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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Johnson Publishing Company, Inc.
v.
Satellite Entertainment Communications Co., Ltd.

Opposition No. 91153167
to application Serial No. 78023525

Leslie A. Bertagnolli of Baker & McKenzie for Johnson
Publishing Company, Inc.

Lin-Yun Cheng of Pro-Techtor International Services for
Satellite Entertainment Communications Co., Ltd.¹

Before Seeherman, Drost, and Kuhlke, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 29, 2000, Satellite Entertainment
Communications Co., Ltd. (applicant) applied to register the
JET and design mark shown below for "television broadcasting
services, cable television broadcasting, pay-per-view
television transmission services, and cable television
transmission services" in Class 38.

¹ The only paper filed by applicant in this case was the Answer.



The application contains an allegation of a date of first use of January 1, 1997, and a date of first use in commerce of October 1, 1999.

On August 5, 2002, Johnson Publishing Company, Inc. (opposer) opposed the registration of applicant's mark on the ground that applicant's mark is likely to cause confusion with opposer's two registered marks. The first registration is for the mark JET (stylized) for "periodical publications" in Class 16.²



Opposer's second registration is also for the mark JET but in a typed or standard character drawing. The goods in that registration are identified as "magazines featuring news, current events, fashion, sports, cosmetics and beauty care, entertainment, photographic features and business;

² Registration No. 563,152 issued August 19, 1952.

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books featuring black history, culture and achievements; calendars; magazines for children" in Class 16.³

Opposer also pleaded ownership of two registrations for the mark EBONY/JET in standard character form. The first (No. 1,295,038) was for "entertainment services-namely, television programs featuring personal and professional lives of celebrities and public figures, awards ceremonies and on the air magazine format productions" in Class 41 and the second (No. 2,148,721) was for "prerecorded video tapes for use in entertaining and educating children, preteen[s] and teenagers; and prerecorded video tapes on topics in the areas of finance and health and entertainment which feature African American artists or on subjects of interest to African Americans; finance and health" in Class 9. However, both registrations have now been cancelled so neither would prevent the registration of applicant's mark.

In its notice of opposition (p. 3), opposer also maintains that "since long prior to the filing date of the Application, [it] used the JET mark and other marks including the word JET (or a form of that word) as a prominent part. Opposer's use has been valid and continuous and has not been abandoned, and has included use on services similar or related to those covered by the Application."

³ Registration No. 1,206,138 issued August 24, 1982.

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the pleadings, the file of the involved application; opposer's Notice of Reliance filed September 29, 2003 for various JET and EBONY magazine covers and pages, registrations, and NEXIS printouts, and opposer's requests for admissions.

Preliminary Issue

Before we can begin our discussion on the merits, it is necessary to address some preliminary matters. We start by noting that an opposer must have standing to bring an opposition proceeding. An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).⁴

⁴ Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

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We have already noted that two of the registrations that opposer refers to in its notice of opposition are cancelled (Nos. 1,295,038 and 2,148,721) so these expired registrations do not demonstrate that opposer has standing. Opposer also claims ownership of two other registrations (Nos. 563,152 and 1,206,138). Obviously, if these registrations were of record, standing would not be an issue to the extent that opposer would have set out a non-frivolous claim of likelihood of confusion. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) ("These registrations and the products sold under the mark they register suffice to establish Laser Golf's direct commercial interest and its standing to petition for cancellation of Cunningham's LASERSWING mark").

Trademark Rule 122(d)(1) (37 CFR § 2.122(d)(1)) sets out the requirements for introducing a party's registration into evidence in an inter partes proceeding:

A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration.

The notice of opposition here did not contain status and title copies. However, there are several other ways for a party to introduce a registration it owns into evidence

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during a board proceeding besides attaching status and title copies to the notice of opposition. A party may also introduce its registration into the record in the following ways: by identification and introduction during the testimony period by a qualified witness who testifies concerning the status and title of the registrations; by admission in the applicant's answer; or by the applicant treating the registration as being of record in its brief. TBMP § 702.03(a) (2d ed. rev. 2004). Inasmuch as opposer did not call any witnesses and applicant did not file a brief and, in its answer, it did not admit the status and title of opposer's registrations, opposer's registrations are not of record through these means.

However, opposer did submit copies of these registrations along with its Notice of Reliance. The question then becomes whether these are status and title copies. Regarding Registration No. 563,152, opposer has submitted what appears to be a true copy of renewal certificates of registration that issued in 1973 and 1993. The registration issued August 19, 1952. These documents were submitted by a notice of reliance dated September 29, 2003. Thus, even at the time these documents were submitted, more than one year after the renewal date, opposer's submission did not indicate the current status of the registration.

