and cheerleader for millions of liberated, fun, fearless females who want to be the best they can be in every area of their lives.”



EXHIBIT D



Enter keyword or Product number

SEARCH

Sign in | Create Account | Track Your Order

International Delivery



Corporate Gifts

Store Locator

Customer Support

- Summer
- Birthday
- Sympathy
- Occasions
- Flowers
- Plants
- Gift Baskets & Food
- Keepsake Gifts
- Same-Day Delivery
- Sale

Home

Image not available

Product Code: 95064

Cosmopolitan Bouquet®

We are sorry, the product you have selected is not available. Please select from the list of products below or click continue shopping.



Forever Yours Rose Medley by Real Simple®
 \$79.99 ~~\$174.99~~
 Same-Day Local Flower Delivery



Five Stars Red Roses & Orbits
 \$69.99 ~~\$114.99~~
 Shipped in a Gift Box



Beauty in Abundance™
 \$59.99 ~~\$79.99~~
 Same-Day Local Flower Delivery



Birthday Fanfare™
 \$149.99 ~~\$174.99~~
 Same-Day Local Flower Delivery



Loyal Loves in Love®
 \$79.99 ~~\$99.99~~
 Same-Day Local Flower Delivery



Floral Treasures Bouquet
 \$29.99 ~~\$79.99~~
 Same-Day Local Flower Delivery

continue shopping

more like this

Description | More Product Information

EXCLUSIVE If they have a taste for all things modern, we've got just the gift for that special someone! This contemporary hand arranged bouquet from our signature floral cocktail collection is artistically designed with pink roses, lilies and mini carnations in an oversized martini glass to help them celebrate in style!

- Our florists hand-design each arrangement, so colors, varieties and container may vary due to local availability.
- Arrangement of light pink roses, pink Stargazer lilies, hot pink mini carnations, white daisy poms, gypsophila and variegated ptilosporum.
- Lilies may arrive in bud form and will open to full beauty over the next 2-3 days.
- Artistically designed in an oversized acrylic martini glass filled with ruby-red crystal gel and finished with a green lime slice pick, glass measures 9"H.
- Extra Large arrangement measures approximately 16"H x 9"L
- Large arrangement measures approximately 15.5"H x 8.5"L
- Medium arrangement measures approximately 15"H x 8"L
- Small arrangement measures approximately 14"H x 7.5"L

COMMUNICATIONS

E-Mail Exclusives

Sign up to receive special offers and promotions from 1-800-FLOWERS.COM.
 (Email Address) [P]

FOLLOW 1-800-FLOWERS.COM



MORE WAYS TO SHOP

- Flower Arrangements
- Same-Day Flower Delivery
- Sympathy & Funeral Flowers
- Baskets
- Birthday Flowers & Gifts
- Plants
- Gift Baskets & Food
- International Flower Delivery
- Find a Local Florist
- Corporate Gifts
- Affiliate



CUSTOMER SERVICE

- Customer Service
- eGift Cards
- Contact Us
- Funeral/Sympathy Advisor

Top Rated in Floral Customer Service



OUR STORES

Store Locator

CELEBRATIONS REWARDS

Join Celebrations Rewards™
 Login Celebrations Rewards™ Account



CORPORATE

Smile Guarantee
 About Us
 Careers
 Investor Relations
 Gift Cards

Affiliate Program

Become an Affiliate

OUR BLOG

Flower Blog, Petal Talk
 Julie's Blog

