

To: Watch Tower Bible and Tract Society of P ETC. (tm-pto@ssjr.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85896124 - JW.ORG - 06420-T0001A
Sent: 3/12/2014 2:03:40 PM
Sent As: ECOM103@USPTO.GOV

U.S. APPLICATION SERIAL NO. 85896124

MARK: JW.ORG

85896124

CORRESPONDENT ADDRESS:

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APPLICANT: Watch Tower Bible and Tract Society of
P ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

06420-T0001A

CORRESPONDENT E-MAIL ADDRESS:

tm-pto@ssjr.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 3/12/2014

THIS IS A FINAL ACTION.

INTRODUCTION

This Office action is in response to applicant's communication filed on February 4, 2014.

In a previous Office action(s) dated August 5, 2013, the trademark examining attorney refused registration of the applied-for mark under Trademark Act Section 2(d) based on U.S. Registration Nos. 1639555, 2168941, and 4087283. In addition, applicant was required to satisfy the following requirement(s): amend the identification of Class 42 services, submit substitute specimens showing use of the mark, and provide an amended description of the mark.

Based on applicant's response, the trademark examining attorney withdraws the following: the refusals based on Registration Nos. 1639555 and 2168941, and the requirements for an amended identification of services, specimens for Classes 09 and 42, and an amended mark description. *See* TMEP §§713.02, 714.04.

Further, the trademark examining attorney maintains and now makes FINAL the refusal(s) and/or requirement(s) in the summary of issues below. *See* 37 C.F.R. §2.64(a); TMEP §714.04.

SUMMARY OF ISSUES MADE FINAL that applicant must address:

- Likelihood of Confusion Refusal—Class 42
- Specimen Must Show Use of Mark with Class 16 Goods

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION—CLASS 42

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 4087283. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a). This refusal is limited to the Class 42 services in the application.

Applicant's mark is JW.ORG & Design, for use with, *inter alia*, *Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, digital print publications, online publications, documents, forms and web pages all in the field of religion*, in Class 42. The cited mark is JW PLAYER, for use with *Downloadable computer software for playing, viewing and streaming audio and video files* in Class 09.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination.

Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In*

re Vittera Inc., 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Vittera Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant's goods and/or services is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii).

Top-level domains (TLDs), such as “.com” and “.org,” are generic locators for Internet website addresses and provide no meaningful source-identifying significance. See *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1055, 50 USPQ2d 1545, 1558 (9th Cir. 1999); TMEP §§1215.02, 1215.09; cf. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009). Thus, a TLD is less significant in creating a commercial impression in the minds of consumers, and is generally given little weight when comparing marks. See TMEP §1215.09.

In this case, the literal elements of the marks are JW.ORG and JW PLAYER. Because the “.ORG” portion of applicant's mark is a top level domain and the PLAYER portion of registrant's mark is disclaimed, these elements are of minimal importance in comparing the marks, and JW is the dominant portion of the marks. For the reasons discussed above, the design element in applicant's mark is insufficient to overcome the similarity in these literal elements.

Furthermore, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Vittera Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Vittera Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). Therefore, the stylistic differences between the marks are also insufficient to overcome the similarities, as registrant is entitled to a scope of protection that would allow for its mark being displayed in the same stylization as applicant's mark.

For the foregoing reasons, it is the JW element of both applicant's and registrant's mark that will remain in consumers' minds, and which are the lasting commercial impression of the marks. The design element in applicant's mark does not overcome the commonality of the dominant literal element between the marks. Therefore, contrary to applicant's position, the commercial impressions of the marks are the same, and the marks are confusingly similar.

Applicant argues that the appearance and the commercial impressions of the marks are different, focusing on the design element in applicant's mark and the addition of the word PLAYER to registrant's mark. As discussed in greater detail above, the design element in applicant's mark and disclaimed wording PLAYER in registrant's mark are not the dominant elements of the respective marks and are of minimal importance in comparing the marks. Rather, the dominant element of both marks is JW, and the stylization of applicant's mark is insufficient to overcome this similarity, particularly in light of the fact that registrant's mark appears in standard characters.

Applicant also argues that the co-existence of the previously-cited JW & Design marks, Registration Nos. 1639555 and 2168941, with the cited registration, mean that the presence of the JW lettering is not sufficient to show a likelihood of confusion. However, as discussed in greater detail below, the similarity of the marks is only one step in the likelihood of confusion analysis. In this case, the other factors, in particular the difference in the goods and services with which the JW & Design marks and the cited registration are used, are sufficient to overcome a likelihood of confusion finding. Contrary to applicant's assertion, this is the primary reason the marks have coexisted on the Register.

