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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 GGWTV, LLC

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Application Serial No. 77086958

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David Hochman, Wolf, Rifkin, Shapiro & Schulman, LLP, for  
GGWTV, LLC.

Toby E. Bulloff, Examining Attorney, Law Office 117,  
(Loretta C. Beck, Managing Attorney).

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**Before Bucher, Mermelstein, and Wellington, Administrative  
Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

GGWTV, LLC. filed an application for registration of  
the mark GAYS GONE WILD (in standard characters) on the  
Principal Register for "prerecorded dvds featuring adult  
entertainment" in International Class 9.<sup>1</sup>

The examining attorney issued a final refusal to  
register pursuant to Trademark Act § 2(d), 15 U.S.C.  
§ 1052(d), on the ground that applicant's mark so resembles  
the following marks (owned by the same entity) that it  
would, if used on or in connection with the identified

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<sup>1</sup> Filed January 19, 2007, alleging a *bona fide* intent to use the  
mark in commerce under Trademark Act § 1(b); 15 U.S.C. § 1051.

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goods, be likely to cause confusion, to cause mistake, or to deceive:

| <b>Registration No.</b> | <b>Mark</b>                  | <b>Goods</b>  |
|-------------------------|------------------------------|---|
| 2411851                 | GIRLS GONE WILD <sup>2</sup> | Prerecorded videotapes featuring adult entertainment  |
| 2936637 <sup>3</sup>    | GUYS GONE WILD               | Pre-recorded video tapes and DVD's, all featuring movies and television programs of all kinds |

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

**I. Evidentiary Issues**

Attached to applicant's opening brief and to its reply brief were copies of a number of documents which were not submitted during examination, comprising third-party applications and registrations (main brief) and a list of applications and registrations as well as dictionary definitions (reply brief). The examining attorney objected to the documents attached to applicant's opening brief as untimely.

Applicant argues that the registrations and applications attached to its opening brief evidence the weakness of the cited registrations. In its response to the first Office action, applicant included a list of third-party registrations and applications for the same purpose.

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<sup>2</sup> Issued December 12, 2000; Trademark Act §§ 8 and 15 affidavits accepted and acknowledged.

<sup>3</sup> Issued March 29, 2005.

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The examining attorney - correctly - informed applicant that a list of registrations

is not the proper way to make such material of record. Rather, plain copies of the registrations or the electronic equivalent thereof, namely printouts of the registrations from the Office's X-Search<sup>[4]</sup> automated records, are required for this purpose.

Final Office Action at 3.

As provided in the Trademark Rules,

The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

Trademark Rule 2.142(d). See, e.g., *In re Posthuma*, 45 USPQ2d 2011, 2012 n.2 (TTAB 1998) (registration attached to appeal brief untimely).

Here, applicant could have made this evidence of record by filing a request for reconsideration prior to appeal<sup>5</sup> or after appeal, by requesting that the Board remand the

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<sup>4</sup> "X-Search" is the USPTO's internal search engine. The examining attorney undoubtedly intended to refer instead to TESS (Trademark Electronic Search System), the public version of the same database, available on the USPTO's website.

<sup>5</sup> Applicant could have taken as long as six months following the mailing of the final office action in which to file any new evidence, argument, or amendment in support of registration.

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application to the examining attorney for further examination, including submission of further evidence. But submission of new evidence with a brief is unacceptable because the examining attorney has not had a chance to examine it and, if appropriate, to submit evidence in response. The Board's task in an appeal is to review the examining attorney's decisions; we do not examine applications or evidence in the first instance, as would be required by consideration of this new evidence. Accordingly, applicant's third-party registrations and applications<sup>6</sup> will not be considered.

The list of applications and registrations attached to applicant's reply brief is also untimely. Further, as the examining attorney noted, submission of a list of trademark records is not an appropriate way to make the records themselves of record. *See, e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record."). We have therefore not considered this list of applications and registrations.

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Trademark Rule 2.64(b).

<sup>6</sup> We note that a cursory glance at this evidence indicates that it includes a number of trademark applications. Prior to registration, a pending application is proof of little beyond its having been filed.

Likewise, the dictionary definition of "gay," and the associated usage note attached to applicant's reply brief were also untimely submitted.<sup>7</sup> Although applicant did not request judicial notice, the Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). However, it is not clear whether applicant's dictionary does exist in printed form.<sup>8</sup> Accordingly, we will not consider applicant's dictionary definition<sup>9</sup> or usage note, although we add that such consideration would not alter the result in this case.

