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OF COUNSEL

AVA M. PAQUETTE

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November 20, 2002

VIA U.S. MAIL AND E-MAIL

Mr. David Touretzky

West Mifflin, PA 15122

Re: Unauthorized Use of Federally Registered Trademark

Dear Mr. Touretzky:

Our office represents Religious Technology Center ("RTC"), the owner of the trademark and service mark "SCIENTOLOGY," which is registered with the United States Patent and Trademark Office under registration numbers 1,775,441; 1,540,928; 1,342,353; 1,329,474; 1,318,717; 1,306,997; and 898018. We also represent the Church of Scientology International ("CSI"), which is the licensee of the Scientology mark.

You are currently the owner of the domain name, "Scientologywatch.org." Your registration of that domain causes your name to be falsely associated with our client's registered mark as owner and creates a likelihood of confusion as to the source or sponsorship of this domain name in violation of state and federal law, including the Lanham Act, 15 U.S.C. § 1125(a) and various international laws.

Additionally, the Scientology trademark is famous, distinctive and unique. The registration of this mark in the domain name, "scientologywatch.org" dilutes the distinctiveness of the mark in violation of the federal trademark antidilution statute, 15 U.S.C. § 1125(c) and California's antidilution statute. See, *Archdiocese of St. Louis v. Internet Entertainment Group, Inc.*, 34 F.Supp.2d 1145 (E.D. Mo. 1999); *Mattel, Inc. v. Internet dimensions, Inc.*, 55 U.S.P.Q.2d 1620 (S.D.N.Y. 2000); *Deere & Co. v. MTD Products, Inc.*, 41 F.3d 39, 43 (2nd Cir. 1994).

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The Anticybersquatting Consumer Protection Act ("ACPA") is also implicated by your registration of this domain name. The Act makes it illegal for a person to register or to use, an Internet domain name, that is "identical or confusingly similar" to the distinctive or famous trademark of another person or entity. *Shields v. Zuccarini*, 254 F.3d 476 (3rd Cir. 2001). Statutory damages can be awarded for violation of the Act in an amount not less than \$1,000 and not more than \$100,000 for each domain name. 15 U.S.C. § 1117(d). In *Shields*, the court imposed a \$30,000 statutory damage award against a cybersquatter under the Act.

The U.S. Patent and Trademark Office (PTO) has specifically addressed the question of whether "Scientologywatch" infringes the Scientology mark. When another person applied for a trademark registration for Scientology Watch late last year, the PTO resoundingly rejected that registration as an infringement of the Scientology trademark under several of the registrations listed above. A copy of that letter is enclosed.

Accordingly, we request that you immediately cease and desist the use of this domain name and transfer it to our client, CSI.

I look forward to hearing from you promptly so we can resolve this issue amicably.

Very truly yours,



Enclosure

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO.	APPLICANT	PAPER NO.
MARK		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small>
ADDRESS	ACTION NO.	
	MAILING DATE	
	REF. NO.	
FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: <ol style="list-style-type: none"> 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID *ABANDONMENT*. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/316157 – SCIENTOLOGY WATCH

The assigned examining attorney has reviewed the referenced application and determined the following.

LIKELIHOOD OF CONFUSION:

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified services so resemble the marks in U.S. Registration Nos. 1,306,997; 1,318,717 and 1,540,928 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registrations.

A. Legal Standard:

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether

there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemeltron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

B. The Cited Registrations Are Highly Similar In Appearance To The Applicant's Mark:

It is recognized that the literal portions are the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *In re Drug Research Reports, Inc.*, 200 USPQ 554 (TTAB 1978). For this reason, the examining attorney must give greater weight to the literal portions of the marks in determining whether there is a likelihood of confusion.

The applicant has applied to register the mark "SCIENTOLOGY WATCH" for intended use on education services relating to the Church of Scientology in International Class 41. The registered marks are as follows:

- 1) Registration No. 1,306,997 is "SCIENTOLOGY" for use on books, booklets, newsletters and bulletins in International Class 16;
- 2) Registration No. 1,318,717 is "SCIENTOLOGY" for religious and ministerial services including pastoral counseling in International Class 42;
- 3) Registration No. 1,540,928 is "SCIENTOLOGY" for educational services, namely, conducting courses in philosophy and religion.

The only difference between the registered marks and the applicant's mark is the additional wording "WATCH" on the applicant's proposed mark. Generally, the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB

1979) ("HEAD START" and "HEAD START COSVETIC"). In this case, the wording "SCIENTOLOGY" is a registered trademark of the Religious Technology Center. The applicant has simply added the wording "WATCH" to the registrants' marks.

C. The Goods And Services For The Registered Marks Are Closely Related And Identical To The Applicant's Services:

If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

The applicant is seeking to register its mark for educational services as well as counseling services. These services are closely related to the registrants' books and ministerial and counseling services. Moreover, these services are identical to the registrants' educational services.

Since the applicant's services are closely related and identical to the registrants' services and goods and since the marks are highly similar in appearance, it is likely that persons familiar with the registrants' services, upon encountering the applicant's services, would assume that the applicant's services originate from, or are in some way associated with the source of the registrants' services. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

INFORMALITIES:

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

RECITATION OF SERVICES:

The wording used by the applicant in the recitation of services is indefinite. Specifically, the services recited may fall in more than one class of services. The applicant may also not use the registered term "SCIENTOLOGY" in the recitation of services.

The applicant may amend the wording in the identification, if accurate, to:

"Educational services, namely, conducting classes, seminars, conferences, workshops in the field of religious cults, religion and churches [Applicant may indicate that it is distributing course materials in connection therewith]" in International Class 41 and/or

"Counseling in the field of religious cult rehabilitation and religion" in International Class 42. TMEP section 804.

In the identification, the applicant should use the common commercial designation for the services, be as complete and specific as possible and avoid the use of indefinite words and phrases. The applicant may not include broad wording such as "services in connection with..." or "such as" or "including" or "and like services" or "systems" or "products" or "concepts" or "not limited to...." TMEP sections 804.08(c) and 1301.05.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of services set forth in the present identification.

PROPER RESPONSE TO OFFICE ACTION:

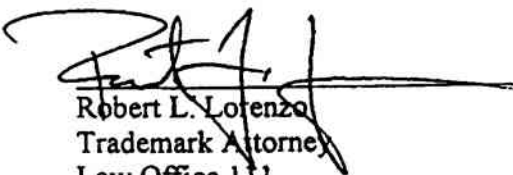
No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The Patent and Trademark Office cannot aid in the selection of an attorney.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.

The following authorities govern the processing of trademark and service mark applications: The Trademark Act, 15 U.S.C. Section 1051 *et seq.*, the Trademark Rules of Practice, 37 C.F.R. Part 2, and the *Trademark Manual of Examining Procedure* (TMEP).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.


Robert L. Lorenzo
Trademark Attorney
Law Office 111
