

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85896124
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant seeks registration of its JW.ORG design mark, U.S. Application Serial No. 85896124 (the "Mark"). The examining attorney has rejected the application for the following reasons: (1) the Mark is likely to cause consumer confusion as to source with three previously registered marks, U.S. Registration Nos. 1639555, 2168941, and 4087283; (2) the Mark's class 042 description is incongruous and requires clarification; (3) the specimens submitted to show the Mark's use in commerce are illegible and insufficient; and (4) the Mark's description is incomplete.</p> <p>Applicant submits the following arguments and amendments and respectfully requests that the examining attorney permit registration of the Mark.</p> <p><b>Likelihood of Confusion</b></p> <p>The examining attorney first refuses to register the Mark because of a likelihood of confusion under 15 U.S.C. § 1052(d), identifying three registered marks—U.S. Registration Nos. 1639555, 2168941, and 4087283—as confusingly similar. Registration Nos. 1639555 and 2168941 are design marks overlapping the letters J and W inside a circle (the "JW design marks"). Registration No. 4087283 is a standard character mark for JW PLAYER, disclaiming the word "player" apart from the remaining mark.</p> <p>The Lanham Act provides for rejecting registration of a mark that "so resembles a [registered] mark . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). The section continues that if "confusion, mistake, or deception is not likely to result from continued use . . . of similar marks . . . , concurrent registrations may be issued." <i>Id.</i> As the examining attorney points out, the likelihood of confusion determination is assisted by applying the <i>DuPont</i> factors outlined by the Court of Customs and Patent Appeals, predecessor to the Federal Circuit. <i>In re E.I. DuPont DeNemours &amp; Co.</i>, 476 F.2d 1357 (C.C.P.A. 1973).</p> <p>The thirteen <i>DuPont</i> factors are as follows: (1) the marks' similarity in appearance, sound, connotation, and commercial impression; (2) the similarity of the goods and services covered by the marks; (3) the similarity of the channels of trade; (4) the sophistication of the typical consumer; (5) the distinctiveness (sales, advertising, length of use) of the registered mark; (6) the number of other, similar marks used for similar goods or services; (7) any evidence of actual confusion; (8) the length of concurrent use without evidence of actual confusion; (9) the variety of goods or services covered by the marks; (10) any discussions or agreements between the marks' owners; (11) the marks' current exclusivity in the marketplace; (12) the substantiality of potential confusion; and (13) any other evidence probative of</p>	

concurrent use's effects on consumers. *Id.* at 1361.

Because the likelihood of confusion determination is case specific, some factors may be more or less relevant in a given case. *Id.* at 1361-62; *see also Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355-57 (Fed. Cir. 2011). The examining attorney asserts that the following factors are most relevant in this case: (1) similarity of the marks; (2) similarity and nature of the goods and/or services; and (3) similarity of the trade channels. However, applicant asserts that the existence of other, similar marks used for similar goods and services is additionally, especially relevant in this case.

The determinative inquiry is whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973).

#### A. Similarity of the Marks

The first *DuPont* factor, on which the examining attorney places particular emphasis, requires an examination of the similarity of the marks in their appearance, sound, connotation, and commercial impression. *In re E.I. DuPont*, 476 F.2d at 1361.

Applicant's Mark uses a particular design of JW.ORG in which the JW. appears above the ORG, with the entire mark enclosed in a square. The letters of the mark contrast with the square box background. The examining attorney identified three registrations that she believes are confusingly similar to the Mark. The first two—Registration Nos. 1639555, 2168941—are design marks for the letters J and W (the "JW Design Marks"); the third—Registration No. 4087283—is a standard character mark for JW PLAYER.