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The Trademark Rules provide a means for implementing this proof of a prima facie case. They require that, in an opposition proceeding, registrations may be entered into evidence by (1) furnishing two copies of each registration prepared and issued by the Patent and Trademark Office showing both the *current status* of and *current title* to the registration; (2) appropriate identification and introduction of the registrations during the taking of testimony; or (3) filing a notice of reliance on the registrations during Opposer's testimony period. 37 C.F.R. § 2.122(d) (emphasis added). These rules are simple and clear, but Hewlett did not follow them.

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (Federal Circuit affirmed the Board's dismissal of an opposition pursuant to Trademark Rule 2.132(a) for opposer's failure to properly make its registrations of record). We conclude that opposer has not submitted status information for Registration No. 563,152, and it therefore cannot rely on this registration for standing, priority, or likelihood of confusion purposes.

The next question is whether opposer has properly made of record its pleaded Registration No. 1,206,138. For this registration, opposer has submitted what appears to be a photocopy of a true copy of a certificate of registration that indicates the registration issued for a term of twenty years from August 24, 1982. This certificate has an attestation date of November 2, 1987. Also, opposer has submitted a copy of a combined "Notice of Acceptance" and "Notice of Renewal" for Registration No. 1,206,138 with a mailing date of September 27, 2002. This document, having

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been issued by the USPTO during the pendency of the opposition, is acceptable evidence of the current status of this registration. Furthermore, in its request for admission (p. 3), opposer asked that applicant admit that opposer "is the owner of U.S. Registration No. 1,206,138." Inasmuch as applicant has not responded to this request for admission, this is considered to be admitted. Fed. R. Civ. P. 36(a) ("Each matter of which an admission is requested shall be separately set forth. The matter is admitted unless, within 30 days after service of the request ... the party to whom the request is requested serves upon the party requesting the admission a written answer or objection addressed to the matter").

When we cobble together the various pieces of information that opposer submitted, we hold that, while this is not a textbook example of how to submit status and title copies of a registration, it does meet the minimum requirement and Registration No. 1,206,138 for the mark JET in standard character form is of record and it establishes opposer's standing.

Priority

As a result of opposer's registration (No. 1,206,138) being of record, opposer has priority. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

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Next we look at whether opposer has established priority for its common law rights. Inasmuch as applicant has not submitted any evidence, it can rely on the filing date of its application (August 29, 2000) as its priority date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991). Opposer has submitted evidence that it has used the mark EBONY JET SHOWCASE for television programming. Opposer's evidence includes advertisements apparently in its magazine for a television program called EBONY JET SHOWCASE.⁵ Opposer has also submitted numerous NEXIS printouts that refer to the EBONY JET SHOWCASE program. Only two of the articles are dated subsequent to 1994. One in *Broadcasting & Cable* dated March 10, 2003, refers to an individual who "was a national sales representative for syndicated program Ebony Jet Showcase in Chicago." The second printout is from the publication *Black Enterprise* dated June 1997. The article refers to John H. Johnson as a man who "bought and sold three radio stations, started a book publishing division and produced the former syndicated television show *Ebony/Jet Showcase*" (emphasis added).

⁵ The date of these advertisements cannot be determined from the document itself because of the quality of the photocopy. The notice of reliance indicates that the dates of the magazines are March 28, 1988, and February 6, 1989.

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Section 2(d) of the Trademark Act provides a bar to registration if a conflicting mark has been "previously used in the United States by another and not abandoned." 15 U.S.C. § 1052(d). "To establish ownership of a mark, the prior user must establish not only that at some date in the past it used the mark, but that such use has continued to the present." McCarthy's on Trademarks and Unfair Competition (4th ed.), § 16:9. See also Id. at § 20:17 ("Proof of prior and continuous use in intrastate commerce is sufficient to preclude registration"). The Trademark Act (15 U.S.C. § 1127) provides that "[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment." In a case like this where applicant has not alleged that opposer has abandoned its mark, we normally do not require opposer to prove non-abandonment. West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994). The Federal Circuit noted that "the party asserting abandonment bears at a minimum a burden of coming forth with some evidence of abandonment." Id. However, in this case, opposer has voluntarily come forward with evidence that suggests it is no longer using its mark on television programming. The article that opposer has submitted refers to "the former syndicated television show Ebony/Jet Showcase." There is no evidence that contradicts this article's suggestion of non-use of the mark. We note

that opposer has the burden of establishing its priority. See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); Cunningham v. Laser Golf Corp., 55 USPQ2d at 1848. In this case, opposer's evidence showing use eight years prior to the filing of the notice of opposition and suggesting non-use of the mark after that time is not sufficient to establish that opposer has priority based on its use of its EBONY JET SHOWCASE mark on television-related programs. Auburn Farms Inc. v. McKee Foods Corp., 51 USPQ2d 1439, 1444 (TTAB 1999) ("[T]hese documents must be viewed in the context of the entire record. Suffice it to say that when viewed in that context, we simply cannot draw the inference that the documents outweigh the objective evidence of nonuse"). Therefore, opposer cannot rely on its common law use of its EBONY/JET or similar marks for television-related goods or services.

