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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Warner Bros. Entertainment Inc.

Serial No. 78670971

Avis Frazier-Thomas for Warner Bros. Entertainment Inc.

Cory Boone, Trademark Examining Attorney, Law Office 104
(Chris Doninger, Managing Attorney).

Before Hohein, Kuhlke and Wellington, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Warner Bros. Entertainment Inc. seeks registration on
the Principal Register of the mark FRIENDS: THE ONE WITH
ALL THE TRIVIA (in standard character form) for goods
ultimately identified as "motion picture films featuring
comedy, drama, action, adventure and/or animation; audio
tapes, audio-video tapes, audio video cassettes, audio
video discs, and digital versatile discs featuring music,
comedy, drama, action, adventure, and/or animation; stereo
headphones; cordless telephones; audio cassette and CD
players; telephone and/or radio pagers; short motion

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picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; video cassette recorders and players, compact disc players, digital audio tape recorders and players; radios; mouse pads; eyeglasses, sunglasses and cases therefor; cellular telephone accessories, namely hands-free accessories, cellular telephone covers and cellular telephone face covers; and decorative magnets; and CD ROM computer game discs; game equipment sold as a unit for playing a parlor-type computer game namely video output game machines for use with televisions and computer game software; video and computer game programs; video game cartridges and cassettes; all featuring clips and background information that is based upon a television series about the lives and ongoing adventures of a group of six buddies consisting of three men and three women living in Greenwich Village, New York" (underlining added) in International Class 9.¹

¹ Application Serial No. 78670971, filed July 14, 2005, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). The application also lists applicant as the owner of Registration No. 2032383, which is for the mark FRIENDS (in typed form) for "entertainment services in the nature of a live-action, comedy, drama and/or animated television program and production of live-action and/or animated motion picture films for television" in International Class 41.

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Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), as to the identified goods underlined above, on the ground that applicant's mark, when used with these goods, so resembles the registered mark FRENZ (in typed form) for "entertainment services, namely, providing online interactive games" in International Class 41² and "interactive multimedia computer games," in International Class 9,³ as to be likely to cause confusion, mistake or deception. Both registrations are owned by AT&T Intellectual Property II, L.P.

When the refusal was made final, applicant appealed and briefs have been filed. We affirm the refusal to register.

Likelihood of Confusion

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). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201

² Registration No. 2856750, issued June 22, 2004.

³ Registration No. 2856751, issued June 22, 2004.

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(Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In comparing the marks FRENZ and FRIENDS: THE ONE WITH ALL THE TRIVIA, we must determine whether they are sufficiently similar that there is a likelihood of confusion as to source and, in doing so, we must consider the recollection of the average purchaser, who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In making our determination, we compare the marks in their entireties in terms of appearance, sound, connotation and commercial impression.

We begin our analysis by noting that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re *National Data Corp.*, 753 F.2d 1056, 224 USPQ749, 751 (Fed. Cir. 1985). The word FRIENDS is the more dominant and memorable element in applicant's mark. Its placement is at the beginning of the mark and it is set apart from the

explanatory phrase THE ONE WITH THE TRIVIA. In calling for the goods, consumers are likely to shorten it to the single word FRIENDS, omitting the longer phrase. This dominant portion in applicant's mark is phonetically identical to registrant's mark FRENZ.

We find the difference in appearance based on the phonetic spelling in registrant's mark and/or the additional explanatory phrase in applicant's mark is not sufficient to outweigh the similarity engendered by the phonetic identity of the common elements. We also find the overall commercial impression of the marks to be similar in view of the dominance of the word FRIENDS in applicant's mark. Moreover, the marks share the same connotation as to the ordinary meaning of the word friends.

In traversing the refusal, applicant argues that the phrase THE ONE WITH THE TRIVIA shades the connotation of the term FRIENDS in its mark to point exclusively to a television series. Specifically, applicant argues:

Applicant's use of the trademark FRIENDS: THE ONE WITH ALL THE TRIVIA is also distinguished from the prior Registrant's FRENZ trademark because this mark has a unique and immediate association with the highly successful FRIENDS television series. More specifically, the FRIENDS: THE ONE WITH ALL THE TRIVIA trademark incorporates a key identifying element of the FRIENDS television series, namely - the individual episode titles. This play on the individual episode titles is a key factor in

creating the commercial impression of the FRIENDS: THE ONE WITH ALL THE TRIVIA trademark, and associates it with the FRIENDS television series.... By way of explanation the Trademark Trial and Appeal Board's attention is respectfully directed to the FRIENDS-TV website ... which answers all of the "Frequently Asked Questions" about the television series. Attention is specifically directed to Question Number 1.03 which asks the question, all about the episode titles (What's 'TOW' mean?). In response to this query the producers of the FRIENDS television series responded as follows: "...1.03 All about the episode titles (What's TOW mean?) The episode guide lists all the titles, gives plot synopses, quotes, and credits.... All episodes begin with "The One with...", "The One Where...", "The One At..." ("TOW" or "TOA").

