

**This opinion is Not a
Precedent of the TTAB**

Mailed: October 24, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re MarvelousAQL Inc.

—
Serial No. 79975267


—
Jeremy D. Bisdorf, Peter M. Falkenstein, Joan H. Lowenstein and Lawrence R.
Jordan of Jaffe Raitt Heuer & Weiss PC, for MarvelousAQL Inc.

Matthew T. Einstein, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

—
Before Bucher, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

MarvelousAQL Inc. (“applicant”) seeks registration on the Principal Register of
the following mark:



MarvelousAQL

for the “production and distribution of movies” in International Class 41.¹

The examining attorney has taken the position that applicant’s mark, when used in connection with the recited services, so resembles the mark, **MARVELOUS MEDIA** (*in standard character format*) registered for services recited as “production and distribution of television shows and movies; production of DVDs featuring documentaries, sporting events, music videos, dramas and comedy,” also in International Class 41,² as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

When the refusal was made final, applicant appealed and requested reconsideration. After the examining attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Arguments of applicant and the examining attorney

Applicant argues that the only commonality between its applied-for mark and the cited mark is that they share a single word, “Marvelous,” and that this alone is not sufficient to support a finding of likelihood of confusion. Specifically, applicant argues that the word “Marvelous” is weak and that the other differences between the marks greatly outweigh their similarities. Furthermore, applicant argues that

¹ Application Serial No. 79975267 was filed on October 12, 2011. The application is based on a request for protection filed under Section 66a of the Trademark Act of 1946, 15 U.S.C. § 1144f(a). The mark consists of a stylized letter “M” above the stylized wording “MarvelousAQL.”

² Registration No. 3528103 issued on November 4, 2008. No claim is made to the exclusive right to use the word “Media” apart from the mark as shown.

these services necessarily involve sophisticated customers. Finally, applicant argues the cited mark is not famous and thus is not entitled to heightened protection.

By contrast, the examining attorney contends that inasmuch as the services are legally identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of more distant services; that the evidence does not show that the term “Marvelous” is weak in the field of production and distribution of movies; that even if the term “Marvelous” should be determined to be weak, even weak marks are entitled to protection against the registration by a subsequent user of a similar mark for identical services; there is no probative evidence in the record that all the relevant customers of these services will be sophisticated; and that even sophisticated customers can be confused when similar marks are used in connection with identical services.

Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based upon an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential

characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

A. Identical services and trade channels

We turn first to the relationship of the respective services, and the channels of trade, the second and third *du Pont* factors, respectively. In its brief, “Applicant concedes that the services described in the Application and Registration are identical and that Applicant has made no claims regarding [a difference in] channels of trade.” Applicant’s brief at 3. Similarly, we presume that they are available to the same classes of purchasers. *See Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). Accordingly, these critical *du Pont* factors weigh in favor of a finding of likelihood of confusion.

B. Strength of the Mark of the Cited Registration

Applicant has argued at some length that the word “Marvelous” is weak both conceptually and commercially. In support of their respective positions on this question, both applicant and the examining attorney have provided for the record quite similar dictionary definitions of the word “marvelous”:

marvelous (mär'və-ləs) *adj.*

1. Causing wonder or astonishment.
2. Miraculous; supernatural.
3. Of the highest or best kind or quality; first-rate: *has a marvelous collection of rare books*

³

marvelous adjective \ 'märv-(ə)-ləs \

: extremely good or enjoyable

- 1 : causing wonder : **ASTONISHING**
- 2 : **MIRACULOUS, SUPERNATURAL** <Gothic tales of *marvelous* and bizarre happenings>
- 3 : of the highest kind or quality : notably superior <has a *marvelous* way with children>

⁴

Applicant argues that the word “Marvelous” is conceptually an inherently weak source identifier. In the context of the cited mark, **MARVELOUS MEDIA**, applicant argues that the definition, “of the highest or best kind or quality; first-rate” would probably be the intended meaning of “Marvelous” – suggesting media of the best kind or highest quality. While the term “Marvelous” may well create mental images of something of the highest quality, it certainly carries with it over-the-top, superlative connotations well beyond the attempted reach of most widely-used laudatory terms, as shown in the initial dictionary entries.⁵ Accordingly, we disagree with applicant that as applied to these services it should be deemed to be

³ The American Heritage® Dictionary of the English Language (4th ed. 2000), <http://www.thefreedictionary.com/marvelous>, as submitted by applicant on March 12, 2013.

