

Office Action Response

GEMINI

U.S. Application Serial No. 97/469,704
DIRECTV, LLC
Ref. No. 61023.620

Remarks

Applicant, DIRECTV, LLC, respectfully submits this Response to the Non-Final Office Action issued on February 10, 2023 with respect to U.S. Trademark Application Serial No. 97/469,704 for the mark GEMINI (“Applicant’s Mark”).

I. Identification of Goods and Services

As an initial matter, Applicant herein submits the following amendments to the Application’s identifications of goods and services:

- Class 9: Set-top boxes; digital video recorders and players; **downloadable and recordable** computer operating software for use with set-top boxes and digital video recorders and players; remote controls **for set-top boxes, digital video recorders and players, televisions, and hardware and equipment for watching television programs**; computer network interconnection hardware; **downloadable and recordable** computer programs for interfacing with computer hardware in computer communications networks; telecommunications products, namely, computer hardware and **downloadable** software for receiving, converting, transmitting, streaming, and reviewing audio, video, images, and data; downloadable computer software for operating telecommunications products; downloadable software in the nature of a mobile application for operating telecommunications products; downloadable video clips in the fields of **action, comedy, drama, variety, adventure, sports, musicals, current events and entertainment news, documentary and animation**, in the nature of television programs, movies and multimedia content, and graphics for display on televisions, computer monitors, personal computers, mobile phones, smartphones, laptops, and tablet computers; computer hardware and downloadable and recorded software for streaming audio and video content to a variety of network devices, namely, televisions, computer monitors, personal computers, mobile phones, smartphones, laptops, and tablet computers; downloadable and recorded computer software for receiving digital video over a communication network; downloadable and recorded computer software for use in organizing, transmitting, receiving, playing, storing and reviewing data, image, audio and video files
- Class 38: Broadcasting, webcasting, streaming, and **electronic** transmission of audio, video, subscription television, and video-on-demand content via the internet and electronic communications networks; television broadcasting to computer monitors, personal computers, mobile phones, smartphones, laptops, and tablet computers; telecommunication services, namely, transmission of voice, data, images, graphics, audio, video, and multimedia by means of wired and wireless networks; satellite television broadcasting; satellite transmission services; video-on-demand television transmission services; streaming of audio and video content via the Internet, other computer networks, wireless networks and electronic communication networks; electronic data transmission

- Class 41: Entertainment services in the nature of providing entertainment programs and content, namely, **non-downloadable** movies, ongoing television programs, **non-downloadable** video clips, **non-downloadable** graphics, webcasts, on-demand content and events, and information relating to movies and television programs in the fields of comedy, drama, action, variety, adventure, sports, musicals, current events and entertainment news, documentary and animation, via satellite, the internet, electronic communications networks, computer networks and wired and wireless communications networks; providing entertainment information in the nature of online programming and scheduling information for movies, ongoing television programs, video clips, graphics, webcasts, on-demand content and events

II. Prior-Pending Applications

The Examining Attorney has indicated that there may be a likelihood of confusion with seven prior pending applications.

As a preliminary matter, five of these – specifically, U.S. Serial Nos. 97469704, 97621902, 97646709, 97648185, and 97681293 – are owned by Applicant. Accordingly, Applicant requests that the Examining Attorney remove Applicant’s pending applications as bars to registration.

Another prior pending application noted by the Examining Attorney is U.S. Serial No. 97537941 for GEMINI JURY, which filed on Aug. 05, 2022. Yet, Applicant’s Mark was filed on June 22, 2022, and thus predates it. As such, Applicant requests that the Examining Attorney remove this later filed application as a bar to registration.

The sole remaining prior pending application is U.S. Serial No. 90674537 for OWC GEMINI, which Applicant will discuss further below.

III. Section 2(d) Refusals

The Examining Attorney has initially refused registration of the applied-for mark based on a likelihood of confusion with five marks: U.S. Registration No. 1,410,190 for GEMINI; Reg. No. 2,169,039 for GEMINI; Reg. No. 3,315,830 for GEMINI STAR PRODUCTIONS; Reg. No. 5,635,191 for MY GEMINI in stylized font (**my|GEMINI**); and Reg. No. 5,377,534 for 9 GEMINI (the “Cited Marks”). Applicant respectfully submits that confusion is highly unlikely as between Applicant’s Mark and the Cited Mark due to *inter alia* the differences in the parties’ respective offerings, differences between certain of the marks, and coexistence of GEMINI-formative marks on the registry.