The Trademark Trial and Appeal Board's attention is also directed to the Wikipedia website ... which presents the following information about the FRIENDS television series and its use of THE ONE WITH/THE ONE WHERE - formative episode titles.... "The only episodes not to begin with "the One..." are "The Pilot" "The Last One, Part 1" and "The Last One, Part 2." ...

Given this widespread, long term use of the FRIENDS and THE ONE WITH/THE ONE WHERE-formative episode titles, it is respectfully submitted that Applicant's use of the FRIENDS: THE ONE WITH ALL THE TRIVIA trademark is distinguishable from the prior Registrant's FRENZ trademark and the marks must therefore be viewed as dissimilar.

Br. pp. 10-11.

While this may be true for many consumers, we must consider all potential consumers of computer games (whether downloaded online or purchased off the shelf) which would include consumers not familiar with the television series and/or the phrasing THE ONE WITH as denoting an episode of

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a television series. Thus, at least for some of the overlapping consumer base, FRENZ and FRIENDS will have the identical ordinary meaning of the word friends. Moreover, as the examining attorney stated, to the extent that applicant's mark FRIENDS is well known as a television series:

...whatever fame the applicant's television show has achieved only increases the likelihood that consumers will confuse the applicant's mark and product with those in the cited registrations. Consumers may mistakenly believe the registered marks to be in fact connected with the applicant, or instead that the registrant is unfairly trading on the applicant's good will, creating a situation of reverse confusion. The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods or services, but it also protects against "reverse confusion," that is, that the junior user is the source of the senior user's goods or services. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

Br. p. 8.

Applicant's reliance on In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990) (because the common element K+ in the respective marks was highly suggestive if not descriptive of the goods, no likely confusion found) and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (marks at issue are not similar for purposes of likely confusion where common element BED & BREAKFAST is descriptive and weak) is

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misplaced. In Electrolyte Laboratories and Bed & Breakfast the common elements were highly suggestive, descriptive and/or weak whereas, here, FRENZ and FRIENDS are arbitrary marks for computer games. Applicant also cites to Spice Islands, Inc. v. The Frank Tea & Spice Co., 505 F.2d 1293, 184 USPQ 35, 37 (CCPA 1974) (overall commercial impression weighs in favor of similarity of marks despite descriptive nature of common element SPICE) presumably in reliance on the statement that "[a]rguments to the effect that one portion of a mark possesses no trademark significance leading to direct comparison between only what remains is an erroneous approach." However, we have viewed the marks in their entirety and find that for some consumers the additional wording in applicant's mark would not change the connotation of the word FRIENDS such as to distinguish it from its phonetic equivalent in registrant's mark and for those familiar with the television series reverse confusion is a valid concern.

In view of the above, we find the marks to be similar when compared in their entirety in terms of appearance, sound, connotation and commercial impression, and the factor of the similarity of the marks thus weighs in favor of a likelihood of confusion. See RE/MAX of America, Inc.

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v. Realty Mart, Inc., 207 USPQ 960, 964 (TTAB 1980)
(similarity in sound sufficient for likely confusion).

With regard to the relatedness of the goods and services, applicant argues that:

Although, the respective products of the parties may be viewed as legally related goods, it is respectfully submitted that, as Applicant's FRIENDS: THE ONE WITH ALL THE TRIVIA mark is dissimilar from the prior Registrant's FRENZ trademark and will be used with computer products all related to the FRIENDS television series, it is highly unlikely that confusion will arise as to the source of the respective computer products of the parties.

Br. p. 12.

In support of the argument that the goods and services are related, the examining attorney argues that since, despite the limiting language in applicant's identification of goods, "the identifications of the registrant's goods and services is very broad, it is presumed that the registration encompasses all goods and services of the type described, including those in the applicant's more specific identification." In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). Br. p. 10.

As the examining attorney correctly states, in making our determination, we must consider the cited registrant's and applicant's goods as they are described in the registration and application, and we cannot read

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limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Thus, applicant's evidence of registrant's actual use of the mark depicting registrant's computer games is unpersuasive. We must make our determination based on the goods as identified and such identification may not be limited by extrinsic evidence. In *re Bercut-Vandervoort & Co.*, 229 USPQ 763, 765 (TTAB 1986) (case must be decided based on the marks as applied to the goods identified in the application and the registration, rather than on "what extrinsic evidence shows those goods to be.") Thus, as identified, registrant's computer games (both online and off the shelf) are not restricted by subject matter in any manner and, therefore, encompass trivia games based on television sitcoms.

In view of the above, the goods are related and this factor accordingly weighs in favor of a likelihood of confusion.

Finally, inasmuch as there are no limitations in registrant's identification of goods and services, we must presume that registrant's goods and services will be offered in some of the same channels of trade and will be

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used by some of the same purchasers as applicant's goods. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In conclusion, we find that because the marks are similar, the goods and services are related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark and the mark in the cited registration. To the extent there are any doubts, we resolve them, as we must, in favor of the registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to applicant's "CD ROM computer game discs; game equipment sold as a unit for playing a parlor-type computer game namely video output game machines for use with televisions and computer game software; video and computer game programs; video game cartridges and cassettes" and the application will proceed to publication as to the remaining goods.