⁴ <http://www.merriam-webster.com/dictionary/marvelous>, as attached to the examining attorney’s denial (April 2, 2013) of applicant’s Request For Reconsideration.

⁵ In fact, applicant refers to a thesaurus entry from its own dictionary entry (“extraordinarily good or great; used especially as intensifiers”) – a section that also contains synonyms for this adjective that few merchants or manufacturers would use, such as “miraculous,” “supernatural,” “improbable,” “incredible” and “unbelievable.”

weak as a matter of law. Even if suggestive, it is still deemed to be an inherently distinctive term when used in connection with the production and distribution of movies.

As to the commercial strength of the cited mark, the sixth *du Pont* factor requires consideration of any evidence pertaining to the number and nature of similar marks in use on similar goods or services. Based upon at least nineteen extant federal trademark registrations⁶ having marks containing the word “Marvelous,” applicant argues that the cited mark is commercially weak.

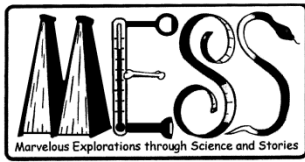
Of course, third-party registrations by themselves are not evidence of actual use of the marks and we therefore cannot conclude that consumers are even familiar with the following registered marks. Bearing this in mind, we clearly cannot say that consumers have become accustomed to the existence of similar marks in the marketplace and are thus able to distinguish between similar marks based on slight differences. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

**MARVELOUS
MULTIPLES**

for educational services, namely, conducting classes and seminars in the field of prenatal and postnatal education in International Class 41;⁷

⁶ Of applicant’s twenty-four listed registrations, two were listed twice, one issued under Section 66A (Registration No. 4137517) and two have been cancelled under Section 8 (Registration Nos. 3085073 and 3042998).

⁷ Registration No. 2246079 issued on May 18, 1999; renewed.



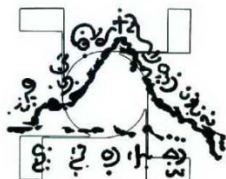
for educational science experiment and activity kits primarily comprising printed books and printed activity workbooks, and also containing tools for making observations and conducting experiments, namely, magnifying lenses, nets, insect viewers, goggles, brushes, chemicals in vials, beakers, test tubes, cork stoppers, measuring spoons, funnels, stirring rods, tubing, and teacher/parent guides containing instructions for experiments in International Class 16;⁸

**MARVELOUS
PHOTO**

for portrait photography services in International Class 41;⁹

**MARVELOUS
MIGUN**

for therapeutic electrical apparatus in International Class 10;
independent sales representatives in the field of medical instruments and physical treatment instruments in International Class 35;¹⁰



Marvelous Tea

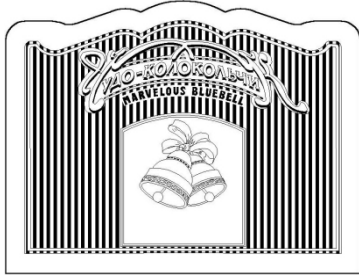
for "herbal teas for food purposes; and tea in International Class 30;¹¹

⁸ Registration No. 2784342 issued on November 18, 2003; renewed. No claim is made to the exclusive right to use the words "Science and Stories" apart from the mark as shown.