A. Reg. No. 1,410,190 for GEMINI

U.S. Reg. No. 1,410,190, owned by Architectural Control Systems, Inc., covers “remote control door locking systems consisting of door locks and electrical and pneumatic actuators therefor” (“Cited Mark 1”).

Given the differences in covered goods, Applicant contends that confusion is highly unlikely. Applicant has herein amended its identification of goods from “remote controls” to specify “remote controls for televisions, set-top boxes, digital video recorders and players, and equipment and hardware products for recording, playing, and watching TV programming.” This further clarifies that Applicant’s goods are wholly disparate from this registrant’s covered goods. Applicant’s offerings do not even remotely encompass or overlap with door locking systems.

In fact, the term “remote control” in registrant’s covered goods —“remote control door locking systems” —describes a feature of the door locking system, rather than a remote control device. This is depicted in

the specimen in the file record, showing that Cited Mark 1 is used in connection with a door locking system that can be controlled remotely. See **Exhibit A** for a screenshot of Registrant’s specimen submitted in connection with a renewal declaration in 2016. The registrant, Architectural Control Systems, Inc., is a door hardware product manufacturer and does not provide products related whatsoever to televisions. See **Exhibit B** for a screenshot of Registrant’s website.

B. Reg. No. 2,169,039 for GEMINI

U.S. Reg. No. 2,169,039, owned by Innovative Concepts and Design LLC, covers:

sound mixers, digital samplers, audio mixers, karaoke machines, compact disc players, phonograph turntables, loudspeakers, stereo amplifiers, sound preamplifiers, wireless headphones and professional phonograph turntables and carrying cases for phonograph turntables, sound mixers, compact disc players, phonograph records and compact discs

(“Cited Mark 2”).

(1) *The Registrant’s Consumers are Sophisticated and are Not Easily Confused.*

As an initial matter, the Registrant provides its products for “DJs, musicians, engineers, sound contractors and professional installers around the globe.” See **Exhibit C** for a screenshot of Registrant’s website. Due to the expensive and specialized nature of professional audio equipment, consumers contemplating making a purchase of such goods are sophisticated, discerning, and thoughtful in their purchasing decisions, thereby negating any likelihood of confusion between Applicant’s Mark and Cited Mark 2.

Case law clearly recognizes that “confusion is less likely where goods are expensive and are purchased after careful consideration than where they are purchased . . . casually.” *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 671 109 U.S.P.Q. 313, 315 (C.C.P.A 1956) (“When a buyer has expertise or is otherwise more sophisticated with respect to the purchase of the goods at issue, a higher standard is proper. Similarly, when goods are expensive and unusual, the buyer can be expected to exercise greater care in her purchases.” *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1111, 18 U.S.P.Q.2d 1587, 1596 (6th Cir. 1991).

(2) *The Respective Goods Differ Widely*

The differences between the goods offered by the respective parties are also significant. Cited Mark 2 relates to audio recording and mixing products, including turntables, mixers, and amplifiers. In contrast, Applicant’s goods are used in connection with television watching. These offerings do not encompass registrant’s professional audio equipment.

(3) *Other GEMINI-Formative Marks Coexist for Audio and Sound Goods*

Additionally, evidence of coexisting marks featuring GEMINI is relevant to show that Cited Mark 2 is only entitled to a narrow scope of protection that would not extend beyond the audio equipment space. Examples of such registered marks on the Principal Register can be found in the chart below:

Mark	Coverage
<p>THE GEMINI RN: 5660212</p> <p>Owner: Joshua Ortman</p>	<p>Class 9 - Audio recordings featuring Music; Downloadable video recordings featuring Music; Downloadable Music via the internet and wireless devices; Sound recordings featuring Music; Video recordings featuring Music.</p>
<p>GEMINI RN: 5243676</p> <p>Owner: Echostone Games LLC</p>	<p>Class 9 - ...Video game cartridges; Video game cartridges and cassettes; Video game cartridges and discs; Video game discs...</p>
<p>GEMINI RN: 5552172</p> <p>Owner: Stewart Filmscreen Corporation</p>	<p>Class 9 - Projection screens</p>

See **Exhibit D** for TESS screenshots of these registrations.

Coexistence on the Trademark Office’s Principal Register indicates that confusion is unlikely between GEMINI-formative marks for sound and music related products in Class 9. The scope of protection afforded to Cited Mark 2 is thus somewhat narrow for sound and audio goods.

