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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Olympia Entertainment, Inc.

Serial No. 76277821

Brian B. Darville and Jeffrey S. Molinoff of Oblon, Spivak, McClelland, Maier & Neustadt for Olympia Entertainment, Inc.

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(Michael W. Baird, Managing Attorney).

Before Walters, Bucher and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

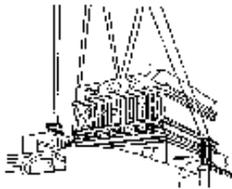
Olympia Entertainment, Inc. has filed an application to register the standard character mark FOX THEATRE on the Principal Register for "entertainment services, namely, the presentation and production of live plays, musicals, live music concerts, educational events and theater presentations of speakers," in International Class 41.¹ The application

¹ Serial No. 76277821, filed June 28, 2001, based on use of the mark in commerce, alleging first use and use in commerce as of November 19, 1988. The application is subject to stated concurrent use exceptions. The application will proceed with the concurrent use claim only if applicant ultimately prevails in this appeal.

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includes a disclaimer of THEATRE apart from the mark as shown. The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered marks shown below, all owned by Twentieth Century Fox Film Corporation, that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Registration No.	Mark	Goods/Services
1485074 Registered April 19, 1988; Sections 8 and 15 affidavits accepted and acknowledged	FOX TELEVISION STATIONS	cinematographic films; pre-recorded video tapes, cassettes, In International Class 9; television and cable broadcasting services, in International Class 38; entertainment services, namely production and distribution of motion pictures and video tapes; and providing film and tape entertainment for viewing through the media of television, cinema and other media, in International Class 41 TELEVISION STATIONS is disclaimed apart from the mark as a whole
1485075 Registered April 19, 1988; Sections 8 and 15 affidavits accepted and acknowledged		television and cable broadcasting services, in International Class 38; entertainment services, namely providing film and tape entertainment for viewing through the media of television, cinema and other media, in International Class 41

<p>1783915</p> <p>Registered 7/27/1993; Renewed; Section 15 affidavit filed and acknowledged</p>	<p>FOXVIDEO</p>	<p>motion picture films; pre-recorded video tapes, videocassettes, videodiscs, tapes and cassettes for reproducing audio/visual material on a variety of subjects, in International Class 9</p>
<p>1784507</p> <p>Registered 7/27/1993; Renewed; Section 15 affidavit filed and acknowledged</p>	<p>FOXVIDEO</p>	<p>entertainment services in the form of production and distribution of pre- recorded videocassettes of motion picture films and television programs, in International Class 41</p>
<p>1808084</p> <p>Registered 11/30/1993; Renewed; Section 15 affidavit filed and acknowledged</p>		<p>Entertainment services; namely, production and distribution of theatrical motion picture films and television programs; production and distribution for others in the field of filmed and tape entertainment for viewing through television, cinema and other media, in International Class 41</p>
<p>2087047</p> <p>Registered 8/12/1997; Renewed; Section 15 affidavit filed and acknowledged</p>		<p>production and distribution of motion picture films; production of pre- recorded video tapes, pre-recorded video cassettes, pre- recorded videodiscs, all featuring live- action and animated entertainment, in International Class 41</p> <p>PICTURES is disclaimed apart from the mark as a whole.</p>
<p>2513019</p> <p>Registered 11/27/2001</p>	<p>FOX FAMILY</p>	<p>Entertainment services in the nature of production and distribution of children's television programs and motion picture films, production of pre-</p>

		<p>recorded video tapes, video cassettes, video discs, audio tapes, audio cassettes, audio discs and CD-ROMS; entertainment services in the nature of live musical, dramatic and comedic performances; providing on-line information in the field of motion picture film, television, video, games, contests and children's entertainment via a global communications network, in International Class 41</p>
<p>2482846 Registered 8/28/2001</p>		<p>Entertainment services in the nature of production and distribution of children's television programs and motion picture films, production of pre-recorded video tapes, video cassettes, video discs, audio tapes, audio cassettes, audio discs and CD-ROMS; entertainment services in the nature of live musical, dramatic and comedic performances; providing on-line information in the field of motion picture film, television, video games, contests and children's entertainment via a global communications network, in International Class 41</p>

