

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

Mailed:
March 18, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Playboy Enterprises International, Inc.
v.
Rick Worobec

Opposition No. 91165814
to application Serial No. 78430099
filed on June 4, 2004

William T. McGrath of Davis McGrath LLC for Playboy
Enterprises International, Inc.

Claire F. Hawkins of Christensen O'Connor Johnson Kindness
PLLC for Rick Worobec

Before Walters, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Rick Worobec filed an intent to use application on the Principal Register for the mark PLAY BODY, in standard character format, for "clothing, namely, under garments, swimwear; footwear, namely shoes," in Class 25 (Serial No. 78430099). Playboy Enterprises International, Inc. has opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion. Opposer has alleged that applicant's mark PLAY BODY, when used in connection with clothing, is likely to cause confusion with

opposer's famous PLAYBOY trademarks, used in connection with a wide variety of goods and services, including clothing.¹ Applicant denied the salient allegations in the notice of opposition.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. Notice of reliance on a certified copy, showing the current status and ownership in opposer, of Registration No. 3140250 for the mark PLAYBOY, in standard character form, for lingerie, sleepwear, loungewear, wraps, and robes;²

2. Notice of reliance on applicant's responses to opposer's first set of requests for admission;

3. Notice of reliance on applicant's responses to opposer's first set of interrogatories;

¹ Opposer also alleged that the registration of applicant's mark will cause dilution of opposer's famous PLAYBOY trademarks, but presented no arguments in support of that claim in its brief. We therefore deem opposer to have waived its pleaded dilution ground, and we have given it no consideration.

² The registration issued September 5, 2006. Opposer claimed first use anywhere and first use in commerce on August 1, 1960.

4. Testimony deposition of Judy Kawal, opposer's Senior Director of Business Management in the licensing group, with attached exhibits; and,

5. Testimony deposition of Michelle McCoy, opposer's in-house trademark counsel, with attached exhibits.

B. Applicant's evidence.

1. Notice of reliance on opposer's responses to applicant's first set of interrogatories;

2. Notice of reliance on the definition of the word "Playboy" in Webster's Third New International Dictionary of the English Language, p. 1737 (1993); and,

3. Notice of reliance on 14 photocopies from the Trademark Office electronic search system of trademark registrations including the word "Play."

Standing

In her testimony deposition, Michele McCoy introduced into evidence certified copies of opposer's pleaded registrations showing their current status and their title in opposer. The following registrations were made of record:³

³ We previously noted that opposer introduced a certified copy of Registration No. 3140250 through a notice of reliance. Opposer also included a certified copy of Registration No. 2485583 for the mark PLAYBOY, in typed drawing form, for "clothing articles, namely, vest and bow ties, cummerbunds and pocket squares," in Class 25. That registration issued on September 4, 2001. However, no declaration of use in accordance with Section 8 of the Trademark Act of 1946 has been filed. Accordingly, we will not give this registration any further consideration.

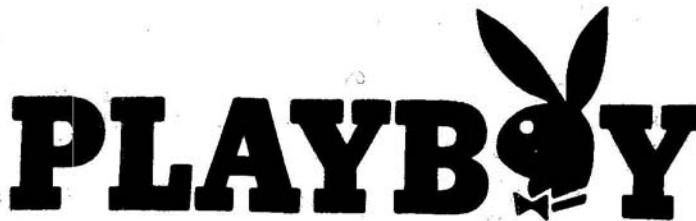
1. Registration No. 984548 for the mark PLAYBOY and design, shown below, for "articles of men's and women's clothing, namely, shirts, sleepwear, ties, sweaters, warm-up shirts," in Class 25;⁴



PLAYBOY

2. Registration No. 1328611 for the mark PLAYBOY, in typed drawing form, for "clothing articles, namely, shirts, ties, t-shirts, ski jackets, gym shorts, sweatpants, bathing suits, briefs, hosiery, sport socks, collared button-down knit shirts, sweat shorts, sweaters, velour tops, jogging suits, and shorts," in Class 25;⁵

3. Registration No. 1318244 for the mark PLAYBOY and design, shown below, for "footwear," in Class 25;⁶ and,



⁴ The registration issued on May 21, 1974; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

⁵ The registration issued on April 2, 1985; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

⁶ The registration issued on February 5, 1985; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

4. Registration No. 1320822 for the mark PLAYBOY, in typed drawing form, for "footwear," in Class 25.⁷

During her deposition Ms. McCoy also testified that Registration No. 0600018 for the mark PLAYBOY, in block letters, for a monthly magazine is an active registration and that opposer owns it.⁸

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in the opposition. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the

⁷ The registration issued on February 19, 1985; Sections 8 and 15 affidavits accepted and acknowledged; renewed.

