

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Picture Entertainment Corporation

Serial No. 78917269

Arthur Aaronson of Aaronson & Aaronson for Picture
Entertainment Corporation

Linda M. Estrada, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney)

Before Seeherman, Taylor and Wellington, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Picture Entertainment Corporation, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register LA CONFIDENTIAL, in standard character format, with LA disclaimed, for "caps, hats, pants, short-sleeved or long-sleeved t-shirts, shorts, sweat shirts, t-shirts." The application, Serial No. 78917269, was filed June 26, 2006, and asserts first use and first use in commerce as early as July 1, 2001. Registration has been refused 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 mark LA CONFIDENTIAL, in typed or standard character form, with LA disclaimed, previously registered for comic books and fiction books,¹ that when used in connection with applicant's identified goods it is likely to cause confusion or mistake or to deceive.

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).

Determining the similarity of the marks involves a consideration of their appearance, pronunciation, connotation and commercial impression. *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003). The

¹ Registration No. 2875852, issued August 24, 2004.

marks here are identical in all four of these aspects. The factor of the similarity of the marks thus weighs heavily in favor of finding a likelihood of confusion.

The greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion. Where the applicant's mark is identical to the registrant's mark, as it is in this case, there need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists. In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001), citing In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993) and In re Concordia International Forwarding Corp., 222 USPQ 355 (TTAB 1983). The examining attorney has shown that viable relationship through the submission of six third-party registrations which cover both comic books and items of clothing.² See, for example, Registration No.

² The examining attorney also submitted a third-party registration for, inter alia, a series of fiction books and articles of clothing. No. 2936761. This single registration would not be sufficient to show the necessary relatedness of fiction books and clothing. However, it is not necessary to show likelihood of confusion with respect to each item in the cited registration, and therefore the evidence with respect to the relatedness of applicant's clothing items and comic books satisfies this du Pont factor. Cf. Tuxedo Monopoly, Inc. v.

Ser No. 78917269

3187467 for MADAGASCAR for, inter alia, comic books and shirts, tops, pants, shorts, sweatshirts, caps and hats; Registration No. 3002976 for PRINCESS AI for, inter alia, comic books and t-shirts; Registration No. 3033186 for CAPTAIN CHARACTER for, inter alia, comic books, t-shirts and hats; Registration No. 3095934 for DOLPHIN MAN for, inter alia, comic books and shirts, t-shirts, hats, caps and sweatshirts; and Registration No. 3040367 for SWEET & INNOCENT GIRL for, inter alia, comic books and hats, shirts, shorts, sweat shirts and tee shirts. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Although comic books and clothing items do not appear on their face to be similar goods, it is not necessary that the goods or services of applicant and the registrant be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered

General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

With respect to the du Pont factor of the channels of trade, although the examining attorney has asserted that the goods travel in the same channels of trade, she has submitted no evidence to support this contention. We can say only that because applicant's identified clothing and the registrant's identified comic books and fiction books are consumer items, the goods must be deemed to be sold to the same classes of purchasers, namely the public at large. As for the conditions of purchase, because of the nature of the goods, the general public who are the purchasers of the goods cannot be considered to have any particular sophistication about these purchases. Moreover, because comic books in particular are inexpensive and subject to impulse purchase, while some of applicant's identified clothing such as t-shirts and caps would also be inexpensive and impulse purchases, consumers are unlikely to exercise care in buying such products. This du Pont factor favors a finding of likelihood of confusion.

Applicant has not disputed any of these points. The only thing applicant has said about the cited registration³ in its brief is a single sentence:

As to U. S. Registration No. 2875852, that Registration is owned by Lee Caplin, who is applicant's principal, who consents to the pending application.

Brief, p. 1. Applicant made a similar statement in its response to the first Office action, submitted on June 4, 2007:

The owner of the registered mark "LA Confidential", Lee Caplin, gives consent to register "LA Confidential" for use on clothing. LA Confidential is owned by the individual principal of Picture Entertainment Corporation [applicant herein] and he hereby consents to this registration.

The problem with this statement, as the examining attorney pointed out in the Office action mailed July 11, 2007, is that the owner of the cited registration did not actually submit his consent to the registration of applicant's mark. A consent, of course, carries great weight in a determination of likelihood of confusion. See *Bongrain International (American) Corporation v. Delice de France*

³ At the time applicant filed its brief registration was also refused based on another party's registration, No. 2182561, for CONFIDENTIAL for certain items of clothing. This registration was cancelled after briefing was completed, and therefore we have considered the refusal based on this registration to be moot.

Inc., 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); In re E.I. du Pont de Nemours & Co., 177 USPQ at 568. However, a statement from applicant's attorney that the registrant gives his consent is not the same as the submission of a consent. Applicant's attorney, in prosecuting the application and appeal, is representing applicant before the Patent and Trademark Office, not the owner of the cited registration. We cannot presume a consent by the registrant merely on the statement by applicant's attorney. We find this situation particularly troubling because applicant and its attorney were advised by the examining attorney, during examination, that applicant's claim that there was a consent was insufficient, in that a consent agreement had not been submitted. However, despite having had this deficiency pointed out, applicant did nothing to secure and submit a consent document. Applicant has represented that its principal is the registrant and that he has no objection to the registration of applicant's mark; thus, it would seem a relatively simple matter to provide the consent agreement. Yet applicant did not submit the consent or provide any explanation as to why it did not do so. As a result, we cannot treat applicant's statement as an actual consent by the owner of the cited registration.

Considering all of the applicable du Pont factors and the evidence pertaining thereto, and in light of applicant's failure to substantiate its claim that the registrant consented to the registration of applicant's mark, we find that applicant's mark LA CONFIDENTIAL for its identified clothing items is likely to cause confusion with the cited registration.

Decision: The refusal of registration is affirmed.