

Request for Reconsideration

The Examining Attorney has raised two issues. With respect to the disclaimer requirement, Applicant respectfully disagrees with the Examining Attorney, but agrees to disclaimer in order to expedite this application. With respect to the Section 2(d) issue, Applicant requests reconsideration.

The Examining Attorney has issued a likelihood of confusion objection based upon a registration of SPORTV and Design (No. 4657849) on the Supplemental Register. Among other things (discussed below), the Applicant's mark and the Cited Mark as very different in overall looks and commercial impressions and the literal elements have different pronunciations:



Moreover, the literal element of the cited mark must be considered by the Office as weak because the mark was registered on the Supplemental Register as the result of a Section 2(e) objection. In light of the weakness of the cited mark and differences between the marks, Applicant respectfully submits that a Section 2(d) refusal would be inappropriate. Accordingly, Applicant respectfully submits that the likelihood of confusion refusal should be withdrawn.

A. Applicant's Mark Creates a Distinct Overall Commercial Impression From the Cited Mark such that Confusion is Not Likely.

Under the Lanham Act, a refusal to register grounded on a likelihood of confusion basis requires that such confusion as to the source of the goods or services is not merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson Inc.*, 222 U.S.P.Q. 367 (T.T.A.B. 1983). Moreover, mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. In *Jacobs v. Int'l Multifoods Corp.*, the Court stated that "[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used..." *Jacobs v. Int'l Multifoods Corp.*, 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982) (emphasis added) (footnote omitted). See also *Merritt Foods Co. v. Americana Submarine*, 209 U.S.P.Q. 591, 599 (T.T.A.B. 1980). When the marks of the parties are viewed in their entirety, Applicant's mark sufficiently differs from the Cited Mark such that confusion would not be likely.

In analyzing the similarity of the marks, it is not proper to dissect the marks of the parties and to discard or ignore all other non-similar elements. The case law regarding anti-dissection is clear that this type of arbitrary analysis is improper in establishing a likelihood of confusion between marks and deviates from the well-established anti-dissection rule. "It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue." *McCarthy On Trademarks and Unfair Competition* §23:41 (quoting *China Healthways Institute, Inc. v. Wang*, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007), cert. denied, 128 S. Ct. 661 (2007)); *PlayMakers, LLC v. ESPN, Inc.*, 69 U.S.P.Q.2d 1439 (W.D. Wash. 2003), aff'd, 376 F.

3d 894, 71 U.S.P.Q.2d 1759 (9th Cir. 2004) (“[W]hat is critical is the overall appearance of the mark as used in the marketplace, not a deconstructionist view of the different components of the marks.”). Applicant’s mark, SPORTS.TV and design, is visually, phonetically, and conceptually different from the Cited Mark such that the application of the “appearance, sound, and connotation” analysis makes clear that Applicant’s Mark and the Cited Mark are not likely to be confused by consumers.

Here, the Examining Attorney did not give adequate weight to the differences in the respective marks. The Cited Mark, SPORTV, lacks integral letters, a symbol, and any design element, when compared to Applicant’s Mark which leads to a different visual, phonetic and conceptual impression, thus, distinguishing it from Applicant’s Mark. The Examiner has “eliminated portions [of Applicant’s mark] and then simply compared the residue” to reach the conclusion that these marks are identical. *Id.* In fact, there is a significant difference in appearance and sound due to the extra “S”, the “.TV”, and the distinctive design element in Applicant’s mark.

Specifically, *the Cited Mark as registered could be read/interpreted as “SPOR TV” or “SPORT VEE” or “SPORT five”*. Contrast this to the *only* pronunciation and reading of Applicant’s “SPORTS dot TV” mark. While some consumers *may* interpret the Cited Mark to be related to sports, the composition of the Cited Mark certainly dictates an ambiguity as to pronunciation, meaning and commercial impression. The differences which the Examiner has dismissed (the “S” and “.TV” (pronounced “DOT” “T” “V”) in Applicant’s mark), create a completely different commercial impression than that of the Cited Mark.

Additions to marks, or the absence of elements in marks, may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP § 1207.01(b)(iii). The Examiner has improperly dissected the marks and discarded meaningful differences between the marks. It is clear consumers will distinguish between the Cited Mark, SPORTV, and Applicant’s mark, SPORTS.TV. This argument is bolstered by the fact that the shared elements between the parties’ marks are weak in the relevant field of use. In sum, the “S”, “.TV” (pronounced “DOT” “T” “V”), stylization of the letters, and unique design element in Applicant’s mark significantly distinguishes the two marks in sight, sound and commercial impression.

The Federal Circuit’s decision in *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) is determinative here. In *Shen Mfg. Co.*, the Federal Circuit reversed the Board’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) was likely to cause confusion, because, *inter alia*, the mark THE RITZ KIDS creates a different overall commercial impression. Certainly, if the words “THE” and “KIDS” can serve to distinguish between marks for consumers, the absence or addition of letters and unique design elements (which, in the current case, completely changes the commercial impression, sound and phonetics of the marks), should sufficiently distinguish the Cited Mark from Applicant’s Mark.

Also of interest is *Bell Laboratories v. Colonial Products*, 231 U.S.P.Q. 569 (S.D. Fla. 1986), in which the Court emphasized the differences in sight and sound between "FINAL" and "FINAL FLIP," both for pesticides. In considering the totality of the marks, the Court stated:

The appearance of the marks in the instant case is quite different. Plaintiff’s mark boldly highlights the word "FINAL" in black against the white background with other black print. The letter "F" is capitalized and the other letters are lower case. The printing is stylized. There is little other ornamentation on the "FINAL" package...*Id.* at 572.

