

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

EAD

Opposition No. 104,765

MAILED

JAN 28 2003

PAT. & T.M. OFFICE

Playboy Enterprises, Inc.

v.

Mavety Media Group Ltd.

Before Simms, Cissel, and Chapman, Administrative Trademark Judges.

By the Board:

Applicant has filed a request for reconsideration of the Board's March 27, 2000 decision¹ denying applicant's motion for summary judgment. Opposer has filed a brief in opposition.

¹ Applicant's request for reconsideration, apparently filed with the U. S. Patent and Trademark Office on May 17, 2000 (by certificate of mailing) was never associated with the Board proceeding file.

On November 17, 2000, the Board granted applicant's consented motion to suspend proceedings pending settlement discussions between the parties, noting the absence of the request for reconsideration. On September 10, 2002, the Board resumed proceedings and ordered applicant to file a copy of its request for reconsideration.

Applicant's request for reconsideration is combined with a motion to reopen its time to file such a request. Applicant's motion to reopen establishes excusable neglect for applicant's failure to timely file its request for reconsideration, and is granted. See Fed. R. Civ. P. 6(b).

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In the notice of opposition, opposer alleges that applicant's PLAYGUY mark, when used in connection with the identified services, so resembles opposer's various previously used and registered PLAYBOY marks as to be likely to cause confusion, mistake or deception; and further alleges that applicant's mark falsely suggests a connection with opposer.

In its motion for summary judgment, applicant asserts that it is entitled to judgment as a matter of law because registration of the PLAYGUY mark in the opposed application for "on-line computer services featuring visual images and articles for adult entertainment; providing access to an electronic bulletin board in the field of entertainment for adults" ² will not be likely to cause confusion with opposer's pleaded marks PLAYBOY for "monthly magazines" ³ and HTTP://WWW.PLAYBOY.COM for "computer services, namely, providing on-line magazines in the field of fashion, entertainment, health, lifestyle and other topics of general interest" ⁴ because applicant already owns Registration No. 1,111,756 for the mark PLAYGUY for "entertainment magazines." ⁵

² Application Serial No. 74/721,428 includes services "providing entertainment information services" which were also opposed but which were not made part of applicant's motion for summary judgment.

³ Registration 600,018 issued December 28, 1954, renewed.

⁴ Registration No. 2,011,646 issued October 29, 1996.

⁵ Registration No.1,111,756 issued January 23, 1979, renewed.

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This affirmative defense, generally referred to as the *Morehouse* defense, is available in situations where the applicant already owns a registration for the same mark for substantially identical goods and services. It is based on the theory that opposer cannot be injured by the registration sought because there already exists a similar registration and, therefore, an additional registration for the same mark for substantially identical goods and services cannot add to the injury. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

In the order denying applicant's motion for summary judgment, the Board found that applicant could not avail itself of the *Morehouse* defense because the defense was not asserted in applicant's answer, because applicant had not sought to amend its pleading, and because the Board found that, as a matter of law, magazines and the on-line services specified in applicant's application are not substantially similar goods and services.

In applicant's request for reconsideration, it points out that on July 9, 1997, the Board, in fact, accepted applicant's amended answer. In its amended answer applicant specified that it was asserting an affirmative defense; pleaded its prior registration for the mark PLAYGUY for entertainment magazines; noted that its registration had co-existed for more than 20 years with opposer's PLAYBOY marks

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for "identical and closely related goods"; and alleged that because the services listed in its opposed application Serial No. 74/721,428 "are closely related to and a commercial extension of entertainment magazines," there is no likelihood of confusion.

The record shows that applicant's amended answer asserting the affirmative defense under *Morehouse* was accepted by Board order dated July 9, 1999. Therefore, to the extent the Board denied applicant's motion for summary judgment on the basis that it was an unpleaded defense, the Board's March 27, 2000 order is vacated.

However, that the *Morehouse* defense was unpleaded clearly was not the only basis for denial of applicant's motion for summary judgment. In the Board's March 27, 2000 decision on the availability of the *Morehouse* defense to applicant, the Board specifically held as follows:

Moreover, the Board finds as a matter of law that magazines and the on-line services in applicant's application are not substantially similar goods and services. Thus, in any event, applicant may not avail itself of the *Morehouse* defense.

The Board disagrees with applicant's position that the denial of summary judgment was based "to a large extent" on the Board's view as to whether the defense had been pleaded. In fact, the Board finds that its order denying summary judgment clearly informed the parties that, even if the

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issue had been properly pleaded, the fact that the goods in applicant's registration and the services in its opposed application were not substantially similar precluded applicant from availing itself of the *Morehouse* defense.

The Board has carefully considered the parties' arguments, has reviewed the evidence of record, and we remain of the view that the Board's March 27, 2000 decision denying applicant's motion for summary judgment is correct. Because the "entertainment magazines" identified in applicant's registration and the identified on-line services listed in applicant's application are not substantially identical goods and services, the *Morehouse* defense is not available to applicant as a matter of law. See *Pamex Foods, Incorporated v. Clover Club Foods Company*, 201 USPQ 308 (TTAB 1978).

Proceedings herein are resumed, and discovery and trial dates are reset as follows:

DISCOVERY to close	March 3, 2003
30-day testimony period for party in position of plaintiff to close:	June 1, 2003
30-day testimony period for party in position of defendant to close:	July 31, 2003
15-day rebuttal testimony period for plaintiff to close:	September 13, 2003

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

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on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.