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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

wellington

Mailed: February 20, 2007

Opposition No. 91162261

HEARST COMMUNICATIONS, INC.¹

v.

TVNESS, LLC

Before Hohein, Drost and Cataldo,
Administrative Trademark Judges.

By the Board:

This proceeding now comes up on the following motions:
opposer Hearst Communications, Inc.'s ("HCI") motion (filed
September 28, 2005) for summary judgment; HCI's motion
(filed January 17, 2006) to exclude certain exhibits filed
by applicant with its opposition to the summary judgment
motion; and applicant's motion (filed December 27, 2005)
for an oral hearing on the summary judgment motion.

¹ As explained later in this order (in particular, see footnotes 2 and 3), Hearst Communications, Inc. is the owner of all pleaded registrations in the notice of opposition. We therefore find that it is the real party in interest and, accordingly, Hearst Magazines Property Inc. is dismissed from this proceeding. Fed. R. Civ. P. 17(a) and 25(c); see also TBMP § 512.01 (2d ed. rev. 2004) and authorities cited therein.

Before addressing the above motions, we note the following relevant pleadings and filings in this proceeding.

On June 17, 2002, applicant filed an application to register the mark COSMO PARTY for the following services:

Providing consumer product information over global computer communications networks, particularly concerning products in the field of dating, parties, and event planning, in International Class 35;

Entertainment services, namely providing a wide range of information over global computer communications networks, particularly concerning services, events, activities, attractions and facilities in particular geographic locations in the field of parties, events, discussions, and entertainment; providing and organizing parties and events planning, in International Class 41; and

Computer dating services; namely providing a web site that registers face-to-face meetings, blind dates, get-together meetings, parties, events, discussions, and entertainment; providing electronic reservations, setting-up day, hour and place to meet; providing on-line information concerning dating and personal relationship issues through a web site, accessed via interconnected global computer networks, for the purpose of making acquaintances, friendship, dating and long term relationships; providing on-line and interactive access to electronic personal classified, providing dating services and matching services for singles; dating service, namely providing dating places consultation; dating parties; dating and singles sweepstakes; on-line computer database in the field of dating, in International Class 45.

The application (Serial No. 76421735) is based on a claim by applicant of a bona fide intention to use the mark

in commerce. Applicant has disclaimed the right to exclusive use of the term PARTY apart from the mark.

HCI and Hearst Magazines Property Inc. ("HMPI"), as joint opposers, initially opposed registration on the grounds of likelihood of confusion and dilution. Specifically, they alleged that they are subsidiaries of The Hearst Corporation, which is "one of the largest communications companies in the world"; that HMPI's predecessor in interest began using the COSMOPOLITAN mark in connection with a magazine in 1886; that such magazine is produced under license by HCI; that "for the last 100 years, HMPI, its predecessors, and its licensees have invested a substantial amount of time, effort, and money in promoting the internationally famous and well-known COSMOPOLITAN magazine"; that HMPI is the owner of Registration No. 630028 for the mark COSMOPOLITAN for a "magazine or periodical published monthly or at other intervals" in International Class 16;² that HMPI is the owner of Reg. No. 2407134 for the mark COSMO GIRL! in connection with "providing an interactive on-line computer

² The registration issued on July 3, 1956 with a date of first use anywhere and in commerce of March 31, 1886. A review of USPTO records reflects that an assignment of the registration from HMPI to HCI was recorded with the USPTO Assignment branch on February 24, 2005 (at reel 3034, frame 0151). The registration was renewed (for ten years) on July 12, 2006.

database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network" in International Class 42;³ that HCI also owns five other registrations for the mark COSMOPOLITAN covering a variety of goods, including pre-recorded exercise video and audio tapes, general interest books, eyeglasses, hair ornaments, and handheld electric dryers and curling irons; that opposers have "made various unregistered uses of the COSMOPOLITAN and COSMO marks," including sponsoring or cosponsoring "a number of social events under the COSMOPOLITAN and COSMO marks each year that bring together unmarried individuals" which took place before the filing date of the subject application; that "[s]ince 1997, HCI has used the mark COSMO QUIZ for a regular section of its magazines that frequently address personal relationships and dating"; that the aforementioned marks constitute a "family of COSMO and COSMOPOLITAN marks"; that this family of marks has "acquired a high degree of recognition, fame,

³ The registration issued on November 21, 2000 with a date of first use anywhere and in commerce of June 29, 1999. A review of USPTO records reflects that the registration issued to HCI, not HMPI, and no assignment of the registration has been recorded. A Section 8 affidavit was filed on November 16, 2006.

and distinctiveness as symbols of the high quality products and services offered by Opposers prior to the filing date of applicant's application"; that "based on the similarities of the marks and the goods and services, the relevant public is likely to be confused into believing that applicant's services, as offered under the COSMO PARTY mark, emanate from opposers"; and that "opposers will be damaged by registration of applicant's COSMO PARTY mark because the mark dilutes and is likely to dilute the distinctiveness of the famous marks making up opposers' family of COSMOPOLITAN and COSMO marks."