##### 1. *The JW Design Marks—Reg. Nos. 1639555 and 2168941*

Each of the JW Design Marks is for a stylized design of the letters J and W in which the letters overlap, use a very distinct font type, and are enclosed in an oval. The clear commercial impression communicated to consumers is not simply the letters J and W, but instead is the fanciful design of the marks. In fact, the letters J and W are somewhat lost in the overall impression of the JW design marks. As noted above, the first *DuPont* factor requires an examination of the similarity of the marks' appearance, sound, connotation, and commercial impression. *In re E.I. DuPont*, 476 F.2d at 1361. It is not exclusively the use of similar words or letters that should be considered, but the entirety of the marks in question. *See e.g. Duluth News-Tribune v. Mesabi Publ. Co.*, 84 F.3d 1093, 1097 (8th Cir. 1996) ("Rather than consider the similarities between component parts of the marks, we must evaluate the impression that each mark in its entirety is likely to have on a purchaser . . .").

The appearance and commercial impression of Applicant's Mark is substantially distinct from that of the JW design marks. The Mark incorporates none of the design elements of the JW design marks. The Mark's font is not fanciful and the letters J and W appear side by side, not overlapping. Add in the fact that the Mark adds .ORG and is enclosed in a square, not a circle, and the Mark is very clearly distinct from the JW design marks.

Consumers encountering the Mark get a very different commercial impression than that created by the JW design marks. This distinct commercial impression clearly distinguishes Applicant's Mark from the JW Design Marks. Thus, there is no likelihood that a consumer would be confused into believing that the goods and services identified under each emanate from the same source.

##### 2. *The JW PLAYER Mark—Reg. No. 4087283*

The JW PLAYER mark is a standard character mark using the letters J and W in conjunction with the word "player." The JW PLAYER registration disclaims the use of "player" apart from the mark as a whole.

Again, the similarity of the marks inquiry under *DuPont* requires a determination of the *commercial impression* of the marks in their entireties. *In re E.I. DuPont* at 1361; *Duluth News-Tribune*, 84 F.3d at 1097. It is improper to dissect or segment the marks when determining their similarity. *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 29 (1919); *see also Packard Press, Inc. v. Hewlett-Packard, Inc.*, 227 F.3d 1352 (Fed. Cir. 2000) (holding that the Trademark Trial and Appeal Board improperly dissected marks in question by focusing only on the "Packard" portion of

HEWLETT-PACKARD and PACKARD TECHNOLOGY).

The appearance and commercial impression of the Mark are clearly and substantially distinct from the JW PLAYER mark, making confusion unlikely. The Mark's immediate commercial impression to consumers is in its design—a square box enclosing the web address JW.ORG. It is certainly not the letters J and W exclusively that immediately stick in the mind of consumers.

The examining attorney seems to assert that Applicant's mere use of the letters J and W in the Mark make confusion with JW PLAYER likely despite the substantial difference in appearance and commercial impression. At the same time, the examining attorney notes two other registered marks—the JW design marks—that *exclusively* use the same letters. These marks have all been maintained on the principal register concurrently for years without any noted instances of confusion. The JW design marks have enjoyed concurrent registration with the JW PLAYER mark principally and understandably because of the clear distinction in appearance and commercial impression. Applicant submits that the same reasons justify registration since Applicant's Mark and the JW PLAYER mark viewed "in their entirety convey significantly different commercial impressions." TMEP § 1207.01(b)(iii); *see also Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding stylization of marks created distinct appearance, sound, connotation, and commercial impression sufficient to register both despite common use of SPORTSMAN'S WAREHOUSE).

Given the Mark's distinct appearance and commercial impression, there is no likelihood that its use concurrent with the JW PLAYER mark "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973).

B. Similarity and Nature of the Goods and/or Services and Similarity of the Trade Channels

The examining attorney also places significant emphasis on the second and third *DuPont* factors—the similarity of the goods and services covered by the marks and the similarity of the channels of trade. *In re E.I. DuPont*, 476 F.2d at 1361.

Applicant's Mark seeks registration under international class 009 for "Digital media, namely, pre-recorded video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition discs all featuring religion," under international class 016 for "Printed materials, namely, books, magazines, brochures, booklets, tracts, calendars, informational cards, paper signs, all in the field of religion," and under international class 042 for "Providing a website that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion." In each class, the Mark specifically limits the goods and services covered to those "in the field of religion."