C. Reg. Nos. 5,635,191 and 5,377,534; U.S. Serial No. 90674537

U.S. Reg. No. 5,635,191 for MY GEMINI (stylized) (**my|GEMINI**), owned by Banking Software Company s.r.o., covers: “Computers; microcomputers; data and word processors; microprocessors; graphic and text computer terminals; punched card office machines (“Cited Mark 3”).

U.S. Reg. No. 5,377,534 for 9 GEMINI, owned by Alco Electronics Limited, covers “tablet computers” (“Cited Mark 4”).

U.S. Serial No. 90674537 for OWC GEMINI, filed by New Concepts Development Corporation, covers various computer hardware, peripherals, and storage goods in Class 9 (the “Cited Application”).

For reasons applicable to each of these – Cited Mark 3, Cited Mark 4, and the Cited Application – Applicant’s Mark is sufficiently distinguishable.

(1) *Several GEMINI-Formative Marks Coexist for Computer, Communication, and Entertainment Related Goods in Class 9*

Cited Mark 3, Cited Mark 4, and the Cited Application all cover types of computers and processors for same. Not only do these coexist peacefully with one another, but also they coexist with several additional separately owned GEMINI-formative marks on the Principal Register for computers and computer-related offerings. Thus, Cited Mark 3, Cited Mark 4, and the Cited Application are only entitled to a narrow scope of protection. Examples of pertinent coexisting marks are below:

Mark	Sample Coverage
<p>9 GEMINI RN: 5377534</p> <p>Owner: Alco Electronics Limited Corporation</p>	Class 9 - Tablet computers
<p>my GEMINI RN: 5635191</p> <p>Owner: Banking Software Company s.r.o.</p>	Class 9 - Computers; microcomputers; data and word processors; microprocessors; graphic and text computer terminals; punched card office machines
<p>OWC GEMINI SN: 90674537</p> <p>Owner: New Concepts Development Corporation</p>	Class 9 - Computer backup and storage systems with multiple removable RAID cartridges; Computer hardware; Computer hardware and peripherals; Computer hardware for upload, storage, retrieval, download, transmission and delivery of digital content; Computer networking hardware; Recorded integrated computer software for the management and automation of data port expansion and connectivity; Computer storage devices, namely, high-speed storage subsystems for storage and backup of electronic data either locally or via a telecommunications network; External computer hard drives; External computer hard drives featuring recorded integrated software for the storage, backup, and retrieval of electronic data; Removable hard drive based computer backup systems; Backup drives for computers
<p>GEMINI RN: 6957972</p> <p>Owner: GSI Technology, Inc.</p>	Class 9 - Silicon chips; integrated circuits; semiconductors
<p>GEMINI SN: 90208376 (Allowed)</p> <p>Owner: Ednetics Incorporated</p>	Class 42 - Design and development of wireless computer networks
<p>GEMINI DUSK RN: 6034698</p> <p>Owner: Input Club, Inc.</p>	Class 9 - Computer keyboards

See **Exhibit E** for TESS screenshots of these marks.

(2) The Respective Marks Differ Sufficiently

Marks are to be considered in their entireties when determining whether a likelihood of confusion exists. TMEP § 1207.01(c)(ii). Further, marks are frequently allowed to exist on the USPTO Register, despite sharing an element, and even the sole or main element, with another mark. *See, e.g., Paco Sport Ltd. v. Paco Rabonne Parfums*, 54 USPQ2d 1205, 1226 (S.D.N.Y. 2000) (PACO not confusingly similar to PACO

RABONNE); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529, 532 (C.C.P.A. 1970) (PEAK PERIOD for personal deodorants was not confusingly similar to PEAK for dentifrices).

Cited Mark 3, that is, MY GEMINI, creates a unique commercial impression because it both implies that the brand belongs to the consumer herself and it rhymes with the term GEMINI.

Cited Mark 4, that is, 9 GEMINI, is notable for its rhyming, as well. When spoken, it flows very interestingly, sounding like “Nine–Gemma–Ni.” It almost has the feel of a spy agent character or a high-tech gadget.

It is well recognized that in assessing the likelihood of confusion between marks, it is appropriate to consider whether a portion of the mark is dominant in creating the mark’s commercial impression. TMEP § 1207.01(b)(viii). The first term that the consumer encounters is often considered the dominant portion. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (T.T.A.B. 1988) (“It is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”).