Likelihood of Confusion

We now address the ultimate issue in this case, i.e., whether applicant's mark for JET and design for "television broadcasting services, cable television broadcasting, pay-per-view television transmission services, and cable television transmission services" is confusingly similar to opposer's mark JET for "magazines featuring news, current events, fashion, sports, cosmetics and beauty care,

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entertainment, photographic features and business; books featuring black history, culture and achievements; calendars; magazines for children."

In likelihood of confusion cases (Section 2(d)), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We start by comparing the goods and services of opposer and applicant. Opposer's goods are magazines while applicant's services are television programming. We must consider the goods and services as they are identified in the identification of goods and services in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). Opposer's magazines feature news, current events, fashion, sports, cosmetics and beauty care, entertainment, photographic features and business; its books feature black history, culture and achievements; and its other goods are calendars and magazines for children. Applicant's television services are not limited by content

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and therefore we must assume that they include television programming featuring news, current events, fashion, sports, cosmetics and beauty care, entertainment, photographic features and business. Applicant, by failing to respond to opposer's requests for admission (p. 4), has admitted that "Applicant's Mark is associated with services that are similar or related to the services and goods associated with Opposer's Registration No. ... 1,206,138." Fed. R. Civ. P. 36(a). When we consider that applicant's television broadcasting services may include television programming that is identical to the subject matter of opposer's magazines, and in light of applicant's admission that its services are similar or related to opposer's goods, we find that potential customers are likely to assume that these magazines and television programs marketed under identical word marks originate from the same source.

Next, we look at the similarity or dissimilarity of the marks. We must compare the marks in their entireties, and not simply the individual features of the marks. In re Shell Oil, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Both marks are for the same word, JET. The only difference between the marks is the fact that applicant displays its mark with a slight stylization and includes a design. Inasmuch as opposer's mark is presented in typed or standard character, there is no viable difference in the

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marks based on the stylization of the mark. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). Furthermore, the geometric design in applicant's mark would not be verbalized and we do not find that it would be relied on by consumers to distinguish the mark. To the extent that the geometric design would be considered a stylized jet, it only reinforces the meaning of the word portion of the mark. Therefore, the differences in the appearance of the marks would not be significant. The common word in the marks would also be pronounced identically and the word "Jet" would have the same meaning. Finally, the commercial impressions of the marks JET and JET with applicant's geometric design would be very similar, if not identical.

In addition to the obvious similarities of the marks, as discussed above, applicant has also admitted that the marks are similar. See Opposer's Request for Admission (p. 3) ("Applicant's Mark only includes the letters JET, which is similar in appearance, sound, and connotation to Opposer's marks, Registration No. ... 1,206,138") and (Applicant's Mark gives the same commercial impression to consumers as U.S. Registration No. ... 1,206,138").

When both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or

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as close as in the situation where the marks are not identical or strikingly similar." Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). The Federal Circuit has noted that "[w]ithout doubt the word portions of the two marks are identical, have the same connotation, and give the same commercial impression. The identity of words, connotation, and commercial impression weighs heavily against the applicant." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Similarly, in this case, the word portion of both marks are identical and this fact weighs heavily against applicant.

Other factors we consider are trade channels and prospective purchasers. Magazines featuring news, current events, fashion, sports, cosmetics and beauty care, entertainment, photographic features and business and television programs on the same subject matter are likely to be read and/or viewed by the same consumers. These viewers/consumers are likely to believe that these magazines and services are associated with a common source. There is also no evidence that these purchasers or viewers would be sophisticated or careful purchasers. Rather, as identified, opposer's goods and applicant's services would be rendered to the public at large. Therefore, we hold that these factors favor opposer.

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Finally, we note that there is no evidence that opposer's mark is weak or otherwise entitled to only a narrow scope of protection.

Therefore, when we consider the fact that both marks are for the identical word JET and that the goods and services are related as well as the other factors, we conclude that there is a likelihood of confusion.

Decision: The opposition to the registration of application No. 78023525 is sustained.