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

As a preliminary matter, applicant has objected to evidence submitted by the examining attorney with her denial

of applicant's request for reconsideration. Applicant characterizes the submission of evidence at this time as piece-meal prosecution that leaves applicant at a disadvantage. As the examining attorney points out, evidence directed to the issues raised in the request for reconsideration is proper. We agree with the examining attorney that the evidence submitted does address the issues raised in the request for reconsideration and, therefore, it is properly of record in this appeal and has been considered.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper*

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Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We note, first, the examining attorney's argument that registrant's FOX marks are famous and should be entitled to

a broad scope of protection. As proof of this allegation, she states that several of the registrations owned by the cited registrant have been active for many years, for example, registration no. 0199107 issued in 1925. Clearly, the mere fact of a mark residing on the register for a long period of time does not establish that it is famous. Therefore, we do not conclude in this case that registrant's marks are famous.

Nor do we conclude, as urged by applicant, that FOX is a weak term in the respective marks and, thus, the cited registrations are entitled to only a limited scope of protection. Applicant submitted third-party registrations² and Internet evidence³ of FOX-formative marks for entertainment services and argues that the additional wording in its mark is sufficient to distinguish it from the cited registered marks.⁴ The ten FOX-formative marks and

² Third-party registrations in the record include "FOX PHOTOGRAPHY" and design for photography services; EFOX.NET for an Internet website containing "sensual" pictures of women; FOX PAINTBALL for entertainment and recreation services pertaining to paintball games; FOXMIND for interactive online games; FOXWELL for live musical performances; GRAYFOX PRODUCTIONS for producing video discs and cassettes; FOXY LADY for exotic dance performances; FOXX for live country music performances; FOXFIRE for live musical performances; FOXES.COM for adult entertainment services; and FOX FORCE 005 for live vocal and visual performances by a musical group that incorporates its image with pre-recorded music.

³ Excerpts from Internet websites in the record include uses of the previously referenced third-party registrations: "Grayfox" productions; "Fox Paintball"; "FoxMind" Games; "Foxes.com," a nude model website; "Fox Force 005." and "Fox Photography." An additional website also excerpted shows "Foxwoods" resort and related services.

⁴ Applicant also submitted Internet evidence and third-party registrations for entertainment services identified by the same or similar non-FOX-formative marks owned by different parties as evidence

uses in the third-party registrations and Internet evidence are distinguishable from the case before us by the additional matter in those marks and/or by the nature of the services identified. Moreover, each case must be decided on its own facts. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed.Cir. 2001).

Applicant argues that the marks are distinguished by the "striking" design elements in several of the cited registered marks and by the additional wording in the marks. However, we agree with the examining attorney that the marks are substantially similar because the first and dominant term in each mark is FOX; the additional wording in the marks is generic or highly descriptive; and the design elements in the registered marks are minimal and clearly not dominant. With respect to applicant's mark, the disclaimed term THEATRE is clearly merely descriptive, if not generic, in connection with the identified entertainment services; whereas, FOX would appear to be an arbitrary term in connection therewith.

With respect to the cited registrations, we consider each mark individually. The standard character mark FOX TELEVISION STATIONS in the '074 registration includes a

that "consumers have become accustomed to the use of the same or similar marks by different companies in the entertainment industry" (brief, p. 15). We do not find this evidence to be probative of practices in the entertainment industry or, specifically, in relation to the marks in the case before us.

disclaimer of TELEVISION STATIONS and this phrase is clearly merely descriptive of the identified services that include television cable and broadcasting services; thus, FOX is the dominant portion of this mark.

The design elements in the FOX marks in the '075 and '084 registrations appear to be stylized spotlights that highlight the term FOX; thus, the design elements reinforce the dominance of the word portion of these two marks, i.e., FOX.