⁹ Registration No. 2887841 issued on September 21, 2004; Section 8 affidavit (six-year) accepted. No claim is made to the exclusive right to use the word "Photo" apart from the mark as shown.

¹⁰ Registration No. 3087566 issued on May 2, 2006; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. The English translation of the Korean word "MIGUN" in the mark is "Beauty Is Health."

¹¹ Registration No. 3125832 issued on August 8, 2006; Section 8 affidavit (six-year) accepted. The mark consists of five Chinese characters pronounced as XIANG; HUA; DA; MIAO; and CHA; meaning FRAGRANT; FLOWERY; BIG; MARVELOUS; TEA; and an abstract drawing symbolizing MARVELOUS. No claim is made to the exclusive right to use the word "TEA" or the non-Latin character that transliterates to CHA, which means TEA in English, apart from the mark as shown.



for soft drinks in International Class 32;¹²



for organizational services for home or personal purposes, namely, cleaning, organizing spaces, rearranging items and eliminating unnecessary items and personal shopping services in International Class 45;¹³

**MARVELOUS
MATH**

for educational services – math enrichment provided through a child care center in International Class 41;¹⁴

**THE MARVELOUS
MISADVENTURES
OF FLAPJACK**

for entertainment services in the nature of a continuing comedy, drama, action, adventure and/or animation program series provided through cable television, broadcast television, and the Internet in International Class 41;¹⁵

**THE MARVELOUS
MISADVENTURES
OF FLAPJACK**

for clothing in International Class 25;¹⁶

Marvelous World

for many class 16 items devoted to science fiction, adventure and/or action in International Class 16;¹⁷

**Marvelous Work and
a Wonder**

for religious books in International Class 16;¹⁸

¹² Registration No. 3144534 issued on September 19, 2006; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. The English translation of the non-Latin characters in the mark is “Marvelous Bluebell.” The non-Latin characters in the mark transliterate to “choudo-kolokolchik.”


¹³ Registration No. 3272330 issued on July 31, 2007; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the words “Simply Marvelous Organizing” apart from the mark as shown.

¹⁴ Registration No. 3320007 issued on October 23, 2007. No claim is made to the exclusive right to use the word “Math” apart from the mark as shown.

¹⁵ Registration No. 3477961 issued on July 29, 2008.

¹⁶ Registration No. 3633193 issued on June 2, 2009.

¹⁷ Registration No. 3750716 issued on February 16, 2010.

MARVELOUS MAMA	for women's apparel, namely, body shapers, pantyhose and tights in International Class 25; ¹⁹
YOU'LL LOOK MARVELOUS	for pet grooming services in International Class 44; ²⁰
ONE MARVELOUS MINIMIZER	for foundation garments; women's undergarments; lingerie; brassieres in International Class 25; ²¹
SAN MARVELOUS	for clothing in International Class 25; ²²
THE MARVELOUS MISADVENTURES OF FLAPJACK	for digital versatile discs featuring music, comedy, drama, action, adventure and/or animation in International Class 9; ²³
MARVELOUS CUTS	for barbershops in International Class 44; ²⁴
	for, <i>inter alia</i> , educational and entertainment services in the field of music in International Class 41; ²⁵

The examining attorney included for the record copies of some of the same third-party registrations shown above, as well as the following ones:

¹⁸ Registration No. 3804512 issued on June 15, 2010.

¹⁹ Registration No. 3853563 issued on September 28, 2010.

²⁰ Registration No. 3854793 issued on September 28, 2010.

²¹ Registration No. 3966810 issued on May 24, 2011. Registrant claims acquired distinctiveness as to the word "Minimizer."

²² Registration No. 4039669 issued on October 11, 2011.

²³ Registration No. 4042489 issued on October 18, 2011.

²⁴ Registration No. 4151970 issued on the Supplemental Register on May 29, 2012. No claim is made to the exclusive right to use the word "Cuts" apart from the mark as shown.