The Mark's channels of trade include the internet as well as the non-profit distribution of print and digital media.

The JW PLAYER mark is registered under international class 009 for "Downloadable computer software for playing, viewing and streaming audio and video files." The JW PLAYER mark's services are offered over the internet.

In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers. *Packard Press, Inc. v. Hewlett-Packard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000). Confusion is not necessarily likely simply because the goods or services can be described as being in the same category or field. *See Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, "[g]oods [and services] may fall under the same general product category but operate in distinct niches," thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001). Applicant's Mark falls in just such a niche category—that of media in the field of religion. Providers of goods and services related to religion tend to remain limited to religious products and services. Similarly, providers of general goods and services tend to avoid the field of religious goods and

services. As such, consumers are unlikely to believe the religious and non-religious goods and services are related, even under similar marks and even where the channels of trade are similar.

Likewise, the Mark's limitation to faith based goods and services makes confusion unlikely in view of the JW Design Marks. In addition to the substantial difference in appearance and commercial impression between Applicant's Mark and the JW Design Marks, neither Design Mark covers the niche field of religious goods and services.

The first JW Design Mark (Reg. No. 1639555) is registered in international class 009 for "Educational prerecorded audio and video tapes, films trips [*sic*] and computer programs" and international class 016 for "Books, encyclopedias, journals, pamphlets, loose-leaf volumes, and textbooks covering a wide variety of subject matter." The second (Reg. No. 2168941) is registered in international class 009 for "educational pre-recorded sound and video recordings and film strips; CD-ROMs and electronic publications, namely, multi-media interactive software on a variety of subjects; computer software for use in database management, for use as a spread sheet and for use in the accounting and scientific fields" and international class 042 for "computerized on-line services, namely, providing scientific journals, tables of contents, information for contributors, discussion for users, providing a wide range of scientific, technical, accounting, and general interest information via global computer information networks."

Neither of the JW Design Marks covers the specific goods and services covered by Applicant's Mark—the field of religious products—making confusion between the two even more unlikely than it is simply because of the dissimilarities in appearance and commercial impression. The Mark's limitation to the field of religion distinguishes it substantially from both JW Design Marks and the JW PLAYER mark.

### C. Concurrent Registration of Other, Similar Marks

As noted, Applicant submits that, in addition to *DuPont* factors one, two, and three, *DuPont* factor six—the number of other, similar marks used for similar goods or services—is also especially relevant to this case. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

The examining attorney points out that the JW PLAYER mark and the JW Design Marks have enjoyed concurrent registration for years without any evidence of consumer confusion. Certainly it cannot be argued that the goods and services offered under the JW PLAYER mark do not overlap with those offered under the JW Design Marks. However, given the distinct appearances and commercial impressions of the JW Design Marks, the three have avoided any confusion in the minds of the consuming public. Likewise, Applicant's Mark is sufficiently dissimilar in appearance and commercial impression, as well as distinguished by limiting its goods to the field of religion, to enjoy concurrent registration as well.

Indeed, numerous other marks are registered reflecting the letters J and W:

Ø JW SECURE (Reg. No. 3922550) – design mark for computer consultation in the field of computer security

Ø JW (Reg. No. 3944163) – design mark for on-line retail and wholesale store services

Ø **JANITOR'S WORLD JANITORIAL SUPPLIES & EQUIPMENT JW** (Reg. No. 3701631) – design mark for on-line retail and wholesale store services

Ø JELD-WEN MILLWORK UNIVERSITY JW TRAINING MILLWORK PROFESSIONALS (Reg. No. 3599569) – design mark for education services

Ø JELD-WEN MILLWORK UNIVERSITY JW TRAINING MILLWORK PROFESSIONALS (Reg. No. 3632347) – design mark for education services

Each of these marks uses the letters J and W in a prominent way. Yet each has enjoyed concurrent registration with one another and with the JW PLAYER mark and the JW Design Marks. This is so despite covering overlapping goods and services because the substantially distinct commercial impression of each makes consumer confusion unlikely. Although the decisions of prior examining attorneys are not binding in subsequent applications, consistency in examination has been recognized as a goal of the Office. *In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Rodale, Inc.*, 80

USPQ2d 1696 (TTAB 2006). Applicant submits this same justification extends to registration of the Mark, and therefore respectfully requests the examining attorney withdraw her refusal to register on the basis of likelihood of confusion.