The standard character mark FOXVIDEO in the '915 and '507 registrations includes, respectively, pre-recorded video tapes and production and distribution of pre-recorded video tapes; thus, the term VIDEO in this telescoped mark is merely descriptive. While the two portions of the mark are telescoped into a single word, both portions are actual words that retain their separate identity as recognizable words. We find FOX to be the dominant portion of this mark as well.

The mark in the '047 registration includes the words FOX PICTURES in a design in which the words appear to be the ends of boards or beams being lifted by a crane with what appears to be a movie camera filming the words. While the design element is distinctive, we find that the words predominate because, not only are they centered in the

design and the focus of the camera, but, it is the wording FOX or FOX PICTURES that would be used by consumers to refer to registrant's services. Thus, the wording would make a greater impression on purchasers and is the portion that is more likely to be remembered as the dominant and source-signifying portion of the registered mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"). See also, e.g., *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (1987). Considering the word portion of the mark, the word PICTURES is merely descriptive in connection with the identified production and distribution of motion picture films and it is disclaimed. Thus, we find that FOX is the dominant portion of this mark.

Similarly, we find FOX to be the dominant portion of the mark FOX FAMILY in the '019 registration and the mark FOX FAMILY CHANNEL and design in the '846 registration for the respective entertainment services which include television programming and movies for children. FAMILY and FAMILY CHANNEL are suggestive in connection with these services; whereas the FOX portion of these marks is the first and arbitrary term in each mark. The design element in the '846 registration consists of a circular background carrier and slightly stylized lettering in which the word FOX appears larger than the other wording in the mark.

Considering the marks in their entireties, we find that the identity of the arbitrary term FOX followed by descriptive wording in applicant's mark and the registered marks outweighs the dissimilarities among these marks. We conclude that applicant's mark is substantially similar to each of the marks in the cited registrations.

We are not persuaded otherwise by applicant's contention that the spelling of "theater" as "theatre" in its mark distinguishes its mark from the registered marks because it "brings to mind old-fashioned theatres in London, as opposed to twentieth century American-style movie theaters" (brief, p. 12). Not only has applicant submitted no evidence in support of this position, but also the examining attorney submitted a definition from *The American Heritage Dictionary of the English Language*, 3rd ed. 1992, of "theater" as "theater or theatre. 1. A building, room, or outdoor structure for the presentation of plays, films, or other dramatic performances." Thus, both spellings would appear to be acceptable and common in American English.

Turning to consider the goods and services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services

actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney notes that applicant's services are live entertainment services and registrant's services include primarily movies, television programs and broadcasting and prerecorded entertainment. She states that such services are closely related and submitted evidence in

this regard.⁵ The examining attorney also submitted excerpts from several Internet websites in support of her contention "that production companies often provide live entertainment"⁶ (denial of reconsideration, p. 4).

Applicant contends that the refusal should be reversed as to registration nos. 2482846 and 2513019 because the marks are different and as to the other cited registrations because the record contains no evidence that the services recited in the cited registrations are related to live theatrical performances.

We consider the services in the application vis-à-vis the goods and services in each of the cited registrations. We begin with the '019 registration for the mark FOX FAMILY and the '846 registration for the mark FOX FAMILY CHANNEL and design. Both of these registrations include "entertainment services in the nature of live musical, dramatic and comedic performances," which are essentially identical to applicant's identified services, i.e., "entertainment services, namely, presentation and production

⁵ In the final refusal of December 7, 2006, the examining attorney states that "MGM and Walt Disney are certainly well known for making movies and other forms of entertainment" and submitted excerpts from the Walt Disney website referring to the Walt Disney Concert Hall and excerpts from the MGM Grand website, the MGM movies website and the MGM Mirage website, although none of the MGM sites refer to live entertainment.

⁶ The excerpted websites include references to live entertainment by Paramount, Warner Bros., and Universal. While applicant correctly notes that the Paramount excerpt refers to its live entertainment theater under a different mark, "The Sherry Lansing Theater," the site clearly indicates its relationship to Paramount.

of live plays, musicals, live music concerts, educational events and theater presentations of speakers."