⁸ The registration issued on December 28, 1954; Sections 8 and 15 affidavits accepted and acknowledged; third renewal. (McCoy Dep., pp. 18-20; Exhibits 36 and 37).

likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

A. Whether opposer's PLAYBOY mark is famous?

We turn first to the factor of fame, because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark . . . casts a long shadow which competitors must avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2s 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures

with competitive products, market share, reputation of the product, etc.). *Bose Corp. v. QSC Audio Products Inc.*, *supra*.

Opposer's primary business is the distribution of a monthly men's magazine. Over time, it has expanded into three separate divisions: publishing, entertainment (*i.e.*, wireless, online, and television), and licensing (*i.e.*, licensed products and freestanding locations including clubs and retail stores).⁹ The first issue of PLAYBOY magazine was distributed in December 1953, and it has been published continuously ever since. The first issue featured Marilyn Monroe on the cover.¹⁰ PLAYBOY magazine is the best selling monthly men's magazine in the world.¹¹ It is 14th largest "consumer publication" in the United States.¹² It has a paid circulation in the United States of 3 million, which is larger than *Esquire*, *GQ*, and *Men's Journal* combined.¹³ More than 10 million people read the magazine each month.¹⁴ In addition, opposer publishes, on average, 25 special editions per year. Those publications have a circulation of more than 2 million and a readership of approximately 7.5

⁹ Kawal Dep., p. 7.

¹⁰ McCoy Dep., p. 23.

¹¹ McCoy Dep., p. 23.

¹² McCoy Dep., p. 24.

¹³ McCoy Dep., p. 23; Exhibits 39-43 (publisher's statements by the Audit Bureau of Circulations, an independent third party that monitors circulation figures).

¹⁴ McCoy Dep., p. 24.

million.¹⁵ There is an online edition of PLAYBOY magazine, and it has more than 15,000 subscribers.¹⁶

In addition to its photographic pictorials of women, PLAYBOY magazine is noted for publishing interviews with famous people, including Jimmy Carter, Yasir Arafat, Donald Trump, Michael Jordan, Nicole Kidman, Jack Nicholson, George Clooney, Bill Gates, and others.¹⁷ Also, many noted authors have contributed to the magazine, including Jane Smiley, John Updike, Scott Turow, Kurt Vonnegut, Michael Creighton, and Stephen King.¹⁸ Some of the well-known women who have posed for PLAYBOY pictorials include Marilyn Monroe, Pamela Anderson, Anna Nicole Smith, Carmen Electra, Cindy Crawford, Drew Barrymore, Elle MacPherson, and Jenny McCarthy.¹⁹ Opposer also operates a PLAYBOY television network.

The PLAYBOY television network is available to approximately 30 million households in the U.S. and Canada.²⁰ The PLAYBOY trademark is prominently featured on network broadcasts.²¹ Also, opposer operates a radio

¹⁵ McCoy Dep., pp. 25-26.

¹⁶ McCoy Dep., p. 27.

¹⁷ McCoy Dep., pp. 27-28.

¹⁸ McCoy Dep., p. 28.

¹⁹ McCoy Dep., p. 29.

²⁰ McCoy Dep., pp. 29-30. We understand Ms. McCoy's testimony to be that 30 million households have access to the PLAYBOY television network, not that 30 million households subscribe or watch the PLAYBOY network.