#### **Identification of Class 42 Services**

The examining attorney also refused registration of the Mark on grounds that the wording identifying the services covered by the Mark is indefinite and incongruous. Specifically, the examining attorney takes issue with the following wording in the Mark's application: "Providing a website that gives computer users the ability to download . . . printed publications." The examining attorney asserts that the suggestion of downloading printed publications is incongruous and that, as a result, the identification is indefinite.

The complete wording of the services claimed under the Mark in international class 042 is as follows:

Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion.

"Printed publications" is one member of a list of items downloadable from Applicant's website. The examining attorney seems to misinterpret the phrase "printed publications." Applicant's website provides users the ability to download publications that have also appeared in print, such as pamphlets, etc. Under this interpretation, it is not incongruous to suggest a website user can download a printed publication. At least one current trademark registration—Reg. No. 4369097—reflects the same phrasing as Applicant's, providing services permitting users to "download digital print publications." To avoid any further possibility of indefiniteness, Applicant will amend the identification to "digital print publications," as reflected below.

#### **Specimens Showing Mark's Use**

The examining attorney also rejected the application because the images Applicant submitted to show the Mark's use relative to classes 09 and 16 were illegible and the specimen submitted relative to class 42 failed to show a website permitting users to download media.

Applicant has attached replacement digitized images clearly showing the Mark's use relative to classes 09 and 16. Applicant has also added an image showing the website's downloadable content relative to class 42.

The replacement specimens are a true and unaltered copy of the original specimens submitted with this application, which were in use in commerce at least as early as April 5, 2013, the filing date of this application. The additional specimen relating to class 42 was also in use in commerce at least as early as the filing date of the application. Attached to this response is the declaration of Steven B. Simonis confirming these statements to be true.

Applicant prays that its arguments and amendments satisfy the examining attorney's concerns and that she will permit the Mark's registration on the principal register.

### **EVIDENCE SECTION**

#### **EVIDENCE FILE NAME(S)**

<b>ORIGINAL PDF FILE</b>	<a href="#">evi_655138130-115605008_.11F2626.PDF</a>
<b>CONVERTED PDF FILE(S)</b> (4 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\858\961\85896124\xml6\ROA0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\858\961\85896124\xml6\ROA0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\858\961\85896124\xml6\ROA0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\858\961\85896124\xml6\ROA0005.JPG</a>

DESCRIPTION OF EVIDENCE FILE	replacement specimens showing use of the mark in connection with the goods/services
<b>GOODS AND/OR SERVICES SECTION (009)(no change)</b>	
<b>GOODS AND/OR SERVICES SECTION (016)(no change)</b>	
<b>GOODS AND/OR SERVICES SECTION (042)(current)</b>	
INTERNATIONAL CLASS	042
<b>DESCRIPTION</b>	
Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 03/15/2013
FIRST USE IN COMMERCE DATE	At least as early as 03/15/2013
<b>GOODS AND/OR SERVICES SECTION (042)(proposed)</b>	
INTERNATIONAL CLASS	042
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion;</del> <u>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</u>	
<b>FINAL DESCRIPTION</b>	
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	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 03/15/2013
FIRST USE IN COMMERCE DATE	At least as early as 03/15/2013
<b>ADDITIONAL STATEMENTS SECTION</b>	
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the stylized letters JW.ORG within a square design, where the characters "JW." Appear above the "ORG".

