

<p><b>This Opinion is Not a Precedent of the TTAB</b></p>
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Mailed: July 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Sherrilyn Kenyon*

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Serial No. 85396538

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Robert L. Brewer and Martha Allard of Bass, Berry & Sims, PLC,  
For Sherrilyn Kenyon.

Bridgett G. Smith, Trademark Examining Attorney, Law Office 115,  
John Lincoski, Managing Attorney.

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Before Wellington, Gorowitz, and Hightower,  
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Sherrilyn Kenyon (“Applicant”) seeks registration on the Principal Register of the mark THE LEAGUE (in standard characters) for “motion picture films in the field of science fiction” in International Class 9 and “entertainment in the nature of a television program in the field of science fiction” in International Class 41.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to a

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<sup>1</sup> Application Serial No. 85396538 was filed on August 12, 2011, based on Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

likelihood of confusion with THE LEAGUE (in standard characters), registered for “entertainment services in the nature of a television series featuring comedy” in International Class 41.<sup>2</sup>

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed.

The Board subsequently granted the Examining Attorney’s request for remand to issue a new requirement for clarification of the identification. Applicant amended the application to reclassify her motion picture goods from Class 41 to Class 9,<sup>3</sup> and the appeal was then resumed once again.

We affirm the refusal to register.

### Analysis

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, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

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<sup>2</sup> Registration No. 4012633, issued August 16, 2011.

<sup>3</sup> That these goods were reclassified from Class 41 to Class 9 after the refusal to register was made final does not affect our analysis. The Patent and Trademark Office’s administrative classification of particular goods and services “is immaterial in determining the likelihood of confusion or mistake or deception of purchasers as to source or origin of the goods.” *In re Knapp-Monarch Co.*, 296 F.2d 230, 132 USPQ 6, 7 (CCPA 1961).

1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

As Applicant admits, her mark is identical to the cited registered mark.<sup>4</sup> Therefore, the first *du Pont* factor, similarity of the marks, weighs strongly in favor of a likelihood of confusion.

We next consider the similarity of the goods and services, the second *du Pont* factor. It is not necessary that the goods and services be identical or even competitive to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and services are related in some manner, or that the circumstances surrounding their marketing are such that they would be encountered by the same persons in situations that would give rise, because of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods and services. *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

The greater the degree of similarity between the marks, the lesser the degree of similarity between the goods and services necessary to support a finding of likelihood of confusion. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). When the marks are identical, as they are here, it is only necessary that there be a viable relationship between the goods and services to support a finding of likelihood of confusion. *In re Iolo Techs. LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010).

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<sup>4</sup> Appeal Brief at 14, 14 TTABVUE at 15.

Applicant's goods and services are "motion picture films in the field of science fiction" and "entertainment in the nature of a television program in the field of science fiction." The services identified in the cited registration are "entertainment services in the nature of a television series featuring comedy."

Applicant does not dispute that "entertainment in the nature of a television program" is similar to "entertainment services in the nature of a television series." Applicant also does not dispute that "motion picture films" are related to "a television series." Furthermore, the Examining Attorney made of record seven use-based registrations for entertainment services related to both films and television.<sup>5</sup> These registrations demonstrate that Applicant's goods and the services identified in the cited registration are of a kind that may emanate from a single source under a single mark. *In re Davey Prods. Pty. Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

The crux of Applicant's appeal is that her goods and services are distinguishable from those in the cited registration because her films and TV program are "in the field of science fiction," while the cited services are a TV series "featuring comedy." Applicant contends that: "When considering Appellant's mark for use with science fiction films and television programs, it is obvious that Appellant's mark is not likely to be confused with the cited mark for use with slapstick comedy television shows."<sup>6</sup> She maintains that "the programs with which the two marks are used are

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<sup>5</sup> See December 8, 2011 Office Action at 4-6, 7-9; March 19, 2013 Reconsideration Letter at 2-4, 5-7, 13-16, 17-18, 25-26.

