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PRECEDENT OF THE TTAB

Mailed: November 8, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Twentieth Century Fox Film Corp.
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Serial No. 77824292
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Jamie E. Platkin, Michelle P. Ciotola, and Curt Krechevsky of Cantor Colburn LLP for Twentieth Century Fox Film Corp.

Naakwama S. Ankrah, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).
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Before Cataldo, Wolfson, and Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Twentieth Century Fox Film Corp. (applicant) filed an application to register the mark PANDORAPEDIA for, as amended, “shirts; pants; shorts; underwear; boxer shorts; hats; caps; sweatshirts; sweaters; skirts; gloves; socks; shoes; boots; coats; jackets; swimwear; belts; scarves; pajamas; slippers; infant wear; hosiery; Halloween and masquerade costumes and masks sold in connection therewith; all of the foregoing related to motion picture films.”¹ Registration has been refused

¹ Application Serial No. 77824292, filed September 10, 2009, pursuant to Section 1(b) of the Trademark Act (intent-to-use).

pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the registered mark PANDORA for "men's[,] women's and children's sportswear, namely, sweaters, swimwear, pants, shorts, shirts, blouses, skirts, jumpers, blazers, jackets, culottes, dresses, cotton knit tops, shifts, swimsuits, and swim suit cover-ups"² that, when used in connection with applicant's identified goods, it is likely to cause confusion or mistake or to deceive prospective purchasers. The examining attorney issued a final refusal of registration, which applicant has appealed.

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 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the *du Pont* factor of the similarity or dissimilarity of the goods. Applicant's goods are identified as "shirts; pants; shorts; underwear; boxer shorts; hats; caps; sweatshirts; sweaters; skirts; gloves; socks; shoes; boots; coats; jackets; swimwear; belts; scarves; pajamas; slippers; infant wear; hosiery; Halloween and

² Registration No. 2827439, issued March 30, 2004, Section 8 Affidavit accepted and Section 15 Affidavit acknowledged.

masquerade costumes and masks sold in connection therewith; all of the foregoing related to motion picture films” and the goods in the cited registration are identified as “men’s[,] women’s and children’s sportswear, namely, sweaters, swimwear, pants, shorts, shirts, blouses, skirts, jumpers, blazers, jackets, culottes, dresses, cotton knit tops, shifts, swimsuits, and swim suit cover-ups.” Applicant acknowledges that “its [a]pplication covers some of the same goods as [r]egistrant’s [m]ark,”³ specifically, “sweaters, swimwear, pants, shorts, shirts, skirts, and jackets.” Accordingly, the goods are identical in part. It is unnecessary for us to address any of the other goods in the application since likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item in the identification of goods for that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Moreover, with the possible exception of the Halloween and masquerade costumes, applicant’s other items of casual apparel are closely related to the other apparel items in the cited registration.

Applicant has specifically restricted its goods to clothing “related to motion picture films.” However, the clothing identified in the cited registration is not limited in any way. We therefore must presume that the clothing in the cited registration encompasses all goods of the nature and type identified, including “clothing related to motion pictures.” It is settled that it is the identification of goods that controls, not what extrinsic evidence may show about the specific nature of the

³ Appeal Brief, p. 13.

goods. An applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163 (TTAB 2013), *See also Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008); and *In re Fisher Scientific Co.*, 440 Fed.2d 434, 169 USPQ 436, 437 (CCPA 1971). Applicant attempts to rely on extrinsic evidence regarding the movie Avatar to purportedly explain its goods. However, the cases cited by applicant only support reliance on extrinsic evidence if such evidence is needed to establish the meaning of the goods set forth in the application and/or registration, i.e. in a case where the goods are of a technical nature. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399,1410 (TTAB 2010) and *In re Trackmobile, Inc.*, 15 USQP2d 1152, 1154 (TTAB 1990). Since the goods at issue here are not of a technical nature and are easily understood items of clothing, these cases are not applicable.

Accordingly, since the goods are in-part identical and in-part closely related, the second *du Pont* factor favors a finding of likelihood of confusion.

Looking next at the channels of trade and class of purchasers, we note the well-established principle “that absent restrictions in the application and registration, [identical] goods and services are presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). There are no restrictions in the cited registration as to the channels of trade or class of customers. Even if we view the language “all of the

foregoing related to motion picture films” in applicant’s identification of goods as imposing a restriction on their trade channels or the classes of consumers to which they are marketed, registrant’s goods, unlimited as to trade channels and classes of consumers, must be presumed to encompass those recited in the involved application. Thus, in the case at bar, because the goods are in-part legally identical and there are no restrictions in trade channels restrictions identified in the cited registration, they are presumed to travel in the same channels of trade to the same classes of purchasers. We further observe that because there are no limitations on the goods identified in the involved application and cited registration relating to cost, we must presume that such goods include items of apparel that are inexpensive, and subject to impulse purchases made with nothing more than ordinary care.