SIGNATURE SECTION	
DECLARATION SIGNATURE	/Steven B. Simonis/
SIGNATORY'S NAME	Steven B. Simonis
SIGNATORY'S POSITION	Attorney of Record, Connecticut Bar Member
SIGNATORY'S PHONE NUMBER	2033246155
DATE SIGNED	02/04/2014
RESPONSE SIGNATURE	/Steven B. Simonis-4501/
SIGNATORY'S NAME	Steven B. Simonis
SIGNATORY'S POSITION	Attorney of Record, Connecticut Bar Member
SIGNATORY'S PHONE NUMBER	2033246155
DATE SIGNED	02/04/2014
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Feb 04 12:19:46 EST 2014
TEAS STAMP	USPTO/ROA-65.51.38.130-20 140204121946582618-858961 24-5004950fe8dedc16758a44 60a1773c1020e7f7d3d714ac1 47e8566faeb93d3647c-N/A-N /A-20140204115605008992

## Response to Office Action To the Commissioner for Trademarks:

Application serial no. **85896124** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Applicant seeks registration of its JW.ORG design mark, U.S. Application Serial No. 85896124 (the

"Mark"). The examining attorney has rejected the application for the following reasons: (1) the Mark is likely to cause consumer confusion as to source with three previously registered marks, U.S. Registration Nos. 1639555, 2168941, and 4087283; (2) the Mark's class 042 description is incongruous and requires clarification; (3) the specimens submitted to show the Mark's use in commerce are illegible and insufficient; and (4) the Mark's description is incomplete.

Applicant submits the following arguments and amendments and respectfully requests that the examining attorney permit registration of the Mark.

### **Likelihood of Confusion**

The examining attorney first refuses to register the Mark because of a likelihood of confusion under 15 U.S.C. § 1052(d), identifying three registered marks—U.S. Registration Nos. 1639555, 2168941, and 4087283—as confusingly similar. Registration Nos. 1639555 and 2168941 are design marks overlapping the letters J and W inside a circle (the "JW design marks"). Registration No. 4087283 is a standard character mark for JW PLAYER, disclaiming the word "player" apart from the remaining mark.

The Lanham Act provides for rejecting registration of a mark that "so resembles a [registered] mark . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). The section continues that if "confusion, mistake, or deception is not likely to result from continued use . . . of similar marks . . . , concurrent registrations may be issued." *Id.* As the examining attorney points out, the likelihood of confusion determination is assisted by applying the *DuPont* factors outlined by the Court of Customs and Patent Appeals, predecessor to the Federal Circuit. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

The thirteen *DuPont* factors are as follows: (1) the marks' similarity in appearance, sound, connotation, and commercial impression; (2) the similarity of the goods and services covered by the marks; (3) the similarity of the channels of trade; (4) the sophistication of the typical consumer; (5) the distinctiveness (sales, advertising, length of use) of the registered mark; (6) the number of other, similar marks used for similar goods or services; (7) any evidence of actual confusion; (8) the length of concurrent use without evidence of actual confusion; (9) the variety of goods or services covered by the marks; (10) any discussions or agreements between the marks' owners; (11) the marks' current exclusivity in the marketplace; (12) the substantiality of potential confusion; and (13) any other evidence probative of concurrent use's effects on consumers. *Id.* at 1361.

Because the likelihood of confusion determination is case specific, some factors may be more or less relevant in a given case. *Id.* at 1361-62; *see also Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355-57 (Fed. Cir. 2011). The examining attorney asserts that the following factors are most relevant in this case: (1) similarity of the marks; (2) similarity and nature of the goods and/or services; and (3) similarity of the trade channels. However, applicant asserts that the existence of other, similar marks used for similar goods and services is additionally, especially relevant in this case.

The determinative inquiry is whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973).

#### **A. Similarity of the Marks**

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Applicant's Mark uses a particular design of JW.ORG in which the JW. appears above the ORG, with the entire mark enclosed in a square. The letters of the mark contrast with the square box background.

The examining attorney identified three registrations that she believes are confusingly similar to the Mark.

