

RESPONSE TO USPTO'S ACTION NOTICE

To the Trademark Examiner:

This letter shall serve as Applicant, WHENSITON, INC.'s ("Applicant") response to the United States Patent and Trademark Office, Office Action, dated January 14, 2019. Applicant respectfully requests a reconsideration of the USPTO's refusal of the above-referenced trademark application, and that the trademark be registered.

The Application was initially refused based on two issues identified by the assigned trademark examining attorney: (1) Section 2(d) Likelihood of Confusion Refusal; and (2) Specimen Refusal. As will be more comprehensively discussed below, Applicant contends that there is no likelihood of confusion between its applied-for mark and the marks in U.S. Registration Nos. 1363747, 1539631, and 2418823 ("Registered Marks"). Additionally, Applicant contends that refusal on the basis of the specimen submission is correctable through submission of a verified, substitute specimen. Given the relative complexities of these issues, Applicant will address the latter first.

Submission of Substitute Specimen

In part, registration was apparently refused because the applied-for mark did not appear anywhere on the specimen initially submitted. This is inaccurate. The Office Action states that the specimen submitted consisted "of a photographic image of four birds, with no wording whatsoever." That was not the specimen submitted. The specimen submitted did in fact include the applied-for mark in use in commerce for each international class of services identified in the application. Specifically, the specimen constituted a webpage banner that shows the applied-for mark as used in the actual rendering and/or advertising of its services; clearly showing a direct association between the mark and the services.

It is unclear how the examining attorney reviewed a wholly unrelated, different, and non-submitted specimen in connection with the application. However, in the interests of responding to this particular refusal, Applicant has submitted a verified substitute specimen, together with a signed affidavit stating that, "The originally submitted specimen was in use in commerce at least as early as the filing date of the application."

There is No Likelihood of Consumer Confusion Applying the DuPont Factors

Contrary to the initial finding of the examining attorney, there is no likelihood of confusion between the applied-for mark and the Registered Marks based on the factors established in *In re E.I. DuPont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973). The examining attorney relied upon two key considerations, namely: (1) the purported similarities between the compared marks; and (2) the relatedness of the compared goods and/or services, in concluding that confusion was likely. A more comprehensive analysis of these two *DuPont* factors, as well as other relevant factors, unequivocally tips in favor of registration and a finding that there is no likelihood of confusion.

Likelihood of confusion under the Lanham Act, 15 U.S.C. § 1052(d) is a legal determination based on factual underpinnings. *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1084 (Fed.Cir.2000). The determination must be made on a case-specific basis.

The first *DuPont* factor requires examination of the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 476 F. 2d at 1361. The proper test is not a side-by-side comparison of the marks, but instead, whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties. *Leading Jewelers Guild*, 82 USPQ 2d at 1905. In this fact-specific inquiry, if the parties' goods are closely related, a lesser degree of similarity between the marks may be sufficient to give rise to a likelihood of confusion. *In re: Inca Textiles, LLC*, 344 Fed. Appx. 603, 606 (Fed. Cir. 2009). However, even in instances where the marks at issue are identical, or nearly identical, it has been found by the Trademark Trial and Appeal Board ("TTAB") that differences in connotation can outweigh visual or phonetic similarity. *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ 2d 1811, 1820-21 (TTAB 2005) (finding that BLUE MAN GROUP "has the connotation of the appearance of the performers" and that applicant's BLUEMAN mark "has no such connotation for cigarettes or tobacco. Thus, the marks differ in their connotations and commercial impressions"); *see also In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B.1987) (considering CROSSOVER for brassieres and CROSSOVER for ladies' sportswear and finding that, "[a]s a result of their different meanings when applied to the goods of applicant and registrant, the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance").

As will be discussed further below, the parties' services are not closely related, therefore, require a greater degree of similarity between the marks to sufficiently give rise to a likelihood of confusion. That high degree is not met here. Contrary to the examining attorney's finding, the applied-for mark and the Registered Marks are not phonetic equivalents. It is verifiable that the "WHIO" portion of the Registered Marks denote and connote radio and television broadcast call signs or call letters, which are assigned by the Federal Communication Commission ("FCC") and federally required to be broadcast by pronouncing the individual letters in sequence separately, not as a word. Indeed, WHIO is a commercial radio station licensed to Dayton, Ohio, and WHIO-TV is a CBS affiliated television station licensed to Dayton, Ohio. *See*, [https://en.wikipedia.org/wiki/WHIO_\(AM\)](https://en.wikipedia.org/wiki/WHIO_(AM)); *see also*, <https://en.wikipedia.org/wiki/WHIO-TV>. On the other hand, the applied-for mark, "WIO" is phonetically pronounced as a word, connoting an acronym for the name of the registrant, "When's It On." Accordingly, while the marks may have literal similarities, they are not similar sounding.

Even if they were similar sounding, however, the marks, when viewed in their commercial context, together with the relevant designs and in connection with their respective services, convey entirely different commercial impressions. The Registered Marks, when applied to radio and television broadcast services is limited to its mandated call letters thereby engendering a very clear and narrow commercial impression of broadcasting services. It also conveys a very specific meaning to its listeners and viewers because the call letters are both

synonymous with and denote the geographic location of its services, specifically Ohio. The applied-for mark does not connote or create the commercial impression that it is in any way related to the broadcasting of any radio or television programming because it consists of only 3 letters (whereas call signs require 4 letters), particularly when the applied-for mark has absolutely nothing to do with the broadcasting of television or radio programming. Nor does the applied-for mark convey any specific meaning regarding its geographic reach of services. These differences in the connotations and the commercial impressions of the marks outweigh the visual and purportedly phonetic similarities, and this factor should tip in favor of Applicant and registration.