Accordingly, we find that the third and fourth *du Pont* factors favor a finding of likelihood of confusion.

Next, we determine the similarities or dissimilarities in the marks, which we do by examining the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) quoting *du Pont*, 177 USPQ at 567. We start by noting that in cases such as the case at bar, where the goods are in-part legally identical, “the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21*

Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987).

While the ultimate conclusion of similarity of the marks must rest on a consideration of the marks in their entireties, “[i]t is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant has adopted the entire mark in the cited registration PANDORA, which, as used in connection with clothing, is arbitrary.⁴ The only difference between the cited mark and applicant’s mark is the addition of the suffix “PEDIA” to the term PANDORA. “PEDIA” is defined by applicant as “relating to learning” or “a specialized encyclopedia [sic] about the prefix or a general encyclopedia in the structured of the prefix,⁵ Thus, the term “PEDIA” modifies PANDORA and is subordinate thereto.

⁴ In an attempt to show that the registered mark is weak, applicant relies on four registrations for the mark PANDORA in various formats for, *inter alia*, jewelry; broadcasting and entertainment; dietary supplements; and computer software and related services, as well as a Danish website using the mark PANDORA for jewelry. The registrations do not establish use and there is no evidence that the website is viewed by consumers in the United States. In any event, four registrations and one Danish website are not sufficient to establish consumer recognition of PANDORA “for a wide range of goods and services” (Appeal Brief, pp. 14-15).

⁵ Exhibit B to July 27, 2012 Response to Office Action – Definition obtained from Wiktionary.org (<http://en.wiktionary.org/wiki/-pedia/>)

“The general rule is that a subsequent user may not appropriate the entire mark of another and avoid a likelihood of confusion by adding descriptive or subordinate matter thereto.” *In re Jump Designs LLC*, 80 USPQ2d 1370 (TTAB 2006), *cf. Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) [HEWLETT PACKARD and PACKARD TECHNOLOGIES]; *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) [MACHO and MACHO COMBOS]; *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) [RESPONSE and RESPONSE CARD]; and *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) [CONFIRM and CONFIRMCELLS].

Applicant contends that this principle is not applicable in the current case because the suffix “-PEDIA” is not descriptive or generic. This argument is not persuasive. The general rule, discussed *supra*, is that a subsequent user cannot avoid confusion by adding *subordinate* matter thereto. *Id.* Applicant has added the subordinate term “PEDIA” to registrant’s mark PANDORA, which does not change its overall commercial impression or distinguish it from registrant’s mark.

Applicant further argues that courts have “found that even when word marks with overlapping elements are applied to the same or related goods or services, they can function to signify different sources.” Appeal Brief, p. 6. To support this allegation, Applicant cited *General Mills Inc. v. Kellogg Co.*, 824 F.2d 622, 3 USPQ2d 1442 (8th Cir. 1987) (APPLE RAISIN CRISP for cereal and OATMEAL RAISIN CRISP for cereal); and *Little Caesar Enterprises Inc. v. Pizza Caesar Inc.*, 834 F.2d 568, 4 USPQ2d 1942 (6th Cir. 1987) (LITTLE CAESARS for pizza and

PIZZA CAESAR USA for an Italian restaurant). These cases can be distinguished from the case at bar because the common element in each of the marks was descriptive (“raisin crisp” – highly descriptive of ingredients of cereal) or otherwise weak (“Caesar” – commonly used in conjunction with Italian food). Similarly, in all of the other cases relied on by applicant, wherein the goods were identical, the common element(s) in each mark was weak. *See, e.g., Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) (PECAN SANDIES v. PECAN SHORTIES); *Land-O-Nod Co. v. Paulison*, 220 USPQ 61 (TTAB 1983) (CHIRO-MATIC v. CHIROPRACTIC); *Taco Time Intl., Inc. v. Taco Town, Inc.*, 217 USPQ 268 (TTAB 1982) (TACO TOWN and TACO TIME); *Approved Pharmaceutical Corp. v. P. Leiner Nutritional Prods. Inc.*, 5 USPQ2d 1219 (TTAB 1987) (HEALTHY LIFE v. HEALTH FOR LIFE); and *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER’S OUTLET v. CALIFORNIA COBBLERS).

Based on the foregoing, we find that the marks PANDORA and PANDORAPEDIA are similar and thus, the first *du Pont* factor favors a finding of likelihood of confusion.

Having considered all the evidence and arguments on the relevant *du Pont* factors discussed herein, we find that applicant’s mark PANDORAPEDIA is likely to cause confusion with the cited mark, PANDORA. The remaining *du Pont* factors not discussed above we treat as neutral.

Decision: The refusal to register is affirmed.