²⁵ Registration No. 4210937 issued on September 18, 2012.



for canned shrimps in International Class 29;²⁶

**MARVELOUS
MARKET**

for bread, pastries and bakery desserts in International Class 30; and retail bakery stores in International Class 35;²⁷

**MARVELOUS
MATTE**

for skin and body care preparations, namely, cosmetics, in International Class 3;²⁸

MARVELOUS LIFT

for bras in International Class 25;²⁹

While it is true that the cited mark has co-existed and continues to co-exist with a number of other marks containing the word “Marvelous” registered in connection with a wide variety of goods and services, we note that most of these composite marks contain other distinguishing matter, creating quite disparate commercial impressions. In some registrations, the word “Marvelous” is treated as the sole distinctive term in the composite (e.g., **MARVELOUS PHOTO, MARVELOUS MARKET, MARVELOUS MATTE, MARVELOUS MATH** and **MARVELOUS LIFT**), not as a merely descriptive term, as argued by applicant.

²⁶ Registration No. 0538007 issued on February 20, 1951; [4th renewal?]

²⁷ Registration No. 2951182 issued on May 17, 2005; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the word “Market” apart from the mark as shown.

²⁸ Registration No. 2967457 issued on July 12, 2005; Section 8 affidavit (six-year) accepted. No claim is made to the exclusive right to use the word “Matte” apart from the mark as shown.

²⁹ Registration No. 3690370 issued on September 29, 2009. No claim is made to the exclusive right to use the word “Lift” apart from the mark as shown.

In addition to the conclusion that the word “Marvelous” has not been adopted as frequently as applicant has suggested, we find that none of these referenced third-party registrations is for the services which are the subject of this appeal.

Finally, applicant points to a website for Marvelous Productions,³⁰ which appears on its face to be a DJ’s largely-inactive and little-used site. We certainly question the probative value of this single site to demonstrate the weakness of registrant’s mark.

Accordingly, to the extent that applicant seeks to persuade us that the cited mark is both conceptually and commercially weak, we remain unconvinced based upon the totality of this record, and we find this to be, at best for applicant, a neutral *du Pont* factor.

C. Comparison of the Marks

In comparing the marks we must consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567; and *Palm Bay*, 73 USPQ2d at 1692. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the services are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable

³⁰ <http://marvelousproductions.webs.com/>

disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700-01 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Applicant has applied to register the special form mark shown at right. The registered mark is **MARVELOUS MEDIA**. The test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather



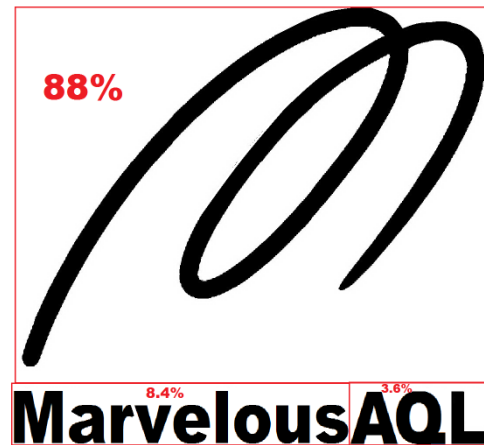
whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a

mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Id.*

As to the appearance of the respective marks, the examining attorney minimizes the differences, saying applicant merely added the letter “M” and the AQL initialism to the word “Marvelous.”

Applicant responds that the examining attorney’s “statement is incorrect because it fails to acknowledge that over 85% of the Mark is actually a stylized drawing of the letter M and that this drawing has its own unique creative



elements that are not the same as the mere addition of a letter M to a standard character mark. Further, the [letters] AQL follow immediately after the word MARVELOUS, not even separated by a space, such that the word in the Mark is actually ‘MarvelousAQL.’”