<sup>6</sup> Appeal Brief at 10, 14 TTABVUE at 11.

or will be completely different and directed to vastly different audiences,”<sup>7</sup> and that “television viewers are savvy and discriminating enough to understand that the programs will emanate from different sources and avoid a likelihood of confusion.”<sup>8</sup>

The flaw in Applicant’s argument is its focus on the nature of the television series currently offered under the cited mark, in contrast to the specific characteristics of her science fiction plots, which are “dark, violent stories taking place in a fictional universe.”<sup>9</sup> It has long been established that the Board must base its analysis of the second *du Pont* factor not on extrinsic evidence of actual use, but rather on the goods and services as identified in the application and the cited registration, respectively. *See, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (“It was proper . . . for the Board to focus on the application and registrations rather than on real-world conditions, because ‘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.’”) (quoting *Octocom Sys., Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) (“It is well settled that in a proceeding such as this, the question of likelihood of confusion must be determined by an analysis of the marks

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<sup>7</sup> *Id.* at 14, 14 TTABVUE at 15.

<sup>8</sup> *Id.* at 15, 14 TTABVUE at 16.

<sup>9</sup> *Id.* at 10, 14 TTABVUE at 11. There is record evidence that Applicant is a NEW YORK TIMES bestselling author with more than 25 million copies of her books in print, and is the “preeminent voice in paranormal fiction.” March 19, 2013 Reconsideration Letter at 27 (screenshots from Applicant’s website sherrilynkenyon.com).

as applied to the goods identified in the application vis-a-vis the goods recited in the registration, rather than what extrinsic evidence shows those goods to be.”).

For the same reason, the trademark infringement cases on which Applicant relies, including primarily *Scorpiniti v. Fox Television Studios, Inc.*, 918 F. Supp. 2d 866 (N.D. Iowa 2013), are not persuasive. In *Scorpiniti*, the court granted summary judgment to defendant Fox, finding no likelihood of confusion between plaintiff’s mark THE GATE for a religion-themed music video show and Fox’s mark THE GATES for a “network-quality hour-long drama series that features supernatural beings residing together in a gated community.” *Id.* at 884. Among other findings, the Iowa court concluded that the parties’ services lacked competitive proximity. *Id.*

The type of reasoning applied in *Scorpiniti* is inapposite here because this is not a trademark infringement case, but rather an administrative proceeding to determine whether the mark in the subject application is entitled to a federal registration for the goods and services *as identified in the application*, not as they actually are or will be used. To the extent that Applicant relies on the prosecution history of the Fox trademark registration discussed in *Scorpiniti*, moreover, it has been noted many times that we must decide each case on its own facts. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1428 (TTAB 2014).

Returning to the matter at hand, the Examining Attorney made of record 11 registrations for both science fiction and comedy entertainment services or DVDs in

the television and film industries, demonstrating that goods and services in both the science fiction and comedy genres emanate from the same source.<sup>10</sup> The Examining Attorney also submitted evidence of overlap between these types of goods and services in the form of science fiction films and television programs featuring comedy. This includes a list of more than 100 “comic science-fiction films” from Wikipedia.org,<sup>11</sup> and evidence relating to “Quark,” a “Campy Science Fiction TV Comedy” broadcast on NBC in 1978.<sup>12</sup>

The record thus supports a finding that “motion picture films in the field of science fiction” and “entertainment in the nature of a television program in the field of science fiction” are similar or related to “entertainment services in the nature of a television series featuring comedy.” Therefore, the second *du Pont* factor also supports a finding of likely confusion.

In sum, the first and second *du Pont* factors weigh in favor of a finding of a likelihood of confusion. There is no record evidence concerning any other *du Pont* factor. We find that Applicant’s mark THE LEAGUE so resembles the cited mark THE LEAGUE as to be likely to cause confusion when used in association with the identified goods and services.

**Decision:** The refusal to register Applicant’s mark is affirmed.

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<sup>10</sup> December 8, 2011 Office Action at 2-3, 4-6, 7-9, 10-11, 12-14; March 19, 2013 Reconsideration Letter at 2-4, 5-7, 13-16, 17-18, 22-24, 25-26.

<sup>11</sup> July 12, 2012 Final Office Action at 24-27. The films span the years 1930 to 2011 and include, for example, “The Adventures of Buckaroo Banzai Across the 8th Dimension,” “Back to the Future,” “Ghostbusters,” “Men in Black,” and “The Fifth Element.”

<sup>12</sup> *Id.* at 11-15 (including a DVD of the complete series offered for sale on quark.name, described as the unofficial homepage for the television show “Quark”).