

5/29/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 14  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

E. Rothenberg and J. Zempel

v.

Eric Beckman

Opposition No. 115,326  
to application Serial No. 75/555,333  
filed on September 18, 1998

J. Allison Strickland of Fross Zelnick Lehrman & Zissu, P.C.  
for E. Rothenberg and J. Zempel.

John Pelosi of Pelosi & Wolf, LLP for Eric Beckman.

Before Chapman, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 18, 1998, Eric Beckman (an individual)  
filed an application to register the mark GUERRILLA KIDS on  
the Principal Register for services identified, as amended,  
as "organizing exhibitions for children for cultural and  
entertainment purposes" in International Class 41.<sup>1</sup>

<sup>1</sup> Application Serial No. 75/555,333, filed September 18, 1998,  
based on applicant's claimed dates of first use and first use in  
commerce of October 1, 1997. Applicant disclaimed the term

**Opposition No. 115326**

E. Rothenberg and J. Zempel (individuals and co-owners) have opposed registration of the mark alleging that opposers have continuously used the mark GUERRILLA GIRLS since at least as early as 1985 to identify their "educational and entertainment services designed to promote public awareness of the need to combat sexism, racism and discrimination in the arts" (notice of opposition, paragraph 3); that opposers applied to register the mark GUERRILLA GIRLS for "'posters; postcards; greeting cards; stickers; series of books and newsletters on a wide variety of topics relating to art, feminism, sexism and racism, and social activism' in Class 16; 'civil rights education and activism offered via lectures, public appearances, radio performances and television performances; creation and distribution of printed material and publications on a wide variety of topics related to civil rights and social activism' in Class 41; and 'providing information on a wide variety of topics related to art, civil rights, feminism, sexism, racism, discrimination, and social activism by means of a global

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"KIDS." [The application, as originally filed, included a disclaimer stated as follows: "Applicant hereby disclaims any trademark in the use of the individual words 'Guerrilla' or 'Kids' independently or out of the context of 'Guerrilla Kids.'" In an Examiner's Amendment, the Examining Attorney set forth, and applicant accepted, a disclaimer of the word "KIDS."]

**Opposition No. 115326**

computer network; promoting public awareness of the need to combat sexism, racism and discrimination' in Class 42"<sup>2</sup>; and that applicant's mark, when used in connection with his services, so resembles opposers' previously used trademark and service mark, GUERRILLA GIRLS, as to be likely to cause confusion, mistake, or deception.

In his answer, applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; the affidavit testimony, with exhibits, of E. Rothenberg<sup>3</sup>; the affidavit testimony, with exhibits, of Eric Beckman<sup>4</sup>; notices of reliance filed by opposers and by applicant; and the supplemental affidavit testimony of E. Rothenberg. Both parties filed briefs on the case<sup>5</sup>. An oral hearing was not requested.

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<sup>2</sup> Application Serial No. 75/509,071, filed June 28, 1998, with claimed dates of first use for each class of goods and services of 1985.

<sup>3</sup> In the stipulation regarding the affidavit testimony, opposers' attorneys referred to the telephone consent of applicant's attorney. The affidavit testimony of both parties is accepted. However, the parties' attorneys should note that Trademark Rule 2.123(b) now requires that such agreements be in writing, i.e., signed by both parties' attorneys.

<sup>4</sup> In applicant's affidavit of Eric Beckman, there are several references to opposers' "Zempel Affidavit." Applicant is advised that the affidavit testimony submitted on opposers' behalf was that of E. Rothenberg.

<sup>5</sup> Applicant's brief was not double-spaced as required by Trademark Rule 2.128(b). Because the brief was 10 single-spaced pages and the page limit for a brief on the case is 55 pages, we have considered applicant's brief. Nonetheless, it is strongly suggested that applicant's counsel file papers which comply with the Board rules on proper format.

Also, applicant's brief did not include a certificate of service of a copy thereof on counsel for opposers as required by

**Opposition No. 115326**

Preliminarily, we will address opposer's contention (brief, page 16) that portions of applicant's evidence are inadmissible and must be disregarded. Specifically, opposer contends that "much" of Eric Beckman's affidavit is irrelevant (e.g., paragraph 2), and thus is inadmissible under Fed. R. Evid. 401 and 402; that the Beckman affidavit is "rife" with opinion and argument (e.g., paragraphs 4-6, 8, 9), and thus is inadmissible under Fed. R. Evid. 602 and 701; and that Exhibit 1 to the Beckman affidavit is inadmissible because it is a two-page listing showing the catalog information on two books from the Library of Congress' on-line catalog, but it does not include copies of the actual books as required by Trademark Rule 2.122(e).

