

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: 10/11/2002

Paper No. 12
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Island Entertainment Group, Ltd.

Serial No. 75/939,506

Island Entertainment Group, Ltd., pro se.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Cissel, Seeherman and Hohein, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Island Entertainment Group, Ltd. has appealed from the
final refusal of the Trademark Examining Attorney to
register ISLAND ENTERTAINMENT, with the word ENTERTAINMENT
disclaimed, as a mark for the following services:

Motion picture production and
distribution in all media;
entertainment, namely, preparation of
motion picture special effects; rental
of motion pictures; screenplay writing
services; preproduction and
postproduction of motion pictures;
movie theater services; entertainment
in the nature of a film festival;
casino services; production of motion

pictures for incorporation into video-on-demand, interactive media, digital video, digital interactive games, streaming media and for distribution via a global computer information network or other electronic communications networks.¹

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 registered marks ISLAND PICTURES² and ISLAND PICTURES and design,³ as shown below, that, as used in connection with applicant's identified services, it is likely to confusion or mistake or to deceive. Both of the cited registrations are owned by the same party; are for services identified as "motion picture production and distribution, home video production and distribution, and syndication of films for commercial television"; and both carry disclaimers of the word PICTURES.

¹ Application Serial No. 75/939,506, filed March 9, 2000, and asserting first use and first use in commerce on February 19, 1993.

² Registration No. 1,410,518, issued December 9, 1986; Section 8 affidavit accepted; Section 15 affidavit received.

³ Registration No. 1,420,517, issued December 9, 1986; Section 8 affidavit accepted; Section 15 affidavit received.



Applicant and the Examining Attorney filed appeal briefs. Applicant did not request an oral hearing.

Our determination of the issue 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 1976).

Turning first to the services, they are, in part, identical. Applicant has identified its services, in part, as "motion picture production and distribution in all media"; the cited registrations include "motion picture production and distribution." In addition, because applicant has identified its motion picture production and

distribution so broadly, that is, "in all media," it would include the service of "syndication of films for commercial television" identified in the registrations and is either encompassed within or is, at the very least, closely related, to the registrant's "home video production and distribution."

In view of the fact that the services are, in part, legally identical, we find totally inapposite applicant's argument that the fact that applicant and registrant "market similar services in the same industry does not of itself provide an adequate basis to find the required relatedness" of the services. Brief, p. 7. Simply because applicant has been able to find case law which sets forth such principles as "the issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both," brief. p. 7, does not mean that those principles are applicable to the case at hand.

Applicant also appears to argue that the services are different because "each motion picture production company does this service differently, to a greater or lesser extent, and has its own style." p. 19. Applicant goes on to say that "no one will go into a theater and sit through the wrong movie because of a misreading of the production-

company name listed on the title card" and "no consumer will purchase the services of Island Entertainment while intending to purchase the services of Island Pictures."

Applicant's argument is similar to one that has been unsuccessfully raised by applicants in other cases, when they claim that a consumer will not purchase a shirt when they want a sweater, or soup when they want tomato sauce. However, the question is not whether consumers can distinguish between particular products, but whether they will think the products come from the same source if they are sold under similar marks. In this case, we are dealing with identical services, but since these services result in a product, a movie, applicant is attempting to distinguish the services based on the different movies which the motion picture production services produce. Obviously, if a consumer wants to see the movie "Gone with the Wind," he will not purchase a ticket for "The Sound of Music." However, he may assume, if the service marks for the production of the movies are the same or very similar, that the movies emanate from the same source.

We turn to a consideration of the marks, keeping in mind that when marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely

confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Applicant has engaged in an extensive discussion of the fact that marks must be not be dissected. It is true that marks must be considered in their entirety, but it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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, applicant itself acknowledges, at page 2 of its brief, that ISLAND is the dominant element in applicant's mark and the cited marks. Applicant disclaimed the word ENTERTAINMENT in its original application papers, a recognition of the descriptiveness of this word. Although at page 4 of its brief applicant asserts that ENTERTAINMENT is suggestive, not descriptive or generic, we do not agree. In its original identification of services, applicant lists the various individual services under the broader heading of "entertainment services, namely..." and it is clear to us that the motion picture production and other services identified in the application, including

applicant's "entertainment in the nature of a film festival," would be considered entertainment services. The word PICTURES in the cited marks is descriptive or generic for the registrant's services; applicant does not dispute this. In view of the descriptive nature of the words in the respective marks, consumers would look to the word ISLAND in each mark as the source-identifying element. ISLAND is also the dominant element in Registration No. 1,420,517, since the palm tree design reinforces the connotation of the word ISLAND, and in any event is less likely to be noted or remembered since it would not be pronounced. **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987) (if a mark comprises both a word and a design, the word is normally accorded greater weight).