²¹ McCoy Dep., p. 30.

channel on SIRIUS Satellite Radio. It airs 24 hours a day, 7 days a week.²²

Opposer has a retail website at www.playboystore.com. That website averages 500,000 "unique visitors every month," and it ships more than 300,000 orders annually.²³ In addition, opposer provides mail order service. It has distributed catalogs to over 10 million people.²⁴

Opposer's licensing business began in 1970.²⁵ Today, opposer licenses a wide variety of PLAYBOY branded products, including key chains, jewelry, outerwear, undergarments, shirts, swimwear, lingerie, socks, scarves, ties, footwear, headwear, apparel accessories, bags, luggage, and cosmetics.²⁶ In 2006, retail sales for all of opposer's PLAYBOY branded products was in excess of \$120 million, including \$40 million for apparel items.²⁷ In 2005, opposer's retail sales for PLAYBOY branded produces was also approximately \$120 million, and it was approximately \$115

²² McCoy Dep., p. 31.

²³ McCoy Dep., p. 32; Kawal Dep., p. 18. Subsequently, Ms. McCoy testified that "We do have a publicly available number for Playboy on-line, and it looks like we have 6 million unique visitors, and 68 million page views each month." McCoy Dep., p. 37. However, it is not clear whether Ms. McCoy's testimony is limited to the United States or references worldwide activity.

²⁴ McCoy Dep., p. 35; Kawal Dep., p. 19. It is not clear whether the testimony is referring to distribution in the United States or worldwide.

²⁵ Kawal Dep., p. 13.

²⁶ Kawal Dep. pp. 8-9, 11, and 26.

²⁷ Kawal Dep., p. 11. However, Ms. Kawal later testified that retail sales for apparel items averaged approximately \$50 million per year in 2004, 2005, and 2006. (Kawal Dep., p. 15).

million in 2004.²⁸ Opposer's licensees have spent in excess of \$900,000 per year advertising PLAYBOY branded products in 2004, 2005, and 2006.²⁹

PLAYBOY branded products can be found in approximately 3500 different stores in the United States, including Henri Bendel, Bloomingdales, Urban Outfitters, Hot Topic, Spencer Gifts, and Kitson.³⁰

Opposer receives unsolicited media attention in television, online, and in magazines and newspapers on almost a daily basis.³¹ For example, in the period between March 14, 2007 and March 20, 2007, "Playboy" was referenced on *The Tonight Show with Jay Leno* (NBC), *The Late Show* (CBS), *Two and a Half Men* (CBS), *Real Sports with Bryant Gumbel* (HBO), *The Real Housewives of Orange County* (Bravo), and *Paradise City* (ETV).³² Opposer is also referenced in the press (e.g., *Esquire*, *Newsweek*, *Teen Vogue*, *Chicago Tribune*, *Cosmopolitan*, *New York Post*, and the *New York Daily News*).³³

Opposer also receives unsolicited media attention when celebrities wear PLAYBOY apparel, including Justin

²⁸ Kawal Dep., p. 12.

²⁹ Kawal Dep., p. 15.

³⁰ Kawal Dep., p. 16.

³¹ McCoy Dep., pp. 40-41.

³² McCoy Dep., Exhibit 45.

³³ Kawal Dep., pp. 38-39; Exhibit 13.

Timberlake, Britney Spears, Christina Aguilera, Paris Hilton, Posh Spice, Jay-Z, and Jewel.³⁴

The Wikipedia website reports that "Playboy is one of the world's best known brands."³⁵ Finally, although applicant denies that the PLAYBOY mark is famous,³⁶ he admits that the "PLAYBOY trademark is widely recognized in the United States."³⁷

In view of the foregoing, opposer has established that its PLAYBOY mark is famous and thus entitled to a broad scope of protection.³⁸ In this regard, we note that several

³⁴ Kawal Dep., pp. 36-37; Exhibit 12.

³⁵ Kawal Dep., Exhibit 18 (<http://en.wikipedia.org>). We note this evidence simply for what is reported in Wikipedia and how its contributors perceive the PLAYBOY trademark. We also note that the May 15, 2003 issue of *Rolling Stone* magazine identified opposer's bunny logo as a significant American logo. The theme of the May issue was "American Icons." (Kawal Dep., Exhibit 16).

³⁶ Applicant's Response to Request for Admission No. 11.

³⁷ Applicant's Response to Request for Admission No. 10.