Applicant, in its answer, denied the salient allegations of the notice of opposition.

We turn first to applicant's request for an oral hearing on the summary judgment motion. An oral hearing is not held on a motion except by order of the Board. Trademark Rule 2.127(a). Moreover, it is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issue or issues to be decided. See TBMP § 502.03 (2d ed. rev. 2004) authorities cited therein. Ordinarily, arguments on a motion are, and should be, adequately presented in the briefs thereon, and therefore the Board rarely grants a request for an oral

hearing on a motion. *Id.* In this case, we find that an oral hearing on the summary judgment motion is unnecessary and, accordingly, applicant's motion requesting such a hearing is denied.

We now turn to HCI's motion for summary judgment. By way of the motion, HCI seeks judgment solely on the likelihood of confusion claim. The parties have briefed the motion. In order to expedite our decision, the Board presumes familiarity with the issues presented and therefore has not provided a complete recitation of the allegations and contentions of each party.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R.

Civ. P. 56(e), and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Preliminarily, we turn to HCI's request to deem its requests for admission as admitted based on applicant's failure to respond to said requests. Specifically, HCI asserts that on December 7, 2004, it served requests for admissions on applicant; that applicant has not responded to these discovery requests; and that, therefore, the requests for admissions are deemed admitted by applicant under Fed. R. Civ. P. 36. A copy of opposer's requests for admissions is attached to the motion.⁴ Opposer argues that these admissions by applicant include admissions as to (i) "opposers' prior use of a family of marks based on COSMOPOLITAN and COSMO", (ii) the "validity, fame, and distinctiveness of opposers' marks," and (iii) the "confusing similarity of applicant's mark and the marks

⁴ The Board's copy of the admission requests was incomplete; pages 2, 6-7, 9, 11-13, 15-18 were missing. On February 8, 2007, opposer filed a complete copy of its requests for admissions, as served on applicant.

making up opposers' family of marks." Based on the admissions deemed by Rule 36 to be admitted, HCI concludes that there is no genuine issue of material fact in this case as to any of the relevant factors pertaining to likelihood of confusion and that it is entitled to judgment as a matter of law.

Fed. R. Civ. P. 36 provides that if a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR § 2.120(j)(3)(i), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Rule 36(b), and granted by the Board. See also TBMP § 527.01(d) (2d ed. rev. 2004).

Based on the record, it is clear that applicant failed to respond to HCI's requests for admission. In its response to the summary judgment motion, applicant ignores the ramifications of failing to respond to the requests for admission and does not otherwise attempt to show that its failure to respond was the result of excusable neglect. Applicant does not seek leave to withdraw or amend any

admissions effectively admitted under Fed. R. Civ. P. 36, but requests that the summary judgment motion be denied.

In view of the above, all of opposer's 116 requests for admissions served on applicant stand admitted and are considered conclusively established. Fed. R. Civ. 36(b); see also *American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (an admission not withdrawn or amended cannot be rebutted by contrary testimony at trial). These admissions include the following: that "[s]ince prior to applicant's filing date and date of first use and as a result of widespread advertising and promotion by opposers, opposers' marks have acquired a high degree of recognition, fame, and distinctiveness as symbols of high quality products and services offered by opposers" (Admission Request No. 111); that applicant's mark "creates the same commercial impression as opposers' marks" (Admission Request No. 115); that applicant's mark is "confusingly similar to [opposer['s] ... registered COSMO GIRL mark used in connection with a magazine that discusses, among other things, personal relationships and dating" (Admission Request No. 20); that applicant's mark is "confusingly similar to ...HCI's COSMOPOLITAN.COM mark" (Admission Request No. 28); that applicant's mark is "confusingly

similar to ...HCI's COSMOPOLITAN mark, used in connection with general interest books" (Admission Request No. 52); that applicant's mark "is confusingly similar to ... HCI's COSMOPOLITAN mark, used in connection with hair ornaments" (Admission Request No. 68); and that "services provided under the opposed mark are directly competitive to those provided under [HCI's] marks" (Admission Request No. 117).

In view of applicant's admissions, we find there is no genuine issue of material fact remaining for trial.

Notwithstanding applicant's arguments and submissions in its opposition to the summary judgment motion, we conclude that there is a likelihood of confusion between the parties' respective marks.⁵

Accordingly, HCI's motion for summary judgment is granted, the opposition is sustained on the likelihood of confusion ground, and registration of applicant's mark is refused. In view of our finding of a likelihood of confusion, it is unnecessary for this case to go forward for a determination of the dilution claim.

* * *

⁵ HCI's motion to strike certain exhibits submitted by applicant with its response to the summary judgment motion is moot. Even considering the exhibits in dispute, these do not raise a genuine issue of material fact in view of the conclusive admissions made by applicant.