## **II. Likelihood of Confusion**

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *See In re E.I. du Pont*

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<sup>7</sup> Especially so in this case, because they were attached to applicant's reply brief, to which the examining attorney may not respond. As far as we can determine, this evidence was not submitted in response to a new argument made by the examining attorney on appeal, and there is no apparent reason why this evidence could not have been proffered earlier.

<sup>8</sup> Although the dictionary definition is apparently from Houghton-Mifflin, it is not clear whether it is an electronic version of a printed volume or an online-only product.

<sup>9</sup> In its reply brief, applicant also cites a definition of "gay" from the American Heritage Steadman's Medical Dictionary. Reply Br. at 1-2. This evidence will also not be considered for the same reasons, and also because a copy of the definition was not supplied with the "request" for judicial notice.

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*de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *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 Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Azteca Rest. Enter., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

**A. The Similarity or Dissimilarity and Nature of the Goods; Channels of Trade; Classes of Customers**

Applicant's goods are identified as "prerecorded DVDs featuring adult entertainment," in International Class 9, while the goods in the cited registrations are "pre-recorded video tapes and DVD's, all featuring movies and television programs of all kinds," ('637 Registration) and "prerecorded videotapes featuring adult entertainment," ('851 Registration). Applicant's goods are included within the scope of the '637 Registration and - except for being recorded on a different medium - are also identical to the

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goods in the '851 Registration. We conclude that applicant's goods are legally identical to the goods identified in both cited registrations.

Applicant argues that its goods feature and are sold to "gays," and that the cited registrant's goods feature and are sold to heterosexual "guys" or "girls." Nonetheless, we note that neither the application nor the cited registrations contain any such restrictions. Our analysis is limited to consideration of the goods as recited in the application or registration, and not what the goods may actually be in the marketplace. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). We may not import limitations into an identification of goods which do not appear in the file. We thus consider the goods of the subject application and those of the cited registrations to be identical. Moreover, because the goods are identical, we must also presume them to share the same channels of trade and to be sold to the same class of customers. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

On a related note, applicant argues that purchasers of its intended products and those of the cited registrant would clearly understand the difference between "gay," "girls," and "guys":

If someone is going to watch a movie that is 'GAY' they will expect that the actors will portray gays, lesbians, bisexuals, drag queens and/or

transgenders, and they will not expect that the main characters are heterosexual "GIRLS" or "GUYS." ....

A reasonably prudent consumer would not think that if they buy a 'GAYS GONE WILD' DVD they would be watching heterosexual GUYS or GIRLS. In fact, based on how famous the Prior Marks (and the principal of the owner of the Prior Marks) have become, society associates these marks with heterosexual individuals performing heterosexual acts, not homosexuals performing homosexual acts.

Reply Br. at 2.

But even if we accept applicant's contention of what the respective goods actually are or will be (and we do not), applicant's argument misses the point. The question isn't whether consumers will confuse the goods, but whether consumers - seeing the marks used on such goods - will be confused as to the source of the goods. Thus, even if consumers would expect applicant's goods to feature "gay" content and expect the prior registrant's goods to feature "heterosexual" content, the question remains as to whether those customers would nonetheless believe that applicant's brand is merely an extension of the prior registrant's admittedly well-known mark.<sup>10</sup> *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972).

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<sup>10</sup> There is no evidence that such products are mutually exclusive, i.e., that they would never emanate from the same source.

The legally-identical goods at issue favors a finding of likelihood of confusion.

**B. Fame of the Prior Registration**

The fame of the senior mark is not often a factor in *ex parte* proceedings in which the prior registrant does not participate. However, as can be seen from the quotation above, applicant apparently admits that the prior registrant's marks are famous, or at least very well known. The Court of Appeals for the Federal Circuit has emphasized that when a prior mark is famous, that factor is entitled to great weight in determining whether confusion is likely. *E.g. Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("The Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark."). Nonetheless, applicant here claims that confusion is not likely precisely because of the renown of the prior registrations.

This argument was rejected in *Kenner Parker Toys*, which is directly on point:

The Board acknowledged "the renown of opposer's mark with respect to modeling compound." Indeed, Rose Art conceded this fame. Yet the Board treated that fame as a liability in assessing likelihood of confusion. Reasoning that consumers might more easily recognize variances from a famous

mark, the Board concluded that the fame of Kenner's mark permitted greater, rather than less, legal tolerance for similar marks.

While scholars might debate as a factual proposition whether fame heightens or dulls the public's awareness of variances in marks, the legal proposition is beyond debate. The driving designs and origins of the Lanham Act demand the standard consistently applied by this court - namely, more protection against confusion for famous marks.