³⁸ Although we have found that PLAYBOY is famous for purposes of opposer's likelihood of confusion claim, we have not addressed the question of whether PLAYBOY is famous in the context of a dilution claim. Fame for likelihood of confusion and dilution is not the same. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition - it either exists or it does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion "[f]ame is relative . . . not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection").

courts have recognized that opposer's mark is strong and should be accorded a high degree of protection. *Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc.*, 687 F.2d 563, 215 USPQ 662, 665 (2nd Cir. 1982) (PLAYBOY is distinctive and is widely recognized); *Playboy Enterprises, Inc. v. Frena*, 839 F.Supp. 1552, 29 USPQ2d 1827, 1833 (M.D. Fla. 1993) (PLAYBOY is a well-known mark and widely associated with Playboy Enterprises); *Playboy Enterprises, Inc. v. P. K. Sorren Export Company, Inc. of Florida*, 546 F.Supp. 987, 218 USPQ 795, 800 (S.D. Fla. 1982) (PLAYBOY is a strong mark, entitled to broad protection). In addition, we also note that applicant has not introduced any evidence of third party uses of PLAYBOY that would weaken the strength of opposer's mark. The 14 third-party registrations consisting, in whole or in part, of the word "play" for clothing are insufficient to show that opposer's mark is a weak mark entitled to a limited scope of protection.

B. The similarity or dissimilarity and nature of the goods as described in the application and registration.

The goods identified in applicant's application are "clothing, namely, under garments, swimwear; footwear, namely shoes." Opposer has pleaded and proven ownership of registrations that include a wide variety of clothing, including lingerie, briefs, bathing suits, and footwear. Thus, the goods at issue are at least in part identical.

The fact that the only some of the products listed in the description of goods are identical is sufficient to support finding that there is a likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any items that comes within the identification of goods in the application). The fact that opposer's registrations include additional items does not obviate the relatedness of the identical products. *Id.*

C. The similarity or dissimilarity of established, likely-to-continue trade channels and buyers to whom sales are made.

Given the identical nature of the parties' goods (clothing, namely, under garments, swimwear, and footwear) and the absence of any trade channel restrictions in either party's description of goods, we must presume that the clothing products of the parties would be marketed in the same channels of trade, to the same classes of purchasers. *Genesco Inc. v. Martz*, 66 USPQ2d 1260 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any trade restrictions in the identifications thereof as to channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ 1531, 1532

(TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"); *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1450 (TTAB 1987).

D. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). *See also In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

Opposer's PLAYBOY marks and applicant's PLAY BODY mark are similar in appearance because they share the word "play" at the beginning of the mark, followed by the letters "BO," in "boy" and "body," and ending in the letter "y." The significance of the word "play" is highlighted by its location as the first word of each mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, *supra* (upon encountering the marks, consumers must first notice the identical lead word). While there are differences between the appearance of opposer's PLAYBOY mark and applicant's PLAY BODY mark, the similarities outweigh the dissimilarities.

Likewise, we find that the marks are more aurally similar than dissimilar.

The marks PLAYBOY and PLAY BODY have different meanings. The word "Playboy" is a recognized word meaning "a young and wealthy man who lives a frivolous indolent life

devoted chiefly to the pursuit of pleasure.”³⁹ On the other hand, the term “play body” appears to be a coined term without any recognized meaning. However, because of the renown of opposer’s PLAYBOY marks, consumers may associate the marks PLAYBOY and PLAY BODY with a single source because of the emphasis opposer places on photographic pictorials of women in its magazines. The marks engender a similar commercial impression created, on the one hand, by the above-noted meaning of the word “playboy” and opposer’s renown for featuring naked women in its magazines, and, on the other hand, by applicant’s use of the word “body” in its mark PLAY BODY causing consumers to draw a connection between PLAY BODY and PLAYBOY featuring photographs of women’s bodies.

While there are differences between the marks PLAYBOY and PLAY BODY, we find that on balance the similarities outweigh the differences.

E. Balancing the factors.

In view of the fame of opposer’s PLAYBOY mark, the identity of the goods, and the similarity of the marks, we find that applicant’s use of PLAY BODY, in connection with “clothing, namely, under garments, swimwear; footwear, namely shoes,” is likely to cause confusion with the mark

³⁹ Webster’s Third New International Dictionary of the English Language Unabridged, 1737 (1993) introduced through applicant’s second notice of reliance.

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PLAYBOY for clothing, including lingerie, briefs, bathing suits, and footwear.

Decision: The opposition is sustained and registration to applicant is refused.