We have carefully reviewed the rather sparse record in this case, and we are of the opinion that in order to conduct a full and fair review to arrive at a just determination of the registrability issue before us, we should not exclude either paragraphs 2, 4-6, 8 and 9 of applicant's (Beckman) affidavit testimony, or Exhibit 1 thereto. Therefore, opposers' objections are overruled, and we have read and considered applicant's affidavit, including Exhibit 1.

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Trademark Rule 2.119(c). It is apparent that opposers received or otherwise obtained a copy of applicant's brief because opposers filed a reply brief. Thus, we have considered applicant's brief. However, applicant's attorney is warned that

**Opposition No. 115326**

Second, in their reply brief, opposers argued that certain portions of applicant's brief are "based on inadmissible evidence [and] should be disregarded." As explained above, we have declined to strike any evidence. However, the Board in general will consider a party's objections to the brief, and any improper portion(s) of a brief will be disregarded. See TBMP §540.

Opposers' objections to the evidence have been overruled, but we hasten to add that the Board has considered the evidence only for appropriate purposes, and for whatever probative value, if any, it may have.

E. Rothenberg and J. Zempel are members of the Guerrilla Girls, and they co-own trademark registrations for the mark GUERRILLA GIRLS. Opposers' group, the Guerrilla Girls, is a collective of women artists, writers, performers, film makers and arts professionals who fight discrimination, and promote recognition of women and minority artists through books, posters, public appearances and other activities. The members of the group wish to remain anonymous and wear gorilla masks when they appear in public.

The Guerrilla Girls are best known for their posters promoting women artists, which they began plastering on walls, fences and kiosks in New York City in 1985. The

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any further papers filed herein must include a certificate of

**Opposition No. 115326**

group is now a nationwide presence through not only their posters and public appearances, but also through their website, as well as the sale of their two published books, Confessions of the Guerrilla Girls and The Guerrilla Girls' Bedside Companion to the History of Western Art. There has been continuous use of the mark GUERRILLA GIRLS since 1985 on a range of goods, such as, books and posters, and in connection with civil rights education and activism.

According to the affidavit of E. Rothenberg, opposers direct their activities at a wide audience including children and teenagers; members of the Guerrilla Girls have appeared and spoken at high schools and children's events across the country; they have also appeared on the Oxygen cable television network on the show "Trackers," which is targeted to 12-18 year olds; they often receive e-mails from teenage children; and the book The Guerrilla Girls' Bedside Companion to the History of Western Art is used as a textbook in numerous high school and college art classes.

Applicant is an individual with an office located in New York City. He markets and produces events for children which include and/or emphasize film and the visual arts; and he has been affiliated with Nickelodeon, Kodak, Time Warner, MGM, Old Navy, The New York Times, and others in connection with the sponsorship and promotion of children's events.

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service of a copy thereof on counsel for opposers.

**Opposition No. 115326**

Specifically, Eric Beckman has marketed and promoted The New York International Children's Film Festival for the immediate past three years from 1998-2000, with about 10,000 people attending the last festival.

Because opposers now own valid and subsisting registrations of their pleaded mark<sup>6</sup>, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Moreover, the evidence clearly proves that opposers used their involved mark long prior to the filing date of applicant's involved application.

We turn then to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA

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<sup>6</sup> Opposers originally pled ownership of one pending federal application (Serial No. 75/509,071), which ultimately issued as Registration No. 2,315,715 for the mark GUERRILLA GIRLS for goods and services in International Classes 16, 41 and 42. During their testimony period, opposers submitted a notice of reliance on a current status and title copy of that registration. Thus, applicant was on notice that opposers claimed rights therein.

Opposers also submitted in its notice of reliance a status and title copy of a second registration, Registration No. 2,349,089, issued May 9, 2000 for the mark GUERRILLA GIRLS for "t-shirts and shirts" in International Class 25. (The claimed date of first use is October 5, 1995.)

While opposers did not move to amend their pleading, to whatever extent it is necessary, we consider the pleading amended to conform to the evidence under Fed. R. Civ. P. 15(b). Therefore,

**Opposition No. 115326**

1973). The factors deemed pertinent in this proceeding now before us are discussed below.

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opposers' Registration Nos. 2,315,715 and 2,349,089 are considered of record herein.

**Opposition No. 115326**

Turning first to a consideration of the involved goods and services, the Board is constrained to compare the services as identified in applicant's application with the services as identified in opposers' registrations<sup>7</sup>. If an opposer's services (or goods) and an applicant's services (or goods) are described so as to encompass or overlap, then an applicant cannot properly argue that, in reality, the parties' actual services (or goods) are not similar. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

In addition, it is well settled that services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to a mistaken belief that they

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<sup>7</sup> Opposers' registrations include goods in Classes 16 and 25, and opposers clearly market numerous posters and books. However, because the affidavit evidence and the briefs on the case generally focus on the services offered by opposers vis-a-vis the services offered by applicant, we have done the same.

**Opposition No. 115326**

originate from or are in some way associated with the same producer or that there is an association between the producers of the services. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Applicant's services are identified as "organizing exhibitions for children for cultural and entertainment purposes" (in International Class 41). With respect to opposers' registered mark, GUERRILLA GIRLS, the services are identified as "civil rights education and activism offered via lectures, public appearances, radio performances and television performances; creation and distribution of printed material and publications on a wide variety of topics related to civil rights and social activism" (in Class 41), and "providing information on a wide variety of topics related to art, civil rights, feminism, sexism, racism, discrimination, and social activism by means of a global computer network; promoting public awareness of the need to combat sexism, racism and discrimination" (in International Class 42).

Applicant's identification of services specifies cultural purposes. Opposers' identified services include the arts, which would be encompassed within the broad category of "cultural" purposes. In addition, applicant's services are identified as organizing "exhibitions," with no

**Opposition No. 115326**

limitations thereon. Thus, opposers' lectures, and television performances would be encompassed as types of exhibitions. We find that applicant's services, as set forth in his involved application, is a broad description and it encompasses the services set forth in opposers' registration. Accordingly, the parties' respective services, as identified, are at least in part overlapping, and otherwise closely related.<sup>8</sup>

Regarding the trade channels, applicant argues that the services of the parties are promoted and delivered in very different manners, with opposers promoting a civil rights/feminist agenda by appearing anonymously wearing gorilla masks in public, whereas applicant promotes children's films and other media through "'mainstream' affiliations" (Beckman affidavit, paragraph 8) such as Nickelodeon and HBO Family. However, this is not persuasive because there are no limitations in either applicant's or opposers' recitations of services as to purchasers or channels of trade.<sup>9</sup> Moreover, there is evidence that both parties' events are

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<sup>8</sup> We note that applicant's "mission" statement appearing in the website for the 1999 New York International Children's Film Festival reads, in part, as follows: "To give educators tools for exploring world culture, social issues, and the media in their classrooms."

<sup>9</sup> Applicant's affidavit testimony (as well as arguments in his brief) appears to be directed to showing that consumers can distinguish between these services. However, the question is not whether the consumers are likely to confuse the services, but whether they are likely to confuse the source of the services. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

**Opposition No. 115326**

publicized in the same media, for example, "The New York Times."

Applicant argues that opposers' products and services are directed to adults, whereas applicant's services are directed to children. While applicant's services are specifically identified as being "for children," there is no such restriction in opposers' registrations. Thus, opposers' services would include all potential audiences, including children. Moreover, the record shows that opposers, in fact, appear on television shows directed to 12-18 year olds, and make appearances in high schools across the country. Perhaps more to the point is the fact that, at least with regard to younger children, the actual audiences for both parties' services will include adults because young children would not attend without a parent or other adult, or, at the very least, the subject matter of the exhibition would be monitored by the parent or other adult. As identified, and based on the evidence of record, we find that both parties would offer their services to the same classes of purchasers.

Turning then to a consideration of the marks, opposers' mark GUERRILLA GIRLS, and applicant's mark GUERRILLA KIDS, both include the word GUERRILLA, which is an arbitrary term

**Opposition No. 115326**

in relation to the involved goods and services.<sup>10</sup> The Random House Webster's Unabridged Dictionary (2d. ed. 1998) defines "guerrilla" as "n. 1. a member of a band of irregular soldiers that use guerrilla warfare, harassing the enemy by surprise raids, sabotaging communication and supply lines, etc. -adj. 2. pertaining to such fighters or their technique of warfare: guerrilla strongholds; guerrilla tactics." The term "KIDS," being a slang term for children<sup>11</sup>, encompasses both "boys" and "girls."

When considered as a whole applicant's mark, GUERRILLA KIDS, looks and sounds similar to opposers' mark, GUERRILLA GIRLS. Further, the connotation of both marks is essentially the same. Opposers' mark connotes a "band of irregular soldiers" who are girls, while applicant's mark connotes the same "band of irregular soldiers" but involving both boys and girls.