The first two—Registration Nos. 1639555, 2168941—are design marks for the letters J and W (the "JW Design Marks"); the third—Registration No. 4087283—is a standard character mark for JW PLAYER.

##### ***1. The JW Design Marks—Reg. Nos. 1639555 and 2168941***

Each of the JW Design Marks is for a stylized design of the letters J and W in which the letters overlap,

use a very distinct font type, and are enclosed in an oval. The clear commercial impression communicated to consumers is not simply the letters J and W, but instead is the fanciful design of the marks. In fact, the letters J and W are somewhat lost in the overall impression of the JW design marks.

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Consumers encountering the Mark get a very different commercial impression than that created by the JW design marks. This distinct commercial impression clearly distinguishes Applicant's Mark from the JW Design Marks. Thus, there is no likelihood that a consumer would be confused into believing that the goods and services identified under each emanate from the same source.

## 2. *The JW PLAYER Mark—Reg. No. 4087283*

The JW PLAYER mark is a standard character mark using the letters J and W in conjunction with the word "player." The JW PLAYER registration disclaims the use of "player" apart from the mark as a whole.

Again, the similarity of the marks inquiry under *DuPont* requires a determination of the *commercial impression* of the marks in their entireties. *In re E.I. DuPont* at 1361; *Duluth News-Tribune*, 84 F.3d at 1097. It is improper to dissect or segment the marks when determining their similarity. *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 29 (1919); *see also Packard Press, Inc. v. Hewlett-Packard, Inc.*, 227 F.3d 1352 (Fed. Cir. 2000) (holding that the Trademark Trial and Appeal Board improperly dissected marks in question by focusing only on the "Packard" portion of HEWLETT-PACKARD and PACKARD TECHNOLOGY).

The appearance and commercial impression of the Mark are clearly and substantially distinct from the JW PLAYER mark, making confusion unlikely. The Mark's immediate commercial impression to consumers is in its design—a square box enclosing the web address JW.ORG. It is certainly not the letters J and W exclusively that immediately stick in the mind of consumers.

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The JW design marks have enjoyed concurrent registration with the JW PLAYER mark principally and understandably because of the clear distinction in appearance and commercial impression. Applicant submits that the same reasons justify registration since Applicant's Mark and the JW PLAYER mark viewed "in their entireties convey significantly different commercial impressions." TMEP § 1207.01(b)(iii); *see also Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding stylization of marks created distinct appearance, sound, connotation, and commercial impression sufficient to register both despite common use of SPORTSMAN'S WAREHOUSE).

Given the Mark's distinct appearance and commercial impression, there is no likelihood that its use concurrent with the JW PLAYER mark "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902 (C.C.P.A. 1973).

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The Mark's channels of trade include the internet as well as the non-profit distribution of print and digital media.

The JW PLAYER mark is registered under international class 009 for "Downloadable computer software for playing, viewing and streaming audio and video files." The JW PLAYER mark's services are offered over the internet.

In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers. *Packard Press, Inc. v. Hewlett-Packard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000). Confusion is not necessarily likely simply because the goods or services can be described as being in the same category or field. *See Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, "[g]oods [and services] may fall under the same general product category but operate in distinct niches," thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001).

Applicant's Mark falls in just such a niche category—that of media in the field of religion. Providers of goods and services related to religion tend to remain limited to religious products and services. Similarly, providers of general goods and services tend to avoid the field of religious goods and services. As such, consumers are unlikely to believe the religious and non-religious goods and services are related, even under similar marks and even where the channels of trade are similar.

Likewise, the Mark's limitation to faith based goods and services makes confusion unlikely in view of the JW Design Marks. In addition to the substantial difference in appearance and commercial impression between Applicant's Mark and the JW Design Marks, neither Design Mark covers the niche field of religious goods and services.