The dominant portion of the Cited Application is OWC, because it is the first term encountered by the consumer. In the Cited Application’s Response to Office Action attached hereto as **Exhibit F**, the mark owner submits that “OWC appears first in the mark at issue, and is the dominant portion of the mark because of its long term use in connection with consumer computer goods, specializing in computer back-up and storage hardware and software.” On the other hand, the dominant portion of Applicant’s Mark is the sole term GEMINI.

The mark owner additionally submits “[t]he second word of the mark, "GEMINI" commonly is associated with "twins" in the astrological sign. Therefore, with regard to the goods of the applicant, there exists a double meaning, because of the copying or "twinning" function of computer back-up and storage.” As such, there is significant difference in meaning given that consumers will associate OWC GEMINI with computing products, and more specifically, the copying/twinning function of computer back-up and storage. Conversely, Applicant’s Mark does not reference or cover any computer back-up or storage goods or services.

Accordingly, the Cited Marks 3 and 4 and the Cited Application impart disparate commercial impressions from Applicant’s Mark.

(3) *The Respective Goods Differ Sufficiently*

The differences between the goods offered by the respective parties mitigate any likelihood for consumer confusion. Cited Mark 3 covers computing and processing machines. Cited Mark 4 and the Cited Application similarly cover computers.

In contrast, Applicant’s goods, which cover hardware used to transmit data or stream to a variety of network devices, are used in connection with television sets or television viewing.

Further, Cited Mark 3 solely is used in connection with banking software. See attached **Exhibit G** for a screenshot of the registrant’s offerings. There is no indication that Cited Mark 3 is used outside of banking software or, more to the point, for any of the goods in the registration: Computers, microcomputers, data and word processors, microprocessors; graphic and text computer terminals, punched card office machines.

(4) *The Respective Consumers are Sophisticated and are Not Easily Confused.*

Due to the importance to daily life and the relatively high cost of computers and peripherals, consumers contemplating making a purchase of such goods are discerning and thoughtful in their purchasing decisions, further negating any likelihood of confusion between Applicant's Mark and Cited Marks 3 and 4 and the Cited Application.

In sum, considering the narrow scope of protection afforded to Cited Marks 3 and 4 and the Cited Application, the differences in the respective offerings, different mark impressions, and cost and sophistication associated with purchases, Applicant respectfully submits that the marks are sufficiently different from Applicant's Marks so to avoid consumer confusion.

E. Reg. No. 3,315,830 for GEMINI STAR PRODUCTIONS

U.S. Reg. No. 3,315,830, owned by Matthew S. Southard, covers "Movie studios; Production and distribution of television shows and movies" ("Cited Mark 5").

(1) The Respective Marks Differ Significantly

The differences between Applicant's Mark and Cited Mark 5 are sufficient to avoid a likelihood of consumer confusion in the instant case. Marks are to be considered *in their entirety* when determining whether a likelihood of confusion exists. Further, marks are frequently allowed to exist on the USPTO Register, despite sharing an element, and even the sole or main element, with another mark.

The first two terms of Cited Mark 5—GEMINI STAR—make reference to Gemini in its sense as the third zodiacal constellation. The third term—PRODUCTION—makes reference to use in connection with television and movie production. As such, the identification of production services referenced on the fact of Cited Mark 5 further distinguish the marks and the respective commercial impressions of the marks.

(2) The Respective Goods Differ Sufficiently

The differences between the goods offered by the respective parties mitigate any likelihood for consumer confusion. GEMINI STAR PRODUCTIONS is the name of a movie production company that appears to be solely owned and operated by the mark owner, an individual. See **Exhibit H** for IMDB information. Although Applicant's services cover "broadcast, transmission, and streaming services as well as the provision of movies and television programs", these offerings are sufficiently distinguishable from Registrant's production company. Cited Mark 5, that is, has the look and feel of a production studio name. Even the term "Star" in the mark can connote a star of the screen.

Accordingly, the dominant portions of the respective marks differ and the meaning of the marks differ, causing the marks to create disparate commercial impressions and mitigating any likelihood of consumer confusion.

Conclusion

On a final note, for confusion to be likely, it must be probable, and not just merely possible. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460, 1465 (TTAB 1992); *Rodeo Collection, Ltd v. West Seventh*, 2 USPQ 2d 1204, 1206 (9 Cir. 1987). Trademark law is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ 2d 1388 (Fed Cir. 1992).

Applicant maintains that confusion is *not probable* with respect to any of the Cited Marks or the Cited Application for the reasons described above.

Applicant respectfully requests that all refusals be lifted, and that its application proceed to publication.