Applicant's argument that the parties' respective marks were derived based on different reasons<sup>12</sup> does not alter the

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<sup>10</sup> Applicant requested (page 4 of his brief) that the Board take judicial notice "that the definition and common use of the word Guerrilla is a matter of common knowledge." Applicant did not submit a dictionary definition. We grant the request as to judicial notice of the definition of the word, "guerrilla." (The specific definition judicially noticed by the Board is set forth above). However, we deny applicant's request that the Board take judicial notice of "common use" of the term. See TBMP §712.

<sup>11</sup> The Random House Webster's Unabridged Dictionary (2d. ed. 1998) defines "kid" as "n. 1. Informal. a child or young person." See TBMP §712.

<sup>12</sup> In answering applicant's interrogatory regarding why opposers adopted their mark, opposers stated that it was to "reclaim the word 'girl' for women and to suggest guerrilla warfare, in the

**Opposition No. 115326**

fact that the respective marks are similar in sound, appearance and connotation, thereby creating a similar commercial impression to the consuming public (who would, of course, not be aware of the background of why each side adopted their respective mark).

Consumers may assume that applicant's mark GUERRILLA KIDS is simply a variant of opposers' mark GUERRILLA GIRLS, used to identify another of opposers' services (perhaps a less political version of opposers' services, targeted to younger children), and would assume that applicant's services come from or are in some way associated with opposers.

Another du Pont factor we consider in this case is the strength/fame of opposers' mark. Opposers have established that they have a "strong" mark because their mark is arbitrary in relation to opposers' goods and services, and they have used the mark for the involved services continuously since 1985, and there is adequate evidence of media coverage. While we do not find on the record before us that opposers' mark is famous<sup>13</sup>, nonetheless opposers'

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context that the Guerrilla Girls strike anonymously, and with surprise." (The concept of using gorilla masks was adopted later.) (footnote continued)

In answering opposers' interrogatory regarding why applicant adopted his mark, applicant stated that the mark was chosen to "combine the two concepts of 'Guerrilla Cinema' and 'Guerrilla Marketing' with our target audience of children, or 'kids.'"

<sup>13</sup> This is because opposers did not provide sales, advertising, or attendance figures, or place any such figures in context. Also, opposers provided no direct consumer evidence of recognition of

**Opposition No. 115326**

strong mark is entitled to a full scope of protection. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154, 1161 (TTAB 1987).

Applicant's statement in his affidavit (and later argued in his brief on the case) regarding 28 third-party registrations which include the word "guerrilla" in combination with other terms is to no avail. First, applicant did not submit any copies of third-party registrations into the record during trial (i.e., as an exhibit to his affidavit)<sup>14</sup>. See TBMP §703.02(b). Thus, there is no information as to ownership, the goods/services, or the circumstances of registration [e.g., which register the marks are on, if they registered with disclaimers or under Section 2(f)]. Second, even if applicant had properly introduced third-party registrations into the record (which he did not), such registrations would be of little weight in determining likelihood of confusion as they are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed

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the mark. Inasmuch as we are left to speculate not only as to the sales, advertising, or attendance numbers; we are also left to speculate as to the actual impact of opposers' mark on the minds of consumers. See *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1457 (TTAB 1998); and *General Mills Inc. v. Heath Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992).

<sup>14</sup> The Board does not take judicial notice of registrations in the USPTO. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

**Opposition No. 115326**

to the existence of similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *Conde Nast Publications, Inc. v. American Greetings Corp.*, 329 F.2d 1012, 141 USPQ 249 (CCPA 1964); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The record shows that there have been no known instances of actual confusion in about four years of co-existence. However, applicant's film festival is a once-a-year event. Further, opposers' services are offered free, and applicant does not directly require the consumer to purchase his services (organizing exhibitions for children). Rather, applicant charges a fee to attend a film event, generally around \$5-\$10. In these circumstances it is less likely that consumers will complain about the respective services. As a result, neither applicant nor opposers are likely to receive telephone calls or letters from consumers regarding instances of actual confusion. In any event, the test is likelihood of confusion, not actual confusion. See *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

We agree with applicant that there is no evidence of applicant's intent to cause confusion in this case. Nonetheless, this factor is of little weight in this case because, as stated by the Court of Appeals for the Federal Circuit (our primary reviewing court), in *J & J Snack Foods*

**Opposition No. 115326**

Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991): "Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion. (citation omitted)."

As the newcomer, applicant has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

On balance, and considering all of the evidence on the relevant du Pont factors, we find that confusion is likely between applicant's mark GUERRILLA KIDS and opposers' mark GUERRILLA GIRLS, when used on their respective services, as identified.

**Decision:** The opposition is sustained, and registration to applicant is refused.