Comparison of Goods/Services

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

In this case, companies often provide websites where users can download various types of media files, while also offering downloadable software for playing, viewing, and streaming audio and video files. These goods and services go hand in hand, allowing users to listen to music or read documents on computers and other mobile devices. The means of delivery to the end user vary only slightly, if at all, as often a website uses downloadable software to perform the same function. Indeed, as evidenced by the attached screenshot from applicant's website, applicant itself offers the ability for users to use its website to both download and stream its audio and video files, so that its online services serve the same function as registrant's goods.

The attached Internet evidence consists of third party websites showing that entities that provide websites where users can download audio and video recordings, DVDs, music, digital print publications, online publications, documents, forms and web pages, also provide downloadable software for playing, viewing and streaming audio and video files. This evidence establishes that the same entity commonly manufactures/produces/provides the relevant goods and/or services and markets them under the same mark. Furthermore, the relevant goods and/or services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Indeed, as applicant itself noted in its Response to Office Action, both applicant's and registrant's channels of trade include the internet. Finally, as discussed above, the goods and/or services are similar or complementary in terms of purpose or function. Specifically, both applicant's and registrant's goods and services are used to listen to music on a computer or other mobile electronic device. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366,

1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

Applicant argues that “providers of general goods and services tend to avoid the field of religious goods and services.” However, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Where there is no limitation in the identification, the scope of the goods and/or services is presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). In this case, the registration uses broad wording to describe the goods, namely that they are for use with audio and video files, and this wording is presumed to encompass all goods and/or services of the type described, including those featuring religion, such as the services offered in applicant’s more narrow identification. Furthermore, attached as additional evidence are screenshots from third party websites showing that the same entities that provide downloadable music and computer software for playing, viewing, and streaming audio and video files also offer such content in the field of religion.

Finally, applicant argues that there are additional marks that include the JW lettering and co-exist with one another. This is true, but it is not the end of the inquiry. Rather, the marks must be compared in their entireties, and then the goods and services with which they are used must also be compared to one another.

In a full comparison of the relevant marks, as well as their goods and services, the pending application is confusingly similar to the registered mark. The evidence submitted by applicant does not indicate a crowded field of marks for similar marks with related goods and services. Therefore, this argument is not persuasive in overcoming the likelihood of confusion refusals.

Because the applied-for mark and cited mark are confusingly similar to one another, and the goods and/or services with which they are used are related to one another, the refusal to register applicant’s mark based on a likelihood of confusion with respect to U.S. Registration No(s). 4087283 is now made FINAL. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

SPECIMEN MUST SHOW USE OF MARK WITH CLASS 16 GOODS

Registration is refused because the specimen does not show the applied-for mark in use in commerce. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Specifically, applicant has applied to register the mark for use with printed materials. The submitted screenshots do not show applicant’s mark in use on printed Class 16 goods. Rather, they show the mark on a website where downloadable magazines are available. However, these electronic publications are not Class 16 goods. Rather, applicant must show the applied-for mark in use on printed materials, or in the ordering of the printed materials, as discussed in greater detail below.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for goods may include tags, labels, instruction manuals, containers, and photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* Webpages may also be acceptable specimens for goods when they include a picture or textual description of the goods associated with the mark and the

means to order the goods. TMEP §904.03(i). However, leaflets, handbills, advertising circulars, and other advertising materials generally are not acceptable specimens for goods. *See* TMEP §§904.03 *et seq.*

Applicant may respond to this refusal by satisfying one of the following:

- (1) Submit a different specimen (a verified “substitute” specimen) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the goods identified in the application or amendment to allege use.
- (2) Amend the filing basis to intent to use under Section 1(b), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen at a subsequent date.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

RESPONSE GUIDELINES

Applicant must respond within six months of the date of issuance of this final Office action or the following class(es) to which the final refusal(s) and/or requirement(s) apply will be **deleted** from the application by Examiner’s Amendment: 16 and 42. 37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

The application will then proceed for the following class(es): 09.

Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements;
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office**

actions; therefore, do not respond to this Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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Subject: U.S. TRADEMARK APPLICATION NO. 85896124 - JW.ORG - 06420-T0001A
Sent: 3/12/2014 2:03:41 PM
Sent As: ECOM103@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/12/2014** FOR U.S. APPLICATION SERIAL NO. 85896124

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **3/12/2014** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.