22 USPQ2d at 1456.

We need not decide here whether applicant's statement alone is enough to establish that the cited marks are "famous," in the same sense that PLAY-DOH in *Kenner Parker* and FRITO-LAY in *Recot* were found to be. The degree to which the public is familiar with the prior registrant's marks is not an all-or-nothing proposition. Here, applicant's statement was clearly premised on the assumption that the prior registrant's marks are well-known within the market for such goods, such that potential purchasers would be aware of them and have them in mind when encountering applicant's goods in the marketplace. Such a degree of public knowledge or renown is indeed a significant factor in the *du Pont* analysis, but not for the reason put forward by applicant. On the contrary, rather than helping to avoid a likelihood of confusion, the renown of the prior weighs *against* applicant.

**C. The Similarity or Dissimilarity of the Marks in their Entireties As To Appearance, Sound, Connotation And Commercial Impression**

We next compare the goods for similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). 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 impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

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We begin our consideration of the involved marks with the observation that when the goods are highly similar, a lesser degree of similarity between the marks will suffice to sustain a finding of likelihood of confusion. *ECI Div. of E-Systems, Inc. v. Env'tl. Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980).

Applicant's mark is GAYS GONE WILD, while the prior registrant's marks are GIRLS GONE WILD and GUYS GONE WILD. It is obvious that the marks share the identical last two words ("GONE WILD"), as well as the same general construction. In addition, like the cited registrations, the first word in applicant's mark is a short word beginning with a "G" (alliterating with the next word) and - by applicant's account - naming the subject matter of the recordings by sexual preference and gender.

Applicant argues that the registered marks are weak, citing a number of applications and registrations including the words "GONE WILD." However, as noted above, those applications and registrations are not part of the record, and will not be considered. While we acknowledge that the marks at issue here appear somewhat suggestive, applicant has admitted that the cited registrations are well-known. We therefore consider the registrant's marks to be strong source indicators, despite any inherent weakness.

Applicant likewise cites several Board decisions in which we found no likelihood of confusion despite the use of identical marks. Suffice it to say that - other than the general principles one may glean from such cases - decisions involving different marks and different goods and presented on different records are of little help in deciding this case. *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260-61 (CCPA 1950).

Considering the marks as a whole, we find them highly similar, a factor which strongly supports the refusal to register.

**D. Actual Confusion**

Finally, applicant alleges that there is "no evidence of actual confusion in the marketplace between Applicant's Mark and the Prior Marks." Appl. Br. at 5-6. As has been repeated numerous times, the relevant question is likelihood of confusion, not actual confusion. While evidence of actual confusion is almost always relevant to a likelihood of confusion determination, the absence of such evidence is only of importance when the evidence establishes that the marks have been contemporaneously used for a significant period under conditions in which confusion, if any, would be likely to arise. There is no such evidence here. The subject application was filed based on applicant's *bona fide* intent to use the mark, and applicant has not yet filed an

allegation of use. While applicant might be using its mark, it has presented no evidence of such use, let alone the kind of evidence we would need to determine whether such use would have already led to confusion, if confusion were likely. And even if we had such evidence, applicant's lack of knowledge of actual confusion is entitled to little or no weight in an *ex parte* appeal, because we do not have the benefit of hearing from the prior registrant, who is at least as likely as applicant to have heard of confusion in the marketplace. *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984) (citations omitted).

Accordingly, we consider this factor neutral in our analysis.

**E. Proffered Disclaimer**

Finally, applicant offers in its reply brief to "provide a disclaimer on its DVD packaging and the DVD's themselves stating that the DVD is in no way associated with the owner of GIRLS GONE WILD or GUYS GONE WILD." However, such a disclaimer (or the offer of it) is of no relevance to our decision. A disclaimer of connection with the owner of a prior registration is not a defense to a refusal to register due to a likelihood of confusion. *Cf. In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (CCPA 1979). Again, our analysis is limited to a determination of whether the mark depicted in the drawing of this application

is registrable *vel non*. Whether a disclaimer of this type appearing along with the mark is enough to dispel confusion is not our concern.<sup>11</sup>

**III. Conclusion**

We have carefully considered the file of this application, and the briefs on appeal. Given the essentially identical goods at issue (and hence the identical customers and channels of trade) and the highly similar marks, we conclude that applicant's use of the mark GAYS GONE WILD as applied to the identified goods is likely to cause confusion as to the source or sponsorship of such goods, with respect to both of the cited registrations. Our decision is further buttressed by applicant's admission that the cited registrant's marks are (at least) well-known.

**Decision:** The refusal to register under Trademark Act § 2(d) is AFFIRMED.

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<sup>11</sup> In any event, applicant's offer is untimely. If it had any merit - which it does not - it should have been proffered during examination, when it could have been considered by the examining attorney.