

Office Action Response



U.S. Application Serial No. 97/621,902
DIRECTV, LLC
Ref. No. 61023.672

Remarks

Applicant respectfully submits this Response to the Suspension Notice issued on May 22, 2023, with respect to GEMINI and Design (“Applicant’s Mark”).

The Examining Attorney has maintained a partial refusal of the applied-for mark based on a likelihood of confusion with four registrations (the “Cited Registrations”) and suspended Applicant’s Mark pending the disposition of two applications (the “Cited Applications”).

In this Response, Applicant hereby deletes Classes 38 and 41 in their entirety, and deletes all Class 9 goods except for “set-top boxes” and “computer hardware for streaming video content to televisions, in conjunction with set-top boxes.”

Applicant submits that its remaining goods (“Applicant’s Amended Goods”) do not overlap or potentially conflict with the Cited Marks and Cited Applications. This is due to significant differences between the respective offerings, in addition to the differences between the marks and coexistence of other GEMINI-formative marks raised in Applicant’s response to the Office Action filed April 14, 2023. As such, Applicant respectfully requests that the suspension and refusal be lifted, and that its application proceed to publication.

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

U.S. Reg. No. 2,169,039 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.”

The Examining Attorney found that the previously “broad wording” of goods and services for Applicant’s Mark created a likelihood of confusion. Applicant’s Amended Goods are specific to set-top boxes and computer hardware used therewith and *solely* for television watching. On the other hand, U.S. Reg. No. 2,169,039 covers audio recording and mixing products, including mixers, amplifiers, and turntables used as professional audio equipment. The marks are used in entirely distinct contexts.

B. Reg. Nos. 5,635,191 for MY GEMINI and 5,377,534 for 9 GEMINI; U.S. Serial No. 90/674,537 for OWC GEMINI

U.S. Reg. No. 5,635,191 for MY GEMINI (stylized) (**my|GEMINI**) covers “Computers; microcomputers; data and word processors; microprocessors; graphic and text computer terminals; punched card office machines.”

U.S. Reg. No. 5,377,534 for 9 GEMINI covers “tablet computers.”

U.S. Serial No. 90/674,537 for OWC GEMINI covers various computer hardware, peripherals, and storage goods in Class 9.


In short, these three marks cover computers or computer peripherals. These coexist with each other and with additional GEMINI-formative marks on the Principal Register for computers and computer-related offerings, as indicated in Applicant's earlier Response to Office Action. That is, GEMINI is commonly incorporated into marks for computer goods and the term has a narrow scope of protection for same.

Given (i) that those marks coexist, (ii) that the term GEMINI is not strong for computer goods, (iii) that those marks contain additional terms not in Applicant's Mark, and (iv) the discrete coverage of Applicant's Amended Goods, Applicant's Mark can clearly coexist here.

C. Reg. No. 3,315,830 for GEMINI STAR PRODUCTIONS; U.S. Serial No. 97/537,941 for GEMINI JURY

U.S. Reg. No. 3,315,830 for GEMINI STAR PRODUCTIONS covers "Movie studios; Production and distribution of television shows and movies."

U.S. Serial No. 97/537,941 for GEMINI JURY covers "Entertainment services in the nature of live visual and audio performances, namely, musical, variety, news and comedy shows; Providing online music, not downloadable."

In light of Applicant's deletion of Classes 38 and 41, and that these cited marks contain additional terms, confusion simply is unlikely with  for set-top boxes and related hardware.

Conclusion

For the reasons described above and in Applicant's Response to the Office Action filed on April 14, 2023, there are sufficient differences with the Cited Registrations and Cited Applications such that confusion is not likely. Applicant respectfully requests that all refusals be lifted, and that its application proceed to publication.