The first JW Design Mark (Reg. No. 1639555) is registered in international class 009 for "Educational prerecorded audio and video tapes, films trips [*sic*] and computer programs" and international class 016 for "Books, encyclopedias, journals, pamphlets, loose-leaf volumes, and textbooks covering a wide variety of subject matter." The second (Reg. No. 2168941) is registered in international class 009 for "educational pre-recorded sound and video recordings and film strips; CD-ROMs and electronic publications, namely, multi-media interactive software on a variety of subjects; computer software for use in database management, for use as a spread sheet and for use in the accounting and scientific fields" and international class 042 for "computerized on-line services, namely, providing scientific journals, tables of contents, information for contributors, discussion for users, providing a wide range of scientific, technical, accounting, and general interest information via global computer information networks."

Neither of the JW Design Marks covers the specific goods and services covered by Applicant's Mark—the field of religious products—making confusion between the two even more unlikely than it is simply because of the dissimilarities in appearance and commercial impression. The Mark's limitation to the field of religion distinguishes it substantially from both JW Design Marks and the JW PLAYER mark.

C. Concurrent Registration of Other, Similar Marks

As noted, Applicant submits that, in addition to *DuPont* factors one, two, and three, *DuPont* factor

six—the number of other, similar marks used for similar goods or services—is also especially relevant to this case. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

The examining attorney points out that the JW PLAYER mark and the JW Design Marks have enjoyed concurrent registration for years without any evidence of consumer confusion. Certainly it cannot be argued that the goods and services offered under the JW PLAYER mark do not overlap with those offered under the JW Design Marks. However, given the distinct appearances and commercial impressions of the JW Design Marks, the three have avoided any confusion in the minds of the consuming public. Likewise, Applicant's Mark is sufficiently dissimilar in appearance and commercial impression, as well as distinguished by limiting its goods to the field of religion, to enjoy concurrent registration as well.

Indeed, numerous other marks are registered reflecting the letters J and W:

- Ø JW SECURE (Reg. No. 3922550) – design mark for computer consultation in the field of computer security

- Ø JW (Reg. No. 3944163) – design mark for on-line retail and wholesale store services

- Ø **JANITOR'S WORLD JANITORIAL SUPPLIES & EQUIPMENT JW** (Reg. No. 3701631) – design mark for on-line retail and wholesale store services

- Ø JELD-WEN MILLWORK UNIVERSITY JW TRAINING MILLWORK PROFESSIONALS (Reg. No. 3599569) – design mark for education services

- Ø JELD-WEN MILLWORK UNIVERSITY JW TRAINING MILLWORK PROFESSIONALS (Reg. No. 3632347) – design mark for education services

Each of these marks uses the letters J and W in a prominent way. Yet each has enjoyed concurrent registration with one another and with the JW PLAYER mark and the JW Design Marks. This is so despite covering overlapping goods and services because the substantially distinct commercial impression of each makes consumer confusion unlikely. Although the decisions of prior examining attorneys are not binding in subsequent applications, consistency in examination has been recognized as a goal of the Office. *In re Nett Designs*, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Rodale, Inc.*, 80 USPQ2d 1696 (TTAB 2006). Applicant submits this same justification extends to registration of the Mark, and therefore respectfully requests the examining attorney withdraw her refusal to register on the basis of likelihood of confusion.

### **Identification of Class 42 Services**

The examining attorney also refused registration of the Mark on grounds that the wording identifying the services covered by the Mark is indefinite and incongruous. Specifically, the examining attorney takes issue with the following wording in the Mark's application: "Providing a website that gives computer users the ability to download . . . printed publications." The examining attorney asserts that the suggestion of downloading printed publications is incongruous and that, as a result, the identification is indefinite.

The complete wording of the services claimed under the Mark in international class 042 is as follows:

- Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion.

"Printed publications" is one member of a list of items downloadable from Applicant's website. The examining attorney seems to misinterpret the phrase "printed publications." Applicant's website provides users the ability to download publications that have also appeared in print, such as pamphlets, etc. Under this interpretation, it is not incongruous to suggest a website user can download a printed publication. At least one current trademark registration—Reg. No. 4369097—reflects the same phrasing as Applicant's, providing services permitting users to "download digital print publications."

