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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

LeRoux Entertainment Corporation of America
v.
The Army and Air Force Exchange Service

Opposition No. 91165813

Mitchell G. Weatherly of Weatherly Kerven & Seigel LLC for
LeRoux Entertainment Corporation of America.

W. Barry Huggins, Esq. for The Army and Air Force Exchange
Service.

Before Bucher, Drost, and Mermelstein, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July, 11, 2005, LeRoux Entertainment Corporation of
America (opposer) filed an opposition to the registration of
applicant's (The Army and Air Force Exchange Service) mark
GIFTS GALORE (standard character drawing) for services
ultimately amended to read: "retail gift item and souvenir
shops operating on military installations and selling to
authorized patrons" in Class 35. Serial No. 78392529
("Gifts" disclaimed). The application is based on
applicant's allegation of a bona fide intention to use the
mark in commerce.

Opposer relies on its ownership of the mark GIFTS GALORE (in typed or standard character form), "Gifts" disclaimed, for the following services in Class 35:

retail catalog services featuring gift items sold primarily to elementary schools for use in their holiday gift program in the school fundraising industry, namely, costume jewelry, calculators, picture frames, novelties, toys, prizes, statues, bird feeders, coffee mugs, globes, plush animals, tools, housewares, candles, candle holders, glassware, keychains, stationery, figurines, cups, straws, plaques, magnets, compasses, electronics, games, balls, nautical products, hats, gloves, ties, vases, flowers, thermometers [sic], rain gauges, glasses, sunglasses, music boxes, lamps, jewelry boxes, snow globes, cosmetics, cosmetic accessories, pet toys, ornaments, pencil sharpeners, pens, pencils, memo pads, diaries, binoculars, umbrellas, flashlights, tape measurers, baby teethingers [sic], baby rattles, baby bibs, baby utensils, baby bowls, baby cups, musical instruments, bags, purses, wallets, candy, banks, hair accessories, rings, necklaces, pendants, bracelets, pins, anklets, dolls, clocks, watches, chimes, wind chimes, birdhouses, plush toys, stuffed animals, stuffed toys, action figures, basketballs, baseballs, soccer balls, bats, volleyballs, four square balls, kick balls, decorations, party supplies, birthday party supplies, party favors, balloons, hats, caps, baseball caps, costumes, masks, perfume, glitter, hairspray, makeup, fingernail polish, tatoos [sic], jewelry, toy jewelry, remote controlled toys, laser lights, lava lamps, oil lamps, water lamps, stoplight toys, mirror balls, disco balls, laser pointers, lighted keychains, keyboards.

The registration (No. 3009319) issued October 25, 2005, and it alleges a date of first use anywhere and in commerce of May 1982. In its notice of opposition (p. 2), opposer referred to the pending application for its GIFTS GALORE mark and also alleges that it "first used its GIFTS GALORE mark in commerce prior to the Defendant's filing date." Applicant has denied most of the allegations of opposer's

notice of opposition although it admitted that opposer "has such a registration [or at that time, an application]."

Answer, ¶ 1.

The Record

The record consists of the file of the opposition; opposer's notice of reliance on a status and title copy of its registration; and the stipulated declaration in lieu of testimony of Robert J. LeRoux, opposer's Chief Executive Officer.

Priority

Priority is not an issue in the opposition proceeding because opposer is relying on its registration for the mark GIFTS GALORE. See *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

The next question is whether there is a likelihood of confusion. In these cases, we analyze the facts as they relate to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin by looking at the parties' marks. In this case, the marks are identical in all respects, GIFTS GALORE.

When the parties' marks are identical, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *Amcors, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Next, we look at the parties' services. Applicant's services are retail gift item and souvenir shops operating on military installations and selling to authorized patrons. Opposer also has retail services in the field of gift services ("retail catalog services featuring gift items sold primarily to elementary schools for use in their holiday gift program in the school fundraising industry..."). We must consider the services as they are identified in the identification of services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods,

the particular channels of trade or the class of purchasers to which the sales of goods are directed").

While opposer argues (Brief at 7) that an applicant cannot avoid a likelihood of confusion by narrowing its identification of services when the registration has a "broad identification" of services, we do not find that opposer's identification of services is broad. Clearly, its services are limited to the very specific services of "retail catalog services featuring gift items sold primarily to elementary schools for use in their holiday gift program in the school fundraising." Therefore, we must determine whether these specific retail catalog services are related to retail gift stores operating on military installations and selling only to authorized personnel.

In order to be related, goods or services do not have to overlap. It "has often been said 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 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 thereon, 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, 1388 (TTAB 1991). See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

Opposer's Chief Executive Officer has submitted a declaration in lieu of testimony (¶ 3) that shows it "has advertised and sold 'its retail catalog services featuring gift items' under the GIFTS GALORE mark to schools on U.S. military bases for over twenty years" including:

- Holloman AFB [Air Force Base], New Mexico
- White Sands Missile Range, New Mexico
- Tyndall AFB, Florida
- Fort Riley, Kansas
- Robbins AFB, Georgia
- Travis AFB, California
- Eglin AFB, Florida
- Vandenberg AFB, California
- Pope AFB, North Carolina

Applicant "does not dispute that a few of the larger or more remote installations have an elementary or middle school within their boundaries." Brief at 6. However, applicant does argue:

These schools are located as they are, under individual memoranda of agreements with the installations, due to logistical difficulties of transporting large number of children long distances off an installation.

More importantly, neither these schools, nor employees of these schools, have any ability to shop at Applicant's stores, particularly for fundraising purposes, for either one or two reasons. One, no business or local government entity can be an authorized patron... And two, even if there were an employee at one of the ten schools who was also a military dependent (and therefore eligible to shop at

Applicant's stores), such an individual could purchase only in such amounts consistent with personal needs.

Brief at 6-7.

We point out that opposer does not have to show that schools will purchase from applicant before there can be confusion. If those familiar with opposer's service mark will also encounter applicant's service mark, there is opportunity for confusion. *See, e.g., Shell Oil*, 26 USPQ2d at 1689 ("[D]istributorship services in the field of automotive parts" related to service station oil change and lubrication services). Here, both applicant and opposer have retail gift-type services. Applicant's services involve retail gift item shops and opposer's services are "retail catalog services." Opposer specifies a large number of items that its catalog services sell. Applicant's gift shops can sell similar items. Goods or services can be related if potential customers will believe that there is a common source for the services. *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989) ("It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources"). *See also In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001). If the same purchasers encounter applicant's and opposer's services with the identical marks they are likely to believe that the

sources of the gift item services are in some way related or associated.

Therefore, the next question is whether customers are likely to encounter these same services. At this point, we note that opposer has shown that it markets its services at schools that are actually on military installations. Furthermore, to the extent that authorized patrons of applicant's shops have children in schools that are not on military installations, there are other purchasers who could encounter opposer's and applicant's services. Parents and school employees who are involved with fundraising activities and who also have access to shops on military installations are likely to encounter both marks used in association with applicant's and opposer's identified services. Inasmuch as the marks are used on gift-related services, even as limited by applicant and opposer, these purchasers are likely to believe that these services are related. Furthermore, there is no evidence that would indicate that these purchasers would exercise great care in using applicant's services. Also, many of those encountering opposer's services would likewise not be particularly careful and sophisticated purchasers.

When we consider the record in this case, we start with the fact that the marks are identical. While the term GIFTS GALORE for gift-related services is not arbitrary, there is

no evidence that the mark is weak and entitled to only a narrow scope of protection. As we noted previously, when marks are identical, the services do not need to be as closely related before there is confusion. Applicant's and opposer's services both involve gift-related services that could be encountered by the same purchasers. Under these circumstances, we must resolve any doubts we have about confusion in favor of opposer/registrant, which we do, and we hold that there is a likelihood of confusion. *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1948 (Fed. Cir. 2004) and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The opposition is sustained.