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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Dennis Drake

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Serial No. 75/892,964

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Denise C. Mazour of Thomte, Mazour & Niebrgall for Dennis Drake.

Brian D. Brown, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Dennis Drake has appealed from the final refusal of the Trademark Examining Attorney to register THEN AND NOW as a trademark for "prerecorded audio cassettes, compact discs and videotapes featuring the historical development and current condition of various American cities; downloadable video and audio recordings, both featuring the

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historical development and current condition of various American cities."<sup>1</sup> Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark NEW YORK THEN AND NOW, with the term NEW YORK disclaimed, previously registered for "entertainment services, namely, a series of short television programs about New York City historical landmarks and points of interest"<sup>2</sup> that, if used in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have submitted appeal briefs. An oral hearing was not requested.

We affirm the refusal of registration.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA

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<sup>1</sup> Application Serial No. 75/892,964, filed January 10, 2000, based on an asserted bona fide intention to use the mark in commerce.

<sup>2</sup> Registration No. 1,866,031, issued December 6, 1994; Section 8 affidavit accepted; Section 15 affidavit received.

1976). In this case, applicant and the Examining Attorney have focused their arguments on these two factors, and we will do likewise.

Turning first to a consideration of the respective goods and services, it is a well-established principle that it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

In this case, there is a clear relationship between applicant's goods and the services identified in the cited registration. Television programs can be released on pre-recorded compact discs and videotapes, or be made available as downloadable recordings. The Examining Attorney has submitted evidence, in the form of third-party

registrations, to show that parties may provide both the goods and services and offer them under a single mark.<sup>3</sup> Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Moreover, the subject matter of applicant's cassettes, compact discs, videotapes, and downloadable recordings--the historical development and current condition of various American cities--is very similar to the subject matter of the registrant's television programs--New York City historical landmarks and points of interest. Although the registrant's subject matter is limited to the city of New York, while applicant's is for "various American cities," applicant does not dispute that New York City would be one

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<sup>3</sup> See, for example, Registration No. 2,315,906 for "prerecorded audio cassettes, video cassettes and compact discs featuring information about paranormal and metaphysical phenomena" and "entertainment in the nature of on-going radio and television programs in the field of paranormal education and research"; Registration No. 2,126,382 for, inter alia, "entertainment services in the nature of television programs relating to home decorating and design" and "pre-recorded videotapes relating to home decorating and design"; Registration No. 2,203,215 for "pre-recorded videotapes featuring travel" and "production of television programs"; and Registration No. 2,141,155 for "pre-recorded videotapes containing hunting and outdoors material" and "entertainment in the nature of ongoing television programs featuring hunting and outdoors material."

of the "various American cities" covered by his identification. Further, the identification of goods would encompass, as subject matter for the goods, the historical development of New York City, and could include New York historical landmarks.

As for the marks, they, too, are extremely similar. Applicant's mark is THEN AND NOW; the cited mark is NEW YORK THEN AND NOW. The marks are identical except that the cited mark also includes the place name NEW YORK. Although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, we think it proper to accord more weight to the THEN AND NOW portion of the cited mark. The name NEW YORK, which has been disclaimed, merely describes the city that the television programs discuss, and therefore does not serve to identify the source of the services.

Applicant's mark, THEN AND NOW, is identical in appearance, pronunciation and connotation to the source-indicating portion of the cited mark. To the extent that consumers will note the inclusion of NEW YORK in the cited mark, they will treat this term as describing the specific

city which is featured in the television programs, rather than viewing this term as identifying a source for the television programs which is different from the source for the cassettes, compact discs and recordings. That is, they will view the presence or absence of the name NEW YORK as relating to whether or not the city of NEW YORK is being featured in the programs or audio and video recordings. In other words, they are likely to assume that the source of the THEN AND NOW audiocassettes, compact discs, videotapes and downloadable audio and video recordings featuring the historical development and current condition of various American cities has produced television programs relating specifically to the city of New York and its historical landmarks and points of interest or, conversely, they are likely to assume that the source of such television programs is also producing audio and videotapes, recordings, etc. on various American cities, and not just NEW YORK.

Accordingly, because of the similarities of the marks and the goods, and the lack of any evidence on the factors that could favor applicant in the likelihood of confusion analysis, we find that applicant's mark, if used on his goods, is likely to cause confusion with the cited registered mark.

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Decision: The refusal of registration is affirmed.