Turning to the second *DuPont* factor, Applicant disagrees with the examining attorney's preliminary determination that the parties' services are such that they may emanate from a single source under a single mark, and therefore, result in a likelihood of confusion. While it may be true that a likelihood of confusion finding requires only that the goods or services be related in some manner such that they could give rise to the mistaken belief that they emanate from the same source, the mere fact that the subject matter of Applicant's services are provided in the general field of some of the services provided under the Registered Marks alone, without more evidence of the relatedness of the services, is insufficient to find the services are related. *Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 94 (TTAB 1983). The examining attorney cannot be 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. et al. v. Electronic Data Systems Corporation*, 954 F. 2d 713, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992). Under this rubric, it is evident that the services identified in the application and those set forth in the registrations for the Registered Marks, are wholly unrelated, and would not lend itself to any mistaken belief that Applicant's services are associated with the Registered Marks.

The identified services for the applied-for mark are, "Computer services, namely, providing search engines for obtaining data on a global computer network; Computer services, namely, providing search engines for obtaining television listing information on a global computer network." The identified services for the Registered Marks are: (1) television broadcasting services; and (2) radio and television broadcasting services. The parties' services are distinct and unrelated. The Applicant provides consumers with search engine services for the purpose of searching, among other things, television show listings. Glaringly absent from its identified services, is radio and/or television broadcasting services because the Applicant does not provide such broadcasting services, and is limited only to the provision of computer services/search engine services. Nothing more should be read into the scope of the identified services. The owners of the Registered Marks, however, use those Registered Marks exclusively in connection with radio and television broadcasting in the Dayton, Ohio area as a commercial AM radio station and a Channel 7 CBS affiliated television station, respectively. See, [https://en.wikipedia.org/wiki/WHIO_\(AM\)](https://en.wikipedia.org/wiki/WHIO_(AM)); see also, <https://en.wikipedia.org/wiki/WHIO-TV>.

While third party registrations may be probative to this particular determination, they are not determinative, and generally are entitled to very little weight on the question of likelihood of

confusion. *In re: Melville Corp.*, 18 USPQ 2d 1386, 1388 (TTAB 1991); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the marks. *In re Comexa Ltda*, 60 USPQ2d 1118 (TTAB 2001); and *National Aeronautics and Space Admin. v. Record Chem. Co.*, 185 USPQ 563 (TTAB 1975). Indeed, the overriding inquiry is whether the services associated with the parties' marks are of a kind that may emanate from a single source under a single mark. The relevant consumer would not likely assume that the origin of services between the applied-for mark and the Registered Marks are the same. A listener or viewer of the radio/television broadcasts under the Registered Marks, exercising ordinary care, would not likely assume that the Applicant's services are provided by those broadcasters under the Registered Mark. Applicant's services are designed to search television show listings across all networks, all channels, and all media (digital or over-the-air), with absolutely no affiliation with any specific television network. A reasonable, ordinary viewer would not associate a television station that is both geographically limited and restricted to a single broadcast network with a service that allows a viewer to search its competing television stations and networks for programming. The mere fact that the Registered Marks' services include television broadcast services and the Applicant's services provide search capabilities into television show listings is simply not enough to find relatedness of services. This is particular poignant when considered in light of other relevant *DuPont* factors.

Other factors to be considered in the likelihood of confusion analysis are the similarities and dissimilarities of established, likely-to-continue trade channels, and the conditions under which and buyers to whom sales are made. *In re: E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The dissimilarities tip in favor of registration for the Applicant. Applicant and the owner of the Registered Marks market their services through wholly different channels. In the case of radio and television broadcasting services such as those provided by the owner of the Registered Marks, the relevant purchasers of such services are advertisers, seeking to purchase advertising time on the airwaves. Advertisers are extremely sophisticated and would not be likely to utilize the services offered by the Applicant's search engine believing that the services were provided by the owner of the Registered Marks. The relevant users of the Applicant's service, on the other hand, would not include advertisers, but instead, the public at large who watch television. The public at large, even exercising just ordinary care would be able to distinguish between the call letters associated with broadcasting stations and the search engine services provided by the Applicant. Moreover, the Applicant's services are offered exclusively through the internet (e.g. computer services), whereas the registrant's services are offered through broadcast television, a distinct trade channel.

Based on the foregoing, it is clear that the services in question are not related, and they are offered through distinct trade channels. In such instances, even if the marks are identical, confusion is not likely. *See DuPont*, 476 F.2d at 1362, 177 USPQ at 567. This principal is wholly applicable here.

Finally, the examining attorney should acknowledge that a determination of likelihood of confusion involving call letters, while governed by the *DuPont* factors, presents some special

difficulties. *See, In re Infinity Broadcasting Corporation of Dallas*, 60 USPQ 2d 1214 (TTAB 2001). “The FCC issues licenses to parties to use very similar call letters, and the public is aware that call letters for separate radio and television stations may vary by just one letter. As a result, call letters may be able to be closer to each other without causing likelihood of confusion than would be the case for other marks for other goods or services.” *Id.* Closer similarities in connection with competing broadcasters have identical or near identical marks registered based on a lack of confusion. Here, the lack of any likelihood of confusion is far more convincing. Applicant does not even provide a service that is related to television or radio broadcasting, alleviating any concern of confusion. For these reasons, Applicant respectfully requests that the trademark be granted and the refusal withdrawn.