The foregoing case highlights the importance of not only considering the marks in their entireties, but also the importance of recognizing the significance of differences in the overall appearance. The

wording in Applicant's Mark appears in bold stylized letters, all of which are one height with a slight slant to the right. The wording is imposed on a unique screen print image of a world map, encased by a thick border. In contrast, the wording in the Cited Mark is simply displayed on a plain background with no distinctive design elements, featuring wording in a completely different stylized font than Applicant's Mark which appear in varying heights and with noticeable spaces in between the letters. Applicant respectfully asserts that these significant differences between the marks in their entireties are sufficient such that confusion would not be likely.

Further, the Examining Attorney does not give proper weight to the completely different commercial impressions the subject marks impart on consumers. The wording "SPORTV" is not a defined term, nor is it a composition of two actual terms, leaving ambiguity as to the meaning and commercial impression. "SPOR" could signal something related to "spores" or an acronym for an organization while the option of "SPORT" and "V" could be a name for a sports-related good or service with the distinguishing term "Vee" or the roman numeral "Five". In contrast, Applicant's Mark which is not made up of any fanciful terms (i.e., "SPOR"), but combines two actual terms, the plural form SPORTS and TV.

When Applicant's Mark and the Cited Mark are viewed in their entireties, Applicant's mark creates a different commercial impressions from the Cited Mark where Applicant's mark is different in visual appearance, sound and connotation. As a result, Applicant respectfully submits that a section 2(d) refusal would be inappropriate.

B. The Mark in the Cited Registration is Entitled to a Narrow Scope of Protection.

The Cited Mark is entitled to a much narrower scope of protection than the Examining Attorney has afforded it in light of the fact that it is registered on the Supplemental Register and the co-existence of similar registered marks. In the Final Office Action, the Examining Attorney states "Applicant's counsel is by all means correct that the term SPORTS is dilute and very descriptive for the services at issue between the application and registration, however, none of the cited marks contain both terms of the marks at issue, namely, SPORT(S) and TV." *Final Office Action*, pg. 6. Respectfully, the Examining Attorney misunderstands Applicant's argument. To clarify its position, Applicant states that it did not argue or make a declaration that the term SPORTS in the parties' marks is descriptive of Applicant's Services. Instead, Applicant argued in the Response, the number of similar SPORT marks co-existing on the register illustrates that the Office believes that prospective consumers can and do distinguish between marks with identical or highly similar literal elements for entertainment-related offerings. In addition to the examples previously submitted, Applicant notes that a search of live registrations of marks including the word SPORT or SPORTS for services that include the word "television" in class 41 was 346 records as of today.

Applicant notes that the "number and nature of similar marks in use on similar goods" speaks to the strength or weakness of a mark, (*In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973)), and third party registrations may be accorded evidentiary weight to show the meaning of a mark. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 189 U.S.P.Q. 693, 694-95 (C.C.P.A. 1976). Such registrations are evidence of the beliefs of the cited registrants and third party registrants themselves "who would be most concerned about avoiding confusion and mistake, that various [] marks can coexist provided that there is a difference." *Jerold Elecs. Corp. v. The Magnavox Co.*, 199 U.S.P.Q. 751, 758 (TTAB 1978)(citation omitted); *Plus Prods. v. Natural Organics, Inc.*, 204 U.S.P.Q. 773 (TTAB 1979) (the co-existence among PLUS-formative registrations for identical/related goods creates an inference that "a number of different trademark owners have believed, over a long interval of time, that various 'PLUS' marks can be used and registered side by side without causing confusion or mistake provided there are minimal differences between the marks."). *See In re Hartz Hotel Services, Inc.* at 1154.

As shown by numerous third-party uses previously submitted by Applicant, approved applications and registrations for variations of SPORT marks, the term SPORT is weak and is entitled to a narrow scope of protection. Therefore, just like consumers are able to distinguish between different SPORT-formative marks cited in the Response, consumers will distinguish Applicant's Mark from the Cited Mark where sufficient differences exist between the two. As such, Applicant's mark should likewise be permitted to peaceably co-exist among the below-referenced marks on the register.

Although the past practice of other Examining Attorneys is not binding on the examination of the subject application, the references shown below, of similar marks co-existing on the register illustrates that the USPTO believes that prospective consumers can and do distinguish between marks with identical or highly similar literal elements for these entertainment-related offerings. The USPTO is "encourage[d]...to achieve a uniform standard for assessing registrability of marks." 57 U.S.P.Q.2d at 1566. Thus, third party registrations may be accorded evidentiary weight to show the meaning of a mark. *See, e.g., Tektronix, Inc. v. Daktronics., Inc.*, 534 F.2d. 915, 189 U.S.P.Q. 693, 694-95 (C.C.P.A. 1976).

Conclusion

In light of the co-existence on the register of many "SPORTS" or similarly formatted marks, the fact that the Cited Mark is registered on the Supplemental Register and must therefore be considered a weak mark, the differences between the literal elements of the Cited Mark and Applicant's mark, and the very different overall look and commercial impression of the Cited Mark and Applicant's mark when considered as whole, Applicant respectfully submits that a Section 2(d) refusal would be wholly inappropriate. Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal and approve the application for publication.