Applicant argues that because "the dominant portion of the marks, *island*, is a common word with well-known meaning, greater weight accrues to the remainder of the mark than otherwise would," brief, p. 3, and then goes on to discuss the differences between ENTERTAINMENT and PICTURES. Applicant's argument is not persuasive. We will not burden this opinion with an attempt to explain basic principles of trademark law (among other arguments, applicant acknowledges that ISLAND is the dominant part of each mark but contends that greater weight should be given

to the descriptive elements); suffice it to say that an ordinary word can be a strong, distinctive trademark if it is arbitrary, as is the case here.

When applicant's mark and the registered marks are compared in their entireties, and giving due weight to the dominant element ISLAND, it is clear that the marks are very similar. Both begin with the identical word ISLAND, which has an identical appearance in the two word marks, and an identical pronunciation and connotation in all three marks. In the cited design mark the word appears in a somewhat stylized type font, but since applicant has applied for its mark as a typed drawing, a registration therefor would encompass this relatively minor stylization. And, as we indicated previously, the fact that the design mark includes the palm trees does not serve to distinguish the cited mark from applicant's, since the picture merely reinforces the connotation of the word ISLAND.

Because it is the word ISLAND that consumers would look to as the source-identifying element in each mark, the differences that applicant has discussed in exhaustive detail are not sufficient to distinguish the marks. Rather, to the extent that consumers would note or recognize the differences between ISLAND ENTERTAINMENT and ISLAND PICTURES, they would view ISLAND ENTERTAINMENT as

another variation of the ISLAND PICTURES mark, rather than as a mark indicating a separate source of the services, especially since motion pictures are a form of entertainment. In short, applicant's mark and the cited marks convey the same commercial impression.

Applicant also argues that because of the nature of the services, even the minor differences in the marks are sufficient to avoid confusion. Applicant notes that there are two different classes of consumers for the involved services: the general public who would be the ultimate consumer for entertainment services such as motion pictures, and those in the trade who are involved in making movies.

Applicant essentially argues that the general public does not care about the source of movies, with the exception of products from Disney Studios, and therefore we should not determine whether this group is likely to be confused by applicant's use of the mark ISLAND ENTERTAINMENT. Specifically, applicant contends that "trademark law does not protect this indifferent class of purchaser from source confusion." Brief, p. 9. We disagree. Although the decision as to whether to view a movie will be based primarily on the content of the movie itself, we have no doubt that consumers are aware of the

Ser No. 75/939,506

service marks of at least the major companies that produce movies, and such marks provide some guarantee of the quality, including quality of production values, of the movie itself. It is common knowledge that marks relating to the sound and visual technology used in the movies, as well as special effects, are often featured in advertisements. If the public were indifferent to such information, there would be no point in advertising it. Moreover, if applicant were to produce inferior quality motion pictures, or pictures of a type that certain groups of people would find offensive (such as R- or X-rated films), that reputation could damage the goodwill of the registrant's ISLAND PICTURES marks.

The second group of purchasers, industry members, are admittedly sophisticated and careful purchasers. However, even if we were to assume that these consumers would note the differences between ISLAND ENTERTAINMENT and ISLAND PICTURES, because of the strong similarities between the marks and the identical commercial impression they convey, these careful purchasers are also likely to view them as variant marks indicating motion picture production and distribution services which emanate from a single source.

Applicant has asserted that the marketing environment in the industry is that very similar marks are used by

different entities without confusion. In support of this, applicant has submitted 173 third-party registrations, and has listed various groupings of what it contends are similar marks used by different entities. We find that the evidence of the third-party registrations does not prove applicant's contention. Third-party registrations do not evidence of use of the marks shown therein. Therefore, we cannot determine from the registrations that there is a pattern of use in the industry of very similar marks. Further, many of the groupings which applicant contends are of very similar marks do not convey the same commercial impression that applicant's and the cited registrant's marks do. See, for example, CL CINEMA LINE and NEW LINE CINEMA; CITYLIMITS and STUDIO CITY; and THE BUBBLE FACTORY and THE STORY FACTORY. Other marks have as their common element a term which is highly suggestive, see HOLLYWOOD PICTURES and HOLLYWOOD ENTERTAINMENT; FAMILY FILMS and FAMILY PRODUCTIONS, while in the present case, as indicated previously, we find ISLAND to be an arbitrary term. And other marks are owned by the same entity, see DOG STAR PICTURES and DOGSTAR FILMS. Further, because we do not have the files of these registrations before us, we cannot ascertain why one mark may have registered despite the existence of another on the register. For example, there

Ser No. 75/939,506

may have been a consent, or the owners are related companies.

Applicant also asserts that the sophisticated customers in the second group of purchasers would know, from industry sources, trade magazines, and the like that the marks in fact identify different entities. Essentially this argument asks us to ignore the trademarks, and assume that there is no likelihood of confusion because the consumers would not even consider the trademarks, but would know about the companies themselves. That we cannot do. The Statute requires us to determine likelihood of confusion between marks.

Decision: The refusal of registration is affirmed.