The '074 registration (FOX TELEVISION STATIONS) and the '075 registration (FOX and searchlight design) both include television and cable broadcasting services. Live performances are often broadcast on network and cable television. Therefore, we find these services to be sufficiently related that consumers viewing applicant's FOX THEATRE live performance on registrant's FOX television network are likely to believe that these services, offered under confusingly similar marks, as discussed above, emanate from the same or a related source.

The '074 registration (FOX TELEVISION STATIONS), the '084 registration (FOX and searchlight design), the '507 registration (FOXVIDEO), and the '047 registration (FOX PICTURES and design) all include the production and distribution of motion picture films. Additionally, '074 and '047 include the production and distribution of video tapes/cassettes; '507 and '084 include the production and distribution of television programs; '074 and '915 (FOXVIDEO) include motion picture films and prerecorded video tapes/cassettes/discs; and '074, '084 and '075 (FOX and searchlight design) include "providing film and tape entertainment for viewing through the media of television, cinema and other media." In other words, these

registrations include goods and services pertaining to production and distribution of motion pictures and television programs. The record establishes that these types of entities also offer live theater performances. Moreover, as discussed above, motion pictures and television programs often feature live theater performances. Therefore, we find applicant's services are closely related to the motion picture and television goods and services in these cited registrations.

Regarding the conditions under which and buyers to whom sales are made, we note that because there are no restrictions in the respective identifications of goods and services, the relevant purchasers of both applicant's services and registrant's goods and services are members of the general public who are likely to exercise no more than ordinary care in purchasing entertainment goods and services.

Applicant cites the Supreme Court decision in *U.S. v. Paramount Pictures*, 334 U.S. 131 (1948), and alleges that this decision held that major movie production studios could no longer own or have interests in chains of theaters where films would be shown. Applicant acknowledges that its theater was originally owned by the cited registrant but claims that confusion is unlikely because its theater has been independently owned and operated for over fifty years.

We find that applicant has overstated the holding about joint ownership of theaters by motion picture studios in that case. Rather, the Court made the following statements:

To the extent that these acquisitions were the fruits of monopolistic practices or restraints of trade, they should be divested.
(334 U.S. at 152)

. . .

It seems, however, that some of the cases of joint ownership do not fall into any of the categories we have listed. Some apparently involve no more than innocent investments by those who are not actual or potential operators. If in such cases the acquisition was not improperly used in furtherance of the conspiracy, its retention by defendants would be justified absent a finding that no monopoly resulted. ... In short, we see no reason to place a ban on this type of ownership, at least so long as theatre ownership by the five majors is not prohibited.
(334 U.S. at 153)

Particular issues of divestiture or continued ownership were then decided by the District Court on remand. *United States v. Paramount Pictures*, 85 F. Supp. 881, 82 USPQ 291 (S.D.N.Y. 1949).

However, we agree with the examining attorney that the average consumer of these entertainment goods and services is not likely to be aware of, or understand, this Supreme Court decision and will be more likely to believe, mistakenly, that an affiliation with registrant exists.

Applicant also argues that despite twenty years of coexistence, there have been no known instances of actual confusion. While a factor to be considered, the absence or

presence of actual confusion is of little probative value where we have little evidence pertaining to the nature and extent of the use by applicant and registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003)

("uncorroborated statements of no known instances of actual confusion are of little evidentiary value."). See also, *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and each of the marks in the cited registrations, their contemporaneous use on the same and/or closely related goods and services in each of the cited registrations is likely to cause confusion as to the source or sponsorship of such goods and services.

Decision: The refusal under Section 2(d) of the Act is affirmed.⁷

⁷ Should either of cited registration nos. 2513019 or 2482846 be cancelled as of a date prior to the date of this decision for failure to file an affidavit under Section 8 of the Trademark Act, 15 U.S.C. §1058, the discussion regarding these registrations will be moot and the decision should be considered vacated with respect to these two

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registrations. However, the result remains the same, i.e., registration to applicant is refused.