In making determinations as to whether two marks are confusingly similar, the relative percentage of surface area consumed by each region of a composite mark is rarely the decisive factor. Yet we do agree with applicant that the large, stylized letter “M” is a significant portion of its composite mark, and cannot be discarded so cavalierly when considering the dissimilarities in the respective marks.

However, even among prospective consumers who recognize the large image as the letter “M,” the examining attorney notes that “[c]onsumers are not likely to refer to applicant’s services as ‘highly stylized M production services.’” Rather,

applicant's mark will be vocalized as "Marvelous AQL." Sounding out the initialism, A-Q-L, does add another three syllables to the enunciation of "Marvelous." On the other hand, there is no indication in the record that consumers will attach any special source-indicating significance to this letter string. In fact, given the difficulty in vocalizing and recalling letter strings, the most likely portion of this mark that the average person would recall and repeat is the leading and familiar word "Marvelous." See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) ("the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical.") and the cases cited therein.

Inasmuch as the word "Media" in registrant's mark has substantially no source indicating value, the connotation of both marks will inevitably boil down to the suggestive word, "Marvelous." Accordingly, the respective marks, while clearly dissimilar in several respects, create quite similar overall commercial impressions around the common word, "Marvelous." Hence, we find that this *du Pont* factor supports a finding of likelihood of confusion.

D. Conditions surrounding sales

The fourth *du Pont* factor focuses on the conditions under which and buyers to whom sales are made, i.e., "impulse" versus careful, sophisticated purchasing. Applicant argues that the fact registrant and applicant are offering legally identical services is much less significant than the fact that the services are so expensive that it would be practically impossible for a client to mistake registrant's and applicant's

respective identities due to the mere sharing of the word “Marvelous” in their service marks.

Applicant has cited to three articles suggesting that engaging the services of a movie or video production company will require “a large sum of money.” None of these articles actually cites specific costs. Moreover, to the extent that the third-party website for Marvelous Productions placed into the record by applicant demonstrates a similar service, we find that the costs of this type of service in a digital age have been greatly reduced, especially given the amateur quality of some online video productions. Hence, we are not convinced that all purchasers of applicant’s and registrant’s services will be sophisticated buyers, and this *du Pont* factor is deemed to be neutral.

E. The fame of the prior mark

Applicant argues in its brief that the cited mark is not famous and the cited mark should not be given any increase in protection as a result. Clearly, it is well-settled that a famous mark is afforded a wide latitude of protection. *See, for example, Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). However, in an *ex parte* proceeding before the Board, “we would not expect the examining attorney to submit evidence of fame of the cited mark.” *See In re Thomas*, 79 USPQ2d 1021, 1027 n. 11 (TTAB 2006). Also, even if applicant could show that the mark in the cited registration is not famous, the absence of fame does not justify narrowing the ordinary scope of protection to which such a mark is entitled. *Majestic Distilling*, 65 USPQ2d at 1205.

Furthermore, inasmuch as registrant is not a party to this proceeding, it has no opportunity to introduce evidence of fame of its mark. In this case, there is no evidence regarding the strength of the registered **MARVELOUS MEDIA** mark, and we accordingly make no finding on whether it is – or is not – famous. *Cf. Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). Accordingly, we find that the cited registration is entitled to the normal scope of protection that would be afforded such a mark and this *du Pont* factor is also neutral.

F. Balancing the factors

In summary, we have carefully considered all of the evidence and arguments of record relevant to the pertinent *du Pont* likelihood of confusion factors. As our precedent dictates, we resolve doubt in favor of the prior registrant. *See In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). We have noted that the services herein are identical and may not be restricted to sophisticated purchasers, and that the cited mark has not been shown to be famous, on the one hand, nor is there evidence of extensive third-party use, on the other hand. In spite of some differences in the appearance and sound of the two marks, we find that the marks are similar enough in connotation and overall commercial impression to support a finding of a likelihood of confusion herein.

Decision: The refusal to register applicant’s applied-for mark under Section 2(d) of the Lanham Act is hereby affirmed.