To avoid any further possibility of indefiniteness, Applicant will amend the identification to "digital print publications," as reflected below.

### **Specimens Showing Mark's Use**

The examining attorney also rejected the application because the images Applicant submitted to show the Mark's use relative to classes 09 and 16 were illegible and the specimen submitted relative to class 42 failed to show a website permitting users to download media.

Applicant has attached replacement digitized images clearly showing the Mark's use relative to classes 09 and 16. Applicant has also added an image showing the website's downloadable content relative to class 42.

The replacement specimens are a true and unaltered copy of the original specimens submitted with this application, which were in use in commerce at least as early as April 5, 2013, the filing date of this application. The additional specimen relating to class 42 was also in use in commerce at least as early as the filing date of the application. Attached to this response is the declaration of Steven B. Simonis confirming these statements to be true.

Applicant prays that its arguments and amendments satisfy the examining attorney's concerns and that she will permit the Mark's registration on the principal register.

## **EVIDENCE**

Evidence in the nature of replacement specimens showing use of the mark in connection with the goods/services has been attached.

**Original PDF file:**

[evi\\_655138130-115605008\\_11F2626.PDF](#)

**Converted PDF file(s)** (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

## **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 042 for Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/15/2013 and first used in commerce at least as early as 03/15/2013, and is now in use in such commerce.

**Proposed:**

**Tracked Text Description:** ~~Providing a web site that gives computer users the ability to download audio and video recordings, DVDs, music, printed publications, online publications, documents, forms and web pages all in the field of religion;~~ [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](#)

Class 042 for 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

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 03/15/2013 and first used in commerce at least as early as 03/15/2013, and is now in use in

such commerce.

## **ADDITIONAL STATEMENTS**

### **Description of mark**

The mark consists of the stylized letters JW.ORG within a square design, where the characters "JW." Appear above the "ORG".

## **SIGNATURE(S)**

### **Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Steven B. Simonis/ Date: 02/04/2014

Signatory's Name: Steven B. Simonis

Signatory's Position: Attorney of Record, Connecticut Bar Member

Signatory's Phone Number: 2033246155

### **Response Signature**

Signature: /Steven B. Simonis-4501/ Date: 02/04/2014

Signatory's Name: Steven B. Simonis

Signatory's Position: Attorney of Record, Connecticut Bar Member

Signatory's Phone Number: 2033246155

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power

of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 85896124

Internet Transmission Date: Tue Feb 04 12:19:46 EST 2014

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## Video Segments

### 133 Gillead Graduation Highlights

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## Download

## What is God's name?

Our family members all have personal names. Even pets have names! Wouldn't it be reasonable for God to have a name? In the Bible, God has many titles, such as God Almighty, Sovereign Lord, and Creator, but he also has a personal name.—Read Isaiah 42:8.

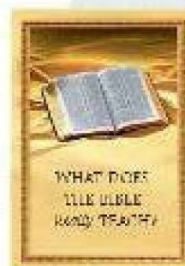
Many translations of the Bible contain God's personal name at Psalm 83:18. For example, in the *New World Translation of the Holy Scriptures*, that verse says: "You, whose name is Jehovah, you alone are the Most High over all the earth."

## Why should we use God's name?

God wants us to use his personal name. We use personal names when we talk with those we love, such as our close friends—especially if they invite us to do so. Should it be different when it comes to talking with God? Furthermore, Jesus Christ encouraged the use of God's name.—Read Matthew 6:9; John 17:26.

However, to be God's friend, we need to know more about him than just his name. For instance, what is God like? Is it really possible to get close to God? You can find the answers to those questions in the Bible.

For more information,  
see chapter 1 of this book,  
published by Jehovah's Witnesses



We use personal names when we talk with those we love, such as our close friends.

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## Jehovah's Witnesses—Who Are We?

We come from hundreds of ethnic and language backgrounds, yet we are united by common goals. Above all, we want to honor [Jehovah](#), the God of the Bible and the Creator

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