

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KidVid, Inc. : BEFORE THE
Trademark: A LITTLE GENIUS IN THE : TRADEMARK TRIAL
MAKING
Serial No: 75710402 : AND
Attorney: Lee B. Beitchman : APPEAL BOARD
Address: 215 14th Street, NW : ON APPEAL
Atlanta, Georgia 30318

OCT 18 2002

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the trademark ... A LITTLE GENIUS IN THE MAKING for a "series of audio and video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children." Registration was refused on the Principal Register pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) on the grounds that applicant's mark ... A LITTLE GENIUS IN THE MAKING is likely to be confused with the prior registered mark: U.S. Registration No. 2372130, LITTLE GENIUS for "musical sound recordings and musical video recordings" and "children's books, baby books, children's activity books, calendars, sheet music, song books, picture books, decals, bumper stickers, paper cake decorations, greeting cards, flash cards, playing cards, trading cards, disposable diapers, children's

encyclopedias, printed teaching materials for teaching youth development skills, life skills, and problem solving, stickers, temporary tattoos, and wrapping paper.”

FACTS

On June 16, 1999 the applicant, KidVid, Inc., (hereinafter referred to as applicant), filed application Serial No. 75710402 to register ...A LITTLE GENIUS IN THE MAKING on the Principal Register for “series of audio and video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children.” On December 1, 1999, the examining attorney issued an Office Action in which she cited prior pending applications 75566818 and 75566833. On July 6th, 2002, the application was suspended pending the disposition of these prior marks. The prior marks both proceeded to registration on April 25, 2002, and August 1, 2000, respectively. On March 14, 2002, registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because applicant’s mark, when used in connection with the above identified goods, was found likely to cause confusion with the registered mark in U.S. Registration Nos. 2372130 and 2344760. On March 26, 2001, the applicant responded to the Office Action and presented arguments in an effort to overcome the Section 2(d) refusal. On June 6, 2001, the examining attorney made **FINAL** the refusal to register based upon section 2(d) based only upon prior registration number 2372130 and withdrew the refusal based upon

registration number 2344760. On December 7, 2001, the applicant submitted a notice of appeal, and filed its appeal brief on August 22, 2002. The application was forwarded to the examining attorney on August 22, 2002.

ISSUE

The sole issue on appeal is whether the applicant's mark, ...ALITTLE GENIUS IN THE MAKING, is confusingly similar to LITTLE GENIUS, U.S. Registration No. 2372130 thus creating a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act.

ARGUMENTS

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods, to cause confusion, or to cause mistake or to deceive. TMEP section 1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods. When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). The overriding concern is to prevent buyer confusion as to the source of the goods. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

I. THE APPLICANT'S MARK IS HIGHLY SIMILAR TO THE REGISTERED MARK

Turning first to consideration of the marks here at issue, the examining attorney submits that the applicant's mark is highly similar to the registered mark. Applicant's mark is ...A LITTLE GENIUS IN THE MAKING. The registered mark is LITTLE GENIUS.

The mere addition or deletion of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"). Strictly viewed, the applicant has adopted the identical terms LITTLE GENIUS from the registered mark creating a likelihood of confusion between the marks.

A. APPLICANT'S ARGUMENTS

The applicant has argued that the applicant's mark and the cited registered mark do not have a similar appearance and that the addition of the terms A and IN THE MAKING to the mark are sufficient to overcome any likelihood of confusion between the

marks. The applicant also claims that the mark LITTLE GENIUS is suggestive of the goods and therefore is entitled to very narrow protection. The applicant also argues that since the terms LITTLE and GENIUS appear many times on the register, that the marks are weak and are entitled to little protection.

The applicant has provided copies of registrations showing the common usage of the terms LITTLE and GENIUS in various other marks. However, third party registrations are entitled to little weight on the question of likelihood of confusion when considered by themselves. The examples that the applicant has provided simply show that these terms are used independently for many various types of trademarks for other goods. The examples shown are not limited to the goods at hand but run the gamut of goods and services. The issue is not whether the terms LITTLE and GENIUS are commonly used separately in other registrations but whether the combination of the terms LITTLE GENIUS used together for "musical sound recordings and musical video recordings" and "children's books, baby books, children's activity books, calendars, sheet music, song books, picture books, decals, bumper stickers, paper cake decorations, greeting cards, flash cards, playing cards, trading cards, disposable diapers, children's encyclopedias, printed teaching materials for teaching youth development skills, life skills, and problem solving, stickers, temporary tattoos, and wrapping paper." are likely to be confused with ... A LITTLE GENIUS IN THE MAKING for "series of audio and video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and

children.” The examining attorney believes that although the terms independently may be commonly used for various other goods, that the combined terms LITTLE GENIUS create a distinctive impression and that there is a likelihood that consumers would be confused despite the addition of the less significant terms “A” and “IN THE MAKING” to the mark.

The Board has held that “one may not take the trademark of another and by adding subordinate or descriptive matter to it, avoid a likelihood of confusion.” *In re South Bend Toy Manufacturing Company, Inc.* 218 USPQ 479 (TTAB 1983). In that case, the mark LIL LADY BUGGY for toy doll carriages was held to be confusingly similar to LITTLE LADY for dolls and doll clothing. The Board held that the applicant had essentially adopted the registered mark and added a descriptive term and that the use of a contraction did not create a difference enough to obviate a likelihood of confusion. The Board further stated that “decisions involving marks with identical initial terms to which a separate suffix term has been added by the junior user have found likelihood of confusion.” (*See In Re South Bend Toy Manufacturing Company, Inc.* at p. 3). In the present case, the applicant has clearly added subordinate matter to a registered mark and has simply added it to the end of the mark. The term A has little or no trademark significance. The terms “IN THE MAKING” comprise subordinate matter since the dominant portion of the marks are the terms LITTLE GENIUS. These terms add little to the mark and consumers are likely to remember the terms “LITTLE GENIUS” when calling for the goods. It would be absurd to assume that consumers would identify the terms IN THE MAKING as the source of the goods or as the dominant portion of the mark. Since the addition of terms to a registered mark, especially descriptive or

subordinate terms, do not overcome a likelihood of confusion, the applicant's mark is confusingly similar.

Since the marks contain the combined identical terms LITTLE GENIUS, consumers are likely to believe that the goods come from the same source despite the addition of the subordinate wording "A" and "IN THE MAKING" by the applicant. As a result, the marks are confusingly similar.

II. THE GOODS AND TRADE CHANNELS ARE EXTREMELY SIMILAR

The applicant's goods are "series of audio and video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing musical recordings, narratives, instruction on the functionality of various objects, phonics and scenes depicting infants and children at play, for developing and improving the creative and intellectual faculties and brain development of infants and children." The registrant is providing "musical sound recordings and musical video recordings" and "children's books, baby books, children's activity books, calendars, sheet music, song books, picture books, decals, bumper stickers, paper cake decorations, greeting cards, flash cards, playing cards, trading cards, disposable diapers, children's encyclopedias, printed teaching materials for teaching youth development skills, life skills, and problem solving, stickers, temporary tattoos, and wrapping paper." The applicant and registrant are both providing musical sound recordings. Although the applicant has limited their musical sound recordings to recordings that are for the development of children's intellects, the registrant has not limited their goods to any topic area and therefore the sound recordings could include identical material. Furthermore, the registrant's musical recordings could also be for

improving intellectual development. It is common for parents to buy musical recordings for their children for the purpose of stimulating brain function. Since these items are identical, the goods are likely to be sold in the same stores and move in the same channels of trade. Therefore, there is a likelihood that consumers would be confused as to the source of the goods.

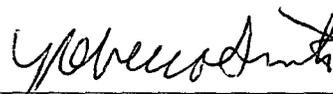
The remainder of the applicant's goods which are compact discs, cassettes, and videotapes containing narratives and instruction for improving learning and brain development are also very related to the registrant's goods. Children's books, activity books, baby books, and printed teaching materials for teaching youth life development are also learning materials that are designed to help children develop various skills. Many baby and children's books and activity books are designed to improve brain functioning by stimulating verbal and visual skills. The fact that the goods are in print and not on pre-recorded cassettes, compact discs, and videotapes is secondary since the materials could include the same topics and are for the same purpose. Additionally, these types of goods are very likely to be sold in the same stores and move in the same channels of trade.

Finally, it is well settled that the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

SUMMARY

In summary, the applicant's mark has a highly similar commercial impression to the cited registered mark. Further, the goods at issue are identical to each other and are found in the same trade channels. Because consumers would mistakenly believe that the goods of the applicant and the registrant emanated from a common source, there is a likelihood of confusion as to the source of the goods. The refusal to register the mark pursuant to Section 2(d) of the Trademark Act should therefore be affirmed.

Respectfully submitted,



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MARK	
... A LITTLE GENIUS IN THE MAKING.	
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	MAILING DATE
	10/18/02
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FORM PTO-1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE